BL O-0037-24

TRADE MARKS ACT 1994

IN THE MATTER OF
an Appeal to the Appointed Person

AND IN THE MATTER OF
UK Trade Mark Application No. 3606113 "JACK & VICTOR" in the name of Jack & Victor Ltd (the "Respondent")

AND IN THE MATTER OF
Opposition No. OP426788 in the name of Jack Daniels Properties, Inc (the "Appellant")

DECISION

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1. This is an appeal from the decision of the Hearing Officer, Heather Harrison, dated 15 May 2023 (the "**Decision**"). It concerns an application for the word mark "JACK & VICTOR" in various goods and services in classes 21, 32, 33, 35, 39 and 40. These goods and services related to, or are associated with the consumption and provision of, alcoholic beverages (as set out in para. 1 of the Decision).

2. The application was opposed by the Appellant under ss 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 ("TMA") in relation to all the aforementioned goods and services. By the time of the hearing, the Appellant relied upon the following nine prior registrations:

	Trade mark	**Specification relied upon**
UK 910532984	JACK	Class 33: Alcoholic beverages; including prepared alcoholic cocktails, and specially excluding cider and perry.
UK 900154211	JACK DANIEL'S	Class 33: Alcoholic beverages (except beers).
UK 2168987	JACK DANIEL'S	Class 21: Glass and plastic drinking containers, glassware, food and beverage containers.
UK 912179438	JACK DANIEL	Class 33: Alcoholic beverages; including distilled spirits.

UK 906329081	GENTLEMAN JACK	Class 33: Alcoholic beverages; including distilled spirits.
UK 911569886	JACK HONEY	Class 33: Alcoholic beverages; including distilled spirits.
UK 910221851	WINTER JACK	Class 33: Alcoholic beverages, including pre-mixed alcoholic cocktails.
UK 905151535	JACK LIVES HERE	Class 33: Alcoholic beverages, including, distilled spirits.
UK 913429121	JACK ROCKS	Class 33: Alcoholic beverages, except beers. Class 36: Sponsoring music events featuring a variety of activities, namely, music in the nature of live entertainment by music artists and musical groups, music exhibitions, festivals, and contests related thereto.

3. For the reasons set out in the Decision, the Hearing Officer rejected the Opposition in its entirety and awarded costs to the Respondent in the sum of £3,200 (payment of which was stayed pending this appeal).

The Hearing Officer's Assessment of the Inherent Distinctive Character of "JACK" ("Ground 1")

4. The Appellant submitted that the Hearing Officer's findings in relation to sections 5(2)(b) and 5(3) TMA was fundamentally flawed as they were based on an incorrect finding that the element of the marks "JACK" was inherently only weakly distinctive. The correct starting point, the Appellant submitted, was to treat JACK as having a normal level of distinctive character. On this basis, the Appellant invited me to re-assess the distinctive character (including acquired distinctive character) of the prior registered marks, and the grounds of opposition under sections 5(2)(b) and (3), *ab initio*.

5. The Appellant advanced this ground of appeal in effectively two ways (albeit they are intricately connected to each other).

6. First, the Appellant submitted that the Hearing Officer failed to address her mind to the question of the inherent distinctiveness of JACK correctly, because she had failed to do so the context of the relevant goods and services (and, in particular, in relation to those related to

whisky). I reject this submission, as there is in my view no basis in the text of the judgment to reach such a conclusion. For example, the first passage which the Appellant draws attention to is at paragraph 73 of the Decision. However, that passage expressly considers the use in relation to sales of whisky. Likewise, in the second passage the Appellant draws attention to, paragraph 105, and the paragraphs that immediately proceed it, it is plain in my view that the Hearing Officer was considering distinctiveness (both inherent and acquired) in the context of the relevant goods and services.

7. Second, the Appellant submitted that the Hearing Officer's finding that JACK, as a common forename, was inherently only weakly distinctive was an assumption which she was not entitled to make. In particular, it submitted that it was a) an assumption unsupported by the evidence, b) an assumption not supported by the relevant case law and c) an assumption contradicted by her finding that *"there is no evidence to show that the use of forenames as brands is common in the [sector for which the specifications are relevant]"*.

8. In relation to these issues, both parties drew my attention to the decision of Daniel Alexander KC, sitting as the Appointed Person, in PIA HALLSTROM [2018] FSR 1. I should note here that this decision is not referred to in the judgment and it is unclear to me the extent to which the Hearing Officer was referred to it. Be that as it may, at paragraph 33 of that decision, Mr Alexander, stated as follows:

> *"if a trader choses a forename as a trade mark, the average consumer is not particularly likely to think that another trader who uses a full name incorporating that forename is thereby denoting goods or services from the first undertaking rather than those connected with someone else who happens to share that forename. That is a problem which arises as a result of a choice of mark which, precisely because it is a name which others either do or could reasonably wish to use to denote themselves, does not start high on the distinctiveness scale. Large-scale use of such a mark does snot, as such, enhance its distinctiveness's in a relevant way, namely so as to increase the likelihood of confusion"*

9. The Appellant submitted that this finding is limited to cases where the sectors for which trade -mark registration is sought are sectors where the use of forenames as brands is recognised as being common (as was the case in PIA HALLSTROM), and therefore should not be applied in this case.

10. I disagree. In my view the rationale of paragraph 33 is applicable generally, albeit the degree to which applies is a matter of fact and degree in each case. Two additional passages from PIA HALLSTROM, namely from paragraphs 15 and 17, support this conclusion:

> *15 "Third, if the term "PIA" on its own is perceived to be a name, it does not follow that the average consumer would imagine that the only person with such a name would be the person behind (or the person after whom) the opponent's business was named. Thus, the mere fact that the name "JOHN" is likely o be perceived by most people as a name does not thereby mean that an average consumer would automatically or probably suppose that goods banded "JOHN SMITH" would come from the same trade source as those branded "JOHN". In some contexts, and depending on the particular evidence in a case, such a finding might be warranted but I do not consider that there is a general rule"*
>
> *17 The hearing officer concluded at para. 34 that the distinctive character of the respective marks was not particularly high because forenames serve to indicate any number of individuals. That, as the opponent contents, is not easy to square, as a matter of language, with the hearing officer's conclusion that "PIA" would not necessarily be perceived as a forename taken alone. However, in my view, what the hearing officer was really saying in that passage was that in so far as the similarity of marks rested on the similarity in the PIA element, there were good reasons for the average consumer not to treat that element as distinctive. To that extent he was justified".*

11. Whilst the Hearing Officer does not appear to have reached her decision by explicit reference to PIA HALLSTROM, the approach she took is consistent with that decision. She was entitled in my view to start from the (undisputed) premise that JACK was a common forename and to go on, on the facts of this case, to place weight on that finding when considering the question of inherent distinctiveness of the mark. Based on the evidence before her (and noting that there was no suggestion that her findings of fact were wrong or that she failed either to take relevant evidence into account or had taken into account evidence that she should not have done) I find there to be nothing in her reasoning that would justify my interference with her finding that JACK was of inherently low distinctiveness. I therefore reject this Ground of Appeal.

TMA Section 5(2)(b) (Grounds 2 and 3)

12. By Ground 2, the Appellant submitted that if it was right in Ground 1 then it necessarily follows that the Hearing Officer should have gone on to consider *Medion*-type confusion. As I have dismissed Ground 1, and no other cogent reason for engaging in a *Medion*-type analysis was advanced, I also dismiss Ground 2.

13. By Ground 3, the Appellant contended is that Hearing Officer failed to consider the question of indirect confusion properly. The point was advanced in paragraph 20 of Appellant's skeleton on appeal as follows:

> *The essence of indirect confusion is that despite recognising that the later mark is not the earlier mark, the average consumer nevertheless assumes an economic connection between the two marks. Even if JACK is not independently distinctive within the contested mark (as it would need to be for Medion confusion to apply) it is still an element which the consumer will associate with the Appellant. The Hearing Officer does correctly find that JACK & VICTOR will "trigger a mental association" (paragraph 154) under Section 5(3) TMA with the JACK mark for goods where there is medium similarity or greater.* ***If the distinctive character of JACK had been properly evaluated, this link/association would be even stronger, and in the context of identical goods at least, would give rise to a likelihood of confusion.***

14. As is apparent from the last sentence of this passage, Ground 3 was also dependent upon Ground 1. Even if I were wrong on that, I can find nothing inherently wrong in the Hearing Officer's overall assessment of indirect confusion. I therefore likewise dismiss Ground 3.

TMA Section 5(3) (Ground 4)

15. The Appellant's final ground of appeal challenged the Hearing Officer's finding, at paragraph 159 of the decision that use of the JACK & VICTOR mark would take unfair advantage of Appellant's earlier JACK DANIELS, JACK and GENTLEMEN JACK marks (these being the marks for which a relevant reputation, for the purposes of section 5(3), was established). At paragraph 159 the Hearing Officer found as follows:

> 159. Turning to whether there is an objective unfair advantage, my view is that there is not. Whilst I have accepted that there will be a link for the earlier "JACK" mark, I do not consider that the applicant will derive any advantage from the link. **It will, in my view, be no more than a momentary bringing to mind of the opponent's mark. Any brief wondering about a connection will be swiftly dismissed because of the dissimilarities between the marks, which will cause the consumer to conclude that these are two unconnected brands which happen to include the name "JACK". It will not result in a leg up for the applicant's mark on the basis of the "JACK" mark's reputation, whether by means of a marketing advantage or an image transfer.**

16. The Appellant submitted that once a "link" had been found by the Hearing Officer it was inevitable on the facts of this case that a finding of unfair advantage must follow.

Furthermore, it submitted that the Hearing Officer had fallen into error by (a) focusing on the question of whether the relevant members of the public would assume there was a relevant economic connection between the brand owners of the marks in question, and (b) failing to give sufficient weight to the question of "image transfer".

17. I reject these submissions for the following reasons.

18. First, it is important to note that the Appellant neither challenged the Hearing Officer's primary findings of fact, nor did it suggest that she took into account evidence she should not have done, or failed to take into account evidence she should have done. It follows that the heart of the Appellant's submission is that the Hearing Officer reached a decision that no reasonable tribunal could have done based on the evidence before her. Thus, at paragraph 33 of its skeleton it submits that:

> In this case the products in question are identical and it is difficult to see how image transfer (of the sort set out in the caselaw) would not occur. The consumer of the Jack & Victor whiskey knows of the JACK brand and its reputation, has that brand brought to mind, and there is nothing to dispel the possibility of image transfer.

19. Second, there is in my view no adequate basis for suggesting that the Hearing Officer failed to give sufficient weight to the question of image transfer (or overly focussed on whether relevant members of the public would assume there was a relevant economic connection between the brand owners). The Hearing Officer spent some considerable time considering the existence and nature of the link and the possibility of image transfer. Although her conclusions on the effect of such a link are briefly expressed, there is nothing in my view inherently wrong with those conclusions, or indeed anything that would justify me interfering with them.

20. I therefore reject this ground of appeal.

Conclusions

21. For the reasons given above, I dismiss this appeal.

22. Since the appeal has been dismissed, I find that Respondent is entitled to a contribution towards its costs. I will therefore make an order that the Appellant pay to the Respondent

£1,000 together with the order for costs below, i.e. the total sum of £4,200 by 4pm on 7 February 2024.

GEOFFREY PRITCHARD

The Appointed Person

15 January 2024