

O/0489/26

TRADE MARKS ACT 1994

IN THE MATTER OF REGISTRATION NO. UK00004066967

IN THE NAME OF AHMED TEJAN-KELLA

FOR THE FOLLOWING TRADE MARK:

**Amalfy Acqua**

IN CLASS 32

AND

AN OPPOSITION UNDER NO. OP000449998

BY

CHIVAS HOLDINGS (IP) LIMITED

## BACKGROUND AND PLEADINGS

1. Ahmed Tejan-Kella (“the applicant”) applied to register the trade mark on the cover of this decision in the UK (UK trade mark (“UKTM”) no. 4066967) (“the contested mark”) on 23 June 2024. It was accepted and published in the Trade Marks Journal on 5 July 2024 in respect of the following goods:

Class 32 - Water; Aerated water [soda water]; Drinking water; Bottled water; Seltzer water; Water (Seltzer -); Mineral water; Soda water; Drinking mineral water; Aerated water; Bottled drinking water; Carbonated water; Coconut water; Drinking spring water; Distilled drinking water; Sparkling water; Purified drinking water; Lithia water; Water (Lithia -); Tonic water; Spring water; Glacial water; Drinking water with vitamins; Quinine water; Mineral water [beverages]; Carbonated mineral water; Coconut water as a beverage; Coconut water as beverage; Birch water.

2. On 4 October 2024, Chivas Holdings (IP) Limited (“the opponent”) opposed the trade mark on the basis of Sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 (“the Act”). For the purposes of both grounds of opposition, the opponent relies upon the following trade mark registration:

UKTM no. 801322701<sup>1</sup>

**MALFY**

Filing date 27 October 2016; registration date 11 May 2017

Priority date 11 October 2016 (based upon a United States of America mark<sup>2</sup>).

It stands registered for *Gin* in class 33.

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<sup>1</sup> The opponent’s mark is a comparable mark based on an earlier International Registration designating the EU (“IR”). On 1 January 2021, in accordance with Article 54 of the Withdrawal Agreement between the UK and the European Union, the UK IPO created comparable UK trade marks for all right holders with existing IR’s. These comparable marks enjoy the same filing and registration dates as their European counterparts.

<sup>2</sup> United States of America trade mark no. 87199140

3. Under section 5(2)(b), the opponent claims that there is a likelihood of confusion on the basis that the marks are similar, and the goods are either identical or highly similar leading to a likelihood of confusion, including a likelihood of association, and that the contested mark should be refused registration.

4. Under section 5(3), the opponent relies upon the above mark, claiming a reputation for *Gin* in class 33, for which the mark is registered. It claims that use of the mark would, without due cause, take unfair advantage of, or be detrimental to, the distinctive character and/or repute of the earlier mark.

5. The applicant filed a defence and counterstatement denying the claims made and putting the opponent to strict proof of its claims.

6. The opponent's mark qualifies as an 'earlier mark' in accordance with section 6 of the Act. It has been registered for more than five years at the filing date of the contested mark and is, therefore, subject to the proof of use requirements in section 6A of the Act. The opponent provided a statement that it had used the earlier mark for *Gin* and the applicant requested that it file proof of the same.

7. The opponent is represented by Marks & Clerk LLP. The applicant is self-represented. The opponent filed evidence in the form of a witness statement. No hearing was requested, however, both parties filed written submissions in lieu. This decision is taken following a careful consideration of all papers filed.

## **EVIDENCE AND SUBMISSIONS**

8. The opponent's evidence consists of the witness statement of Mr Benjamin Goldenberg, dated 21 January 2025, which is accompanied by five exhibits (BG1 – BG14). Mr Goldenberg is the Senior Intellectual Property Counsel within the Group Intellectual Property Hub of Pernod Ricard, which is the parent company of the opponent, and he provides evidence of use of the earlier mark as relied upon and the reputation it claims to hold.

9. The applicant filed written submissions in lieu dated 24 February 2025.

10. The opponent filed written submissions in lieu dated 21 May 2025.

11. The applicant filed further written submissions in lieu dated 19 June 2025.

12. Whilst I have given due consideration to all of the documents filed by both parties I do not propose to summarise them in full but will only refer to the evidence/submissions as appropriate to the extent that is necessary in my decision.

## **PRELIMINARY ISSUES**

13. The parties' submissions in lieu were due to be filed by 21 May 2025. The applicant did not file their written submissions at this time. On 19 June 2025, the applicant wrote to the Registry as follows:

“Regrettably, I must inform you that I failed to meet this deadline due to an unforeseen technical error. I prepared and intended to submit written submissions by the stipulated date. However, due to a malfunction in my email system, the submission, which I believed had been successfully sent to Tribunalsection@ipo.gov.uk and the Applicant was not transmitted. This error was only discovered upon a routine system check conducted on 18 June 2025, at which point I immediately took steps to rectify the issue. I have gone out of my way tonight 19 June 2025 (approximately 01:00AM) to send this email [sic] and submission. I sincerely apologise for this oversight and any inconvenience caused to the Registry and the Opponent.”

14. The Registry wrote to the applicant on 19 June 2025, confirming that given the content of the submissions, the Registry would admit the late-filed written submissions and that the opponent should respond only if it felt it necessary. No response was received from the opponent and the applicant's late filed submissions were admitted in proceedings. I do not consider that there is a need to address this further.

## **RELEVANCE OF EU LAW**

15. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained

EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

## **DECISION**

### **PROOF OF USE**

16. The relevant statutory provisions are as follows:

“6A(1) This section applies where:

- (a) an application for registration of a trade mark has been published,
- (b) there is an earlier trade mark of a kind falling within section 6(1)(a), (aa) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and
- (c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

(1A) In this section “the relevant period” means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

- (a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or
- (b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes –

a) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5)-(5A) [Repealed]

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.”

17. As the earlier mark is a comparable mark, paragraph 7 of Part 1, Schedule 2A of the Act is also relevant. It reads:

“7.— (1) Section 6A applies where an earlier trade mark is a comparable trade mark (EU), subject to the modifications set out below.

(2) Where the relevant period referred to in section 6A(3)(a) (the “five-year period”) has expired before IP completion day—

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM; and

(b) the references in section 6A(3) and (4) to the United Kingdom include the European Union.

(3) Where [IP completion day] falls within the five-year period, in respect of that part of the five-year period which falls before IP completion day —

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM ; and

(b) the references in section 6A to the United Kingdom include the European Union”.

18. Section 100 of the Act is also relevant, which reads:

“If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

19. The relevant period for the purposes of assessing genuine use is from 24 June 2019 to 23 June 2024. As the earlier mark is a comparable mark, the opponent can rely upon use in the EU for any and all parts of the relevant period which falls prior to IP Completion Day, namely, 31 December 2020, and thereafter use must be shown in the UK.<sup>3</sup>

20. In *easyGroup Ltd v Nuclei Ltd & Ors* [2023] EWCA Civ 1247, Arnold LJ summarised the law relating to genuine use as follows:

“105. The principles applicable to determining whether there has been genuine use of a trade mark have been considered by the CJEU in a considerable number of cases, the principal decisions being Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159, Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bunderversvereinigung Kamaradschaft 'Feldmarschall Radetsky'*[2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], Case C-141/13 *P Reber Holding & Co KG v Office for Harmonisation in the Internal Market*

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<sup>3</sup> paragraphs 7 and 8 of Part 1 Schedule 2A of the Act.

(*Trade Marks and Designs*) [EU:C:2014:2089], Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434] and Joined Cases C-720/18 and C-721/18 *Ferrari SpA v DU* [EU:C:2020:854].

106. Ignoring issues which do not arise in the present case, such as use in relation to spare parts or second-hand goods and use in relation to a sub-category of goods or services, the principles may be summarised as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29]; *Ferrari* at [32].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29]; *Gözze* at [37], [40]; *Ferrari* at [32].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an

outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56]; *Ferrari* at [33].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

21. In *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*, Case BL O/404/13, Mr Geoffrey Hobbs QC (as he then was), sitting as the Appointed Person stated that:

“22. When it comes to proof of use for the purpose of determining the extent (if any) to which the protection conferred by registration of a trade mark can

legitimately be maintained, the decision taker must form a view as to what the evidence does and just as importantly what it does not ‘show’ (per Section 100 of the Act) with regard to the actuality of use in relation to goods or services covered by the registration. The evidence in question can properly be assessed for sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use.”

22. What I take from this case law is that there is no requirement to produce any specific form of evidence, but that I must consider what the evidence as a whole shows me, and whether on this basis I can reasonably be satisfied on the balance of probabilities that there has been genuine use of the contested mark.

### The Opponent’s Evidence

23. Mr Goldenberg states as follows:

- a. The opponent is a holding company and registered proprietor of trade marks for spirit brands, including Malfy Gin, which is an Italian gin brand which was established in 2016 and acquired by the opponent in 2019. The brand launched in the UK in 2016. The products are distributed globally in 60 markets.
- b. The opponent’s range of products include “MALFY Originale, MALFY Rosa, MALFY Con Arancia, and MALFY Con Limone”. The opponent’s MALFY gin products are offered in varying bottle sizes, including 50ml, 700ml, 1L and 1.75L bottles”<sup>4</sup>.
- c. Details of the range of gin goods currently offered have been provided<sup>5</sup>, a sample of these are below:

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<sup>4</sup> Witness statement of Mr Goldenberg, para 5

<sup>5</sup> Exhibit BG1



Malfy > Gin Rosa

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GIN ROSA

CON LIMONE CON ARANCIA

MALFY ORIGINALE

FOOD & DRINK PAIRINGS

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## MALFY GIN ROSA

Malfy Gin Rosa is a bright and refreshing gin, distilled in Northern Italy, at the Torino Distillati, with some of the finest botanicals including handpicked juniper, Italian lemons and some fresh Sicilian pink grapefruit.

Inspired by the Amalfi lifestyle, Malfy Gin invites you to live 'La Dolce Vita' as a true Italian and experience Italy's passion of sharing love, laughter and lasting moments.



Malfy Rosa Sicilian Pink Grapefruit Flavoured Gin | Various Flavours | 41% ABV | 70cl | Citrus Grapefruit Notes | Background Notes of Juniper | Grapefruit...

4.8 ★★★★★ 4,425

£29.99 (£12.84/l)

Get it by Friday 17 January

Dispatched from and sold by Amazon

ABOUT MALFY ROSA GIN (70cl): Inspired by 'La Dolce Vita' and the Amalfi Coast, Malfy is effortlessly stylish and features contemporary expressive brush strokes across its bottle in vibrant colours and finer patterns to bring the tasting notes of the gin to life

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Malfy Con Arancia

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## MALFY CON ARANCIA

A colourful burst of Italian sunshine, Malfy Con Arancia is distilled in Northern Italy, at the Torino Distillati, with some of the finest botanicals including handpicked juniper, Italian oranges and a selection of flavourful Sicilian blood oranges.

Inspired by the Amalfi lifestyle, Malfy Gin invites you to live 'La Dolce Vita' as a true Italian and experience Italy's passion of sharing love, laughter and lasting moments.



Malfy Arancia Sicilian Blood Orange Flavoured Gin | 41% ABV | 70cl | Flavoured Italian Gin | Orange Blossom Notes | Background Notes of Juniper |...

4.8 ★★★★★ 5,528

**£27.00** (€38.57/l)

RRP: £60.00 (12% off)


Get it by Friday 17 January.

Dispatched from and sold by Amazon.

ABOUT MALFY GIN CON ARANCIA (70cl): Inspired by 'La Dolce Vita' and the Amalfi Coast, Malfy is an effortlessly stylish flavoured gin and features contemporary expressive brush strokes across its bottle in vibrant colours and flower patterns to bring the tasting notes of the

✖ Show more

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d. Mr Goldenberg has provided the following information regarding the UK sales of the opponent's various products, which are sold via Amazon UK<sup>6</sup> (I also have evidence before me which shows that products bearing the figurative mark are for sale in Tesco, Sainsbury's, Waitrose, Selfridges and Harvey Nicholls):

- i. MALFY Originale – first sold on 1 November 2017. Over 50 bottles were sold in the month preceding 20 January 2025. Ranked as bestseller no. 224 in the gin category on Amazon UK;

<sup>6</sup> Witness statement of Mr Goldenberg, para 6 and Exhibit BG2

- ii. MALFY Rosa – first sold on 10 May 2018. Over 300 bottles were sold in the month preceding 20 January 2025. Ranked as bestseller no. 62 in the gin category on Amazon UK;
  - iii. MALFY Con Limone – first sold on 15 March 2016. Over 100 bottles were sold in the month preceding 20 January 2025. Ranked as bestseller no. 74 in the gin category on Amazon UK;
  - iv. MALFY Con Arancia – first sold on 12 January 2018. Over 400 bottles were sold in the month preceding 20 January 2025. Ranked as bestseller no. 58 in the gin category on Amazon UK;
  - v. MALFY Italian Gin Miniatures Gift Box – first sold on 27 July 2018. Over 1000 boxes were sold in the month preceding 20 January 2025. Ranked as bestseller no. 22 in the gin category on Amazon UK;
- e. In respect of sales of products bearing the mark, Mr Goldenberg states as follows:
- “The Opponent has made significant sales of its goods under the MALFY brand in the UK and globally. Its sales figures globally include 1,200,000 (9-litre) cases of gin during the fiscal year (“FY”) 2020 (i.e. between 1 July 2019 and 30 June 2020), 2,400,000 cases in FY 2021, 3,552,000 cases in FY 2022, 3,848,000 cases in FY 2023 and 3,292,000 cases in FY 2024”.<sup>7</sup>
- f. 11 invoices have been provided<sup>8</sup> dated between 3 December 2020 and 7 August 2024. Mr Goldenberg states that these are example invoices. The invoice amounts have been redacted; however, I note that each of the invoices is addressed to distributors within the UK, including (but not limited to) Tesco Stores Ltd, Ocado Retail Ltd, Dhamecha Foods Ltd, Asda Stores Limited and LWC drinks Limited. Each of the invoices contains the opponent’s name in the header and makes reference to

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<sup>7</sup> Witness statement of Mr Goldenberg, para 8 and Exhibit BG3

<sup>8</sup> Exhibit BG4

goods which are sold in the name of the mark. Malfy Gin appears in the product description of each invoice and makes reference to Gin products which were sold under the earlier mark.

- g. Mr Goldenberg states that the opponent currently sells MALFY gin products to at least 60 UK distributors, however, each distributor may have multiple stores. For example, the opponent's largest customers in the UK are Tesco and Sainsbury's, which have approximately 2,876 and 1,415 stores respectively.<sup>9</sup>
- h. Mr Goldenberg states:

"The Opponent has made significant efforts in terms of the marketing and promotion of the MALFY brand and produces a large amount of marketing material prominently featuring the MALFY mark both in the UK and globally".<sup>10</sup>

Total marketing expenditure for the past five years is as follows:

<b>Year</b>	<b>Total marketing expenditure (in GBP)</b>
2020	£886,654
2021	£1,994,238
2022	£3,255,324
2023	£2,925,816
2024	£1,515,794

- i. As part of its marketing, the opponent publishes recipe cards for MALFY gin cocktails, which include non-alcoholic beverages and carbonated beverages<sup>11</sup>. I note that none of these are dated. An example of this is as follows:

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<sup>9</sup> Exhibit BG5

<sup>10</sup> Witness statement of Mr Goldenberg, para 12

<sup>11</sup> Exhibit BG6



- j. In 2022, the opponent launched its global “Immagina Malfy” marketing campaign. Mr Goldenberg states that “the objective of the campaign was to establish MALFY as a super-premium Italian gin and lifestyle brand”<sup>12</sup>. The following marketing expenditure figures for the campaign have been provided:

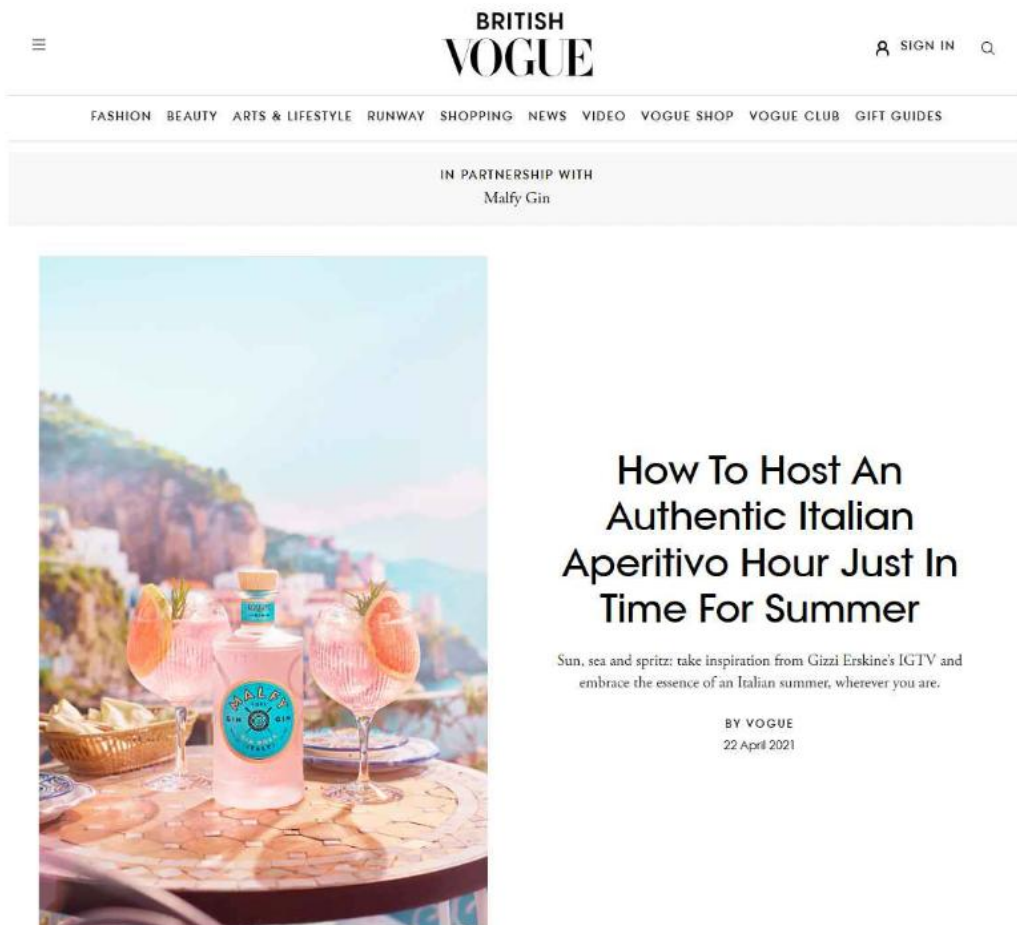
Year	Approximate marketing expenditure (in GBP)
2023	£772,000
2024	£518,000

The campaign was marketed via a number of platforms including social media, online video advertising and online retail platforms such as Meta, Pinterest, YouTube and Amazon. The number of views were as follows:

Year	Total number of impressions	Total number of video views
2023	83.8 million	20 million
2024	104 million	22.4 million

<sup>12</sup> Witness statement of Mr Goldenberg, para 15

- k. In July 2024, the opponent took part in a brand collaboration with Missoni for the launch of a limited-edition bottle of MALFY Gin Rosa. The limited-edition bottle was available to purchase in the UK, Italy, Greece and global travel retail. As part of the marketing campaign, social media influencers were gifted a bottle of the gin. 12 stories were posted on Instagram, with a reach of 459,600.
  
- l. The MALFY brand has featured in press coverage within the UK. I have before me examples of articles<sup>13</sup> from national and global press, dated between 2018 and 2024, featuring the mark as set out below. Mr Goldenberg states that publications have been included on websites such as The Independent, which has around 24 million UK browsers and 77 million global browsers as of November 2024. An example of one of these articles is as follows:



<sup>13</sup> Exhibit BG11

m. The opponent has won approximately 37 awards for its various MALFY Gin products between 2022 and 2024. A list of the various awards has been provided within paragraph 21 of Mr Goldenberg's witness statement, an example of which is as follows:



## FORM OF THE MARK

24. Before I move on to assess if the opponent has shown genuine use of the earlier mark, I must first consider if I find the use of the mark as shown in the evidence to be use of the mark as registered and/or use of an acceptable variant of the same.

25. The earlier mark is a word only mark presented in upper case. Given that normal and fair use of the registration will cover use in any standard typeface or font, where the mark is used in capitals or title case, or a mixture of both, this is use of the mark as registered and is use upon which the opponent may rely. The mark is also shown as follows throughout the evidence on the labels of the bottles themselves:



26. I acknowledge that where a registered mark is used with additional matter, this may still constitute acceptable use of the mark as registered, where this element continues to act independently as an indicator of origin<sup>14</sup>.

27. The above variations show the word MALFY presented on a round label on the bottles themselves and in which the word MALFY is prominently displayed at the top of the mark in a large, stylised font of differing colours. Beneath the word MALFY are a number of differing text elements which give information regarding the product such as its volume, alcohol content and flavour, some of which also appear to be in Italian. At the centre of the label is a circular crest device.

28. These additional elements are indicative of information contained on the label of a product and are non-distinctive, since they are descriptive elements regarding the goods on offer. Whilst the crest device in the middle of the label contains symbols, I do not consider that the average consumer would attribute a specific meaning to this, and it would be considered as decorative. I consider that the stylised word, MALFY,

<sup>14</sup> *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12

remains the dominant element in the variant shown and is therefore an acceptable variation of the mark and is use upon which the opponent can rely.

## **SUFFICIENT EVIDENCE**

29. An assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself<sup>15</sup>.

30. I am satisfied that the evidence shows that the earlier mark has been used either as registered or in an acceptable variation as outlined above. Whilst I do not have turnover figures before me, the units sold are in the millions per annum and the opponent has clearly taken steps to promote the products sold under its mark and to maintain a share in the market. Taking the evidence as a whole into account, I am satisfied that the earlier mark has been put to genuine use for *Gin* during the relevant period in the UK.

31. I note that the mark is registered in respect of *Gin* in class 33. It is clear from the evidence that MALFY products are different flavours of gin. I therefore consider that the opponent has shown use for the term, and this is a fair specification for the earlier mark.

## **DECISION**

### **Section 5(2)(b)**

32. Section 5(2)(b) of the Act is as follows:

“5(2) A trade mark shall not be registered if because-

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is

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<sup>15</sup> *New Yorker SHK Jeans GmbH & Co KG v OHIM*, T-415/09

protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark”.

33. Section 5A of the Act states as follows:

“Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

## **THE PRINCIPLES**

34. The following standard summary of the principles applicable to the assessment of the likelihood of confusion was approved by the Supreme Court in *Iconix Luxembourg Holdings SARL v Dream Pairs Europe Inc & Anor*, [2025] UKSC 25:

(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may, in certain circumstances, be dominated by one or more of its components;

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense; and

(k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically linked undertakings, there is a likelihood of confusion.

## COMPARISON OF GOODS

35. The goods for comparison are as follows:

<b>The opponent's goods</b>	<b>The applicant's goods</b>
	Class 32 - Water; Aerated water [soda water]; Drinking water; Bottled water; Seltzer water; Water (Seltzer -); Mineral water; Soda water; Drinking mineral

	<p>water; Aerated water; Bottled drinking water; Carbonated water; Coconut water; Drinking spring water; Distilled drinking water; Sparkling water; Purified drinking water; Lithia water; Water (Lithia -); Tonic water; Spring water; Glacial water; Drinking water with vitamins; Quinine water; Mineral water [beverages]; Carbonated mineral water; Coconut water as a beverage; Coconut water as beverage; Birch water.</p>
Class 33 - Gin	

36. In the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary.”

37. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;

(d) The respective trade channels through which the goods or services reach the market;

(e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;

(f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

38. In *Absolut Company Aktiebolag v Dongguan Topson Electronic Technology Co. Ltd*, BL O/0488/25, Phillip Johnson, as the Appointed Person, identified the following considerations relevant to the comparison of alcoholic beverages and other drinks:

“13. First, the fact that spirits are mixed with soft-drinks (mixers) does not make the products complimentary (*Yilmaz*, [55]; *Wesergold*, [40]; *CHIC*, [53 to 55]), but it does mean there is a partial (but not significant) overlap between spirits and soft drinks (*Wesergold*, [32 and 33]).

14. Second, soft-drinks, water and (possibly) beer are drunk to quench the thirst (*Yilmaz*, [54]; *Wesergold*, [35 and 36]; *ROSALIA DE CASTRO*, [31]; the *CHIC* case takes a different view that low alcoholic drinks are not consumed to quench thirst, *CHIC*, [44]), but in any event spirits are not consumed to quench thirst (*Yilmaz*, [54]; *Wesergold*, [35 and 36]).

15. Thirdly, the methods of production for alcoholic drinks (and between alcoholic drinks and non-alcoholic drinks) differ and this is relevant to the similarity between them: *Mezzopane*, [64 and 69]; *Bodegas*, [29]; *Yilmaz*, [54]. Likewise, products which are processed versions of each other might be more similar (eg wine and Brandy): *Vanhove*, [87].

16. Fourthly, the differences between the colour, aroma and taste of two alcoholic drinks suggests to consumers that they are different: *Mezzopane*, [65]; *Yilmaz*, [54].

17. Finally, the alcoholic content of the goods is a very relevant factor in determining the similarity of the goods: *Bodegas*, [32]; *Wesergold*, [31]; *CHIC*, [40 and 41]; *FLÜGEL*, [84]. However, a non-alcoholic version of an equivalent alcoholic drink is likely to be highly similar to it: *CERVISIA*, [20]. Nevertheless, the Grand Board highlighted that a drink's alcoholic content is only a factor in the assessment of similarity and is not determinative: *ZORAYA*, [68]."

39. The applicant submits:

"The Opponent categorizes the Applicant's goods (various waters in Class 32) into "drink mixers," "mineral and aerated waters," and "other beverages," alleging similarity to gin (Class 33) due to shared nature, trade channels, and complementary use. This analysis is untenable:

- Nature and Purpose: Water, even when used as a mixer, serves a primary purpose of hydration, distinct from gin's alcoholic, recreational function. The Opponent's reliance on cocktail recipes (e.g., gin and tonic) overlooks that mixers are generic commodities, not branded goods tied to "Malfy."
- Trade Channels and Proximity: While both goods may be sold in supermarkets, they occupy different aisles (water vs. spirits), targeting different purchasing decisions. The Opponent's evidence of proximity (e.g., Exhibit BG13) is anecdotal and fails to establish a material overlap.
- Complementary Nature: The use of water as a mixer for gin does not imply similarity. Per *British Sugar Pie v James Robertson & Sons Ltd* [1996] RPC 281, complementarity requires a closer economic or functional link, absent here. The rise of hard seltzers, cited by the Opponent, pertains to alcoholic beverages, not the Applicant's non-alcoholic waters.

The goods are dissimilar or, at best, remotely related, negating any likelihood of confusion."

40. The opponent submits that the goods are similar:

“As they are [sic] share the same nature, all being beverages for human consumption. Further, these Contested Goods are commonly used as mixers for alcoholic beverages. In particular, tonic water, quinine water, seltzer water and soda water are rarely consumed on their own and are primarily used as mixers for alcoholic drinks, including gin-based cocktails such as the "gin and tonic". Accordingly, the Contested Goods and the Opponent's Goods share the same end users, methods of use and are complementary. We refer to paragraph 20 of the Witness Statement of Benjamin Goldberg ("WS/BG") and Exhibit BG13, which demonstrate numerous gin-based cocktail recipes in which gin is used together with carbonated/sparkling water, tonic water and/or soda water, as further substantiation of this claim. The goods also share the same trade channels, as they are sold in the same bars, pubs, restaurants, retail stores and supermarkets. In supermarkets, these goods are typically found in close proximity to one another in the alcoholic beverage and mixer aisles. In addition, the similarities between carbonated and seltzer waters and alcoholic beverages (including gin) have increased in recent years following the rising popularity of low alcohol beverages as well as zero alcohol alternatives on the one hand, and the rising popularity of alcoholic versions of otherwise non-alcoholic beverages, such as hard seltzers, on the other hand, in the UK market. Hence the Opponent submits that both the producers and consumers of the Contested Goods may coincide, as more alcoholic beverage companies are expanding into the market of low and zero alcohol alternatives, which can also in some cases take the form of seltzers or flavoured carbonated water beverages. Therefore, it is submitted that the goods are similar to at least a medium degree.”

*Water; Aerated water [soda water]; Drinking water; Bottled water; Seltzer water; Water (Seltzer -); Mineral water; Soda water; Drinking mineral water; Aerated water; Bottled drinking water; Carbonated water; Coconut water; Drinking spring water; Distilled drinking water; Sparkling water; Purified drinking water; Lithia water; Water (Lithia -); Tonic water; Spring water; Glacial water; Drinking water with vitamins; Quinine water;*

*Mineral water [beverages]; Carbonated mineral water; Coconut water as a beverage; Coconut water as beverage; Birch water.*

41. The applicant's goods are different types of water. The users of these goods will be the same as for the opponent's goods, except in the opponent's case consumers will be above the age of 18. However, although both parties' goods are drinks, their respective natures are very different, consisting of different ingredients. Their purpose is also not the same (the applicant's goods will be consumed primarily to quench thirst and for sustenance, whereas the opponent's goods are more likely to be consumed to enjoy the effects of alcohol). They are, in my experience, not stocked in close proximity in supermarkets and the like (even though they are all commonly sold in such establishments, along with bars and restaurants etc.). Their different nature and purpose means that they are also not in competition and neither is there a complementary relationship, in the sense described in the case law<sup>16</sup>. I do not doubt, as the opponent submits, that the contested goods are commonly used as mixers for alcoholic drinks, and in low/zero alcohol beverages, but that factor alone does not mean that the respective goods are important or indispensable to each other in such a way that the average consumer will believe that they come from the same undertaking. I consider the goods to be dissimilar.

42. As some degree of similarity between goods is necessary to engage the test for likelihood of confusion, my findings above mean that the opposition under section 5(2)(b) will fail<sup>17</sup>.

### **Section 5(3)**

43. Section 5(3) states:

“(3) A trade mark which-

is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom and the use of the later mark without due cause would take unfair advantage

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<sup>16</sup> *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06

<sup>17</sup> *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, Lady Justice Arden

of, or be detrimental to, the distinctive character or the repute of the earlier trade mark”.

44. Section 5(3A) of the Act states:

“Subsection (3) applies irrespective of whether the goods and services for which the trade mark is to be registered are identical with, similar to or not similar to those for which the earlier trade mark is protected.”

45. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, Case C-252/07, *Intel*, Case C-408/01, *Adidas-Salomon*, Case C-487/07, *L’Oreal v Bellure* and Case C-323/09, *Marks and Spencer v Interflora* and Case C-383/12P, *Environmental Manufacturing LLP v OHIM*. The law appears to be as follows:

(a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman*, paragraph 29 and *Intel*, paragraph 63.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark’s reputation and distinctiveness; *Intel*, paragraph 42.

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel*, paragraph

68; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel*, paragraph 79.

(f) the more immediately and strongly the earlier mark is brought to mind by the later mark, the greater the likelihood that use of the latter will take unfair advantage of, or will be detrimental to, the distinctive character or the repute of the earlier mark; *L'Oreal v Bellure NV*, paragraph 44.

(g) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel*, paragraphs 76 and 77 and *Environmental Manufacturing*, paragraph 34.

(h) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel*, paragraph 74.

(i) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV*, paragraph 40. The stronger the reputation of the earlier mark, the easier it will be to prove that detriment has been caused to it; *L'Oreal v Bellure NV*, paragraph 44.

(j) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in

order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora*, paragraph 74 and the court's answer to question 1 in *L'Oreal v Bellure*).

46. The conditions of section 5(3) are cumulative. Firstly, the opponent must show that their mark and the applicant's mark are similar. Secondly, the opponent must show that the earlier mark has achieved a level of knowledge/reputation amongst a significant part of the public. Thirdly, it must be established that the level of reputation and the similarities between the marks will cause the public to make a link between them in the sense of the earlier mark being brought to mind by the later mark. Finally, assuming the first three conditions have been met, section 5(3) requires that one or more of the types of damage will occur. It is unnecessary for the purposes of section 5(3) that the goods be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks. For the purposes of section 5(3) the relevant date for the assessment is 23 June 2024.

## **SIMILARITY OF MARKS**

47. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall

impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

48. It would be wrong, therefore, to dissect the trade marks artificially, although it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

49. The respective trade marks are shown below:

The earlier trade mark	The contested trade mark
<b>MALFY</b>	<b>Amalfy Acqua</b>

50. Both parties have made submissions regarding the comparison of the marks. I have considered these submissions in full and will refer to them where necessary.

### **Overall impression**

51. The opponent’s mark is a word only mark that consists solely of the word ‘MALFY’. There are no other elements that contribute to the overall impression of the mark, which lies in the word itself.

52. The applicant’s mark is a word only mark, consisting of the words ‘Amalfy Acqua’. There are no other elements that contribute to the overall impression of the mark, which lies in the words themselves. I find ‘Amalfy’ to be the dominant/distinctive element of the mark, as I am of the opinion that ‘Acqua’ will be considered by the majority of consumers as a misspelling of ‘aqua’ and which will be understood to mean water and will therefore be considered to be descriptive of the applicant’s goods.

## Visual comparison

53. The respective marks overlap to the extent that the entirety of the opponent's mark appears within the first word of the applicant's mark, differing only in the letter 'A' at the beginning of the applicant's mark. I remind myself that the beginnings of a mark tend to have more visual and aural impact than the ends<sup>18</sup>. The applicant's mark includes an additional element in the form of the word, 'Acqua', there being no counterpart in the opponent's mark. Given these factors and weighing up the similarities against the differences, I consider that the 'marks are visually similar to a medium degree.

## Aural comparison

54. The earlier mark will be pronounced as MAL-FEE. The applicant's mark will be pronounced A-MAL-FEE A-KWA. As per *El Corte Inglés, SA*, I find the beginning of each mark to be aurally different as they start with different letters, albeit that the opponent's mark appears within the first word of the applicant's mark in its entirety. Given 'Acqua's' role within the mark, being descriptive of the goods on offer, the average consumer may not articulate this word, focussing solely on 'Amalfy'. I note Philip Johnson's comments in *TM ENRICH LEARNING* BL/O/1141/25 in which he said:

"15. The General Court continues to take the view that secondary or descriptive elements of marks are not necessarily spoken: see T-68/2021 *Hauz 1929 v EUIPO*, EU:T:2021:127, [40]; T-560/20 *Yadex International v EUIPO*, EU:T:2021:714, [75]; T-357/21 *Jose Alfonso Arpon v EUIPO*, EU:T:2022:405, [52]; T-1144/23 *Enedo Oyj v EUIPO*, EU:T:2025:207, [88]. These cases follow the general pattern of the jurisprudence before the UK left the EU and so they remain strongly persuasive, and I therefore consider them as reflecting English law: see *Lipton v BA Cityflyer Ltd* [2024] UKSC 24, [158].

16. In my view, the principle that descriptive or secondary elements in a mark may not be pronounced when the mark is spoken is distinct from the rule that negligible elements of marks can be disregarded in the comparison of marks

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<sup>18</sup> *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

(see C-3/03/P *Matratzen Concord* [2004] ECR I-3657). The former is a reflection of the fact that in everyday life people often say things in a simplified or shortened form (even though they may be aware of the entire mark). The latter principle, on the other hand, reflects the fact that negligible or insignificant elements of the mark will be forgotten (or not memorised in the first place).”

55. If *Acqua* is not pronounced, I find the marks to be aurally highly similar, as despite the contested mark starting with an ‘A’, the words are otherwise identical. However, if all verbal elements of the mark are articulated, there will be a medium degree of aural similarity between them.

### **Conceptual comparison**

56. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer, as highlighted in numerous judgments of the GC and the CJEU<sup>19</sup>.

57. The applicant submits:

“The Applicant’s mark derives from “Amalfi”, a recognized Italian town, paired with “Acqua” (Italian for water), reflecting the goods’ origin and nature. “Malfy” lacks any inherent meaning and is associated with Amalfi or water. The Opponent’s suggestion of an Italian connotation for “Malfy” is contrived and unsupported by its own evidence, which links “Malfy” to the Amalfi Coast as a marketing trope rather than a conceptual comparison”.

58. The opponent submits:

“Conceptually, the elements MALFY and AMALFY in the respective marks would likely be perceived as alluding to the Italian town of Amalfi and/or the Amalfi Coast. The additional element ACQUA does not detract from this message conveyed by the AMALFY element in the Contested Mark given its non-distinctive and descriptive nature in relation to the Applicant’s goods. This is further supported by the Applicant’s submissions wherein they admit that the

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<sup>19</sup> *Ruiz Picasso v OHIM* [2006] e.c.r.-I-643; [2006] E.T.M.R 29

Contested Mark was chosen/named “after the city [Amalfi] where the water was discovered” (at paragraph 10). Further, or in the alternative, it is submitted that the marks would at least be perceived by consumers as having an Italian connotation because both MALFY and AMALFY resemble Italian-sounding names and ACQUA in the Contested Mark is a basic Italian dictionary word which would be commonly understood by the UK public...as such, the marks share a high degree of conceptual similarity overall”.

59. Both parties submit that the marks in question would likely be perceived as alluding to the Italian town of Amalfi and/or the Amalfi Coast. I note that the spelling of the marks and the town in Italy differ, however, I agree that the Amalfi coast/town of Amalfi will be brought to mind in the case of both parties’ marks despite the misspellings. In the event that this is not the case, the average consumer is likely to view the marks as being from either an unidentified foreign language, or to be a meaningless word.

60. I have already found that ‘Acqua’ will be considered by the majority of consumers as a misspelling of ‘aqua’ and will therefore be considered to be descriptive of the goods on offer. The addition of ‘Acqua’ in the applicant’s mark gives rise to a point of conceptual difference, but not significantly so, as I have found it to be descriptive / non distinctive of the goods on offer. Conceptually, I find that the marks are highly similar.

## **REPUTATION**

61. In *General Motors*, Case C-375/97, the CJEU held that:

“25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market

share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.

28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation ‘in the Member State’. In the absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation ‘throughout’ the territory of the Member State. It is sufficient for it to exist in a substantial part of it.”

62. In assessing whether the earlier marks have a reputation to a significant number of consumers, I must assess the evidence in terms of the extent it demonstrates “the market share held by the trademark, the intensity, geographical extent and duration of use, and the size of the investment made by the undertaking in promoting it.”<sup>20</sup> I have summarised what I consider to be the key factors from the opponent’s evidence above.

63. I note that there are some issues with the evidence before me. For example, I do not have turnover figures relating to the mark, or market share details to assist my assessment of the level of the reputation or their position within that market. I note that the opponent’s evidence shows that millions of cases of MALFI Gin have been sold per annum up to and including the relevant date. Whilst I accept that the volume of units sold before me are global, and not solely related to sales within the UK, I note that the product is sold by 60 UK distributors, and that some of these are national retailers with multiple stores throughout the UK. I also note that the opponent’s products have been covered in the UK press during the relevant dates including articles in *The Independent*, *British Vogue* and *Good Food*, which are national publications, and that online advertising on sites such as YouTube has in excess of 20 million views globally, and therefore I accept that a proportion of these views would be by UK consumers.

64. Given the above, and as I have no details as to market share, and the only figures I have before me are global, and not directly for the UK, I am not reliably able to pitch the extent of the opponent’s reputation. However, I consider that the opponent’s mark

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<sup>20</sup> *General Motors* para 27.

had at least a moderate degree of reputation in the UK for the goods listed during the relevant period.

## LINK

65. Having found a moderate reputation for *Gin*, I must now go on to consider whether this reputation would give rise to the necessary mental link being made between the respective trade marks. The factors to be taken into account to establish as to whether a link would be made, are those as set out in *Intel*.<sup>21</sup> Taking each of the factors in turn:

### The degree of similarity between the conflicting marks

The marks are similar in varying degrees overall, as per my earlier findings, which I adopt here.

### The nature of the goods or services for which the conflicting marks are registered, or proposed to be registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public

The goods are dissimilar.

The average consumer of the respective goods will be the general public, albeit that the opponent's goods are alcoholic beverages, and will therefore be directed at those over the age of 18. The goods will be selected on a relatively frequent basis and are not expensive. Considerations such as taste, cost, and purpose of the beverage will be considered. i.e. whether the beverage will be consumed to quench thirst or for social, psychological and physiological reasons. The selection process will involve mainly visual considerations, with consumers being exposed to the marks in-store or in a pub, bar or club, or via advertising. There is nothing to suggest that beverages purchased in a public house setting will preclude a visual inspection<sup>22</sup>. There is also the potential for aural considerations to be relevant on the basis of verbal recommendations or

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<sup>21</sup> *Intel Corporation Inc v CPM United Kingdom Ltd* - [2009] RPC 15 (CJEU).

<sup>22</sup> *Simonds Farsons Cisk plc v Office for Harmonisation in the Internal Market 8* (Trade Marks and Designs) (OHIM), Case T-3/04

requests made to staff. I consider that the average consumer is likely to pay at least a medium level of attention to the goods in issue.

The strength of the earlier mark's reputation

The earlier mark had a moderate reputation in the UK at the relevant date.

The degree of the earlier mark's distinctive character, whether inherent or acquired through use

In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97, the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The earlier mark is a word only mark and consists of the word, MALFY. I have found that the average consumer of the goods in issue will understand the mark as either being a reference to the Amalfi coast/town of Amalfi despite the misspellings. In the event that this is not the case, the average consumer is likely to view the marks as being from either an unidentified foreign language, or to be a meaningless word. Furthermore, the earlier mark is not descriptive of the goods for which it is registered, nor does it allude to any quality of those goods. Although I have found that the average consumer is likely to perceive the mark as a reference to a geographical location, given its misspelling which adds to the distinctiveness of the mark, I consider the earlier mark overall to have a medium level of inherent distinctiveness.

Mr Goldenberg provided evidence of the opponent's use of the mark in the UK, which he states commenced in 2016. The opponent's products are distributed via 60 distributors within the UK, including major supermarkets, with some of those distributors having thousands of stores each. I note that turnover figures have not been provided, and the figures provided by the opponent in relation to units sold and marketing spend are global, and not UK specific. Although millions of units have been sold globally between 2020 and 2024, and I also note that in the same period £10,577,826 has been spent on marketing globally, it is necessary for the opponent to show that this is aimed at customers from the relevant territory, and I do not have this information before me.

The opponent's "Immagina Malfy" marketing campaign was launched in 2022 with the objective "to establish MALFY as a super-premium Italian gin and lifestyle brand". This campaign received over 20 million video views and in excess of 83.8 million impressions between 2023 and 2024 across its social media and retail platforms, albeit I have no specific information as to how many of these views/impressions were UK based. I also note that a collaboration was entered into with "well-known luxury Italian fashion brand", Missoni, for a limited

edition MALFY gin. Given the scale of the opponent's business, I am satisfied that it has also acquired enhanced distinctiveness through use in relation to its goods as set out above. However, as the majority of the figures provided are global and I cannot reliably assess the opponent's reputation with the relevant public within the UK, in my view, the distinctiveness of the earlier mark has been enhanced to a slightly higher degree than medium, but not significantly so.

#### Whether there is a likelihood of confusion

As above, I have found the marks to be visually and aurally similar to a medium degree and conceptually highly similar. I have found the goods to be dissimilar. When considering this as a whole, given the distance between the parties' goods, and the different spellings of Malfy / Amalfy, as well as the addition of Acqua in the applicant's mark, I do not consider that the relevant public would believe that anyone using the word AMALFY, which contains the opponent's mark, but is not the same as it, and a word that will be understood to mean water (which is descriptive of the goods on offer) in combination must be connected with the opponent. It is not likely that an economic entity which produces gin, would also produce water. When considering the above, in combination with the different spellings of Malfy / Amalfy, I do not find a likelihood of either direct or indirect confusion.

#### *Conclusions on link*

66. Taking all of the above factors into account and given that MALFY / AMALFY differ in spelling, and the applicant's mark contains an additional descriptive word, alongside the distance between the parties' respective goods, I find that the reputation of the earlier mark is not strong enough for the relevant public to make a link between the respective marks. I do not consider that the opponent's moderate reputation, would lead the average consumer to disregard the differences in the goods. I find the distance between the fields of activity is too great. If the average consumer did link the two marks, I consider that this association would be too fleeting for damage to occur, as the distance between the goods is too great.

67. The opposition based upon section 5(3) of the Act is dismissed.

## **CONCLUSION**

68. The opposition is unsuccessful and subject to appeal; the application may proceed to registration.

## **COSTS**

69. The applicant has been successful and is entitled to a contribution towards its costs. Awards of costs in proceedings are based upon the scale as set out in Tribunal Practice Note (“TPN”) 1/2023. In the circumstances I award the applicant the sum of £1,200 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Preparing and filing the TM8 and considering the counterstatement:	£250
Considering the other side’s evidence	£600
Preparing submissions-in-lieu	£350
<b>TOTAL</b>	<b>£1,200</b>

70. I therefore order Chivas Holdings (IP) Limited to pay Ahmed Tejan-Kella the sum of £1,200. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

**Dated this 10<sup>th</sup> day of June 2026**

**LA Bailey**

**For the Registrar**