

TRADE MARKS ACT 1995


DECISION OF A DELEGATE OF THE REGISTRAR OF TRADE MARKS WITH REASONS

Re: Opposition by The Scotch Whisky Association to registration of trade mark application 976817(33) - **GLENN OAKS** - filed in the names of Marlon Dewitt and John Tormey.

DELEGATE:	Deirdre O'Brien
REPRESENTATION:	Opponent Warwick Rothnie of counsel instructed by Corrs Chambers Westgarth, lawyers
	Applicant Did not appear but filed written submissions
DECISION:	Section 52 opposition Grounds under ss42(b), 43 and 60 not made out. Registration to proceed. Parties to bear own costs.

Background

1. Messrs Marlon Dewitt and John Tormey applied for registration of the following trade mark:

Application Number:	976817
Priority date:	31 October 2003
Goods:	Class 33: Scotch whisky, bourbon, vodka, dark rum, white rum, ouzo, tequila, gin, liqueurs and all other spirits in this class
Trade Mark:	
Acceptance advertised:	1 April 2004

2. The Scotch Whisky Association ('the opponent') opposed registration. After the parties had filed and served evidence the matter came to a hearing before me, as delegate of the Registrar of Trade Marks, in Melbourne on 17 February 2006. The opponent was represented by Mr Warwick Rothnie of counsel (instructed by Corrs Chambers Westgarth, lawyers). Subsequent to the hearing the application was assigned to Mr Dewitt and I shall refer to him in this decision as 'the applicant'.

3. The evidence filed and served by the parties is as follows:

DECLARANT	MADE	EXHIBITS	KNOWN AS
Evidence in support Ian Barclay	16.12.2004	IGB1 to IGB22	First Barclay
Evidence in answer Marlon Dewitt	08.03.2005	MT1 to MT6	Dewitt
Evidence in reply Ian Barclay	20.06.2005	IGB-A & IGB-B	Second Barclay

Grounds of opposition

4. This opposition is unusual in that the opponent does not seek to have registration refused. Rather it wants the goods of the application to be amended so that, in its opinion, use of the trade mark will not cause confusion, deception and/or misrepresentation as to the nature of the goods. At the hearing it pressed the grounds pursuant to sections 42(b), 43 and 60 of the *Trade Marks Act 1995* ('the Act') and said that registration should only proceed if the goods are amended to *Spirits in this class; but, insofar as whisky and whisky-based liqueurs are concerned, only Scotch whisky and Scotch whisky-based liqueurs produced in Scotland*. The opponent said it had attempted to get the applicant's consent to such an amendment early in proceedings¹ but that it had been unsuccessful.
5. When I informed the applicant of this subsequent to the hearing, it said it was prepared to amend its goods to *Scotch whisky, bourbon, vodka, dark rum, white rum, ouzo, tequila, gin, liqueurs and all other spirits in this class except for whisky that is not produced in Scotland*. The application was so amended, however the retention of *bourbon* was not acceptable to the opponent and it seeks my determination of the opposition.
6. As is usual in opposition proceedings the onus is on the opponent to make out at least one of the grounds pressed.²

¹ MT1 to Dewitt and IGB-A to Second Barclay

² *Kowa Company Ltd v NV Organon* (2005) 66 IPR 131 at 153

Opponent's standing

7. In its submissions the applicant queries the opponent's standing to oppose registration as it does not own any of the trade marks cited in its evidence. However, as the opponent points out, there is no requirement in the Act for a person opposing registration to be a 'person aggrieved'. The only prerequisite is that the person opposing is a legal person, that is, an individual person or persons, or a body of persons such as a company, partnership or an association, incorporated or otherwise. The opponent is a UK company incorporated under the relevant UK legislation and is thus a legal person and entitled to oppose registration.

Section 60 ground

8. Section 60 provides:

60. The registration of a trade mark in respect of particular goods or services may be opposed on the ground that:

- (a) it is substantially identical with, or deceptively similar to, a trade mark that, before the priority date for the registration of the first-mentioned trade mark in respect of those goods or services, had acquired a reputation in Australia; and
- (b) because of the reputation of that other trade mark, the use of the first-mentioned trade mark would be likely to deceive or cause confusion.

The threshold test for section 60 is that the present trade mark, GLENN OAKS, be substantially identical with, or deceptively similar to, the trade marks cited by the opponent. Those trade marks include GLENFIDDICH which is registered in Australia³ as well as the trade marks GLENLIVET and GLENMORANGIE.⁴

9. It is immediately obvious that GLENN OAKS is not substantially identical with any of those trade marks. Deceptive similarity is defined by section 10 of the Act⁵ and is determined by the test in *Shell Company of Australia Co Limited v Esso Standard Oil*

³ Registration 184532. The opponent asserts there are other Australian registrations for "GLEN" trade marks in respect of whisky (paragraph 12 to First Barclay) but the state of the register is not in evidence and it would be inappropriate for me to introduce it here.

⁴ These are the trade marks the opponent considers to be well known internationally (paragraph 3 to First Barclay). Although the opponent's evidence contains examples of other "GLEN" trade marks used on whisky produced in Scotland (IGB10 to First Barclay), there is nothing before me to show which, if any, of those trade marks is used in Australia and/or has a reputation in Australia.

⁵ Section 10 provides: For the purposes of this Act, a trade mark is taken to be *deceptively similar* to another trade mark if it so nearly resembles that other trade mark that it is likely to deceive or cause confusion.

(Australia) Limited.⁶ Simply stated the test says trade marks are deceptively similar if they will be remembered in similar fashion by consumers such that deception and/or confusion are likely to occur. In *Pioneer Hi-Bred Corn Co v Hyline Chicks Pty Ltd* the court said:⁷

“Deceived” implies the creation of an incorrect belief or mental impression and “causing confusion” may go no further than perplexing or mixing up the minds of the purchasing public. Where the deception or confusion alleged is as to the source of the goods, deceived is equivalent to being misled into thinking that the goods bearing the applicant’s mark come from some other source and confused to being caused to wonder whether that might not be the case.

10. Applying the aforesaid test I find GLENN OAKS is not deceptively similar to any of the cited trade marks. All the trade marks present as place names but as place names that are sufficiently different that they would not be confused. If the cited trade marks had all been owned by the same trader, there may have been an argument for deceptively similarity based on GLENN OAKS being perceived by consumers as a new addition to a particular trader’s family of GLEN trade marks.⁸ However the evidence shows all the cited trade marks have different trade source.⁹ Consumers of whisky will be aware of this and would not be confused by the entry of the applicant’s trade mark into the marketplace. I find the opponent’s case for the section 60 ground fails the threshold test.

Section 43

11. This section provides:

43. An application for the registration of a trade mark in respect of particular goods or services must be rejected if, because of some connotation that the trade mark or a sign contained in the trade mark has, the use of the trade mark in relation to those goods or services would be likely to deceive or cause confusion.

⁶ (1963) 109 CLR 407 at 415

⁷ (1979) RPC 410 at 423

⁸ *Beck Koller & Co Ltd’s Application* (1947) 64 RPC 76

⁹ IGB2 to First Barclay shows GLENFIDDICH is made by Grant, William & Sons Ltd, GLENLIVET by Chivas Bros Ltd and GLENMORANGIE by Glenmorangie plc.

12. To put it in simple terms, a trade mark has a 'connotation' when it conveys more than just its primary or dictionary meaning. For example in *McCorquodale v Masterson*¹⁰ the court found that the trade mark DIANA'S LEGACY IN ROSES carries with it the connotation of the late Princess of Wales. Here the opponent argues that the trade mark GLENN OAKS when used on whisky carries with it the connotation of Scotch whisky.

Types of whisky

13. I am not a consumer of whisky but even I am aware of the reputation Scotland has for producing quality whisky. I am also aware of bourbon being an alcoholic beverage originating in the southern states of the USA. However until hearing this opposition I was not aware that bourbon is also a whisky. Therefore, in order to properly inform myself about the nature of whisky I consulted the online World Encyclopedia.¹¹ As this information will be known to both parties I have not sought their comments.
14. The encyclopedia has the following entry for whisky:¹²

whisky (*Irish or US whiskey*) Alcoholic spirit made by distilling fermented cereal grains. Scotch whisky and Irish whiskey are both distilled from barley that has been allowed to sprout. It is then roasted, 'mashed', and distilled. In the USA, maize and rye are used to produce bourbon whiskey (corn) and rye whiskey. After distillation, refined whisky spirit is 70–85% alcohol by volume; all whiskies are therefore heavily diluted. Most whiskies are blended.

According to this entry the description 'whisky' encompasses at least four distinct types: Scotch, Irish, bourbon and rye. The opponent's evidence shows that in Australia the use of Scotch and bourbon to describe a type of whisky is controlled by law as a consequence of an international agreement to which Australia is a party.¹³

15. Standard 2.7.5. of the Australia New Zealand Food Standards Code provides that a geographical indication must not be used in connection with spirits (which include whisky) unless the spirit has been produced in the country, locality or region

¹⁰ (2004) 63 IPR 592

¹¹ Regulation 21.15 of the *Trade Marks Regulations 1995* gives me the authority to do so.

¹² *World Encyclopedia*. Philip's, 2005. *Oxford Reference Online*. Oxford University Press. 11 May 2006 <<http://www.oxfordreference.com/views/ENTRY.html?subview=Main&entry=t142.e12494>>

¹³ Article 23 of the World Trade Organization Agreement on Trade and Related Aspects of Intellectual Property Rights ('TRIPS')

indicated. This means whiskies produced in countries other than Scotland and the USA may not be described in Australia as Scotch and bourbon respectively. The description Scotch can only be applied to barley based whisky produced in Scotland which meets the standards set by UK law¹⁴ whereas the description bourbon can only be applied to corn based whisky produced in the USA. In other words bourbon whisky is not Scotch whisky under a different name.

Use of GLENN OAKS on Scotch style whiskies

16. According to the Macquarie Dictionary a ‘glen’ is a ‘small, narrow, secluded valley’. It is a word derived from Gaelic and forms part of many Scottish place names such as Glen Aray (a glen on the river Aray), Glen Isla (the valley of the upper part of the river Isla), and Glen Lochy (the valley of the river Lochy).¹⁵ The opponent says that many Scottish whisky distilleries, particularly those in the Speyside region, are located in glens.¹⁶ It says the distillery may be named after the glen in which it is located, as may the whisky.¹⁷

17. Among the opponent’s members are the following distilleries:

Region	Highlands	Speyside	Lowlands
Distillery	Glendronach	Glenallachie	Glen Keith
	Glen Garioch	Glenburgie	The Glenlivet
	Glenglassaugh	Glendullan	Glenlossie
	Glengoyne	Glen Elgin	Glen Moray
	Glenmorangie	Glenfarclas	Glenrothes
	Glen Ord	Glenfiddich	Glen Spey
	Glenturret	Glen Grant	Glentauchers
			Glenkinchie

In addition the opponent points to the Glengyle, Glen Scotia and Glencadam distilleries which are not its members. The evidence also shows there are distilleries named Glenalbyn, Glengarloch, Glenfyne, Glenmavis, Glenloch, Glenury and Glenugie.¹⁸

¹⁴ Paragraph 7 of First Barclay

¹⁵ IGB8 to First Barclay

¹⁶ IGB9 to First Barclay

¹⁷ The well known Glenlivet whisky, for example, is produced by The Glenlivet distillery in Glen Livet which is the glen (or valley) of the Livet river in Scotland.

¹⁸ IGB8 to First Barclay

18. Australia is a large consumer of Scotch whisky. In 2003 nearly 8.5 million litres were imported here.¹⁹ This makes Australia the 8th largest market outside the UK.²⁰ The opponent says Scotch whisky has been exported to Australia for many years and provides sales figures for the years 1990 to 2003.²¹
19. I have already noted Scotland's reputation for producing whisky. I consider that reputation, together with the large Australian market for Scotch whisky, the fact that the names of many Scottish distilleries commence with GLEN, and the use of GLEN in the brand names of internationally renowned Scotch whiskies, may give rise to an impression that a whisky name starting with GLEN means the whisky is a Scotch whisky.
20. This can by no means be a general rule. Such an impression is unlikely if the whisky name is the name of a person (eg GLEN JONES), or if it is a well known Australian place name (eg GLEN INNES). However if a trade mark for a Scotch style whisky comprises an unknown place name commencing with GLEN, I consider it likely a substantial number of Australian whisky consumers will take it to be a Scotch whisky.
21. The present trade mark commences with the word GLENN, not GLEN. GLENN and GLEN sound the same and the trade marks GLENN OAKS and GLEN OAKS are substantially identical. When Australian consumers form an impression of GLENN OAKS, it is debatable whether they will even notice the spelling of GLENN. GLENN OAKS will appear to most to be a place name, perhaps of a place where there are many oak trees. Moreover, if GLENN OAKS were to be used on a bottle of Scotch style whisky, I am satisfied that, in addition to its primary signification as a place name, it will also create the impression that the whisky is Scotch whisky. It does not matter if this initial impression can be corrected by closer inspection of the bottle. For the ground pursuant to section 43 to be made out, it is sufficient that there is a real likelihood of deception and/or confusion among a substantial number of persons, however fleeting that may be.

¹⁹ IGB6 to First Barclay

²⁰ IGB5 to First Barclay

²¹ IGB6 to First Barclay

22. I find the section 43 ground has been made out with respect to the Scotch style whiskies which were included in the application when registration was opposed. However, as these goods were subsequently excluded from the application, the opposition cannot now succeed on this basis.

Use of GLENN OAKS on bourbon

23. The applicant is adamant bourbon would not be mistaken for Scotch and vice versa. As a non-whisky drinker I would expect that bourbon and Scotch would each have its own distinct taste and properties arising from their differing base products and manner of production.²² Furthermore I would expect whisky drinkers to have at least the level of knowledge that I possess and be aware of the different origin and nature of bourbon and Scotch.
24. In my (albeit limited) experience of bottle shops, bourbon and Scotch whisky²³ are not grouped together but are displayed on separate shelves. Scotch whiskies are grouped with Irish and Canadian type whiskies, often in locked cabinets, presumably because they are expensive and desirable goods. Bourbon whisky is co-located with rye whisky and other spirits. Bourbon and rye are generally less expensive than Scotch.
25. Bourbon and Scotch may be purchased by the same type of customer. However the respective purchases will be for different reasons, such as taste and intended purpose. Furthermore bourbon is by its very nature an American whisky and there will be no expectation among ordinary consumers that it would or could be made elsewhere. It would, in my opinion, be an 'exceptionally stupid' person who took the presence of GLENN OAKS on a bottle of bourbon as an indication that the bourbon is made in Scotland or that bourbon is Scotch whisky. I find GLENN OAKS has no connotation when used in relation to bourbon and that the section 43 ground cannot be made out based on use of the trade mark on bourbon.

²² Order 3 of The Scotch Whisky Order 1990 (IGB5A to First Barclay) defines Scotch whisky and provides inter alia that "Scotch whisky" means whisky 'which retains the colour, aroma and taste derived from the raw materials used in, and the method of, its production and maturation' (Order 3(d))

²³ The usual spelling of whisky with respect to bourbon and rye is whiskey but I have not observed that convention in this decision.

Section 42(b)

26. This section provides that use of a trade mark must not be contrary to law. The opponent contends that use of the present trade mark would be contrary to the Australian and New Zealand Food Standards Code which, the opponent says, has the force of law.²⁴ Standard 2.7.5²⁵ of that Code prohibits misleading use of a geographical indication as follows:²⁶

A geographical indication must not be used in relation to a spirit, even where the true origin of the spirit is indicated or the geographical indication is used in translation or accompanied by expressions such as ‘kind’, ‘type’, ‘style’, ‘imitation’ or the like, unless the spirit has been produced in the country, locality or region indicated.

27. It is accepted by both parties that “Scotch whisky” is a geographical indication. The present trade mark does not contain the words Scotch whisky, however the opponent points to the way in which ‘geographical indication’ is defined in clause 1 of Standard 2.7.5, namely:

geographical indication means an indication, whether express or implied –
(a) which identifies a spirit as originating in a particular country, locality or region; and
(b) where a given quality, reputation or other characteristic of the spirit is essentially attributable to its origin in that particular country, locality or region.

The opponent says the geographical indication “Scotch whisky” is implied by the presence of the word GLENN in the applicant’s trade mark.

28. There may be some basis for saying Scotch whisky is implied from a map of Scotland on a whisky label. But what about a picture of a man in a kilt playing bagpipes? Or a thistle? I note that Standard P3 of the former Australian Food Standards Code was more specific about what was allowed on whisky labels and that paragraph P3(5)(f)(ii)(B) provided:

the word ‘Scotch’, “Scottish”, “Scots”, ‘Irish’, ‘Canadian’ or any word or words having the same or a similar effect shall not be written in the label

²⁴ Eg *Food Standards Australia New Zealand Act 1991 (Cth)*; *Imported Food Control Act 1992 (Cth)*; *Food Act 2003 (NSW)*; *Food Act 1984 (Vic)*

²⁵ The purpose of Standard 2.7.5. is described, inter alia, as the protection of “geographical indications which represent a given quality, reputation or other characteristic of the product which is essentially attributable to its geographical origin.”

²⁶ clause 4(1)

on or attached to a package containing whisky, the contents of which are not whisky produced wholly in the respective country to which each of those words refers.

29. Taking this into account, it seems to me that an ‘implied geographical indication’ must be limited to only the most obvious indicators of Scotch whisky, otherwise it would leave traders uncertain about how they can label their goods.
30. In any event the applicant will not be using its trade mark on whisky other than Scotch whisky and bourbon. Use of its trade mark on Scotch whisky cannot be contrary to Standard 2.7.5 and any argument that the trade mark implies Scotch whisky when used on bourbon does not stand up. Paragraph (5)(f)(ii)(A) of Standard P3 of the former Australian Food Standards Code provided:

the word ‘Bourbon’ or any word or words having the same or a similar effect shall not be written in a label on or attached to a package containing whisky, the contents of which are not corn whisky produced wholly in the United States of America.

31. In other words, by labelling its whisky as bourbon, the applicant is guaranteeing that it is corn whisky made in America. Any implication the words GLENN OAKS may have arguably possessed in relation to a Scotch style whisky cannot arise with respect to what is clearly an American whisky. I find the section 42(b) ground has not been made out.

Decision

32. As none of the grounds pressed by the opponent has been made out, my decision is that application 976817 may proceed to registration one month from the date of this decision. If the Registrar has been served with a notice of appeal before that time, I direct that registration shall not occur until the appeal has been decided or discontinued.

Costs

33. I accept the applicant’s explanation for the adoption of its trade mark at face value and am satisfied there was no intention on its part to cause confusion by implying the goods were something they are not. The applicant appears to me to be an honest businessman who has been greatly inconvenienced both in time and money by the delay in getting its trade mark registered. Nonetheless I am satisfied the opposition

was justified. The opponent was correct in saying use of the present trade mark on the goods for which the application was accepted was likely to cause confusion. On the other hand the applicant's amendment to its goods following the hearing was sufficient to eliminate that likelihood.

34. As both parties have thus had a measure of success I consider it appropriate that each bear its own costs.

Deirdre O'Brien
Trade Marks Hearings
30 May 2006