

O-014-06

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NOS. 2320228A, 2320228B, 2320228C,
2320228D, 2320228E, 2320228F AND 2320228G
IN THE NAME OF SUNJUICE LIMITED**

AND

**IN THE MATTER OF OPPOSITIONS THERETO UNDER NOS. 92343, 92344,
92345, 92346, 92347, 92348 AND 92349
BY A. McLELLAND & SON LIMITED**

TRADE MARKS ACT 1994

**IN THE MATTER OF
application Nos. 2320228A,
2320228B, 2320228C, 2320228D,
2320228E, 2320228F and 2320228G
in the name of Sunjuice Ltd and in the
matter of oppositions thereto under
Nos. 92343, 92344, 92345, 92346, 92347,
92348 and 92349 by A. McLelland & Son Ltd**

Preliminary Issue

1. Sunjuice Ltd is the applicant for registration of seven separate trade marks under Nos. 2320228A, 2320228B, 2320228C, 2320228D, 2320228E, 2320228F and 2320228G, all having application dates of 8 January 2003. On 4 March 2004, A. McLelland & Son Ltd filed notices of opposition against each of the applications. Each of the proceedings continued in line with usual practice. The Trade Marks Registry subsequently wrote to the parties proposing that the seven sets of proceedings would benefit from being consolidated. The parties were allowed a period within which to comment on the proposal.

2. Haseltine Lake, on behalf of the applicant, replied indicating that they had no comment to make on the proposal. Marks & Clerk, on behalf of the opponent, responded objecting to the proposed consolidation, indicating that the opponent was concerned that to consolidate the oppositions would “remove the focus on the trade marks at issue which the opponent relies upon as part of the opposition”.

3. On 26 August 2004, the Trade Marks Registry wrote to the parties advising of the registrar’s preliminary view to consolidate the seven sets of proceedings. The letter stated:

“After careful consideration of your comments, it is the registrar’s preliminary view to consolidate the seven above mentioned proceedings. It is noted that the opponent is concerned that the consolidation would remove the focus on the trade marks, therefore it is proposed to issue a separate substantive decision for each of the oppositions, however one composite evidence may be issued (sic). Consolidation of the proceedings is a (sic) administrative procedure which reduces costs and work involved in dealing with two or more sets of related proceedings. It allows each side to file one set of evidence headed for, and covering, all the consolidated proceedings.”

4. I agree that consolidation is an administrative procedure intended to reduce the work involved for all parties in multiple related proceedings and thus reduce costs. It

is well established that consolidation allows further savings by the issuing of a single decision covering all those proceedings. Despite the earlier indication that separate substantive decisions would be issued, to do so would seem to be contrary to the principal behind consolidation. Having considered the issues and the evidence filed, I see no need or benefit in issuing separate decisions in relation to these proceedings. I therefore intend to issue a single decision and will give due consideration to each of the respective trade marks relied upon as I am required to do.

Background

5. The following trade marks all have an application date of 8 January 2003 and stand in the name of Sunjuice Ltd:

Application No.	Trade Mark	Classes
2320228A	SERIOUS FOODS	29 30 32
2320228B	SERIOUS JUICE	29 30 32
2320228C	SERIOUS SOUP	29 30 32
2320228D	SERIOUS PASTA	29 30 32
2320228E	SERIOUS SAUCE	29 30 32
2320228F	SERIOUS CRUSH	29 30 32
2320228G	SERIOUS SMOOTHIE	29 30 32

6. On 4 March 2004, A. McLelland & Son Limited filed notices of opposition to each of the applications. The grounds of opposition were originally based on Sections 5(2)(b) and 5(4)(a) of the Act. During the course of proceedings, the objections based on Section 5(2)(b) were withdrawn and therefore only the objections based on Section 5(4)(a) remain.

7. In each case, the opponent states that it is the registered proprietor of the following trade marks:

Registration or Application No.	Trade Mark	Classes
2044758 registered	 <p>SERIOUSLY STRONG</p>	29 30

2281932A registered		29 30 32
2281932B registered		33
2317123 registered		29
2317148 application	SERIOUSLY STRONG	29 30 31 32 33

and that based on these, registration of the applications should be refused under Section 5(4)(a).

8. The applicant filed counter-statements denying the grounds on which the oppositions are based and challenging the opponent to prove use of its trade marks.

9. Both parties seek an award of costs.

10. Both parties filed a single consolidated set of evidence in these proceedings. Neither party requested an oral hearing although the applicant did file written submissions. After a careful study of the papers on file, I hereby give my decision.

Opponent's evidence

11. The opponent's evidence consists of a statutory declaration of James McGregor dated 24 February 2005. Mr McGregor states he is the Sales Director of the opponent company, a position he has held since July 2002. He confirms he is authorised to make the declaration on behalf of the opponent.

12. Mr McGregor explains the opponent was incorporated in April 1927 and has traded continuously since that date in relation to cheese and dairy products. Until very recently, he says, the opponent was a family business, incorporated to expand and protect the cheese and grain business which the family had operated since about 1850.

Mr McGregor states the opponent is a manufacturer and merchant of cheese and dairy products. These are, he says, two of the most widely used food products though he provides no evidence to support this claim.

13. Mr McGregor states the opponent produces a number of cheese products but adds that the only product of relevance to these proceedings is a cheddar product sold under the trade mark SERIOUSLY STRONG which the opponent has sold since 1996.

14. Mr McGregor says the cheddar product is sold throughout the UK by all of the major multiples, including Tesco, Sainsbury's, Somerfield, Kwik Save, Netto, Co-op, Asda and Morrisons/Safeway. He provides the following approximate retail sales values:

Year (to April)	Retail Sales
1996	£5,000,000
1997	£9,000,000
1998	£12,000,000
1999	£21,000,000
2000	£23,000,000
2001	£25,000,000
2002	£31,000,000

Mr McGregor also provides figures for 2003 and 2004 but as these relate to periods which post-date the relevant date in these proceedings, I have not included them in this summary.

15. Mr McGregor states that since the launch of the SERIOUSLY STRONG trade mark in 1996 and up to 2002, the opponent has spent approximately £100-200k per year on advertising, promoting and marketing the trade mark in the UK, in both general and specialist press, in-store promotion, pack design and sponsorship deals. Mr McGregor states that the opponent also owns a website which is used to promote the SERIOUSLY STRONG trade mark and which shows adverts used by the opponent. Mr McGregor states that in 2002, the opponent decided to advertise on television. Whilst this might be the date the decision to advertise on television was made, I note from the exhibits that this television advertising itself did not commence until after the relevant date in these proceedings (see for example, Grocer Magazine article dated 22 February 2003 exhibited at JMcG3).

16. Mr McGregor states that SERIOUSLY STRONG cheese won the Best Cheddar award at the British Cheese Awards and a gold medal at the World Cheese Awards, both in 2001. In 2002, it won the Best Extra Mature Cheddar Award at the Royal Highland Show. In 2003, the trade mark was awarded Best Emerging Brand in the Sunday Times PriceWaterhouseCoopers Profit Track 100 Awards and was positioned at No. 12 in the "TNS Hall of Fame". There is no explanation given of what this "Hall of Fame" might be.

17. Mr McGregor states that the opponent has always tried to enhance the value of its SERIOUSLY STRONG trade mark. In 2003 it licensed its trade mark to a company who developed SERIOUSLY STRONG PIZZAS although that license has since been

withdrawn for commercial reasons. No information is given as to when in 2003 this license was entered into but I note from exhibit JMcG6 that recordal of the license was published in the Trade Marks Journal in July of that year.

18. Mr McGregor says that the opponent has been unable to ascertain any use of the applicant's mark and is therefore unable to report any instances of actual confusion. He goes on to provide comments on the likelihood of confusion between the applicant's and opponent's trade marks.

19. Mr McGregor's evidence has a number of attached exhibits.

- JMcG1 is a copy of an article appearing in the October 2002 edition of UP magazine giving information about the adoption of the opponent's trade mark. The article refers to what is described as the opponent's SERIOUSLY STRONG brand of mature cheddar.
- JMcG2 is a copy of an article which appeared in Marketing Week magazine. Neither the exhibit nor the article contain any identifier as to when the article was published. The article relates to a company named TNS which is said to be a leading global provider of market information. TNS appears to be a commercial operator as the article goes on to explain that TNS collects, analyses and interprets information for its clients, providing research, advice and insight on market segmentation, advertising and communications, new product development, brand performance and stakeholder management for those clients.

The exhibit also contains a report of a survey carried out by TNS for the opponent. The survey indicates that SERIOUSLY STRONG has a 19% share of the UK branded cheddar market. It is said to be the fastest growing brand of cheddar in the UK and purchased by 23% of UK households. No indication is given to explain how these figures were arrived at. The survey is not dated but appears to relate to 2003.

- JMcG3 are what are said to be representative samples of advertising material. Mr McGregor accepts that some (I would say most) of the material post dates the relevant date in these proceedings though he goes on to indicate that the opponent believes them to be typical of the style of earlier press reports. Much of the material appears to have been published in specialist (trade) magazines although there are some examples of advertising appearing in more general men's and women's magazines before the relevant date.
- JMcG4 consists of extracts from the opponent's internet site which are said to contain copies of press advertising used by the opponent in the UK during 1999/2000 and 2000/2001 advertising campaigns.
- JMcG5 consists of copies of promotional photographs showing the livery used on the opponent's fleet of lorries. Accepting the photographs to be undated, Mr McGregor confirms that the lorries carried this livery before the relevant date.

- JMcG6 is a copy of a letter from the Trade Marks Registry confirming recordal of the licence for trade mark registration Nos. 2044758 and 2281932A and the potential future recordal of the license for trade mark application No. 2317148.
- JMcG7 are copies of email responses received from various people said to be or have been involved in the cheese trade. There is no explanation of how these emails came to be written although it would appear from the content that they were sent in response to contact from the opponent. As well as opining on the likelihood of confusion between unidentified marks, the emails make various statements on the reputation of SERIOUSLY STRONG cheese. There is some similarity of wording between each of the emails. None refer to the position at the relevant date. None of the writers of the emails have submitted sworn evidence.

Applicant's evidence

20. The applicant's evidence consists of a witness statement, dated 22 March 2005, by Martin H Krause. Mr Krause states he is a partner in the firm of Haseltine Lake, the applicant's trade mark attorneys.

21. Mr Krause explains that he carried out research on the Internet on 7 March 2005 with the object of finding use of the word SERIOUSLY as an adverb, specifically in relation to food. Mr Krause exhibits at MHK1 a list of the website addresses and at MHK2, pages from each website highlighting his findings.

22. That concludes my summary of the evidence insofar as it is relevant to these proceedings.

DECISION

23. The single ground of opposition is founded under Section 5(4)(a). This reads as follows:

“5. –(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented –

- (a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or
- (b) -----

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an “earlier right” in relation to the trade mark.”

24. Mr Geoffrey Hobbs QC sitting as the Appointed Person in the *WILD CHILD* case, [1998] RPC 455, set out a summary of the elements of an action for passing off. The necessary elements are said to be as follows:

“A helpful summary of the elements of an action for passing off can be found in *Halsbury’s Laws of England* (4th Edition) Vol. 48 (1995 reissue) at paragraph 165. The guidance given with reference to the speeches in the House of Lords in *Reckitt & Colman Products Ltd v Borden Inc* [1990] R.P.C. 341 and *Erven Warnink BV v J. Townend & Sons (Hull) Ltd* [1979] A.C. 731 is (with footnotes omitted) as follows:

“The necessary elements of the action for passing off have been restated by the House of Lords as being three in number:

- (1) that the plaintiff’s goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;
- (2) that there is a misrepresentation by the defendant (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by the defendant are goods or services of the plaintiff; and
- (3) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant’s misrepresentation.

The restatement of the elements of passing off in the form of this classical trinity has been preferred as providing greater assistance in analysis and decision than the formulation of the elements of the action previously expressed by the House. This latest statement, like the House’s previous statement, should not, however, be treated as akin to a statutory definition or as if the words used by the House constitute an exhaustive, literal definition of ‘passing off’, and in particular should not be used to exclude from the ambit of the tort recognised forms of the action for passing off which were not under consideration on the facts before the House.”

Further guidance is given in paragraphs 184 to 188 of the same volume with regard to establishing the likelihood of deception or confusion. In paragraph 184 it is noted (with footnotes omitted) that:

“To establish a likelihood of deception or confusion in an action for passing off where there has been no direct misrepresentation generally requires the presence of two factual elements:

- (1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and
- (2) that members of that class will mistakenly infer from the defendant’s use of a name, mark or other feature which is the same or sufficiently similar that the defendant’s goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact.

In arriving at the conclusion of fact as to whether deception or confusion is likely, the court will have regard to:

- (a) the nature and extent of the reputation relied upon;
- (b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;
- (c) the similarity of the mark, name etc used by the defendant to that of the plaintiff;
- (d) the manner in which the defendant makes use of the name, mark etc complained of and collateral factors; and
- (e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.

In assessing whether confusion or deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of the action.””

26. The date at which the matter must be judged is not entirely clear from Section 5(4)(a) of the Act. This provision clearly is intended to implement Article 4(4)(b) of Directive 89/104/EEC. It is well settled that it is appropriate to look to the wording of the Directive in order to settle matters of doubt arising from the wording of equivalent provision of the Act. The relevant date may therefore be either the date of the application for the mark in suit (although not later), or the date at which the acts first complained of commenced –as per the comments in *Cadbury Schweppes Pty Ltd v The Pub Squash Co Pty Ltd* [1981] RPC 429. In this case the relevant date is the date of the application for the marks in suit: 8 January 2003.

27. In *South Cone Incorporated v Jack Bessant and others* [2002] RPC 19, Pumphrey J stated:

“27. There is one major problem in assessing a passing off claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent’s reputation extends to the goods comprised in the applicant’s specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under s.11 of the 1938 Act (see *Smith Hayden & Co Ltd’s Application (OVAX)* (1946) 63 R.P.C. 97 as qualified by *BALI Trade Mark* [1969] R.P.C. 472). Thus the evidence will include evidence from the trade as to reputation;

evidence as to the manner in which the goods are traded or the services supplied; and so on.

28. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date. Once raised, the applicant must rebut the prima facie case. Obviously, he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the hearing officer that it is not shown on the balance of probabilities that passing off will occur.”

28. The opponent’s objection is based on five trade marks as set out in paragraph 7 above. Registration Nos. 2044758, 2281932A and 2281932B are identical and consists of what I take to be a device of a cheese press above the words SERIOUSLY STRONG which appear in relatively small, plain block capitals. Registration No. 2317123 is also a composite mark. It consists of what appears to be an essentially circular plaque or nameplate device containing a representation of a cheese press with the name McLelland running through it. The device also contains the words SERIOUSLY in dark letters on a pale background, and, on separate lines, the words STRONG, CHEDDAR, CHEESE MERCHANTS and SINCE 1850, all in pale letters on a dark background. Each of the lines of words appear in different sizes with the word STRONG being in the largest font. Application 2317148 is for the words SERIOUSLY STRONG simpliciter.

29. The five trade marks relied on by the opponent cover many different goods however, Mr McGregor concedes that use is claimed only in respect of “ a cheddar product”. From my review of the evidence the only evidence of use shown is in respect of cheddar cheese. No information is provided as to the size of the UK market for cheddar cheese, however the figures provided by Mr McGregor show a not insignificant and indeed increasing level of sales by the opponent.

30. Whilst there is much evidence provided relating to advertising and promotion of the opponent’s products, most of it is undated or post-dates the relevant date in these proceedings. Some of the material is aimed at the specialist and retail trades although material is provided showing advertising made before the relevant date and which appeared in more generalist magazines.

31. Overall, I accept that the evidence shows the opponent to have a reputation for cheddar cheese but on the basis of that same evidence, I cannot go further than that. Each of the marks relied on by the opponent contain or consist of the words SERIOUSLY STRONG. The opponent’s evidence consistently refers to the SERIOUSLY STRONG trade mark (singular) or brand but gives no explanation of whether this is an umbrella term intended to cover all of the marks relied on or whether it is intended to relate to any one or more of those marks. There is no evidence from the relevant public, who I take to be the general public, nor any independent trade evidence which shows what reputation each specific mark relied on by the opponent had at the relevant date. The evidence is wholly deficient in this regard and the deficiencies are such that despite accepting the opponent to have a reputation for cheddar cheese, I am unable to evaluate that reputation or apportion it to any of the individual trade marks relied on by the opponent in these proceedings.

32. In summary, the evidence filed by the opponent has not established that at the relevant date it had a reputation in relation to any of the individual trade marks it relies on. That being so, the objection under Section 5(4)(a) must fail and I do not intend to go on to consider whether there is misrepresentation or damage. I would, however, say that the words SERIOUSLY STRONG are ordinary words in common use, capable of being used naturally in a descriptive manner to describe a characteristic of cheese. The marks applied for do not give the same impression. The same evidence was filed in respect of each of the consolidated opposition proceedings and this being the case the opposition under Section 5(4)(a) therefore fails in respect of each of the seven opposition proceedings.

Costs

33. Each of the oppositions having failed, the applicant is entitled to an award of costs. Whilst separate notices of opposition and counter-statements have been filed, the grounds of each were identical. The oppositions were consolidated and a single set of evidence was filed and reviewed by each party. No hearing has taken place, the parties being content for a decision from the papers, and a single decision is being issued. I order the opponent to pay the applicant the sum of £3000. This sum is to be paid within 7 days of the expiry of the appeal period or within 7 days of the final determination of these proceedings should any appeal against this decision be unsuccessful.

Dated this 17 day of January 2006

**Ann Corbett
FOR THE REGISTRAR
THE COMPTROLLER-GENERAL**