

O/244/20

TRADE MARKS ACT 1994

IN THE MATTER OF REGISTRATION NO. 3305043

IN THE NAME OF MUCKLE BRIG LIMITED

FOR THE TRADE MARK

Leith Glass Works

IN CLASS 21

AND

THE APPLICATION FOR REVOCATION THERETO

UNDER NUMBER 502584

BY

GLEANN MOR SPIRITS COMPANY LIMITED

BACKGROUND AND PLEADINGS

1. Muckle Brig Limited (“the registered proprietor”) is the registered proprietor of trade mark registration No. 3305043: **Leith Glass Works**. The trade mark was filed on 19 April 2018 and completed its registration procedure on 13 July 2018. It is registered in respect of the following goods:

Class 21

Glass bowls; Glass containers; Glass cups; Glass decanters; Glass dishes; Glass flasks; Glass jars; Glasses, drinking vessels and barware; Glassware for household purposes; Beverage glassware; Bottles.

2. On 2 May 2019, Gleann Mor Spirits Company Limited (“the applicant”) sought revocation of the trade mark registration under section 46(1)(d) of the Trade Marks Act 1994 (“the Act”). The applicant claims that use of the trade mark is likely to mislead the general public as to the geographical origin of the registered goods, as they may think that the products come from a glass works based in Leith in Scotland. The applicant claims that the bottles contain drinks made in, and associated with, Leith, but are made in Italy.

3. The registered proprietor denies that the trade mark is likely to mislead the general public and that it is attempting to affect an incorrect geographical association or intentionally causing confusion with the general public.

4. Both parties filed evidence, the applicant on 21 May 2019 and the registered proprietor on 19 November 2019.

5. Neither party requested a hearing. The registered proprietor filed submissions alongside its evidence on 19 November 2019. The applicant and registered proprietor filed written submissions in lieu of a hearing on 11 and 12 February 2020 respectively. These will not be summarised but will be referred to as and where appropriate during this decision.

6. In these proceedings, the applicant is represented by BTO Solicitors and the registered proprietor by TLT LLP.

EVIDENCE

Applicant's evidence

7. The applicant's evidence comes from Derek Mair, a Director of Gleann Mor Spirits Co Ltd. It is dated 21 May 2019.

8. He states that the mark appears on the bottom of the glass bottles, and includes in Exhibits 1 and 2 images that show the whole of the mark and a detail. He says that these come from social media accounts, with the first being from the Twitter account of Leith Distillery, which is owned by the opponent. The posts are accompanied by the hashtags #Leith, #edinburgh, #glass and, in the case of the first image, #scotland. They are undated.

9. Exhibit 3 contains an undated tweet from Lind & Lime Gin which contains an image of the underside of the bottles. The tweet states that the bottles are

“... manufactured in Italy, but we decided to hide a reference the glass making industry that once existed in our port. Leith Glass Works.”

10. Mr Mair states that the glass industry in Leith started in the early 17th century. One of the manufacturers was The Leith Glassworks, which stood on Baltic Street, and was producing a million bottles a week in around 1770. Exhibit 4 contains an image of the road sign for Baltic Street in Leith. Mr Mair states that this was taken from Leith Distillery's Twitter account.

Registered proprietor's evidence

11. The registered proprietor's evidence comes from Ian Stirling, Founder and co-CEO of Muckle Brig Limited, a Scottish-based distillery incorporated in 2014. It is dated 19 November 2019.

12. Mr Stirling states that Muckle Brig has used the mark on the bottom of its gin bottle since the launch of the product in November 2018, and that the reason behind using the mark was “that it reflects and honours the historical and industrial heritage of Leith”. He also gives a brief history of The Leith Glass Works and notes that it ceased operating in around the late 1700s. Further historical information is contained in Exhibit IS1, an extract from the website Electric Scotland, which states that the Leith glass bottle trade no longer exists. The extract is undated.¹

13. Exhibit IS2 consists of an excerpt from Muckle Brig’s website. Although this was accessed on November 2019, Mr Stirling confirms that the text has remained unaltered since the product launch. The applicant has not challenged this particular statement. It describes the life and achievements of 18th-century Edinburgh ship’s surgeon Dr James Lind, after whom Muckle Brig’s Lind & Lime Gin is named, and then gives an account of the history of the glass bottle trade in Leith. The website explains that:

“It was this remarkable local industrial heritage that inspired us to choose a wine bottle shape for our gin. We’ve also embossed the words ‘Leith Glass Works’ on the base of our bottle, a name that will feature on all the spirit bottles we produce for years to come. While the industry no longer exists in our historic port, who knows what the future might hold.”

14. Six tweets from Lind & Line Gin dating from 18 November 2018 to 5 May 2019 are to be found in Exhibit IS3. The three tweets dating from 2019 state that the bottles are made in Italy, but the mark celebrates the historical production of glass in Leith. The tweet from 4 December 2018 notes that wine bottles “were once produced here”. Exhibit IS4 contains two Instagram posts from 4 December 2018 and 20 March 2019 with the same messages.

15. Exhibit IS5 contains The Port of Leith Distillery brochure, dating from the launch of the gin in November 2018. Mr Stirling states that the brochure was distributed to

¹ It appears to be a chapter from a book. From certain geographical references (Finland is described as being in “North Russia”), it is likely to date from the early twentieth century at the latest.

journalists and people in the industry. The text is very similar to that on the website. However, the final sentence of the passage quoted above is not present.

16. The final exhibit, Exhibit IS6, is a screenshot of website analytics for the Port of Leith Distillery website. It shows that between 1 January 2019 and 30 April 2019, the number of visitors to the Lind & Lime Gin section of the website was nearly 9000.

DECISION

17. Section 46(1) of the Act is as follows:

“The registration of a trade mark may be revoked on any of the following grounds-

...

(d) that in consequence of the use made of it by the proprietor or with his consent in relation to the goods or services for which it is registered, it is liable to mislead the public, particularly as to the nature, quality or geographical origin of those goods or services.”

18. In *AKT Obohtohestov Zakritogo Tipa Torgovy Dom Potomkov v UDV North America Inc* [2002] EWHC 2911 (Ch), Pumfrey J said:

“... It will be seen that the ground under Section 46(1)(d) differs from the absolute prohibition on registration under Section 3(3)(b) in that it relates to the use which the proprietor, or those acting with his consent, have made of the mark after registration; or conceivably before registration but not such as to give rise to an objection under 3(3)(b).”²

19. In *Scandecor Developments AB v Scandecor Marketing AB & Ors* [2001] UKHL 21, Lord Nicholls of Birkenhead stated:

² Paragraph 5.

“The claim in these proceedings is that, in consequence of the use made of the marks by Scandecor Marketing and Scandecor Ltd with the consent of Scandecor International, the marks are ‘liable to mislead the public’. That is essentially a question of fact. That question of fact must be answered having regard to matters as they now are, not as they were at some time in the past. In deciding this issue of fact the court must have due regard, as I have been at pains to emphasise, to the message which a trade mark conveys. But since the question is whether the marks are currently liable to mislead, the message which is relevant is the message which use of the marks conveys today, not the message it would have conveyed to the public in the past.”³

20. The Court of Justice of the European Union (CJEU) stated in *Consorzio per la Tutela del Formaggio Gorgonzola v Käserei Champignon Hofmeister GmbH & Co KG & Anor*, Case C-87/97, ECR [1999] I-01301 that:

“... The circumstances envisaged in the other two relevant provisions of that directive [Articles 3(1)(g) and 12(2)(b)] – refusal of registration, invalidity of the trade mark, or revocation of the proprietor’s rights, which preclude its use being continued under Article 14(2) of Regulation No. 2081/92 – presuppose the existence of actual deceit or a sufficiently serious risk that the consumer will be deceived (see, on that subject, *Clinique*, cited above, Case C-470/93 *Mars* [1995] ECR I-1923, and Case C-313/94 *Graffione* [1996] ECR I-6039, paragraph 24).”⁴

21. The applicant also drew my attention to *Wilkinson Sword v Juda* (1967) 59 DLR (2d) 418, where, it said, the court held that a geographical reference in promotional material suggesting British manufacturing when the product was not manufactured in Britain was misleading. This, however, appears to me to be a Canadian case⁵ and it is not clear how it sheds any light on the current trade mark proceedings.

³ Paragraph 49.

⁴ Paragraph 41.

⁵ *DLR* stands for *Dominion Law Reports*.

22. The first finding I must make concerns what use has been made of the mark in relation to the goods or services for which it is registered. These goods are all types of glassware, including bottles. The mark is used on the base of bottles that contain gin. This feature is highlighted in the opponent's promotional materials, in the brochure, and on its website and social media accounts.

23. I must now consider whether this use is liable to mislead the public as to the geographical origin of the goods for which the mark is registered. The applicant submits that use of the mark

“... is likely to mislead the public as the use of the place name here suggests origin. The use of the mark suggests a connection with Leith to the product as a whole and not just the contents.”⁶

24. I agree with the applicant that the registered proprietor makes a connection with Leith to its business and the gin that it distils, but I find no evidence of actual deceit. The use of the mark on the base of the bottles is described as a tribute to the industrial heritage of the area, not as an indication of provenance.

25. Is there a serious risk that the public will be misled on account of the use that has been made of the mark? The applicant submits that the locally-based consumer is more likely to buy a product which they believe to have been made in Leith. The consumer browsing in a shop is, in my view, unlikely to inspect the base of the bottle and so the mark will play an insignificant, if any, role in this type of purchase. Instead, the consumer will notice the labels on the bottle, and may even take account of the shape of the bottle itself.

26. The consumer may encounter the mark through the registered proprietor's promotional material. The applicant makes the following challenges to the use shown in the evidence:

⁶ Paragraph 15.

- “Nowhere in [Exhibit IS1] does it refer to the fact that the Proprietor’s product is not made in Leith.” I dismiss this challenge, as this evidence is adduced to provide historical context, rather than to show use of the mark.
- “There is no reference contained [in Exhibit IS2] that the bottle is not manufactured in Leith. ... Further the Proprietor clearly states here that the words ‘Leith Glass Works’ are embossed on the base of their bottle and that the ‘industry’ no longer exists in the port.” In my view, the consumer will not interpret the material on the opponent’s website as suggesting that the bottle is manufactured in Leith. It is clearly stated that the industry no longer exists there. The website also states that the registered proprietor is “obsessed” with local history and wants to use its gin to make this history better known.
- With regard to Exhibit IS3, the applicant submits that the user would not search for historical Twitter posts, and that three of the posts do not clarify that the bottle is not made in Leith. The first of these posts states that thousands of wine bottles were “once” produced in Leith and, in my view, the average consumer would see the use of the mark as intended to bring to mind this heritage. The second post does not show the mark, while the third shows the base of the bottle and provides notice of the forthcoming launch of Lind & Lime Gin on 27 November 2018. There is, therefore, one post that might be seen as referring to glass made in Leith. However, the assistance this might give to the case for revocation is lessened by the applicant’s to-my-mind correct submission that the user is unlikely to search for historical Twitter posts. This tweet would have been seen round the time of the launch, where further information was provided to the consumer through tweets, the brochure and the website.
- Of the two Instagram posts in Exhibit IS4, the applicant submits that only one clarifies that the bottles are not made in Leith. The other post uses the same text as the first tweet discussed above, stating that bottles were “once” produced in Leith. Again, I consider that taking the post as a whole, this would bring to mind the area’s industrial heritage, rather than create the assumption that the bottles were produced locally.

- The brochure in Exhibit IS5 contains “the apparent ‘rationale’ behind the words on the base of the bottle. Nowhere within this brochure does it clarify that the bottle itself is not made in Leith”. I agree that this is not explicitly stated and neither is there any reference to the local industry having closed down.

27. The applicant also submits that the web analytics in Exhibit IS6 show a significant increase in visitors to the website during the period 1 January to 30 April 2019, and that these visitors are not being properly informed of the provenance of the goods at issue. As the House of Lords ruled in *Scandecor*, it is the message that is conveyed today, rather than at some point in the past, that is relevant. The evidence shows that all the promotional material from 2019 states that the bottles are made in Italy. Prior to this, in December 2018, the message was that bottles were once produced in Leith. It is only the earliest material, notably the launch brochure, where there is some ambiguity. I have already found that the casual purchaser would pay little if any regard to the mark on the base of the bottle. Consequently, I find that the use of the mark is not liable to mislead the public as to the geographical origin of the registered goods.

Conclusion

28. The application for revocation has failed and the mark will remain registered.

Costs

29. The registered proprietor has been successful and is entitled to a contribution towards its costs in line with the scale of costs set out in Tribunal Practice Notice 2/2006. I award the registered proprietor the sum of £1050 as a contribution towards the cost of proceedings. The sum is calculated as follows:

Preparing a statement and considering the other side’s statement: £250

Preparing evidence and considering and commenting on the other side’s evidence: £500

Preparation of submissions: £300

Total: £1050

30. I therefore order Gleann Mor Spirits Company Limited to pay Muckle Brig Limited the sum of £1050. 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 20th day of April 2020

**Clare Boucher
For the Registrar,
Comptroller-General**