

BL O/0646/24

TRADE MARKS ACT 1994

IN THE MATTER OF:

OPPOSITION No. 426607

IN THE NAME OF WATERFORD DISTILLERY GROUP LTD

TO:

TRADE MARK APPLICATION No. 3590980

IN THE NAME OF CURRAGHMORE WHISKEY LTD

DECISION

1. On 5 February 2021, Curraghmore Whiskey Ltd (“the Applicant”) applied under number 3590980 for registration of the designation **LADY LOUISA WATERFORD** as a trade mark for use in relation to “*Alcoholic beverages, except beer; whiskey; gin; alcoholic preparations for making beverages*” in Class 33.
2. On 3 September 2021, Waterford Distillery Group Ltd (“the Opponent”) filed a Notice and Grounds of Opposition objecting to the application for registration on the basis that use of the opposed mark would conflict with the rights to which it was entitled under s.5(2)(b) of the Trade Marks Act 1994 as proprietor of the following earlier trade marks:
 - (i) **WATERFORD** registered under number 914354716 on 30 November 2015 with a filing date of 13 July 2015 for “*spirits*” in Class 33 (“the First Earlier Mark”); and
 - (ii) **WATERFORD TEIREOIR** registered under number 3299184 on 29 June 2018 with a filing date of 23 March 2018 for “*spirits*” in Class 33 (“the Second Earlier Mark”).
3. At the request of the parties, the Opposition was determined without recourse to a hearing on the basis of written submissions and the papers on file. It was rejected in its

entirety for the reasons given by Ms Leanne Fayter on behalf of the Registrar of Trade Marks in a carefully considered Decision issued under reference BL O/1034/22 on 24 November 2022. The Opponent was ordered to pay £600. to the Applicant in respect of its costs of the proceedings in the Registry.

4. The First Earlier Mark was found to have satisfied the use condition prescribed by s.6A of the 1994 Act in relation only to “*whisky*”. Since there was no requirement for the Second Earlier Mark to satisfy the use condition, it remained fully protected for “*spirits*”.
5. In para. [106] of her Decision, the Hearing Officer summarised her findings with regard to the factors to be considered in the determination of the objection to registration under s.5(2)(b):

[106] The following factors must be considered to determine if a likelihood of confusion can be established:

- The opponent’s First Earlier Mark consists of the word WATERFORD. There are no other elements to contribute to the overall impression which lies in the word itself.
- The opponent’s Second Earlier Mark consists of the word WATERFORD TEIREOIR. I consider that the two words play independent distinctive roles, with the word TEIREOIR being the most dominant and distinctive element within the mark, and therefore, playing a greater role in the overall impression, with the word WATERFORD playing a lesser role.
- The applicant’s mark consists of the words LADY LOUISA WATERFORD. I consider that the overall impression of the mark lies in the combination of these elements.
- I have found the First Earlier Mark and the applicant’s mark to be visually and aurally similar to no more than a medium degree.
- I have found the Second Earlier Mark and the applicant’s mark to be visually and aurally similar to between a low and medium degree.
- I have found all of the marks to be conceptually dissimilar.
- I have found the opponent’s First Earlier Mark to be inherently distinctive to a medium degree.

- I have found the opponent's Second Earlier Mark to be inherently distinctive to a high degree.
- I have identified the average consumer as adult members of the general public, who will select the goods primarily by visual means, although I do not discount an aural component.
- I have concluded that a medium degree of attention will be paid during the purchasing process for the goods.
- I have found the parties' goods to be identical to similar to between a medium and high degree.

6. She concluded as follows in relation to the First Earlier Mark:

[107] Taking all of the factors listed in paragraph 106 into account, particularly the visual, aural and conceptual differences between the marks, I am satisfied that the marks are unlikely to be mistakenly misremembered as each other.

[108] I note that the only common element between the marks is the presence of the word WATERFORD. However, this word has completely different meanings within each mark. The word WATERFORD in the opponent's mark will be recognised as the geographical location within Ireland. The word WATERFORD in the applicant's mark is presented after the words LADY and LOUISA, meaning it will be recognised as a last name.

[109] Furthermore, and as established above, the beginning of marks tend to make more of an impact than the ends. Consequently, I do not consider that the average consumer would overlook the beginning words LADY or LOUISA in the applicant's mark. Especially as the effect is to change the word from designating a geographical location to becoming a surname for LADY LOUISA. Therefore, taking all of the above into account, I do not consider there to be a likelihood of direct confusion.

...

[112] Having noticed that the competing trade marks are different, I see no reason why the average consumer would assume that they come from the same or economically linked undertakings. I do not consider that the average consumer would think the applicant's trade mark was connected with the opponent or vice versa on the basis that they both contain the word WATERFORD. It is more likely to be viewed as a coincidence, especially, as highlighted above, the average consumer does not dissect the mark, it will be viewed as a whole. Consequently, they are not natural variants or brand extensions of each other.

Therefore, taking all of the above into account, I do not consider there to be a likelihood of indirect confusion.

7. She concluded as follows in relation to the Second Earlier Mark:

[114] As highlighted above, I consider that the words WATERFORD and TEIREOIR in the Second Earlier Mark play independent distinctive roles, with the word TEIREOIR being the most dominant and distinctive element within the mark, and therefore, playing a greater role in the overall impression. This is on the basis that the word TEIREOIR would not be recognised by a significant proportion of average consumers, and therefore would be perceived as an invented word with no conceptual meaning. Consequently, and as highlighted by the case law above, since the applicant's mark does not include the TEIREOIR element, which is the most distinctive element in the Second Earlier Mark, I do not consider that there would be a likelihood of direct confusion. I do not consider that the TEIREOIR element would be overlooked in the opponent's mark, nor do I consider that the words LADY and LOUISA at the beginning of the applicant's mark, would be overlooked. Taking the above into account, I do not consider there to be a likelihood of confusion.

[115] It now falls to me to consider the likelihood of indirect confusion. Having noticed that the competing trade marks are different, I see no reason why the average consumer would assume that they come from the same or economically linked undertakings. Albeit both marks contain the word WATERFORD, I do not consider that they are natural variants or brand extensions of each other because the applicant's mark does not share the dominant and distinctive element of the Second Earlier Mark: TEIREOIR. Therefore, I do not consider that the average consumer would think that the applicant's trade mark was connected with the opponent. Consequently, I consider there is no likelihood of indirect confusion.

8. I can see that the Hearing Officer directed herself correctly as to the applicable legal principles in paras [61], [63] to [67], [75], [79], [90], [95], [99], [110] and [111] of her Decision and applied them consonantly with the case law she referred to.

9. It is necessary to emphasise the predominantly factual nature of the evaluative task that the Hearing Officer was required to undertake in order to resolve the objection to registration raised by the Opponent in the present case.

10. Her Decision is not liable to be set aside by this Tribunal on appeal unless it can be regarded as rationally insupportable, whether by reason of an identifiable flaw in the treatment of the question to be decided, such as a gap in logic, a lack of consistency, or a failure to take into account a material factor, which undermines the cogency of the conclusion, or for being contrary to principle or plainly wrong: Lifestyle Equities CV v Amazon UK Services Ltd [2024] UKSC 8 at paras [46] to [50] per Lord Briggs and Lord Kitchin SCJJ (with whom Lord Hodge, Lord Hamblen and Lord Burrows SCJJ agreed); Volpi v Volpi [2022] EWCA Civ. 464 at paras [2], [3] per Lewison LJ (with whom Males and Snowden L.JJ agreed).
11. The Opponent appeals under s.76 of the 1994 Act contending in its Skeleton Argument for the Appeal that “*the Decision was one that no reasonable hearing officer could come to*” (para. 2) and alleging “*a number of significant and overlapping errors of law and principle ... split into seven distinct grounds, each of which stand alone, with the eighth ground acting as a cumulation of all the errors if none are found to stand alone*” (para. 17).
12. The alleged “*errors of law and principle*” were identified as:

Ground 1: Erred in the assessment of the conceptual similarity between the Opposed Mark and the Appellant’s WATERFORD Mark. (Citing for error: the Hearing Officer held that the Appellant’s WATERFORD Mark will be perceived by the average consumer as the name of the county in Ireland; the Hearing Officer found that the Opposed Mark will be recognised as a title (LADY), first name (LOUISA) and surname (WATERFORD); the Hearing Officer stated that the Opposed Mark will be understood as a name which has no specific concept; the Hearing Officer ought to have found that LADY LOUISA WATERFORD was likely to be understood by the relevant public as referring to the historical figure of Louisa Anne Beresford, Marchioness of Waterford (1818 to 1891) or at least as referring to a woman of nobility with a peerage linked to Waterford in Ireland; and maintaining that “*Had the Hearing Officer correctly assessed the conceptual similarity between the marks, she would have found the marks to be conceptually similar to at least a low to medium degree, leading to a greater likelihood that either direct or indirect confusion would have been found*”).

Ground 2: Erred in the assessment of the conceptual similarity between the Opposed Mark and the Appellant’s WATERFORD TEIREOIR Mark. (Citing for error: the Hearing Officer found that the Appellant’s WATERFORD TEIREOIR Mark is conceptually dissimilar to the

Opposed Mark because the “WATERFORD” element of the Appellant’s Mark would be recognised as a geographical location within Ireland and TEIREOIR would be understood as an invented word without meaning and the Opposed Mark is a name which has no specific concept; and reiterating the points made in relation to Ground 1).

Ground 3: Erred in the assessment of the overall impression produced by the Appellant’s WATERFORD TEIREOIR Mark. (Citing for error: the Hearing Officer stated that the word “TEIREOIR” is the most dominant and distinctive element of the mark because it is an invented word with no conceptual meaning; she failed to apply sufficient weight to the first word “WATERFORD” and that it would have more of an impact than “TEIREOIR” when the mark is viewed as a whole; the relevant public will understand “WATERFORD” as the name of the distillery and primary brand and “TEIREOIR” as the sub-brand; and maintaining “*had the Hearing Officer given sufficient weight to the first word in the Appellant’s WATERFORD TEIREOIR Mark and assessed the overall impression of the mark by reference to the relevant goods it is more likely that direct or indirect confusion would have been found*”).

Ground 4: Erred in the assessment of the visual similarity between the Opposed Mark and the Appellant’s WATERFORD Mark. (Citing for error: the Hearing Officer did not properly consider the fact that the Appellant’s WATERFORD Mark is wholly contained in the Opposed Mark and the fact that the Appellant’s WATERFORD Mark is a standalone word mark and does not include any other elements; and maintaining that “*had the Hearing Officer properly considered the above factors, she would have found that the marks are similar to at least a medium to high degree...likely to have led to a finding of direct, and at the very least indirect, confusion*”).

Ground 5: Erred in the assessment of direct confusion between the Opposed Mark and the Appellant’s WATERFORD Mark. (Citing for error: the Hearing Officer found the Opposed Mark and the Appellant’s WATERFORD Mark to be visually and aurally similar to a medium degree and inherently distinctive to a medium degree and that the goods in question were identical or similar to between a medium to high degree, but made no finding of direct confusion; the Hearing Officer failed to find that the relevant public is more likely to be confused when the Opposed Mark is applied to whiskey and sold within close proximity to whiskey bearing the Appellant’s WATERFORD Mark; and maintaining that “*the Hearing Officer would have found a likelihood of direct confusion had the relevant legal principles been correctly applied ... due to the common element WATERFORD*”).

Ground 6: Erred in the assessment of indirect confusion between the Opposed Mark and the Appellant’s WATERFORD Mark.(Reiterating the points made in relation to Ground 1 and maintaining “*it is highly likely that the relevant public will mistakenly believe that the Opposed Mark is connected with the Appellant ... In particular, the relevant*

public is likely to believe that the Opposed Mark is a range of whiskey or special bottling from the Appellant that commemorates, or simply makes reference to the historical person Lady Louisa Waterford because of her links to the county of Waterford” or “will assume that “LADY LOUISA WATERFORD ” refers to a woman of nobility with a principal family seat in, or link to, WATERFORD, which is the name of the Appellant’s distillery and primary brand”).

Ground 7: Erred in the assessment of confusion between the Opposed Mark and the Appellant’s WATERFORD TEIREOIR” Mark. (Reiterating the points made in relation to Ground 4 and maintaining that “Given that the Hearing Officer herself found that the words “WATERFORD” and “TEIREOIR” will play independent distinctive roles in the overall impression of the mark, the relevant public is likely to view “WATERFORD ” as the primary brand name and therefore will believe that the Opposed Mark originates from the Appellant because of the overlapping “WATERFORD ” element”).

Ground 8: The totality of all errors led to a decision that no reasonable hearing officer could reach. (Maintaining that “each of the errors set out above build upon each other to create a snowball effect which leads to a wholly incorrect decision being reached).

13. These contentions were further developed in oral argument at the hearing before me. They boil down to the proposition that the Hearing Officer attached too much significance to the differences and not enough significance to the similarities between the Applicant’s and the Opponent’s marks, mainly because (in the Opponent’s view) she erroneously found the marks in issue to be conceptually dissimilar.
14. It is symptomatic of the Opponent’s approach to this Appeal that it asks the Tribunal to find error in that connection taking into account the matters asserted in paras [22] and [23] of its Skeleton Argument:

[22] ... “Lady Louisa Waterford” is a real historical person. Louisa Anne Beresford, Marchioness of Waterford was a watercolourist and philanthropist that lived between 1818 and 1891. She was married to Henry de La Poer Beresford , 3rd Marquess of Waterford (Lord Waterford). The Marquess of Waterford is a title in the Peerage of Ireland. The Marquess peerage is one of eight in Ireland. The family seat of the Marquess of Waterford is the historic house and estate of Curraghmore near Portlaw, County Waterford, Ireland. The [Applicant] is named after the estate and plans to build a distillery and visitor

centre on the estate. In the premises, it is highly likely that Lady Louisa Waterford would be understood to refer to Lady Louisa of Waterford i.e. Louisa Anne Beresford, Marchioness of Waterford.

[23] ... even if the relevant public does not have knowledge of the historical person, the Marquess of Waterford peerage or the Curraghmore estate, they will understand the word “LADY”, when used before a family name, as denoting nobility and referring to a woman who holds a certain title, such as marchioness, viscountess or baroness. This is because it is a publicly known fact or will be assumed. ... The relevant public will also understand that territorial designations follow peerage titles that link the peerage to a specific place. When considered as a whole, the relevant public will understand LADY LOUISA WATERFORD to refer to a woman of nobility with a peerage linked to Waterford in Ireland.

15. Nothing to that effect was pleaded in the Opponent’s Statement of Grounds of Opposition filed on 3 September 2021 and the evidence it filed in support of its objection to registration under s.5(2)(b) did not address, let alone attempt to substantiate, what is now asserted in those paragraphs. They posit a detailed interpretation of the name LADY LOUISA WATERFORD and project it onto the mindset of the relevant average consumer. Which is not the appropriate approach to adopt for the purpose of assessing consumer perception.
16. In the written submissions it filed for the purposes of the Opposition proceedings in the Registry on 16 September 2022, the Opponent contended that “... *The relevant public will separate “LADY LOUISA WATERFORD” into “LADY LOUISA” and “WATERFORD” since “LADY LOUISA” would be understood as a composite term to refer to a “LADY” (i.e. peeress below the rank of duchess and also the wife of a baronet or of a knight) called Louisa, whereas “WATERFORD” has a separate meaning.*” (para. [50]).
17. The Hearing Officer decided in paras [84] and [89] of her Decision that “*the words LADY LOUISA WATERFORD ... together, will be recognised as a title, first name and surname.*” It was open to her to do so on the basis that it is a composite mark the overall

impression of which resides in the combined effect of all three elements. In effect, she attributed surnominal significance unconstrained by geographical significance to the word WATERFORD. I understand that to have been the point she was making in para. [91] where she characterised the Applicant's mark "*as a name which will hold no specific concept*" as compared with the Opponent's First Earlier Mark which "*assigns a geographical meaning to the word WATERFORD*". It was not illogical or irrational for her then to conclude that the words LADY and LOUISA changed the word WATERFORD "*from designating a geographical location to becoming a surname for Lady Louisa*" (para. [109]).

18. In order to resolve the objection to registration, the Hearing Officer had to make a realistic appraisal of the net effect of the similarities and differences between the marks and the goods in issue, giving the similarities and differences as much or as little significance as the relevant average consumer, who is taken to be reasonably well-informed and reasonably observant and circumspect, would have attached to them at the relevant point in time (in this case February 2021). As part of that process it was necessary to consider how the interplay between the visual, aural and conceptual aspects of the marks in issue would affect the way in which they were liable to be perceived and remembered.
19. The Hearing Officer did what she was required to do. In order to maintain the required distance between the role of decision taker at first instance and decision taker on appeal, it is necessary for this Tribunal to proceed on the basis that the Decision below should stand unless the matters on which the Opponent relies are by force of what they reveal sufficient to establish — to the standard indicated in para. [10] above — that the Decision is vitiated by error. Having regard, in particular, to the Opponent's approach to this Appeal as summarised in paras [11] to [15] above, I must add that for the Hearing Officer's position to be characterised as "wrong" it is "*not enough to show, without more, that the appellate court might have arrived at a different evaluation*": Lifestyle Equities (above) at para. [50].
20. I have reviewed the Decision in the light of the Opponent's criticisms of the Hearing Officer's evaluations. Having done so, I am satisfied that the matters referred to by the Opponent do not reveal any substantive mistakes on her part and cannot be taken,

individually or together, to establish that the Decision under s.5(2)(b) is liable to be set aside. In my view, it was open to the Hearing Officer on the evidence and materials before her to come to the conclusions she did for the reasons she gave.

21. For the reasons I have given the Appeal is dismissed. The Applicant's professional representatives maintained in correspondence with the Tribunal that the Hearing Officer did not err in law or in the application of the relevant principles and simply requested that her Decision be upheld. I am prepared to infer that the Applicant has incurred some, relatively small, professional costs in dealing with the Appeal. I direct the Opponent to pay £500. to the Applicant in respect of those costs within 21 days of the date of this Decision. That sum is payable in addition to the sum of £600. awarded to it by the Hearing Officer in respect of the costs of the Registry proceedings.

Geoffrey Hobbs KC

9 July 2024

Ms Kendal Watkinson instructed by Marks & Clerk LLP appeared on behalf of the Opponent (Appellant)

Mr Paul Kelly of FRKelly corresponded with the Tribunal on behalf of the Applicant (Respondent)