

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 2125558 BY FRANK BOYD
TO REGISTER THE MARK TARTAN GLORY
IN CLASS 33**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER 47707
BY THE SCOTCH WHISKY ASSOCIATION**

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DECISION

On 5 March 1997 Frank Boyd applied to register the mark TARTAN GLORY in Class 33 for “Scotch whisky, vodka, gin, spirits.” The application is numbered 2125558.

On 30 October 1997 The Scotch Whisky Association filed notice of opposition to this application. The single ground of opposition is set out in the following paragraph:

“The trade mark applied for incorporates the word “TARTAN”. Scotland is noted for tartan and the mark is therefore highly evocative of Scotland. Scotland is famous for the production of Scotch Whisky, being whisky lawfully produced in Scotland and nowhere else, and Scotch Whisky Liqueurs being liqueurs which have been wholly produced in Scotland whose sole alcoholic constituent is Scotch Whisky. In view of the strong Scottish connotation of the mark applied for and Scotland’s reputation for the production of Scotch Whisky and Scotch Whisky Liqueurs, the use of the mark applied for upon any whisky or any drink containing whisky which is not Scotch Whisky or a Scotch Whisky Liqueur, as the case may be, will be of such a nature as to deceive the public as to the geographical origin of the goods. Registration of the mark in respect of “spirits” (which may include whisky and whisky liqueurs other than Scotch Whisky and Scotch Whisky liqueurs) would therefore be contrary to the provisions of Section 3(3)(b) of the Trade Marks Act 1994.”

The opponents set out three separate consequences as follows:

- “ (a) that the application be refused in so far as “spirits” are concerned, or
(b) that the application for spirits be refused in so far as whisky and alcoholic beverages containing whisky are concerned, save in respect of Scotch Whisky or Scotch Whisky Liqueurs produced in Scotland, or
(c) that the application for registration be refused ”

The opponents ask for an award of costs in their favour.

The applicant neither filed a counterstatement nor evidence. The opponents filed evidence. Neither side has asked to be heard. After a careful study of the papers I give this decision.

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The opponents filed a statutory declaration by Quintin Kennedy Stewart, the Company Secretary of the Scotch Whisky Association.

10 As the applicant has not played an active part in these proceedings and has not challenged any of the opponents' claims I do not propose to offer a full evidence summary. The main points are:

- Mr Stewart describes the role and functions of the Scotch Whisky Association

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- the description "Scotch Whisky" is geographical in meaning and means whisky which has been wholly distilled and matured in Scotland. Scotch Whisky has been defined in UK law since 1933. The current United Kingdom statutory definition is to be found in Section 3 of The Scotch Whisky Order 1990 (SI No 998) (it is unnecessary for me to record further details)

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- substantiating information is given on the size of the Scotch Whisky industry, the registration and goodwill built up in it and the efforts made to protect it

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- Mr Stewart suggests that tartan is highly evocative of Scotland and often features on labels either pictorially or as part of a brand name. He says that the Registry's work practices recognise this position.

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- in addition to its reputation for whisky, Scotland is famous for the production of Scotch whisky liqueurs

Exhibits A to F have been supplied in support of the opponents' evidence.

Section 3(3)(b) reads:

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“ (3) A trade mark shall not be registered if it is -

(a)

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(b) of such a nature as to deceive the public (for instance as to the nature, quality or geographical origin of the goods or service).

The following extracts from the Work Manual serve to indicate the position adopted by the Registry.

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“9.4 Form of wording agreed with the Scotch Whisky Association

The Scotch Whisky Association is concerned about the treatment of marks evocative of Scotland which are sought to be registered in respect of whisky and whisky based

liqueurs. A form of wording has been agreed with The Scotch Whisky Association which should be used whenever possible.

5 Use of the following terms in specifications will avoid/overcome a 3(3)(b) objection to marks which are evocative of Scotland and applied for in respect of a specification which consists of, or includes whisky or liqueurs:

“Scotch whisky”

10 “Scotch whisky based liqueurs produced in Scotland”

“Alcoholic beverages, but in so far as whisky and whisky based liqueurs are concerned only Scotch whisky and Scotch whisky based liqueurs produced in Scotland.”

15 **Note:** It is, of course, open to any applicant to challenge the general practice, or to argue that a proposed specification is sufficient to overcome an objection under Section 3(3)(b) of the Act. Any alternative wording suggested by an applicant should be considered on its merits. (PAC 23/96 refers).”

20 (Chapter 6 Examination and Practice)

The Addendum (Practice Guide) to Chapter 6 has the following under “Scottish references”

25 “Words and devices such as THISTLE, TARTAN, HIGHLAND, GLEN or LOCH strongly suggest Scotland or Scottish goods. In the case of goods where Scotland has a reputation, like whisky, knitwear, salmon, spring water, beef, biscuits etc., a Section 3(3)(b) objection may be appropriate. This could be overcome by a limitation of the specification but of course, the mark as a totality must also be distinctive.”

30 Although the mark applied for is TARTAN GLORY and not TARTAN solus it does not on that account escape objection under Section 3(3)(b). Words such as GLEN and LOCH are almost always associated with other words but that does not in itself detract from an association with Scotland. I take the view that the mark applied for is likely to be strongly evocative of Scotland.

35 As indicated in the extract from the Work Manual (9.4) it is open to an applicant to challenge the general practice or to propose a specification which would overcome the objection. No such challenge or proposal has been made by the applicant in this case. I, therefore, find that the objection is made out insofar as the specification contains the (unrestricted) term “spirits” -
40 the other terms either do not require amendment (Scotch whisky being acceptable) or do not attract objection (vodka and gin). The term “spirits” is usually taken to mean any distilled alcoholic liquor and could, therefore, include whiskies other than Scotch whisky. The applicant has made no attempt to limit the term “spirits” and in the absence of argument or written submissions on the point it is not clear to me whether in normal usage the term would
45 be understood to include liqueurs and so be susceptible to outcome (b) of the opponents’ grounds (set out at the start of the decision).

The outcome is therefore that the application can proceed to registration if, within one month of the end of the appeal period for this decision, the applicant files a Form TM21 amending his specification to “Scotch whisky, vodka, gin”. If the applicant does not amend his specification in this way the application will be refused in its entirety.

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The opponents made clear their area of concern and have been successful in their attack. The applicant could have taken steps to meet their concerns but failed to do so. The opponents are, therefore, entitled to a contribution towards their costs even if, as a result of this decision, the applicant elects to amend his specification as proposed above.

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I order the applicant to pay the opponents the sum of £500.

Dated this 11 day of January 2000

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**M REYNOLDS
For the Registrar
the Comptroller General**

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