

**o/908/21**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. UK00003507570**

**BY WILD THYME SPIRITS LTD**

**TO REGISTER THE FOLLOWING MARK:**

**#colonsaygin**

**IN CLASSES 33 AND 35**

**AND**

**IN THE MATTER OF OPPOSITION THERETO**

**UNDER NO. 421629**

**BY COLONSAY BEVERAGES LTD**

## BACKGROUND AND PLEADINGS

1. On 2 July 2020, Wild Thyme Spirits Ltd (“the applicant”) applied to register the trade mark **#colonsaygin** in the UK. The application was published for opposition purposes on 31 July 2020. The applicant seeks registration for the following goods and services:

Class 33      Alcoholic beverages (except beer).

Class 35      Advertising, marketing and promotional services provided by means of indirect methods of marketing communications, namely, social media, blogging and other forms of passive, shareable or viral communications channels.

2. The application was opposed by Colonsay Beverages Ltd (“the opponent”) on 30 September 2020. The opposition proceeds on the basis of section 3(1)(c) of the Trade Marks Act 1994 (“the Act”). In its Notice of Opposition, the opponent states:

“This application seeks to protect a social media hashtag made up of generic good (gin) and geographical location (Colonsay). **#colonsaygin** clearly should be available to anyone producing, consuming, discussing gin and Colonsay in whatever context.”

3. The applicant filed a counterstatement denying the claims made.

4. The opponent is unrepresented, and the applicant is represented by Cameron Intellectual Property Ltd. Both parties filed evidence in chief and the opponent filed evidence in reply. The applicant also filed written submissions in lieu. This decision is taken following a careful perusal of the papers.

5. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts.

## **EVIDENCE AND SUBMISSIONS**

6. The opponent's evidence consists of the witness statement of Mr David Melville Steele Johnson dated 20 June 2021. Mr Johnson is the Director of the opponent, a position he has held since February 2015.

7. The applicant's evidence consists of the witness statement of Mr John Finlay Geekie dated 6 August 2021. Mr Geekie is one of the founders and currently the Production Director of the applicant. Mr Geekie's statement is accompanied by 1 exhibit (JFG1).

8. The opponent filed evidence in reply in the form of the witness statement of Mr Johnson dated 3 October 2021. Mr Johnson's statement is accompanied by 9 exhibits (DMSJ1-DMSJ9).

9. Whilst I do not propose to summarise it here, I have taken all of the evidence and submissions into consideration in reaching my decision and will refer to it where necessary below.

## **PROCEDURAL HISTORY**

10. As noted above, the opposition proceeds on the basis of section 3(1)(c) of the Act. However, the opposition was originally based upon sections 5(2)(a), 5(2)(b), 5(3), 5(4)(a) and 5(4)(b) of the Act.

11. On 21 December 2020, the opponent filed a Form TM7G withdrawing the above grounds from its claim and requesting to proceed on the basis of section 3 instead. On the 19 January 2021, the Tribunal wrote out to the parties notifying them that it was the preliminary view of the Tribunal to accept the request and to amend the pleadings. However, the opponent was requested to specify what grounds under section 3 it wanted to proceed with, as this was not adequately particularised. The Tribunal stated that "if either party disagrees with the preliminary view, they may request a hearing in writing within 14 days of this letter, that is on or before **1 February 2021**".

12. On 19 January 2021, the applicant wrote to the Tribunal in disagreement of the above preliminary view and requested a hearing on the matter.

13. A case management conference (“CMC”) took place on the 8 February 2021 by telephone. I note that the Hearing Officer concluded that the preliminary view to allow the opponent to amend its pleadings was appropriate and within the Tribunal’s discretion. However, it was considered that the latest Form TM7, which was filed on 3 February 2021, still needed further amendment. The opponent was given until 23 February 2021 to file an amended version.

14. On 10 February 2021, the opponent refiled an amended Form TM7 basing its case on section 3(1)(a) and 3(1)(c).

15. On 16 March 2021, the Tribunal wrote out to the parties notifying them that the opponent’s section 3(1)(a) claim was struck out because there was no legal basis for it and that the opposition would proceed under section 3(1)(c) only. This was given as a preliminary view. On 25 March 2021, the applicant wrote to the Tribunal in disagreement and requested a hearing on the matter.

16. On 29 March 2021, the Tribunal wrote out to the parties as follows:

“The Hearing Officer has reviewed the amended form TM7 filed on 10 February 2021 and is satisfied that the opponent has adequately pleaded section 3(1)(c) ground. For reasons given in the Registry’s letter dated 16 March 2021, section 3(1)(a) ground is struck out. As the amended form TM7 is adequately particularised so far as section 3(1)(c) ground is concerned, the Registry should have served the form on the applicant instead of giving a preliminary view on its admissibility. The opposition will now proceed based on section 3(1)(c) and the deadline to file a TM8 reset.

[...]”

17. Following this letter, the applicant filed its defence on 31 May 2021, and the case proceeded to the evidence rounds.

## DECISION

18. Section 3(1)(c) reads as follows:

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

(a) [...]

(b) [...]

(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 product of goods or of rendering of services, or other characteristic 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.”

19. The relevant date for determining whether the mark is objectionable under section 3(1)(c) is the date of the application in issue - 2 July 2021.

20. Section 3(1)(c) prevents the registration of marks which are descriptive of the goods and services, or a characteristic of them. The case law under section 3(1)(c) (corresponding to article 7(1)(c) of the EUTM Regulation, formerly article 7(1)(c) of the CTM Regulation) was set out by Arnold J. in *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2012] EWHC 3074 (Ch) as follows:

“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 I2779, 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].”

21. Firstly, the opponent argues that the mark #colonsaygin is made up of a social media hashtag, the geographical location of the Isle of Colonsay and gin which is an alcoholic spirit. Therefore, this mark “should be available to anyone producing, consuming, discussing gin and Colonsay in whatever context”. I also note that the opponent highlights that the hashtag #colonsaygin is regularly used by the opponent on several social media channels and that “19 of the first 21 uses of this hashtag on Instagram were made by this competing company, rather than the applicant”. Exhibits DMSJ2 to DSMJ9 demonstrate use of the hashtag #colonsaygin on both the applicant’s and opponent’s Instagram and Facebook pages.

22. The registration of a trade mark provides the owner an exclusive right in that mark, in relation to the applied for goods and services. It acts as a guarantee of trade origin. The purpose of section 3(1)(c) is to ensure that signs which are descriptive of its goods and services, or a characteristic of them, for which registration is sought, remain free for use by traders of those goods and services. Hashtags, which are used on social media, are typically used to identify trending digital content on a specific topic and, therefore, are not generally used to indicate trade origin. In these proceedings, I have to determine if the mark #colonsaygin, whether it is a used social media hashtag or not, describes a characteristic of alcoholic beverages, advertising, marketing and/or promotional services.

23. The opponent argues that use of the element Colonsay indicates the geographical location of the Isle of Colonsay and, therefore, the filing of the applicant’s mark is contrary to section 3(1)(c). Both parties have provided evidence that Colonsay is an island in the Southern Hebrides. I note that this is also supported by its appearance in the dictionary, defined as an island from Western Scotland in the Inner Hebrides,

which has an area of about 41 square kilometers.<sup>1</sup> The island can be interchangeably referred to as the Isle of Colonsay or Colonsay, albeit the applicant argues that the abbreviated term is mainly used by locals or a small number of people who know the island around the UK. I note that the applicant also highlights that there are other geographical locations with the same name including a Colonsay in Canada, and street names based in the UK including, for example, Colonsay Road in Crawley.

24. The opponent argues that the relevant consumer must know the meaning of Colonsay because of “their use of the #colonsaygin hashtag” as people wouldn’t be able to search for #colonsaygin if they were unaware that Colonsay is a geographical location. The opponent further argues that “this is a dispute solely online and the very fact that people are using the hashtag to search or follow demonstrates they are aware of the geographical nature of the word Colonsay”. As highlighted above, the opponent is focusing on the use of hashtags in a social media context. The focus needs to be on the characteristics of the mark itself, in the context of the applied-for goods and services.

25. The applicant has applied for alcoholic beverages (except beer) in class 33 and advertising, marketing and promotional services provided by means of indirect methods of marketing communications, namely, social media, blogging and other forms of passive, shareable or viral communications channels in class 35. In this case, the average consumer, who will be deemed to be reasonably observant and circumspect,<sup>2</sup> will be adult members of the general public and professional users such as businesses. I consider that the average consumer will consider factors such as cost, flavour and alcohol percentage when purchasing the applicant’s goods. I consider that the average consumer will consider factors such as cost, the type of services offered and the suitability of these services when purchasing the applicant’s services. Consequently, I consider that a medium degree of attention will be paid during the purchasing process for both. It is, therefore, the perspective of this consumer which is important to consider in these proceedings.

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<sup>1</sup> <https://www.collinsdictionary.com/dictionary/english/colonsay>

<sup>2</sup> *Matratzen Concord AG v Hukla Germany SA*, Case C-421/04

26. When assessing whether a trade mark offends section 3(1)(c) I keep I mind the guidance relating to geographical names as set out by the CJEU in *Windsurfing Chiemsee v Boots Attenberger* (“*Chiemsee*”), C108/97 and C-109/97:

“31. Thus, under Article 3(1)(c) of the Directive [equivalent to section 3(1)(c) of the UK Trade Marks Act 1994 or ‘UKTMA’], the competent authority must assess whether a geographical name in respect of which an application for registration as a trade mark is made designates a place which is currently associated in the mind of the relevant class of persons with the category of goods concerned, or whether it is reasonable to assume that such an association may be established in the future.

32. In the latter case, when assessing whether the geographical name is capable, in the mind of the relevant class of persons, of designating the origin of the category of goods in question, regards must be had more particularly to the degree of familiarity amongst such persons with that name, with the characteristics of the place designated by the name, and with the category of goods concerned.

33. In that connection, Article 3(1)(c) of the Directive [section 3(1)(c) UKTMA] does not in principle preclude the registration of geographical names which are unknown to the relevant class of persons or at least unknown as the designation of a geographical location or of names in respect of which, because of the type of place they designate (say, a mountain or lake), such persons are unlikely to believe that the category of goods concerned originates there.

34. However, it cannot be ruled out that the name may serve to designate geographical origin within the meaning of Article 3(1)(c) [section 3(1)(c) UKTMA], even for goods such as those in the main proceedings [being, in that particular case, items of sports clothing], provided that the name could be understood by the relevant class of persons [to include the shores of the lake or the surrounding area].

35. It follows from the foregoing that the application of Article 3(1)(c) [section 3(1)(c) UKTMA] does not depend on there being a real, current or serious need to leave a sign or indication free.

36. Finally, it is important to note that, whilst an indication of the geographical origin of goods to which Article 3(1)(c) [section 3(1)(c) UKTMA] applies usually indicates the place where the goods were or could be manufactured, the connection between a category of goods and a geographical location might depend on other ties, such as the fact that the goods were conceived and designed in the geographical location concerned.”

27. Although not bound by the same I also keep in mind the guidance as set out in the Registry’s Work Manual which states as follows:

“the ‘association’ between place name and product, which the Court has confirmed is central to the assessment, need not be limited to a consideration of whether the word designates the ‘place of manufacture’ (or, in the case of services, the ‘place of rendering’).

Beyond the more conventional forms of geographical place names (being countries, cities, and towns), section 3(1)(c) can equally apply to any other designation of geographical area be it inter alia a district, a mountain, a lake (see Chiemsee, for example), a commercial district, see Canary Wharf [2015] EWHC 1588 (Ch) a natural spring, a resort, or a place of natural beauty. Wherever it is considered that the relevant consumer will make an association between the place name and the product(s) intended for protection, then an objection will be likely. Equally, where it is considered that other traders may genuinely seek to use the geographical place-name in their future course of trade (most likely, again, because of the existence of an association between the place and the product) then an objection will apply.

Where the geographical place name intended for protection has no obvious reputation, it must still be considered how the mark will be perceived in trade. In order to do so, consideration will be given to all facts related to the place

name including, but not limited to, the size of the location, and the extent and nature of commercial activity that goes on within its boundaries.

Whilst every town, regardless of size, would likely offer library services, not every town would produce tea bags, and so the consideration of reputation becomes more prevalent. For example, Oxford Leisure Centre would face an objection under 3(1)(c), however, Oxford Tea Bags would not. The names of places which are likely to be the source of natural produce are unlikely to be registrable as trade marks for such goods even if the place identified by the mark has no specific reputation. A place will have to be obscure before its name can be registered as a trade mark for unprocessed products of the kind frequently sold from roadsides and farm shops, such as fruit and vegetables, flowers, potatoes, water, eggs and milk. This may not be the case in respect of processed foodstuffs, which are less likely to be associated with local producers and providers. In the case of such products, the names of a larger, more populous areas may be objectionable if the examiner considers them likely to be perceived as a reference to where the foodstuff was processed.”

### Alcoholic beverages (except beer) in Class 33

28. I will consider the section 3(1)(c) ground first in relation to the applicant’s class 33 goods.

29. Although any assessment of descriptiveness must consider the mark in totality, it is also helpful to first analyse the mark by reference to its constituent parts.<sup>3</sup> However, I make it clear that my conclusion is not a finding on the registrability of the individual elements of the trade mark.

30. Firstly, I will consider the hashtag element within the mark. As noted above, hashtags are commonly used to highlight trending content, and also can be used to advertise goods on social media sites. I bear in mind the decision *JOOP! GmbH v OHIM* , Case T-75/08, where the General Court held that a representation of an

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<sup>3</sup> See *BABY-DRY* decision (Case C-383/99 P) para 40

exclamation mark was devoid of any distinctive character because it simply emphasised the words preceding it. Similarly, I consider that the hashtag is also non-distinctive because it is used to draw attention to the words which follow it. Consequently, I also consider that the majority of consumers will omit pronouncing the hashtag when verbalising the mark, the same way an exclamation mark would also not be pronounced.

31. I acknowledge that the applicant's goods are alcoholic beverages (except beer), however, there is an overwhelming likelihood that the mark will be used on gin. Therefore, the word 'gin' in the applicant's mark #colonsaygin is descriptive of the applicant's goods. In the unlikely event that the mark is used in relation to other alcoholic beverages, consumers will expect the goods to be gin, even if they are not. Therefore, any possible use of the mark as a misdescription of the type of alcoholic beverage concerned (for example, using the word gin on vodka) will not give the mark a distinctive character it would otherwise lack.

32. Taking all of the above evidence into account, I consider that Colonsay is a relatively obscure geographical location. There is no evidence before me to conclude that Colonsay is known to the majority of UK consumers of alcoholic beverages. However, I do consider that it will be known to a minority which could be large enough to constitute as a significant proportion. Regardless of whether it is recognised or not by the average consumer, I note that neither the opponent nor the applicant has provided me with any evidence to demonstrate that Colonsay is associated with gin or other alcoholic beverages. However, for the sake of completeness, I will consider whether the presence of the opponent and applicant on the island and the trade they conduct from that location has established a current association between gin and Colonsay in the minds of average UK consumers.

33. From the evidence provided, I acknowledge that both the applicant and the opponent rectify gin on Colonsay. However, the opponent also "distils some of its gin at Langley Distillery [...] using botanicals gathered on Colonsay". As highlighted in paragraph 36 of *Windsurfing Chiemsee* (above), an indication of the geographical origin of goods does not have to indicate where the goods are manufactured, it could "depend on other ties". Therefore, in this case, I consider that use of the Colonsay

botanicals, used to distil gin elsewhere, could be an indication of geographical origin and therefore a factor to consider when assessing whether the name is currently associated with gin or other alcoholic beverages.

34. I have not been provided any evidence of other undertakings marketing gin from the island apart from the applicant and the opponent. Mr Johnson did provide turnover figures for the opponent's sale of gin which amounted to £208,000 for the year to August 2020. Although I have no evidence as to the extent of the gin market for the UK, the sales figures provided seem modest for what is undoubtedly a significant market. It is also important to note that I have not been provided with any evidence as to where the opponent's sales were made and how many were made to the UK (if any).

35. Overall, due to the lack of evidence, I can only conclude that both the opponent and applicant are small players in the gin market and therefore are not big enough alone to demonstrate that Colonsay is currently associated with gin.

36. Of course, the applicant's class 33 specification doesn't just include gin, but alcoholic beverages as a whole, excluding beer. Scotland is known for the production of whiskey, which is an alcoholic beverage. However, again, due to the lack of evidence there is nothing to demonstrate that Colonsay specifically is known and associated with whisky either.

37. Although there is no association currently, it still has to be considered whether it is reasonable to assume that such an association may be established in the future. The applicant provides evidence that the island is small, covering an area of approximately 40km<sup>2</sup> and it is one of the "most remote communities in the United Kingdom" with currently around 130 inhabitants. Consequently, I do not consider that such a small and remote island would be likely to have a significant amount of gin distilleries due to its sheer size. I note that the opponent uses the botanicals from Colonsay to flavour their gin, and this use can be an indication of geographical origin. However, the opponent has not provided me with any evidence to indicate that the botanicals from Colonsay have a reputation, or that the botanicals from Colonsay are particularly suitable for flavouring gin because of, for example, their quality. The only reference to

Colonsay's botanicals is exhibited in DMSJ5 where a tweet was made from the account 'Dead Famous Cities', on the 22 March 2018, stating that "a citrus beauty from @WildIslandGin with ten botanicals & Six hand-foraged from the Island of Colonsay this is a regular in the mix". On this evidence alone, it cannot be concluded that the Isle of Colonsay has a reputation for their botanicals, such as to make it likely that the island will, in the future, become associated in the public's mind with the production of gin. Further, there is no evidence that Colonsay is particularly suitable in any other respect as to make it likely to become recognised as a possible source of gin or other alcoholic beverages in the future.

38. I remind myself of the test which comes from *Windsurfing Chiemsee* (above). Is the geographical location currently known and associated with the goods and, if not, is it **reasonable to assume** that such an association may be established in the future? (underlined for emphasis). Although the evidence demonstrates that there is a possibility for Colonsay to gain this association with gin, I believe that to conclude that based on the evidence before me would be mere speculation. For example, I have not been provided with any evidence that the botanicals from Colonsay are particularly suitable for flavouring gin which would cause companies in the future to distil their gins with Colonsay botanicals, or on the island. Consequently, as the evidence is not strong enough to conclude that it would be "reasonable to assume" that Colonsay may become associated with gin in the public's mind in the future, the opponent's case fails the second part of the *Windsurfing Chiemsee* test.

39. In conclusion, taking all of the above into account, I consider that Colonsay, a relatively obscure place, which even if recognised as a place, is not currently associated with gin or botanicals suitable for use in flavouring gin. I also consider it is unlikely to be recognised in the future as a geographical source of gin by any significant proportion of average UK consumers. Accordingly, I find that the mark should not be refused under the provisions of section 3(1)(c) for the above goods.

Advertising, marketing and promotional services in Class 35

40. Now I will consider the section 3(1)(c) ground in relation to the applicant's class 35 services.

41. It is important to note in this connection, that services are provided to others. Simply advertising one's own goods is not a service.

42. I have no evidence before me that Colonsay is associated with advertising, marketing and promotional services. I do not consider that that such an association will be established in the future for such a small and remote island. I note that, although the applicant's services are limited to social media, in which hashtags are frequently used, the hashtag itself is not descriptive of the applicant's services. As highlighted above, the hashtag is a non-distinctive element of the mark which simply emphasises the words that follow it. Therefore, the inclusion of the hashtag makes no material difference. It follows from my earlier findings that colonsaygin will not be recognised by any significant proportion of average consumers as a description of the subject matter of the services at issue. Consequently, the meaning of the mark in its entirety i.e. colonsaygin is not descriptive of the applicant's advertising, marketing and promotional provided by means of indirect methods of marketing communications, namely, social media, blogging and other forms of passive, shareable or viral communications channels services.

43. The mark does not consist exclusively of signs descriptive of the applicant's goods and services. Therefore, the opposition under section 3(1)(c) fails.

## **CONCLUSION**

44. The opposition is unsuccessful, and the application may proceed to registration.

## **COSTS**

45. The applicant has been successful and has requested that off-scale costs be awarded. The applicant's representatives submit that the protracted delays caused by the inadmissibility of the opponent's various Form TM7's and evidence has led to significantly increased costs for the applicant.

46. Rule 67 of the Trade Marks Rules 2008 provides:

“The registrar may, in any proceedings under the Act or these Rules, by order award to any party such costs as the registrar may consider reasonable, and direct how and what parties they are to be paid.”

47. Tribunal Practice Notice (“TPN”) 4/2007 indicates that the Tribunal has a wide discretion when it comes to the issue of costs, including making awards above or below the published scale where the circumstances warrant it. The TPN stipulates that costs off the scale are available “to deal proportionately with wider breaches of rules, delaying tactics or other unreasonable behaviour”.

48. I acknowledge there were multiple filings of the Form TM7. However, as the Tribunal has already acknowledged in the post CMC letter dated 9 February 2021, the opponent is unrepresented, and therefore, the multiple filings can be attributed to the fact that there was a lack of understanding of trade mark law and how complete the Form TM7. There is nothing to suggest that this behaviour was an abuse of process, inappropriate, nor a tactic to delay the proceedings. Consequently, I do not consider that off-scale costs would be appropriate in this instance.

49. The relevant scale is contained in Tribunal Practice Notice 2/2016. The opponent was informed by letter on 18 January 2021 that, as the amendment of the pleadings required the applicant to file an amended counterstatement, an award of costs to cover this may be made when a final decision is issued. Therefore, I make an uplifted award in respect of considering the notice of opposition and preparing a counterstatement. I also note that a CMC took place on 8 February 2021 in which the opponent was successful. As such, it would not be appropriate to award the applicant costs for the CMC. In the circumstances, I award the applicant the sum of **£1,400** as a contribution towards the costs of the proceedings. The sum is calculated as follows:

|   |      |
|---|------|
| Considering the Notice of opposition and preparing a Counterstatement | £350 |
| Preparing evidence and considering                                    | £700 |

the opponent's evidence

|  |      |
|--|------|
| Preparing and filling written submissions<br>in lieu | £350 |
|--|------|

|              |               |
|--------------|---------------|
| <b>Total</b> | <b>£1,400</b> |
|--------------|---------------|

50. I therefore order Colonsay Beverages Ltd to pay Wild Thyme Spirits Ltd the sum of £1,400. This sum is to be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

**Dated this 15<sup>th</sup> day of December 2021**

**L FAYTER**

**For the Registrar**