

O-159-16

**TRADE MARKS ACT 1994
IN THE MATTER OF REGISTRATION 3020359
FOR THE TRADE MARK:**

THE GLASGOW DISTILLERY
— THE PUMP HOUSE - CLYDESIDE —

**STANDING IN THE NAME OF
MORRISON GLASGOW DISTILLERS LIMITED
(FORMERLY:
THE GLASGOW DISTILLING COMPANY LIMITED)
AND
APPLICATION 500821
BY GLASGOW DISTILLERY COMPANY LIMITED
FOR A DECLARATION THAT THE TRADE MARK IS
INVALID**

Background and pleadings

1) This is an application by Glasgow Distillery Company Limited (“the applicant”) to have registration 3020359 for the following mark declared invalid:

THE GLASGOW DISTILLERY

— THE PUMP HOUSE - CLYDESIDE —

2) The application to register the trade mark was filed on 2 September 2013 by The Glasgow Distilling Company Limited, which changed its name during the course of these proceedings to Morrison Glasgow Distillers Limited (“the proprietor”), in which name the mark now stands registered; it was registered on 7 March 2014 for the services in classes 16, 18, 21, 24, 25, 28, 30, 33, 35, 41 and 43 which are shown in the annex to this decision.

3) The application to invalidate the registration was filed on 7 April 2015. Invalidation is sought in respect of all the goods and services of the registration. The grounds for invalidation are that registration of the trade mark was contrary to sections 3(1)(b) and 3(1)(c) of the Trade Marks Act 1994 (“the Act”) because:

- The words “PUMP HOUSE - CLYDESIDE” in the mark denote a non-distinctive address, and are presented in a *de minimis* way within the challenged mark.
- The extremely slight stylisation in the challenged mark is not sufficient to impact upon the mind of the consumer and distract from the fact that its essential feature consists of the words “THE GLASGOW DISTILLERY”, which will directly alert the relevant consumer to the nature and characteristics of the registered goods and services, therefore being a sign such as other traders might legitimately wish to use.
- The mark being entirely descriptive of characteristics of goods and services, its registration is contrary to section 3(1)(c), and will also be devoid of any distinctive character under section 3(1)(b), being thus incapable of performing the essential function of guaranteeing the origin of the relevant products and services to the consumer or end user by enabling him, without any possibility of confusion, to distinguish the product or service from others which have another origin

4) The proprietor filed a counterstatement denying the applicant’s claims and putting it to strict proof of them. In particular, it denies that the words “THE PUMP HOUSE – CLYDESDIDE” denote a non-distinctive address, or that the stylisation of the mark does not impact on the mind of the consumer. It asserts that the applicant has sought to dissect the mark, whereas it is the combination of features which render the mark distinctive, and it considers that the registrar did not err in finding that the mark met the requirements for registration.

5) The applicant is represented by jtTM Consultancy Limited. The proprietor is represented by Murgitroyd & Company. Both sides filed evidence and written submissions during the evidence rounds. The proprietor also filed written submissions

in lieu of attendance at a hearing. The parties' pleadings and witness statements contain a number of what amount to submissions in relation to the grounds. I take these into account in what follows along with the evidence and written submissions filed. Neither party asked to be heard. I therefore give this decision after a careful consideration of the papers before me.

The applicant's evidence

6) In a witness statement of 12 August Mr Ian McDougall, a director of the applicant, explains how an application at the UK Intellectual Property Office to protect the word mark GLASGOW DISTILLERY COMPANY for alcoholic spirits goods in class 33 was refused on the grounds that it was a sign which may serve in trade to designate the kind and geographical origin of alcoholic spirits which are from a distillery company in Glasgow; that it was not capable of individualising the goods of one undertaking from those of another and that, consequently, the average consumer would not attach any trade mark significance to the words. In a subsequent conversation with an examiner, he states, it had been explained to one of Mr McDougall's co-directors that no party would likely be able to register a mark featuring words like GLASGOW DISTILLERY COMPANY owing to their descriptive nature. This had provided the applicant with some comfort that, although it might not itself be able to obtain registered rights in GLASGOW DISTILLERY COMPANY, in the absence of any significant amount of trade use at that time the chances of the applicant facing an allegation that its use conflicted with another company's registered or unregistered trade mark rights were much reduced.

7) Mr McDougall says it had therefore been a shock for the applicant to receive a solicitor's letter of 23 June 2014, which he appends as **Exhibit IM2**, in which the proprietor claimed to own unregistered rights in the words GLASGOW DISTILLERY. A desire to seek some sort of answer on the seeming disparity between the treatment of the challenged registration and the strength of objection raised against the applicant's earlier application for GLASGOW DISTILLERY COMPANY had contributed to the applicant's decision to file the current invalidity action.

8) Mr McDougall goes on to submit that the main part of the challenged mark consists of the descriptive words THE GLASGOW DISTILLERY, the words THE PUMP HOUSE – CLYDESIDE simply providing further description and clarification of the physical location of the owner's premises. He appends as **Exhibit IM3** extracts from various articles containing references to the premises of the proprietor. Although these articles do not pre-date the filing of the challenged registration (he states it to be his understanding that no public-facing use was made by the owner of the challenged registration in advance of filing for the challenged registration), he submits that these articles demonstrate that references to the pump house premises and to the situation of these premises by the Clyde are made in a descriptive way, and that such descriptive use is the obvious and natural way to refer to the location of the premises of the owner of the challenged registration.

9) Mr McDougall submits that Consumers would not need to be educated that THE PUMP HOUSE section of the mark of the challenged registration is anything more than descriptive clarification of the location of the owner's premises, and would be

aware that the word CLYDESIDE simply describes the location of the owner's premises, rather than attaching any trade mark significance to this word.

10) In a second witness statement of the 4 December 2015 in reply to the proprietor's evidence, Mr McDougall provides the following evidence on the use of the term "Clydeside":

- **Exhibit IM5** contains Wikipedia entries for "Greater Glasgow", stating that this region "*uses numerous other terms for itself, including Metropolitan Glasgow, the metropolitan City-Region of Glasgow, Glasgow and the Clyde Valley, and Clydeside,*" and for the "River Clyde", stating that "*The shipbuilding firms became 'household names' on Clydeside*".
- **Exhibit IM6** consists of extracts from the online Merriam-Webster dictionary, from three travel guide websites referring to Clydeside, and from the website of Riverside Museum in Glasgow, providing directions to visitors to walk '*just along the Clydeside*'..
- **Exhibit IM7** contains details of the A814 in Glasgow, called the Clydeside Expressway as it runs along the North bank of the River Clyde, with a map showing it running beside Stobcross Road, where the proprietor's premises are located.
- **Exhibit IM8** shows the Wikipedia entry for 'Red Clydeside', being the name given to an era of political activism in Glasgow and in the areas around the city on the banks of the Clyde.
- **Exhibit IM9** contains extracts from *British Pathe's* library of newsreel footage, showing the term "Clydeside" being used to describe the area by the River Clyde in Glasgow and surrounding areas since at least the early 20th century.

11) In a witness statement of 12 August 2015 Ms Jude Tonner, a director of the applicant's representatives in these proceedings, appends as **Exhibit JT1** an extract from the Intellectual Property Office's "Manual of trade marks practice" providing a specific example of a permissible alteration to a registered trade mark, as follows:

"Examples

... 1. A pictorial mark of a Scottish rural scene, such as a whisky label, including the address 'The Old Distillery, Aberdeen' in small print could be changed to 'The New Distillery, Glasgow', because the mark includes an address and the alteration would not substantially affect the identity of the mark."

She observes: "*Without entering into a hypothetical examination of whether the provisions of section 44(2) of the Trade Marks Act 1994 may be applicable if the the registered proprietor were to move premises, this particular example is submitted to be apt within the present proceedings. In the example address, 'The Old Distillery, Aberdeen' uses the structure '[building name/identifier] [common punctuation mark] (geographical location)'. This is mirrored by the smaller, secondary wording*

seen in the registered proprietor's mark, specifically 'THE PUMP HOUSE – CLYDESIDE'". She submits that this could only be perceived as an address or part of an address in the context of the presentation and overall impact of the challenged mark as a whole (i.e.- a description or identifier of the geographical location of the owner's commercial premises).

The Proprietor's evidence

12) In a witness statement of 6 October 2015 Ms Eleanor Gail Coates, a Senior Trade Mark Attorney with the proprietor's representatives, explains that the proprietor is proposing to operate a whisky distillery and visitor centre in Glasgow on the site of the former Maritime Museum, where tall ship Glenlee was berthed until its relocation. She appends as **Exhibit EGC1** an article from the Glasgow based newspaper *The Herald*. The report includes the following: "*The former pump house at Queens Dock by the Clyde, near where the tall ship Glenlee was once berthed, is to be converted into a single malt distillery with a bar, cafe, tasting room and shop ... The project is the brainchild of a team of experts led by Tim Morrison ... Mr Morrison said: ... Our vision for the new distillery and educational visitor centre is that it becomes a part of Glasgow's busy tourist trail. We anticipate it will attract more than 50,000 visitors a year ... The pump house was recently at the centre of proposals to turn it into a luxury hotel. It was bought by Glasgow City Council for £450,000 from the Clyde Maritime Trust A planning application has been submitted to Glasgow City Council for the site, which Mr Morrison said had once played a historically significant role in the whisky trade on the Clyde*".

13) Ms Coates states that the words THE PUMPHOUSE and CLYDESIDE do not represent or form any part of the proprietor's address, the formal and correct address of the site in fact being: 100 Stobcross Road, Glasgow, G3 8QQ. In support of this statement she appends: an extract from the Post Office postcode address finder (**Exhibit EGC2**); extracts from planning application lists showing 100 Stobcross Road, Glasgow, G3 SQQ as the subject of an application for "conversion and extension of listed building to form distillery visitor centre ..." (**Exhibit EGC3**); copy of the planning decision (**Exhibit EGC4**); an extract from Historic Scotland's listed building database for 100 Stobcross Road, Queen's Dock, former hydraulic pumping station; an internet extract showing a list of museums around the Glasgow area, including a reference to The Tall Ship formerly berthed at the site, and showing the address as 100 Stobcross Road, Glasgow, Strathclyde, G3 8QQ (**Exhibit EGC6**); extracts from Glasgow City Council's website mapping and listing areas of the city, and from the internet, listing the areas to the north and south of the River Clyde, none of which contain a reference to "Clydeside" (**Exhibit EGC7**). Ms Coates contends that "*These extracts show that there is no formal area in Glasgow referred to as Clydeside or named accordingly*".

The law

14) Section 47(1) of the Act is as follows:

“47. - (1) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 3 or any of the provisions referred to in that section (absolute grounds for refusal of registration).

Where the trade mark was registered in breach of subsection (1)(b), (c) or (d) of that section, it shall not be declared invalid if, in consequence of the use which has been made of it, it has after registration acquired a distinctive character in relation to the goods or services for which it is registered.

[...]

(5) Where the grounds of invalidity exists in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made.

Provided that this shall not affect transactions past and closed.”

15) Section 3(1) of the Act is as follows:

“3(1) The following shall not be registered –

(a)

(b) trade marks which are devoid of any distinctive character,

(c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,

(d)....

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.”

Preliminary matters

16) In its submissions the proprietor draws analogies with third party registrations on the register. Such analogies are generally problematic, not least because I do not know the grounds on which they were accepted; they may have been accepted on the basis of acquired distinctiveness. I must decide the present case on its own facts.

17) Nor is the mere fact that, prior to the registration of the contested mark, the registrar considered the arguments now raised by the opponent ex parte, and decided that the mark was registrable, a factor to which I can, or should, attach any weight.

This is because in inter partes proceedings the registrar must act as an independent tribunal and judge the matter purely on the basis of the arguments and evidence presented in those proceedings. However, section 72 of the Act states that registered trade marks should be treated as prima facie valid, so it is for the applicant to show that the proprietor's mark was registered contrary to section 3(1) of the Act.

18) Since the proprietor has neither pleaded acquired distinctiveness, nor claimed it in its submissions or evidence, I have only the inherent distinctiveness of the contested mark to consider. The date of application for the mark was 2 September 2013. Since there is no claim to acquired distinctiveness, the question under section 47(1) of whether the mark was registered in breach of section 3(1)(b) or 3(1)(c) falls to be decided as of this date. Use of the contested mark not having been put in issue, the letter in **Exhibit IM2** has no bearing on these proceedings, and I have taken no account of it.

19) Each of the claimant's claims for a declaration of invalidity calls for an assessment of the distinctiveness of the defendant's mark, that is to say, its capacity to distinguish the services of one undertaking from those of other undertakings. It is well-established that what matters is the overall impression given by the mark as a whole, although in assessing the impact of the whole it is permissible to consider the parts from which it is made up provided that the tribunal does not engage in a salami-slicing approach¹.

20) It is also well-established that the distinctive character of a mark must be assessed in relation to the goods or services in respect of which registration is applied for or obtained, and by reference to the perception of the average consumer of such goods or services². The average consumer of the following goods or services of the registration will primarily represent business consumers: in Class 16 office requisites (except furniture); in Class 18 animal skins, hides; in Class 21 unworked or semi-worked glass; in Class 35 retail services and on-line retail services connected with the sale of office requisites (except furniture), unworked or semi-worked glass; arranging and conducting of talks and tastings for promotional and advertising purposes; arranging of competitions for trade, commercial and business purposes; distribution and dissemination of advertising matter and information; in Class 41 corporate hospitality (entertainment); in Class 43 corporate hospitality (provision of food and drink). The average consumer of all the other goods and services in all the classes of the proprietor's specification consists for the greater part of the general public, though there may also be some business consumers.

21) It will be convenient to consider the applicant's challenge to the proprietor's mark first under section 3(1)(c) and then 3(1)(b).

Section 3(1)(c)

22) The case law under section 3(1)(c) was summarised by Arnold J. in *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2012] EWHC 3074 (Ch):

¹ See *Hormel Foods Corp v Antilles Landscape Investments NV* [2005] RPC 28 at paragraph 123

² *ibid* at paragraph 121.

“91. The principles to be applied under art.7(1)(c) of the CTM Regulation were conveniently summarised by the CJEU in *Agencja Wydawnicza Technopol sp. z o.o. v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-51/10 P) [2011] E.T.M.R. 34 as follows:

“33. A sign which, in relation to the goods or services for which its registration as a mark is applied for, has descriptive character for the purposes of Article 7(1)(c) of Regulation No 40/94 is – save where Article 7(3) applies – devoid of any distinctive character as regards those goods or services (as regards Article 3 of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40 , p. 1), see, by analogy, [2004] ECR I-1699 , paragraph 19; as regards Article 7 of Regulation No 40/94 , see *Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) v Wm Wrigley Jr Co* (C-191/01 P) [2004] 1 W.L.R. 1728 [2003] E.C.R. I-12447; [2004] E.T.M.R. 9; [2004] R.P.C. 18 , paragraph 30, and the order in *Streamserve v OHIM* (C-150/02 P) [2004] E.C.R. I-1461 , paragraph 24).

36. ... due account must be taken of the objective pursued by Article 7(1)(c) of Regulation No 40/94 . Each of the grounds for refusal listed in Article 7(1) must be interpreted in the light of the general interest underlying it (see, inter alia , *Henkel KGaA v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-456/01 P) [2004] E.C.R. I-5089; [2005] E.T.M.R. 44 , paragraph 45, and *Lego Juris v OHIM* (C-48/09 P) , paragraph 43).

37. The general interest underlying Article 7(1)(c) of Regulation No 40/94 is that of ensuring that descriptive signs relating to one or more characteristics of the goods or services in respect of which registration as a mark is sought may be freely used by all traders offering such goods or services (see, to that effect, *OHIM v Wrigley* , paragraph 31 and the case-law cited).

38. With a view to ensuring that that objective of free use is fully met, the Court has stated that, in order for OHIM to refuse to register a sign on the basis of Article 7(1)(c) of Regulation No 40/94 , it is not necessary that the sign in question actually be in use at the time of the application for registration in a way that is descriptive. It is sufficient that the sign could be used for such purposes (*OHIM v Wrigley*, paragraph 32; *Campina Melkunie* , paragraph 38; and the order of 5 February 2010 in *Mergel and Others v OHIM* (C-80/09 P), paragraph 37).

39. By the same token, the Court has stated that the application of that ground for refusal does not depend on there being a real, current or serious need to leave a sign or indication free and that it is therefore of no relevance to know the number of competitors who have an interest, or who might have an interest, in using the sign in question (Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee* [1999] ECR I-2779, paragraph 35, and Case C-363/99 *Koninklijke KPN Nederland*

[2004] ECR I-1619, paragraph 38). It is, furthermore, irrelevant whether there are other, more usual, signs than that at issue for designating the same characteristics of the goods or services referred to in the application for registration (*Koninklijke KPN Nederland*, paragraph 57).

And

46. As was pointed out in paragraph 33 above, the descriptive signs referred to in Article 7(1)(c) of Regulation No 40/94 are also devoid of any distinctive character for the purposes of Article 7(1)(b) of that regulation. Conversely, a sign may be devoid of distinctive character for the purposes of Article 7(1)(b) for reasons other than the fact that it may be descriptive (see, with regard to the identical provision laid down in Article 3 of Directive 89/104, *Koninklijke KPN Nederland*, paragraph 86, and *Campina Melkunie*, paragraph 19).

47. There is therefore a measure of overlap between the scope of Article 7(1)(b) of Regulation No 40/94 and the scope of Article 7(1)(c) of that regulation (see, by analogy, *Koninklijke KPN Nederland*, paragraph 67), Article 7(1)(b) being distinguished from Article 7(1)(c) in that it covers all the circumstances in which a sign is not capable of distinguishing the goods or services of one undertaking from those of other undertakings.

48. In those circumstances, it is important for the correct application of Article 7(1) of Regulation No 40/94 to ensure that the ground for refusal set out in Article 7(1)(c) of that regulation duly continues to be applied only to the situations specifically covered by that ground for refusal.

49. The situations specifically covered by Article 7(1)(c) of Regulation No.40/94 are those in which the sign in respect of which registration as a mark is sought is capable of designating a 'characteristic' of the goods or services referred to in the application. By using, in Article 7(1)(c) of Regulation No 40/94, the terms 'the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service', the legislature made it clear, first, that the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service must all be regarded as characteristics of goods or services and, secondly, that that list is not exhaustive, since any other characteristics of goods or services may also be taken into account.

50. The fact that the legislature chose to use the word 'characteristic' highlights the fact that the signs referred to in Article 7(1)(c) of Regulation No 40/94 are merely those which serve to designate a property, easily recognisable by the relevant class of persons, of the goods or the services in respect of which registration is sought. As the Court has pointed out, a sign can be refused registration on the basis of Article 7(1)(c) of Regulation No 40/94 only if it is reasonable to believe that it will actually be recognised by the relevant class of persons as a

description of one of those characteristics (see, by analogy, as regards the identical provision laid down in Article 3 of Directive 89/104, *Windsurfing Chiemsee*, paragraph 31, and *Koninklijke KPN Nederland*, paragraph 56).”

92. In addition, a sign is caught by the exclusion from registration in art.7(1)(c) if at least one of its possible meanings designates a characteristic of the goods or services concerned: see *OHIM v Wrigley* [2003] E.C.R. I-12447 at [32] and *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* (C-363/99 [2004] E.C.R. I-1619; [2004] E.T.M.R. 57 at [97].”

23) Looking at the general impression conveyed by the mark as a whole it is very clearly the words THE GLASGOW DISTILLERY which are intended to attract the attention, and I will deal with them first. The average consumer will be aware of distilleries as being places where the goods of the proprietor’s specification in Class 33 – i.e. *alcoholic beverages; spirits; liqueurs; in so far as whisky and whisky based drinks are concerned such products being Scotch and/or Scotch based, all being produced in Scotland; Scotch whisky; gin* – are produced and may be retailed; accordingly, they will perceive the words THE GLASGOW DISTILLERY used in connection with all the proprietor’s Class 33 goods, and with *retail services and on-line retail services connected with the sale of alcoholic beverages, spirits, whisky, gin, liqueurs and arranging and conducting of talks and tastings for promotional and advertising purposes* in Class 35 of the proprietor’s specification, as descriptive of one of their characteristics; namely, that they are produced or provided by a distillery in Glasgow. The use of the definite article will not alter that immediate perception.

24) Similarly, the average consumer of the following services of the proprietor’s specification will perceive these too as services provided by distilleries: in Class 41: *education and entertainment services, all relating to the manufacture, production, sale and consumption of whisky; whisky tasting services; publication of tasting notes and bottling lists; arranging and conducting talks, tastings; publication of tasting notes and bottling lists*. In addition, the proprietor’s services include some broad terms which include within their ambit services of which the words THE GLASGOW DISTILLERY would be descriptive in the sense described above, with the result that the term as a whole is not acceptable³. Certain *education services relating to the manufacture, production, sale and consumption of whisky* are also covered by *provision of courses of instruction for tourists; arranging of courses of instruction for tourists. Entertainment services relating to the manufacture, production, sale and consumption of whisky; arranging and conducting talks, tastings* also fall within the ambit of *presentation of live performances, cultural facilities and overlap corporate hospitality (entertainment) and provision of club recreation services*. In like manner, in Class 43 *bar services; services for providing drink; corporate hospitality (provision of food and drink); whisky tasting services (provision of beverages)* would also be regarded by the relevant public as covering services likely to be provided by distilleries. In respect of

³ I have considered whether any of these broader terms could be amended to exclude services for which these words would be descriptive. Whilst this might perhaps theoretically be possible, I consider that the nature of the proprietor’s actual area of commercial interest, as reflected in the evidence, would make this an empty exercise in substance. The proprietor submitted no fall-back position, and its submissions do not indicate an interest in amendments of this kind. In the circumstances I do not consider it appropriate to consider revised specifications.

these services too, therefore, the words THE GLASGOW DISTILLERY will be perceived by the average consumer as descriptive of one of their characteristics; namely, that they are provided by a distillery in Glasgow.

25) Thus, the words THE GLASGOW DISTILLERY may serve in trade to designate the kind and geographical origin of all the goods and services I have specified in paragraphs 23 and 24. The population of Glasgow is nearly 600,000; the words THE GLASGOW DISTILLERY could apply to any distillery in Glasgow providing these goods and services, and to that extent are not capable of individualising the goods and services of one undertaking from those of another.

26) That leaves the words THE PUMP HOUSE – CLYDESIDE, flanked by two plain straight lines, presented unobtrusively in much smaller print at the bottom of the contested mark in the manner of an address. The proprietor submits that these words are not an address, that CLYDESIDE is not a recognised district for official purposes, and that both CLYDESIDE and THE PUMP HOUSE have distinctive character in respect of all the goods and services in issue. The applicant submits that the words THE PUMP HOUSE – CLYDESIDE constitute an address, and that an address constitutes an indication of geographical origin within the meaning of section 3(1)(c); it also pleads that these words can be regarded as “*de minimis*” in the context of the whole mark. Before explaining my own assessment of the significance of these words in the mark it is appropriate to examine the issues raised by the parties in their submissions with regard to these words.

27) I understand the applicant’s view to be that such an address, being in the strict sense a precise geographical location, in itself constitutes an indication of geographical origin within the meaning of section 3(1)(c). I cannot agree. The general interest underlying section 3(1)(c) is that of ensuring that descriptive signs relating to one or more characteristics of the goods or services in respect of which registration as a mark is sought may be freely used by all traders offering such goods or services. Clearly, other producers of alcoholic beverages may wish to describe their products as originating in Glasgow or Clydeside; but they can have no interest in associating their products with, or describing them by reference to, the particular premises occupied by the proprietor. (Moreover, such an address given on a label need not even necessarily indicate the place of production of the goods or provision of the services in question; it could, for example, be an administrative address). The address on the contested mark does not, therefore, constitute an indication of geographical origin within the meaning of section 3(1)(c).

28) In support of its contention that THE PUMP HOUSE – CLYDESIDE is not an address the proprietor files the evidence appended to the witness statement of 6 October 2015 of Ms Coates, as described above, to show that “*there is no formal area in Glasgow referred to as Clydeside or named accordingly*”, and that the normal address for postal purposes, and the address by which the proprietor’s premises are specified for formal purposes, such as planning permission, does not consist of the words shown in the contested mark. In assessing this issue I must not lose sight of the fact that what matters here is the perception of the average UK consumer. Whether or not there is an area designated as Clydeside for formal postal, administrative or legal purposes, I am satisfied that the average UK consumer will perceive this term as descriptive of a geographical area in Scotland, in the same way

as s/he recognises terms such as Merseyside, Tyneside, Teesside, Speyside, etc. as indicating particular areas or districts. The evidence submitted by the applicant, particularly the extracts from *British Pathé's* library of newsreel footage showing consistent use of the term over a considerable period during 20th century, confirms me in this conclusion. It is not uncommon to see descriptions of buildings formerly used for other purposes now used as part of the address of current occupiers, whether private or commercial. Whether or not the average UK consumer would be aware that there is a building in Glasgow referred to as THE PUMP HOUSE, I am satisfied that s/he would perceive the words THE PUMP HOUSE – CLYDESIDE, presented unobtrusively in small print along the bottom of the contested mark, simply as an address.

29) I am not, however, convinced that the average consumer will even get as far as reading these words. Looking at the mark as a whole, the disparity of treatment between the words THE GLASGOW DISTILLERY and the words THE PUMP HOUSE – CLYDESIDE is striking. The impression is that they are inconspicuous by design. Whether by design or not, however, I consider that in the context of the proprietor's mark as a whole, they play an insignificant role. I must bear in mind how the mark may be employed in various modes of use in the market place, not just on the goods themselves – on bottle labels or swing tags, etc. – but also in promotional materials, for example. Used on a label containing other graphic material and/or items of information (percentage alcohol by volume or proof, bottle capacity, etc.) I think it quite possible that the words THE PUMP HOUSE, given their relative size and presentation, could simply be overlooked. Even in the context of an uncluttered label, however, consisting of a clear and simple representation of the proprietor's mark as it stands registered, I think it improbable that the relevant public in the market place will see these words as forming part of a mark. They will not perceive them as having a trade mark function, but simply as words conveying information – such as an address. They may well not read them; if they do, they will see them simply as an address

30) I have found that the words THE GLASGOW DISTILLERY designate a characteristic of the goods and services which I have specified in paragraphs 23 and 24. The question is therefore whether other elements in the mark mean that it does not consist exclusively of descriptive signs or indications for the purposes of section 3(1)(c). I have found that the words THE PUMPHOUSE CLYDESIDE play an insignificant role in the proprietor's mark, it being improbable that the relevant public will see them as forming part of a mark. Nor do I consider the graphical presentation of the mark – the plain font, two short, straight flanking lines, and the lay-out – are sufficient, either on their own or in combination with the address line, to remove it from the prohibition in section 3(1)(c). I consider that this justifies my finding that **the proprietor's mark consists exclusively of a sign which may serve in trade to designate a characteristic of the goods and services which I have specified in paragraphs 23 and 24. Accordingly, the registration is invalid in respect of those goods and services.**

31) If a mark consists entirely of indications which are descriptive for the purposes of section 3(1)(c) it must be devoid of distinctiveness within the meaning of section

3(1)(b)⁴. However, in case I am wrong in finding that the proprietor's mark consists exclusively of elements descriptive of certain of the proprietor's goods and services, I shall also consider the position with regard to those same goods and services under section 3(1)(b) of the Act. Moreover, I shall also need to consider whether the goods in respect of which I have not found the mark descriptive are caught by section 3(1)(b); a mark which is not descriptive may nevertheless be devoid of distinctive character for other reasons⁵.

Section 3(1)(b)

32) The principles to be applied under article 7(1)(b) of the CTM Regulation (which is identical to article 3(1)(b) of the Trade Marks Directive and s.3(1)(b) of the Act) were conveniently summarised by the CJEU in *OHIM v BORCO-Marken-Import Matthiesen GmbH & Co KG* (C-265/09 P) as follows:

"29..... the fact that a sign is, in general, capable of constituting a trade mark does not mean that the sign necessarily has distinctive character for the purposes of Article 7(1)(b) of the regulation in relation to a specific product or service (Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* [2004] ECR I-5089, paragraph 32).

30. Under that provision, marks which are devoid of any distinctive character are not to be registered.

31. According to settled case-law, for a trade mark to possess distinctive character for the purposes of that provision, it must serve to identify the product in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish that product from those of other undertakings (*Henkel v OHIM*, paragraph 34; Case C-304/06 P *Eurohypo v OHIM* [2008] ECR I-3297, paragraph 66; and Case C-398/08 P *Audi v OHIM* [2010] ECR I-0000, paragraph 33).

32. It is settled case-law that that distinctive character must be assessed, first, by reference to the goods or services in respect of which registration has been applied for and, second, by reference to the perception of them by the relevant public (*Storck v OHIM*, paragraph 25; *Henkel v OHIM*, paragraph 35; and *Eurohypo v OHIM*, paragraph 67). Furthermore, the Court has held, as OHIM points out in its appeal, that that method of assessment is also applicable to an analysis of the distinctive character of signs consisting solely of a colour per se, three-dimensional marks and slogans (see, to that effect, respectively, Case C-447/02 P *KWS Saat v OHIM* [2004] ECR I-10107, paragraph 78; *Storck v OHIM*, paragraph 26; and *Audi v OHIM*, paragraphs 35 and 36).

⁴ The relationship between sections 3(1)(b) and 3(1)(c) is explained by Mr Geoffrey Hobbs, QC, sitting as the Appointed Person in *FLYING SCOTSMAN* O-313-11 at paragraph 19.

⁵ Case C-363/99 *Koninklijke KPN Nederland BV v Benelux-Merkenbureau (POSTKANTOOR)* [2004] ETMR 57 (ECJ) at paragraphs 70 and 86.

33. However, while the criteria for the assessment of distinctive character are the same for different categories of marks, it may be that, for the purposes of applying those criteria, the relevant public's perception is not necessarily the same in relation to each of those categories and it could therefore prove more difficult to establish distinctiveness in relation to marks of certain categories as compared with marks of other categories (see Joined Cases C-473/01 P and C-474/01 P *Proctor & Gamble v OHIM* [2004] ECR I-5173, paragraph 36; Case C-64/02 P *OHIM v Erpo Möbelwerk* [2004] ECR I-10031, paragraph 34; *Henkel v OHIM*, paragraphs 36 and 38; and *Audi v OHIM*, paragraph 37)."

33) In respect of the goods at issue, including those I have specified in paragraphs 23 and 24, the words "THE PUMP HOUSE", not being descriptive or allusive of those goods, could potentially function distinctively. This would depend on context and presentation. In the challenged mark, however, the words THE PUMP HOUSE – in striking contrast to the words THE GLASGOW DISTILLERY – are given no prominence; instead, they are relegated to, and absorbed into, the unobtrusive address. I have already found that the words THE PUMP HOUSE – CLYDESIDE could be overlooked by the relevant public – which will not in any case perceive these words as having a trade mark function, but simply as words conveying information, such as an address; that they may well not read them; and that, if they do, they will see them simply as an address. Such an address would not normally be relied on by the average consumer to distinguish the products and services in issue supplied under the relevant mark from those of other producers. Moreover, it is virtually impossible, for example, to imagine a consumer in a public house (or off-licence) requesting the proprietor's product by asking for "a glass [or bottle] of *THE GLASGOW DISTILLERY THE PUMP HOUSE CLYDESIDE*". Quite apart from any other consideration, such addresses can change – as, indeed, is illustrated by the excerpt from the Manual of Trade Marks Practice in the applicant's **Exhibit JT1**. It must, of course, be clearly emphasised that the test of whether an alteration of a mark substantially affects its identity under section 44(2) of the Act is a quite different test from the test of distinctiveness to be applied under section 3(1)(b). Nevertheless, I think the example is at least consistent with my view of the relative significance which the average consumer is likely to attribute in a case like the present to what I have found to be the address in the contested mark.

34) I have already found that the words THE GLASGOW DISTILLERY are descriptive. In respect of the goods and services specified in paragraphs 23 and 24 they lack distinctive character from the perspective of the average consumer, and will not serve to identify their commercial origin, or create a lasting impression of the mark, thus enabling the consumer who acquires the goods or services covered by the mark to repeat the experience, if it proves to be positive, or to avoid it, if it proves to be negative, on the occasion of a subsequent purchase. Nor do I consider that mark's graphic presentation – the straightforward lay-out, two short straight lines, and plain font – are sufficient to enable the average consumer to individualise the goods in question to a single undertaking, without having been educated to do so through exposure to the mark. These elements are not sufficient to distract the attention of the consumer from the descriptive meaning of the word element or likely to create a lasting impression of the mark.

35) I bear in mind that the assessment of the distinctive character of a mark cannot be limited to an evaluation of each of its words or components, considered in isolation, but must be based on the overall perception of that mark by the relevant public, and not on the presumption that elements individually devoid of distinctive character cannot, on being combined, have a distinctive character⁶. I am also mindful that if a mark does have inherent distinctive character, it should convey its commercial origin message immediately when first encountered. Whether a trade mark performs its essential function of enabling the consumer to distinguish the product or service from others which have another commercial origin will be a matter of first impression, because the average consumer does not analyse trade marks beyond what is usual in the ordinary course of purchasing the relevant goods.

36) Stepping back and viewing the contested mark as a whole, I do not consider that it will immediately enable the relevant public, absent distinctiveness acquired through use, to identify the goods and services in question as originating from a particular undertaking, and thus to distinguish them from those of other undertakings. Accordingly, **with regard to the goods and services of the proprietor which I specified in paragraphs 23 and 24, the mark is devoid of distinctiveness within the meaning of section 3(1)(b), and is invalid in respect of those goods.**

The remaining goods and services

37) The word DISTILLERY is a principal and prominent feature of the contested mark. None of the remaining goods and services of the proprietor's specification are such as the relevant public would associate with distilleries. The word DISTILLERY is not descriptive of these goods and services, nor may it serve to designate a characteristic of them; thus, it has distinctive character in respect of them. As regards these remaining goods and services, therefore, the mark neither consists exclusively of descriptive indications under section 3(1)(c), nor is it devoid of distinctive character under section 3(1)(b). Accordingly, the application for a declaration of invalidity fails in respect of all the goods and services of the proprietor's specification which I have not explicitly specified in paragraphs 23 and 24.

Outcome

38) The application for a declaration of invalidation succeeds and, accordingly the registration is deemed invalid and never to have been made in respect of the following goods and services:

Class 33: Alcoholic beverages; spirits; liqueurs; in so far as whisky and whisky based drinks are concerned such products being Scotch and/or Scotch based, all being produced in Scotland; Scotch whisky; gin.

Class 35: Retail services and on-line retail services connected with the sale of alcoholic beverages, spirits, whisky, gin, liqueurs; arranging and conducting of talks and tastings for promotional and advertising purposes;

⁶ (*Eurohypo AG v OHIM* C-304/06 P, at paragraph 41)

Class 41: Education and entertainment services, all relating to the manufacture, production, sale and consumption of whisky; arranging of courses of instruction for tourists; corporate hospitality (entertainment); whisky tasting services; provision of club recreation services; arranging and conducting talks, tastings; publication of tasting notes and bottling lists; provision of courses of instruction for tourists; cultural facilities; presentation of live performances;

Class 43: Bar services; services for providing drink; corporate hospitality (provision of food and drink); whisky tasting services (provision of beverages)

The application for a declaration of invalidation fails and, accordingly, the registration stands in respect of the following goods and services:

Class 16: Paper, cardboard and goods made from these materials, not included in other classes; printed matter; books; notebooks; postcards; printed publications; photographs; stationery; adhesives for stationery or household purposes; artists' materials; office requisites (except furniture); instructional and teaching material (except apparatus); wrapping and packaging materials; plastic materials for packaging (not included in other classes); signs and signboards of paper or cardboard; flags, posters, labels, stickers, transfers, decalcomanias.

Class 18: Leather and imitations of leather, and goods made of these materials namely belts and belt bags, card wallets and card holders, cases for holding keys, luggage tags, cosmetic bags, folio cases, document cases, attache cases, garment carriers; animal skins, hides; articles of luggage, bags, baggage; trunks and travelling bags; handbags, backpacks, rucksacks, haversacks, bumbags, pouches, purses, wallets; umbrellas, parasols and walking sticks; parts and fittings for all of the aforesaid goods.

Class 21: Glassware; porcelain and earthenware; domestic utensils and containers; household or kitchen utensils and containers; brushes; unworked or semi-worked glass; non-precious metalware; coolers; cool bags, beverage coolers, bottle coolers; ice buckets; trays; drinking flasks; drinking vessels; drinking glasses; tumblers, shot glasses; wash bags; signs, signboards; parts and fittings for all of the aforesaid goods.

Class 24: Textiles and textile goods; table covers; towels; bar towels, bar cloths; flags, bunting, banners; tea towels.

Class 25: Clothing, footwear, headwear; t-shirts, sweatshirts, jackets, rainwear, waterproof jackets, fleeces, shirts, underwear; aprons; caps; visors; belts; accessories for all of the aforesaid goods.

Class 28: Golf leather bags.

Class 30: Prepared foodstuffs containing principally cereals, rice or corn; prepared snacks; prepared meals; biscuits; confectionery; cakes and gateaux;

pastries; pies; puddings; flavourings; sauces; vinegars; essences; ice-cream; ice-cream confections; honey; mustard; tea, coffee.

Class 35: Retail services and on-line retail services connected with the sale of waters [beverages], mineral water, aerated water, non-alcoholic beverages, printed matter, publications, photographs, stationery, adhesives for stationery or household purposes, artists' materials, office requisites (except furniture), instructional and teaching material, wrapping and packaging materials, plastic materials for packaging, signs and signboards of paper or cardboard, flags, posters, labels, stickers, transfers, decalcomanias. glassware, porcelain, earthenware, household or kitchen utensils and containers, brushes, unworked or semi-worked glass, non-precious metalware, coolers, cool bags, beverage coolers, bottle coolers, ice buckets, trays, drinking flasks, drinking vessels, drinking glasses, tumblers, shot glasses, signs, signboards, jewellery, cufflinks, bracelets, pendants, necklaces, earrings, cooling stones for drinks, pastries, confectionery, biscuits, shortbread, chocolate, gift boxes, hip flasks, drinks measures, textiles and textile goods, table covers, towels, bar towels, bar cloths, flags, bunting, banners, tea towels, books, clothing, footwear, headwear, t-shirts, sweatshirts, jackets, rainwear, waterproof jackets, fleeces, shirts, underwear; aprons, caps, visors, belts, foodstuffs, confectionery, biscuits, cakes, pastries, pies, puddings, flavourings, sauces, vinegars, essences, ice-cream, ice-cream confections, honey, mustard, tea and coffee, key rings, magnets, notebooks, tiepins, cuff links, toys, games and playthings, cards, postcards, CDs, DVDs, audio and video recordings, software, phone accessories and covers, mouse mats and computer hardware accessories; arranging of competitions for trade, commercial and business purposes; distribution and dissemination of advertising matter and information.

Class 41: arranging and conducting conferences and seminars; publication of texts and newsletters; arranging and conducting conferences and exhibitions; arranging of competitions for educational, entertainment and cultural purposes organisation of competitions and prize giving; publication of books; information and advisory services relating to the foregoing services.

Class 43: Provision of museum, presentation and exhibition facilities; restaurant services; services for providing food; temporary accommodation; hiring of rooms for social functions; catering services; arranging of wedding receptions (venues); arranging of wedding receptions (food and drink); restaurants; cafes; cafeterias.

Costs

39) Both sides have enjoyed some measure of success. The proprietor has succeeded in defending a substantial majority of the goods and services of its specification. On the other hand, the applicant has successfully challenged the validity of the registration in respect of goods and services at the centre of both parties' interest. Balancing all this, I do not propose to favour either side with an award of costs.

Dated this 29th day of March 2016

**Martin Boyle
For the Registrar
The Comptroller General**

Annex

Class 16: Paper, cardboard and goods made from these materials, not included in other classes; printed matter; books; notebooks; postcards; printed publications; photographs; stationery; adhesives for stationery or household purposes; artists' materials; office requisites (except furniture); instructional and teaching material (except apparatus); wrapping and packaging materials; plastic materials for packaging (not included in other classes); signs and signboards of paper or cardboard; flags, posters, labels, stickers, transfers, decalcomanias.

Class 18: Leather and imitations of leather, and goods made of these materials namely belts and belt bags, card wallets and card holders, cases for holding keys, luggage tags, cosmetic bags, folio cases, document cases, attache cases, garment carriers; animal skins, hides; articles of luggage, bags, baggage; trunks and travelling bags; handbags, backpacks, rucksacks, haversacks, bumbags, pouches, purses, wallets; umbrellas, parasols and walking sticks; parts and fittings for all of the aforesaid goods.

Class 21: Glassware; porcelain and earthenware; domestic utensils and containers; household or kitchen utensils and containers; brushes; unworked or semi-worked glass; non-precious metalware; coolers; cool bags, beverage coolers, bottle coolers; ice buckets; trays; drinking flasks; drinking vessels; drinking glasses; tumblers, shot glasses; wash bags; signs, signboards; parts and fittings for all of the aforesaid goods.

Class 24: Textiles and textile goods; table covers; towels; bar towels, bar cloths; flags, bunting, banners; tea towels.

Class 25: Clothing, footwear, headwear; t-shirts, sweatshirts, jackets, rainwear, waterproof jackets, fleeces, shirts, underwear; aprons; caps; visors; belts; accessories for all of the aforesaid goods.

Class 28: Golf leather bags.

Class 30: Prepared foodstuffs containing principally cereals, rice or corn; prepared snacks; prepared meals; biscuits; confectionery; cakes and gateaux; pastries; pies; puddings; flavourings; sauces; vinegars; essences; ice-cream; ice-cream confections; honey; mustard; tea, coffee.

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Class 35: Retail services and on-line retail services connected with the sale of alcoholic beverages, spirits, whisky, gin, liqueurs, waters [beverages], mineral water, aerated water, non-alcoholic beverages, printed matter, publications, photographs, stationery, adhesives for stationery or household purposes, artists' materials, office requisites (except furniture), instructional and teaching material, wrapping and

packaging materials, plastic materials for packaging, signs and signboards of paper or cardboard, flags, posters, labels, stickers, transfers, decalcomanias. glassware, porcelain, earthenware, household or kitchen utensils and containers, brushes, unworked or semi-worked glass, non-precious metalware, coolers, cool bags, beverage coolers, bottle coolers, ice buckets, trays, drinking flasks, drinking vessels, drinking glasses, tumblers, shot glasses, signs, signboards, jewellery, cufflinks, bracelets, pendants, necklaces, earrings, cooling stones for drinks, pastries, confectionery, biscuits, shortbread, chocolate, gift boxes, hip flasks, drinks measures, textiles and textile goods, table covers, towels, bar towels, bar cloths, flags, bunting, banners, tea towels, books, clothing, footwear, headwear, t-shirts, sweatshirts, jackets, rainwear, waterproof jackets, fleeces, shirts, underwear; aprons, caps, visors, belts, foodstuffs, confectionery, biscuits, cakes, pastries, pies, puddings, flavourings, sauces, vinegars, essences, ice-cream, ice-cream confections, honey, mustard, tea and coffee, key rings, magnets, notebooks, tiepins, cuff links, toys, games and playthings, cards, postcards, CDs, DVDs, audio and video recordings, software, phone accessories and covers, mouse mats and computer hardware accessories; arranging and conducting of talks and tastings for promotional and advertising purposes; arranging of competitions for trade, commercial and business purposes; distribution and dissemination of advertising matter and information.

Class 41: Education and entertainment services, all relating to the manufacture, production, sale and consumption of whisky; arranging and conducting conferences and seminars; arranging of courses of instruction for tourists; corporate hospitality (entertainment); whisky tasting services; provision of club recreation services; publication of texts and newsletters; arranging and conducting talks, tastings, conferences and exhibitions; publication of tasting notes and bottling lists; arranging of competitions for educational, entertainment and cultural purposes organisation of competitions and prize giving; provision of courses of instruction for tourists; cultural facilities; presentation of live performances; publication of books; information and advisory services relating to the foregoing services.

Class 43: Provision of museum, presentation and exhibition facilities; restaurant and bar services; services for providing food and drink; temporary accommodation; hiring of rooms for social functions; catering services; arranging of wedding receptions (venues); arranging of wedding receptions (food and drink); restaurants; corporate hospitality (provision of food and drink); whisky tasting services (provision of beverages); cafes; cafeterias.