TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO 2209524
BY NAURUS (PVT.) LIMITED
TO REGISTER THE TRADE MARKS:

SUNDiP

SUNDIP

IN CLASSES 3, 29, 30 AND 32

AND

IN THE MATTER OF OPPOSITION THERETO
UNDER NO 50875
BY
PRODUCT SUPPLIERS AG

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IN THE MATTER OF Application No 2209524
by Naurus (Pvt.) Limited
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IN THE MATTER OF Opposition thereto under No 50875
by Product Suppliers AG

Background

1) On 23 September 1999 Naurus (Pvt.) Limited applied to register the trade marks (a series of two):

SUNDiP

SUNDIP

2) The application was published in respect of the following goods:

cosmetics; hair care preparations, shampoos, conditioners, hair colouring preparations, hair tinting preparations, hair dyes; henna, henna powders; essential oils; rose water for cosmetic purposes - class 3

prepared foodstuffs containing meat, fish, poultry and game; snack foods; preserved, dried and cooked fruits and vegetables; jams and jellies, preserves, sauces, pickles, chutney; butter; edible oils and fats - class 29

tea, rice, tapioca, sago; preparations made from flour, cereals and grains; snack foods; vinegar, sauces; salt, mustard; kheer; flour, cornflour; custard powder; ketchup, tomato ketchup; pasta, vermicelli; flavourings; spices; syrups; confectionery; rose water for flavouring purposes; snack foods; salad dressings - class 30

non-alcoholic beverages, fruit juices, fruit drinks; mineral and aerated waters; syrups for making beverages; squashes; lemon barley squashes, mango squashes, orange squashes, lemon squashes, mixed fruit squashes; rose water used for flavouring beverages; kewra water - class 32

3) On 5 April 2000 Product Suppliers AG filed notice of opposition to this application.

4) The opponent states that he is the registered proprietor of the following trade mark registrations:

United Kingdom registration no 1175973 of the trade mark SUNTIPT which is registered in respect of:

beer, ale and porter; mineral waters, aerated waters, non-alcoholic beverages and preparations for making such beverages, and syrups, all included in Class 32; fruit juices for use as beverages

Community trade mark registration no 54106 of the trade mark SUNTIPT which is registered in respect of:

beers; mineral and aerated water and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages - class 32

United Kingdom registration no 685344 of the trade mark SUNTIPT which is registered in respect of:

fresh fruits and fresh vegetables - class 31

United Kingdom registration no 837425 of the trade mark SUNTIPT which is registered in respect of:

fruits and vegetables, all being canned, bottled, dried and frozen - class 29

5) The opponent states that the trade mark is in use in the United Kingdom in relation to frozen fruit juice concentrates via a permitted user - Douwe Egberts Coffee Systems Ltd, which he states is an associated company.

6) He states that the respective trade marks are visually similar and phonetically very close to one another. He states that in normal speech the pronunciation of SUNTIPT is very close to SUNTIP and thus is extremely close to SUNDIP. He states that the goods of the application in suit are either identical or closely similar to the goods encompassed by his registrations. He states that the application offends against section 5(4)(a) of the Act under the law of passing-off.

7) The opponent states that the application should be refused under section 5(2)(b) of the Act. He states that the application in suit is closely similar to his trade mark and is to be registered for the same or similar goods and a likelihood of confusion exists on the part of the public. He states that the goods of the application in suit which are deemed to conflict with the goods of his registrations are:

class 29: *preserved, dried and cooked fruits and vegetables*

class 30: *flavourings; syrups; rose water for flavouring purposes*

class 32: *non-alcoholic beverages, fruit juices, fruit drinks; mineral and aerated waters; syrups for making beverages; squashes; lemon barley squashes, mango squashes, orange squashes, lemon squashes, mixed fruit squashes; rose water used for flavouring beverages; kewra water*

8) The opponent states that the application offends against section 5(3) of the Act. He states that

use of the application in suit by the applicant would take unfair advantage of or be detrimental to the distinctive character or reputation of his earlier trade mark. He states that he considers that the following goods of the application in suit are not similar to those encompassed by his earlier registrations:

prepared foodstuffs containing meat, fish, poultry and game; snack foods; jams and jellies, preserves, sauces, pickles, chutney; butter; edible oils and fats - class 29

tea, rice, tapioca, sago; preparations made from flour, cereals and grains; snack foods; vinegar, sauces; salt, mustard; kheer; flour, cornflour; custard powder; ketchup, tomato ketchup; pasta, vermicelli; spices; confectionery; snack foods; salad dressings - class 30

all goods in class 3 of the application

9) The opponent states that, in relation to the non-similar foods, the applicant's use of the trade mark SUNDIP in relation to foods of a different quality to those of the opponent could be detrimental to his business. He states that use of a trade mark so similar to his would take unfair advantage of the repute of the opponent's goods sold under SUNTIPT as it might prevent him form expanding his business into areas into which he may wish to trade. The opponent states that, in relation to the class 3 goods of the application in suit, that the public might be deceived or assume that the goods emanate from him "such that possible disappointment with the goods non-liable the detriment of the opponents" (sic).

10) The opponent states that his reputation arises out of his use of the trade mark SUNTIPT in relation to frozen fruit juice concentrates since about 1984/5. He states that this use had taken place throughout the United Kingdom with a total turnover as follows:

Year	1994	1995	1996	1997	1998	1999
Turnover (litres x 1000)	1625	1506	1251	1013	936	822

11) The applicant filed a counterstatement in which he denies the above grounds. In particular he states that prior to the filing of the application in suit a search of the United Kingdom Trade Marks Registrar was made. He states that the search revealed a large number of trade marks having the prefix SUN in addition to the opponent's SUNTIIPT trade marks. He states that the respective trade marks are similar only in respect of their shared prefix "SUN". The applicant states that the suffixes "DIP" and "TIPT" are wholly distinguishable. He states that "DIP" is a dictionary word having a well-known meaning as both a noun and a verb. He states that "TIPT" is a corruption of or a phonetic variation of the word "tipped". The applicant states that the respective trade marks are clearly distinguishable and different.

12) Both parties seek an award of costs.

13) Both parties filed evidence. They both agreed that a decision could be made on the basis of the papers filed. Consequently a decision will be taken from a careful study of the papers.

14) Acting on behalf of the registrar I duly give the following decision.

Opponent's evidence

15) The opponent's evidence consists of two statutory declarations. The first declaration, dated 5 January 2001, is by John Fulton, who is finance director of Douwe Egberts Coffee Systems Limited (DECS). He states that DECS is an associate company of the opponent and is the distributor of products under the trade mark SUNTIPT in the United Kingdom.

16) Mr Fulton states that the trade mark SUNTIPT was first used in the United Kingdom in 1985/6 and has been used continuously since then in relation to beverages including fruit juices and fruit drinks. He states that in particular the trade mark has been use on or in relation to the following goods:

raspberry and blackcurrant fruit drinks
orange juice
apple juice
tropical nectar (a mix of tropical juices)
grapefruit juice
frozen orange juice
frozen grapefruit juice

The above, hereinafter, are referred to as "the goods".

17) Mr Fulton states that the approximate annual turnover for the years 1994-2000 for the goods sold under the trade mark SUNTIPT are:

YEAR	VALUE (pounds sterling)
1994	6, 880, 000
1995	6, 394, 000
1996	6, 082, 000
1997	4, 269, 000
1998	4, 130, 000
1999	4, 299,000
2000	3, 327, 000

18) He states that the approximate amount spent on advertising the goods sold under the trade mark is £20, 000 per annum.

19) Mr Fulton states that goods have been sold under the trade mark SUNTIPT throughout the United Kingdom. He goes on to give a sample of locations.

20) Mr Fulton states that the trade mark SUNTIPT is applied directly to the packaging for the goods. He exhibits at JF1 a carton for concentrated orange juice bearing the trade mark SUNTIPT (in lower case).

21) Mr Fulton states that DECS also supplies machines to dispense the goods to customers who buy the goods. He exhibits at JF2 a plastic label that he states is used on the front of a dispensing

machine. This bears the name SUNTIPT in title case.

22) Mr Fulton states that the trade mark SUNTIPT has been used in relation to the goods at the following exhibitions:

Hospitality 1997
Hotel & Catering Association conference 22-24 April 1999
Cater Hotel 3-4 March 1999
Scot Hot 15-18 March 1999
Independent Hotelier 30 November - 1 December 1999
Pub Trade Show 24-26 March 1999 in Sheffield
Café 99 13-15 October 1999 in Brighton
Pub Café-Bar Show 18-20 January 2000 at the National Exhibition Centre, Coventry
Hotelympia 2000 7 - 11 February 2000

(All the italicised exhibitions are after the relevant date of the instant proceedings i.e. the date of the filing of the application in suit - 23 September 1999.) Exhibited at JF3 is a photograph of a stand at Hospitality 1997.

23) Mr Fulton exhibits at JF4 four telesales orders, all of which emanate from after the relevant date. He exhibits at JF5 three examples of publicity cards and one example of a brochure. He states that the aforesaid materials are distributed to customers to advertise the goods sold under the trade mark SUNTIPT. Mr Fulton states that advertisements have appeared in the trade press and similar publications relating to the sale of the goods under the trade mark SUNTIPT. He exhibits at JF6 four examples of press releases.

24) Mr Fulton states that DECS is a member of the following trade associations: Café Society and Beverage Service Association.

25) Mr Fulton states that SUNDIP is similar, and phonetically virtually identical, to SUNTIPT and is for similar goods. He states that he considers that the meanings of the respective marks is also similar. One, he states, relates to something tipped with the sun whilst the other, that of the applicant, means dipped in sun and presumably coated or partially coated in sun. He states that any use of SUNDIP alongside SUNTIPT for the same or similar goods must amount to bad faith and passing-off. He ends by stating that in lazy or imprecise speech SUNTIPT becomes SUNTIP, to which SUNDIP is even closer.

26) The second declaration of the opponent is by Peter Hillier and is dated 9 January 2001. Mr Hillier is a registered trade mark attorney and is also a patent agent.

27) Mr Hillier states that the applicant in his counterstatement states that the respective trade marks are similar only in respect of their shared stem. He states that this is clearly not the case as both trade marks share the letters "IP" in the last part of their respective words. He states that the letter "D" and "T" when used in the middle of a word are often pronounced in a very similar manner. He states that the "T" of SUNTIPT, although pronounced, is not normally accented or emphasised. Mr Hillier goes on to state that all but one of the letters of the application in suit is present in the mark of the opponent, the letter "D" appearing in place of the letter "T" . He states

that the respective signs are, accordingly, very similar and in certain circumstances (for example when spoken in a noisy environment or when spoken by a person with a soft voice) are virtually indistinguishable. Mr Hillier states that the respective trade marks are also visually very similar. He states that they are also conceptually similar in that they are both fanciful marks. He also states that both trade marks imply a fanciful coating or part coating of sun(shine).

28) Mr Hillier comments upon the trade marks referred to by the applicant as a result of a search. He states that the trade marks referred to are not on a par with the trade marks the subject of the instant proceedings.

29) Mr Hillier states that the respective trade marks are very close phonetically and conceptually and to some extent visually. He states that, therefore, the application in suit is of such a nature as to deceive the public as to the origin of goods sold under it.

30) Mr Hillier states that owing to the use of the opponent's trade mark he can justifiably claim a right of action under passing-off.

31) Mr Hillier states that the goods of the application in suit in classes 29 and 30 are similar to the goods upon which the opponent uses his trade mark. He states that they are generally foodstuffs and in a large degree fruit - or vegetable - based. He states that such goods may be perceived as a natural extension by the opponent to his range of goods by, for example, imperfect recollection (sic).

32) Mr Hillier states that the distinctive character of SUNTIPT is manifest.

Applicant's evidence

33) The applicant's evidence consists of a witness statement dated 9 August 2001 by Helen Thomas-Peter, who is a registered trade mark attorney.

34) Ms Thomas-Peter states that exhibited as HTP1 is an affidavit by Zafar Mahmood Shaikh, the managing director of the applicant. She states that the affidavit is an amended version of a document forwarded by the applicant to her for signature. She states that whilst the document has been notarised it is missing the headings on the original. She states that the cover sheets of the exhibits have not been notarised.

35) Mr Shaikh states in his affidavit that he first adopted the trade mark SUNDiP in 1996 and the trade mark was first used in the United Kingdom in 1999. He states that the trade mark has been in continuous use since 1999. Mr Shaikh states that the trade mark has been in continuous use since 1999 in relation to the following goods:

custards, crystal jellies, vermicelli, sauces, ketchup, vinegar, jams, jellies, pickles, syrups, juices, squashes, spices, recipe spices, pastes, fried onions, corn flower and dried fruits.

36) Exhibited at HTP 2 is an export price list, for the United Kingdom, dated 2 April 1999.

37) Mr Shaikh states that goods sold under the trade mark have been distributed to shops, restaurants and cafés throughout the United Kingdom.

38) Also exhibited at HTP 2 is a selection of packaging material. All of the material bears the trade mark NAURUS above SUNDiP. The packaging samples are for custard powder, kheer mix, bitter gourd and garlic pickle, orange squash, lemon squash, chatpata sauce, kasondi pickle, mango pickle, mixed pickle, tomato ketchup, cornflour, vinegar and mango jam.

39) Mr Shaikh states that in the year 1999-2000 the applicant exported goods of the value of £40,335 to the United Kingdom. He states that in the year 2000-2001 this sum increased to £95,283.

40) Mr Shaikh states that his United Kingdom distributor released a television advertisement in June 2001 and that the applicant had a stand at the International Food Exhibition in London in March 2001. He states that the applicant has also produced an information pack for customers, which is also exhibited. Included in the information pack are leaflets showing the trade mark SUNDiP in relation to squashes, syrups, spices, pastes, fried onions, ketchup, chutney, sauces, halva, various tinned meat products, jelly crystals, custard, corn flour, kheer mix, rasmalai mix, vermicelli, pickles, vinegar, kewra water, rose water, jams, jellies, marmalade and fruit preserves.

Opponent's evidence in reply

41) The opponent's evidence in reply consists of a witness statement by Mr Hillier, dated 6 November 2001.

42) Mr Hillier states that Mr Shaikh in his affidavit does not state when in 1999 use of the trade mark SUNDiP commenced and how much of it was before the filing date of the application. He states that the price list exhibited by Mr Shaikh gives the impression that use commenced on 2 April 1999, however, this is not specifically stated. Mr Hillier states that the affidavit of Mr Shaikh is too imprecise to be of any use in support of the applicant's case. He states that the evidence of use should be dismissed.

Decision

Preliminary issues

The affidavit of Mr Shaikh

43) Ms Thomas-Peter exhibits the affidavit of Mr Shaikh as an exhibit to her witness statement. She refers to the lack of notarisation of the exhibits to the affidavit

44) The Civil Procedure Rules 1998 32PD-011 state:

11.1 A document used in conjunction with an affidavit should be -
(1) produced to and verified by the deponent, and remain separate from the affidavit, and
(2) identified by a declaration of the person before whom the affidavit was sworn.
11.2 The declaration should be headed with the name of the proceedings in the same way as the affidavit.
11.3 The first page of each exhibit should be marked -
(1) as in paragraph 3.2 above, and
(2) with the exhibit mark referred to in the affidavit.

Paragraph 3.2. states:

3.2 At the top right hand corner of the first page (and on the backsheet) there should be clearly written -
(1) the party on whose behalf it is made,
(2) the initials and surname of the deponent,
(3) the number of the affidavit in relation to that deponent,
(4) the identifying initials and number of each exhibit referred to, and
(5) the date sworn.

45) The exhibits have not been duly sworn to as per the Civil Procedure Rules. Ms Thomas-Peter has tried to circumvent this failure by exhibiting them as an exhibit to her witness statement. I cannot see how this can be acceptable. The exhibits are part and parcel of the affidavit of Mr Sheikh, if they have value they have it in so much as they are a part of his affidavit. If they have not been duly sworn they do not form part of his affidavit.

46) I, therefore, do not consider that the exhibits to the affidavit of Mr Sheikh can be considered in relation to the proceedings. In the instant case I do not consider that anything turns upon this. The evidence of the opponent shows use in relation to the goods he has declared to in the catering trade. The evidence of the applicant does not indicate who are the users of his goods. They could be in quite a different area of the trade e.g. small retail shops. The affidavit also does not give a breakdown of the turnover of the goods; I don't know how much of the turnover relates to fruit juices for instance. It is quite possible that the respective goods have never crossed in trade and so a lack of confusion demonstrates nothing. Also even the combined sales figures are of a very small scale taking into account the size of the food and drinks trade. It is also to be noted that a declaration by Mr Sheikh from Pakistan that he is not aware of any confusion tells me very little. Simply that he is not aware of any confusion. Mr Sheikh refers to a television advertisement but fails to advise where the advertisement was broadcast and does not supply a copy of the advertisement. Again it is a statement that adds nothing to my consideration of the case. Taking all the above into account I do not consider that even if I did take into account the exhibits to the affidavit that it would effect the outcome of the case.

47) I note Mr Hillier's comments in relation to the lack of specificity in relation to the relevant date. However, evidence of use after the relevant date could be of relevance. If the evidence of the parties showed that, even after the relevant date, the respective trade marks had been used widely for identical or similar goods and through the same channels of trade and that there was no

evidence of confusion this could be indicative that there was not a likelihood of confusion or deception.

The registrations of the opponent

48) During the proceedings the opponent surrendered registration numbers 685344 and 837425.

49) There are two registry decisions, of which I am aware, on this issue. Mr Probert in *Club Soda* (unreported O/230/98) found that the question should be determined as at the date of the application for the trade mark and, therefore, a subsequent revocation of a trade mark would not affect the status of that trade mark as an "earlier trade mark". However, Mr Knight in *Transpay* [2001] 6 RPC 191 found that when the matter comes to be determined, the Hearing Officer should take account of all facts that are before him. Thus, in the circumstances of that case, he found that a trade mark on which the opponents sought to rely should not be considered as an earlier trade mark because it had lapsed after the date of the application but before the matter came to be determined.

50) It seems to me that the approach taken by Mr Knight is the one to be preferred and I adopt the reasoning given in his decision. In the instant case the adoption of this approach would seem particularly appropriate. Prior to the voluntary surrender of the registrations revocation actions for non-use were launched by the proprietor of the application in suit. It would not seem correct that a registered proprietor could avoid the potential effects that a revocation action might have in other proceedings by surrendering the registration which was the subject of the revocation action. In such a case the issues in question would not be tested and the registered proprietor could dispose of his registration by surrender but still make use of it in other proceedings; relying upon the fact that the registration was extant at e.g. the date of the filing of an application for registration of a trade mark.

51) Consequently I take no account of registration nos 685344 and 837425 in relation to the instant proceedings.

52) A revocation action has also been launched against registration no 1175973. However, this action is still continuing. The opponent owns Community trade mark registration no 54106 which is not subject to revocation action. This registration is for the identical trade mark as for registration no 1175973 and encompasses all the goods of this registration - the term "beers" of the Community trade mark registration encompasses all types of beer and so will include ale and porter. Therefore, by considering the Community trade mark rather than the United Kingdom registration the opponent's case is not weakened. I consider it appropriate, therefore, in the instant case to consider only the Community trade mark in relation to the grounds of opposition that rely upon a trade mark registration.

53) Consequent upon the above in relation to the instant proceedings the only trade mark registration of the opponent I will consider is his Community trade mark.

The grounds of opposition - similar goods

54) In the grounds of opposition the opponent has stated which goods of the application in suit which he considers similar and which he considers dissimilar, in relation to the grounds under section 5(2)(b) and 5(3). However, in the statutory declaration of Mr Hillier it is stated that the goods of classes 29 and 30 of the application in suit are similar to those encompassed by the registrations of the opponent. I am not certain if this refers to just the goods identified in the statement of grounds or all the goods in classes 29 and 30. A doubt that is reinforced by the absence of reference to section 5(3) in the declaration. However, the opponent has not requested an amendment to the statement of grounds. I, therefore, base this decision upon the basis of the identification of similar and non-similar goods in the statement of grounds.

The evidence of use by the opponent

55) The evidence of use of the opponent goes to all three of the grounds of opposition:

- Under section 5(2)(b) recognition of the earlier registration can increase the penumbra of protection.

- Under section 5(3) reputation is a requirement for success under this head.

- Under section 5(4)(a) and the law of passing-off goodwill needs to be established.

The evidence of the opponent I accept as showing use of his trade mark SUNTIPT in relation to raspberry and blackcurrant fruit drinks, orange juice, apple juice, tropical nectar (a mix of tropical juices), grapefruit juice, frozen orange juice and frozen grapefruit juice. However, in viewing the exhibits I consider that the use shown is limited to the catering trade. I find, owing to the turnover figures and length of use, that the opponent has established a goodwill in relation to the above goods in so far as they are sold to the catering trade.

56) In relation to section 5(2)(b) the European Court of Justice stated that public recognition of a trade mark can affect the likelihood of confusion (see *Sabel* below). The Court did not indicate what would constitute such recognition. Consequently I rely upon the view that Mr Thorley QC, acting as the Appointed Person, took in *DUONEBS* (BL 0/048/01) (unpublished) where he stated:

> "In my judgment, I believe what the ECJ had in mind was the sort of mark which by reason of extensive trade had become something of a household name so that the propensity of the public to associate other less similar marks with that mark would be enhanced. I do not believe that ECJ was seeking to introduce into every comparison required by section 5(2), a consideration of the reputation of a particular existing trade mark."

57) I certainly do not consider that the extent and nature of use shown by the opponent falls within the parameters set out by Mr Thorley. I, therefore, find that the trade mark of the opponent does not enjoy an enhanced penumbra of protection.

58) In *General Motors Corporation v Yplon SA Case C-375/97* the European Court of Justice established the parameters for claiming a reputation in relation to section 5(3):

> "Article 5(2) of the First Council Directive (89/104/EEC) of 21 December 1988 to approximate the laws of the Member States relating to trade marks is to be interpreted as meaning that, in order to enjoy protection extending to non-similar products or services, a registered trade mark must be known by a significant part of the public concerned by the products or services which it covers. In the Benelux territory, it is sufficient for the registered trade mark to be known by a significant part of the public concerned in a substantial part of that territory, which part may consist of a part of one of the countries composing that territory."

59) The evidence of the opponent does not show that his trade mark is known to a significant part of the public of a substantial part of the United Kingdom. The consideration of the reputation relates to the goods registered. Goods which are found in almost every and any household. Even if I were to limit the goods, in the context of the evidence, to the goods referred to above in relation to the catering trade, and to consider the section 5(3) issue in relation to such goods, I do not consider that the evidence of the opponent demonstrates that his trade mark is known to a significant part of the catering trade in a substantial part of the United Kingdom. If the opponent wishes to claim the exceptional protection of section 5(3) he has to demonstrate that he is entitled to it. He could have done so, potentially, by evidence from the trade and/or an indication of the market share that he enjoys. I, therefore, find that the opponent has not demonstrated a reputation in respect of section 5(3) of the Act.

Grounds of opposition

60) The grounds of opposition pursued by the opponent are those under sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994. The relevant provisions read as follows:

Section 5:

(2) A trade mark shall not be registered if because -

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.

(3) A trade mark which -

(a) is identical with or similar to an earlier trade mark, and

(b) is to be registered for goods or services which are not similar to those for which the earlier trade mark is protected,

shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the

United Kingdom (or, in the case of a Community trade mark, in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.

(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....

The term 'earlier trade mark' is defined in section 6 of the Act as follows:

"6.- (1) In this Act an "earlier trade mark" means -

(a) a registered trade mark, international trade mark (UK) or Community trade mark which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks."

Section 5(2)(b) objection

61) In determining the question under section 5(2)(b), I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* [1999] E.T.M.R. 1, *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v. Adidas AG* [2000] E.T.M.R. 723. It is clear from these cases that:-

(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v. Puma AG* page 224;

(b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v. Puma AG* page 224; who is deemed to be reasonably well informed and reasonably circumspect and observant - but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind; *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* page 84, paragraph 27.

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v. Puma AG* page 224;

(d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v. Puma AG* page 224;

(e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* page 7, paragraph 17;

(f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v. Puma AG* page 8, paragraph 24;

(g) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v. Puma AG* page 224;

(h) further, the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense; *Marca Mode CV v. Adidas AG* page 732, paragraph 41;

(i) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* page 9 paragraph 29.

Comparison of goods

62) The goods encompassed by the specification of the earlier registration are:

beers; mineral and aerated water and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages - class 32. The goods encompassed by the application in suit which the opponent claims are identical or similar are:

class 29: *preserved, dried and cooked fruits and vegetables*

class 30: *flavourings; syrups; rose water for flavouring purposes*

class 32: *non-alcoholic beverages, fruit juices, fruit drinks; mineral and aerated waters; syrups for making beverages; squashes; lemon barley squashes, mango squashes, orange squashes, lemon squashes, mixed fruit squashes; rose water used for flavouring beverages; kewra water*

63) The earlier registration includes the terms *non-alcoholic drinks* and *preparations for making beverages*. All the goods of the application in suit in class 32 can be defined as either non-alcoholic drinks or preparations for making beverages. The goods encompassed by class 32 of the application in suit are, therefore, identical to the goods of the earlier registration.

64) I now need to consider if the remaining goods recited above are similar to the goods of the earlier registration. In *Canon* the European Court of Justice held, in relation to the assessment of the similarity of goods, that the following factors inter alia should be taken into account: their nature, their end users and their method of use and whether they are in competition with each other or are complementary.

65) I will consider first the class 29 goods of the application in suit. The goods of the earlier registration are all beverages or goods for making beverages. The goods of the application in suit are all foodstuffs. This differentiation also defines the end users; for one set of goods the consumer

is seeking a beverage - something to slate the thirst - for the other a food - to assuage hunger. I consider, therefore, that the respective goods have a different nature and a different end user. One would not normally substitute one set of goods for the other, if one wants a drink it is unlikely that, for example, one would decide upon a tin of peaches as an alternative. Consequently I do not consider that the respective goods are in competition with one another. I do not consider that the respective goods enjoy a symbiotic relationship or our mutually dependant upon one another, as is the case for example with systems software and a computer. Therefore, I do not consider that the respective goods are complementary. Further I consider that in shops the respective goods are likely to be in discreet areas. Taking into account all the above I consider that the goods rehearsed above in class 29 of the application in suit are not similar to the goods of the earlier registration.

66) In relation to the class 30 goods of the application in suit I take into account *Reliance Water Controls Ltd v Altecnic Ltd* case no A3/2000/3800 before the Court of Appeal. In that case Mummery LJ stated that:

> "The fact that the system of classes of goods is for the purposes of administrative convenience or that the identification of a Class number serves such purposes does not prevent the statement of the Class number from being part of the application, which can only be amended in accordance with the provisions of the 1994 Acts and Rules."

The goods class defines the nature of the goods or, possibly, their purpose. In the instant case the *syrups* covered by class 30 include golden syrup, glucose syrup and molasses syrup. Goods of a very different type to those for making beverages. However, it also includes chocolate syrups for making beverages. In the latter case these goods clearly share major similarities with the syrups of the opponent's registration. They have the same nature, the same purpose, they could be readily substituted for one another. Such goods are, I consider, clearly highly similar to the goods of the earlier registration. I do not know what goods the applicant specifically wishes to encompass by the term syrups, indeed he might well wish to encompass all types of syrups. In this context I consider that I must consider the term in its generality. Consequently I find that *syrups* in class 30 of the application in suit are similar to the goods of the earlier registration.

67) The specification of the earlier registration includes *preparations for making beverages*. Such goods include goods for flavouring the said beverages, which would include also rose water for flavouring beverages. *Rose water for flavouring purposes* in the application in suit would, therefore be the same as the goods that could be included in the earlier registration with the exception that the final purpose would vary slightly. I, therefore, find that *rose water for flavouring purposes* of the application in suit is similar, indeed highly similar, to the goods of the earlier registration. The same argument applies to *flavourings* in the application in suit at large. I, therefore, find that these goods are similar to the goods of the application in suit.

68) In summary I find that all the goods which the opponent considers similar or identical in classes 30 and 32 of the application in suit to the goods of his earlier registration are similar or identical. I find that the goods of class 29 of the application in suit are not similar.

Comparison of signs

70) The trade marks to be compared are as follows:

Earlier registration:	Application in suit:
SUNTIPT	**SUNDiP** **SUNDIP**

71) I will consider the upper trade mark of the series first. As this trade mark includes a slight form of stylisation, the letter "i" being in lower case, if the opponent succeeds in relation to this registration he will, inevitably succeed in relation to the lower trade mark also.

72) The respective trade marks both begin with "SUN" and this element is phonetically identical. I consider that the letters "D" and "T" which follow "SUN" have a sound that aurally is quite similar. I am fortified in this view by consideration of the fact that in Welsh, which is a language that practices sandhi, the letter "T" often mutates into the letter "D". This practice reflects the change of the sound of the letter in various contexts. The final letter "T" of the earlier registration will have a sound that falls away. It is common in oral use, also, for the ends of words to be slurred or even dropped. A tendency that was noted in *TRIPCASTROID* 42 RPC 264 at page 279. It is also to be noted that the "IP" sound appears in both trade marks at the same point. Taking the above into account I consider that the respective trade marks are phonetically similar, and to a high degree.

73) The opponent has referred to the conceptual similarity of the respective trade marks. I have rehearsed his arguments above and will not do so again. I agree with the opponent's analysis that to both trade marks allude to the idea of something partially coated by the sun. I consider that the respective trade marks enjoy a similar conceptual association. I, therefore, find that the respective trade marks are conceptually similar.

74) The application in suit has a slight variation from the normal format by the use of the lower case letter "i". However, balanced against this is that the majority of the letters are not only the same but appear in the same position. Owing to the phonetic and conceptual similarity I do not think that much turns upon the issue of visual similarity. In relation to word marks I consider that the major identifiers are sound and concept; this is how the brain differentiates between words. Although in the instant case I do not consider that visual similarity or otherwise of the respective trade marks is of importance, I find that there is a degree of similarity.

75) Consequent upon the above I consider that the respective trade marks enjoy a high degree of similarity. As indicated at the beginning of this section if the upper trade mark is similar then the lower trade mark will have to be considered similar to at least the same extent.

Conclusion

76) I need to take into account that the respective goods which I have found similar are not the sort of goods which will normally involve a particularly careful purchasing decision. They are far nearer to the "bags of sweets" end of a purchasing decision than the car end. I also take into

account that the earlier registration enjoys inherent distinctiveness, it does not allude to the goods. It is also to be noted that the respective goods are either identical or highly similar and that the respective signs are also highly similar; so the opponent covers both ends of the interdependency principle of goods and signs.

77) In relation to the similarity of the signs I consider that the degree of phonetic similarity is such that the opponent could have succeeded upon this basis alone. I consider that the finding in *Lloyd* is relevant in the instant proceedings:

> "It is possible that mere aural similarity between trade marks may create a likelihood of confusion".

78) Consequent upon the above I find that there is a likelihood of confusion in respect of the following goods of the application in suit:

class 30: ***flavourings; syrups; rose water for flavouring purposes***

class 32: ***non-alcoholic beverages, fruit juices, fruit drinks; mineral and aerated waters; syrups for making beverages; squashes; lemon barley squashes, mango squashes, orange squashes, lemon squashes, mixed fruit squashes; rose water used for flavouring beverages; kewra water***

Section 5(3) objection

79) I have already decided that the opponent has not established a reputation in relation to section 5(3). This ground of opposition must, therefore, be dismissed.

Section 5(4)(a) objection

80) I intend to adopt the guidance given by the Appointed Person, Mr Geoffrey Hobbs QC in the *Wild Child case* [1998] 14 RPC 455. In that decision Mr Hobbs stated that:

> "The question raised by the Grounds of Opposition is whether normal and fair use of the designation WILD CHILD for the purposes of distinguishing the goods of interest to the Applicant from those of other undertakings (see Section 1(1) of the Act) was liable to be prevented at the date of the application for registration (see Art. 4(4)(b) of the Directive and Section 40 of the Act) by enforcement of rights which the opponent could then have asserted against the applicant in accordance with the law of passing off".
>
> "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] RPC 341 and Erven Warnink BV v J Townend & Sons (Hull) Ltd [1979] ACT 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."

> ....."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 action."

81) In consideration the issue of passing-off I am not greatly assisted by the opponent who addresses this issue in the most perfunctory fashion, almost as a throw away line. He has eschewed any reference to case law and effectively just made a vague and broad statement. However, I still

must come to some conclusion.

82) I have accepted above the opponent has established a goodwill in relation to the trade mark SUNTIPT in relation to *raspberry and blackcurrant fruit drinks, orange juice, apple juice, tropical nectar (a mix of tropical juices), grapefruit juice, frozen orange juice and frozen grapefruit juice for sale to the catering trade.* Effectively a goodwill for fruit drinks for the catering trade. So the sphere of the goodwill is limited. The evidence also fails to tell me that within the catering trade if this is a particularly well-known trade mark. There is no evidence from the trade and no comparative figures given in relation to the size of the potential market. Passing-off is not limited to similar or identical goods or services, however it does not give carte blanche to attack everything and anything. In *Harrods v Harrodian School* [1996] RPC 697 Millett LJ states:

> "It is not in my opinion sufficient to demonstrate that there must be a connection of some kind between the defendant and the plaintiff, if it is not a connection which would lead the public to suppose that the plaintiff has made himself responsible for the quality of the defendant's goods or services"

In the same case Millet LJ states:

> "The absence of a common field of activity, therefore, is not fatal; but it is not irrelevant either. In deciding whether there is a likelihood of confusion, it is an important and highly relevant consideration."

In *Stringfellow v McCain Foods (G.B.) Ltd.* [1984] RPC 501 Slade L.J. said:

> "even if it considers that there is a limited risk of confusion of this nature, the court should not, in my opinion, readily infer the likelihood of resulting damage to the plaintiffs as against an innocent defendant in a completely different line of business. In such a case the onus falling on plaintiffs to show that damage to their business reputation is in truth likely to ensue and to cause them more than minimal loss is in my opinion a heavy one."

In *Harrods* Millet LJ states also: "To be known to everyone is not to be known for everything". The evidence before certainly does not put the opponent on a par with Harrods, it does not suggest the opponent is known to everyone or even to a large number of members of the public.

83) In relation to the class 3 goods of the application in suit there is no common field of activity with the goods for which the opponent has goodwill. In relation to the goods which I have refused already under section 5(2)(b) I need say no more about them, there is no point in considering whether I should refuse them twice. Also owing to the greater breadth of the specification of the opponent's registration, in comparison with his goodwill, he certainly could not do better under the law of passing-off. In relation to the remaining goods in classes 29 and 30 I consider that I need to consider if the customer, who in the terms of the opponent's goodwill will be a catering professional, is likely to be deceived into thinking that the goods of the applicant are in fact the goods of the opponent. (This is in contrast to my deliberations in relation to section 5(2)(b) where I had to take into account all potential customers, there is no restriction as to the parameters of

the specification of the trade mark registration.) I am hamstrung by the lack of evidence to the nature of the trade. I have nothing before me which tells me if the catering trade would be likely to see the goodwill of the opponent as acting as a magnet in relation to non-similar goods. Would the catering trade for instance be likely to see a connection between fruit beverages and meat and fish? It is for the opponent to prove his case. In the absence of evidence in relation to this issue I do not consider that I can find for the opponent in relation to non-similar goods.

84) Consequently I dismiss the ground of opposition based upon passing-off under section 5(4)(a).

85) Consequent upon my findings in relation to section 5(2)(b) the application in suit is refused in respect of all goods in class 32 and in respect of flavourings, syrups and rose water for flavouring purposes in class 30. The application in suit may proceed to registration in respect of all other goods.

As both parties have been successful to some extent I make no award of costs.

Dated this 18TH day of January 2002

D.W.Landau
For the Registrar
the Comptroller-General