



## Irish Distillers Ltd. v Cooley Distillers plc – *whiskey in on the jar?*



On 4 July 2008, Mr Justice Roderick Murphy in the Irish High Court ruled in favour of Irish Distillers Ltd (“Irish Distillers”), the Irish whiskey maker, in injunctive proceedings against its smaller rival, Cooley Distillery plc (“Cooley”). Mr Justice Murphy held that there was a likelihood of confusion on the part of the public in the association of the sign of St. Patrick with the trade mark Jameson and that this was contrary to the Irish Trade Marks Act 1996.

Irish Distillers Ltd is owned by the Pernod Ricard group and is the largest manufacturer and exporter of Irish whiskey in the world. Its primary whiskey brand is Jameson. Cooley is a smaller Irish owned distillery which manufactures a range of whiskeys for consumption in Ireland and abroad.

### The Claim

Irish Distillers’ claim was that the label used to market Cooley’s St Patrick branded whiskey was an infringement of, *inter alia*, their Jameson trade mark, their copyright in the label and constituted passing off. Irish Distillers also claimed that the labels on each product had a similar appearance. Mr. Justice Murphy concentrated exclusively on the trade mark element of the claim.

Irish Distillers claimed that brand name of each product was placed at the top of the label in a curved format and that the format and location of other textual and graphic details on the label were also similar as was the background colour and the style of the borders.

It is notable that St. Patrick whiskey was produced in Ireland but not sold there. Instead, it was sold exclusively to the Russian market through a distributor, who had previously held the Jameson distribution contract. It was the sale and promotion of St. Patrick whiskey in Russia which alerted Irish Distillers to the alleged infringement.

Cooley claimed that neither they nor the distributor had copied the Jameson label and that the motivation for the proceedings was economic, i.e. by desiring to frustrate competition in the new and emerging whiskey market in Russia.

Irish Distillers adduced evidence of promotional material for St Patrick whiskey which they claimed encouraged confusion between the brands. This promotional material required St Patrick whiskey to be placed beside Jameson on any shelving units, and required the St Patrick whiskey to be priced at a cheaper level than Jameson. Further evidence was adduced by Irish Distillers that one Russian night club listed Jameson as the only Irish whiskey available. However a customer of that night club was served St Patrick whiskey which was noted on the receipt as Jameson.

### The Law

Section 14 of the Trade Marks Act 1996 provides, at subsection 2, that a person infringes a registered trademark where

“the sign is similar to the trade mark and is used in relation to goods or services identical with or similar to those for which the trade mark is registered, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association of the sign with the trade mark.”



The Court held that the:

“visual impact of the label – the general visual impression – is of similarity, despite the difference in the name and cap. However, the name, though arched as the Jameson name is, is clearly distinctive in lettering, connotation and phonetics.”

The Court further accepted:

“the obvious conclusion that there is no similarity between the names St. Patrick and Jameson, and accordingly no degree of confusion between the verbal elements of the names.”

However, the Court held on the basis of, *inter alia*, the uncontroverted evidence of confusion regarding the sale of St. Patrick, that Cooley had:

“in the course of a trade used a sign which is similar to the trade mark and which is used in relation to goods identical to those for which the trade mark is registered.”

The Court further noted that it was satisfied Irish Distillers could maintain its proceedings in Ireland as the infringing label was affixed to the St. Patrick product in Ireland “notwithstanding that the product is being sold outside the member States of the European Union.”

The Court concluded:

“on the balance of probability, that there exists a likelihood of confusion on the part of the public in the association of the sign of St. Patrick, with the trade mark Jameson.”

## **Conclusion**

This case serves as a useful practical example of trade mark infringement. It is notable that despite the infringing product being marketed and sold in Russia, the fact that the whiskey was distilled and the infringing label was applied in Ireland, was sufficient to permit intellectual property infringement proceedings to be brought in Ireland.

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