

O/0217/26

TRADE MARKS ACT 1994

**IN THE MATTER OF
THE UK DESIGNATION OF INTERNATIONAL REGISTRATION NO.
WO0000001770124**

**BY KALZER NATÜREL ÜRÜNLER GIDA SANAYİ VE TİCARET ANONİM ŞİRKETİ
FOR PROTECTION OF THE FOLLOWING TRADE MARK:**



IN CLASSES 5, 29, 30 AND 32

AND

**IN THE MATTER OF THE OPPOSITION THERETO
UNDER NO. 447074
BY FEVERTREE LIMITED**

BACKGROUND AND PLEADINGS

1. KALZER NATÜREL ÜRÜNLER GIDA SANAYİ VE TİCARET ANONİM ŞİRKETİ (“the holder”) designated the international registration (“the IR”) shown on the front cover of this decision for protection in the UK on 06 October 2023. This is also its international registration date. Protection is sought for the following goods:

Class 5: *Medicated dental care preparations, teeth filling material, dental impression material, dental adhesives, and material for repairing teeth; dietary supplements for pharmaceutical and veterinary purposes, dietary supplements, nutritional supplements, medical preparations for slimming purposes, food for babies, herbs, and herbal beverages adapted for medicinal purposes; pharmaceutical and veterinary preparations for medical purposes, chemical preparations for medical and veterinary purposes, chemical reagents for pharmaceutical and veterinary purposes, and medicated cosmetics; disinfectants, antiseptics, detergents for medical purposes, medicated soaps, disinfectant soaps, antibacterial hand lotions; deodorants, other than for human beings or for animals, air purifying preparations, and air deodorizing preparations; preparations for destroying vermin, herbicides, fungicides, preparations for destroying rodents.*

Class 29: *Prepared nuts and dried fruits as snacks; hazelnut spreads and peanut butter, sesame seed paste namely tahini; dried, preserved, frozen, cooked, smoked, or salted fruits, vegetables, and tomato paste; edible oils; milk of animal origin and milk of plant origin, milk products, butter; processed olives, and olive paste; soups, bouillon; potato chips; meat, fish, poultry and game, processed meat products; dried pulses.*

Class 30: *Coffee, cocoa, coffee or cocoa-based beverages, chocolate-based beverages; molasses for food; cereal-based snack food, popcorn, crushed oats, corn chips, breakfast cereals, processed wheat for human consumption, crushed barley for human consumption, and processed oats for human; salt; pasta, stuffed dumplings, noodles; pastries and bakery products based on flour, desserts based on flour and chocolate, bread, Turkish ring-shaped bagel*

covered with sesame seeds namely simit, Turkish bagel namely poğaç, pita, sandwiches, Turkish pastry namely katmer, pies, cakes, Turkish dessert based on dough coated with syrup namely baklava, Turkish dessert based on dough namely kadayıf, desserts based on dough coated with syrup, puddings, custard, Turkish pudding namely kazandibi, keşkül, rice pudding; honey, bee glue for human consumption, and propolis for food purposes; condiments for foodstuff, vanilla flavoring, spices, sauces, tomato sauce; yeast, baking powder; flour, semolina, and starch for food; sugar, cube sugar, powdered sugar; tea, ice tea; confectionery, chocolate, biscuits, crackers, wafers; chewing gums; ice-cream, edible ices.

Class 32: *Beers, extracts for making beer; fruit and vegetable juices, fruit and vegetable concentrates and extracts for making beverages, and non-alcoholic soft drinks; mineral water, spring water, table water, soda water; energy drinks, protein-enriched sports beverages.*

2. The mark contains the following text: *“Colours claimed: The mark contains the colours EMERALD GREEN and BEIGE.”*

3. On 19 April 2024, the IR was opposed in its entirety by Fevertree Limited (“the opponent”) based upon Sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”).

4. Under both Sections 5(2)(b) and 5(3), the opponent relies upon the following three trade marks and the goods covered by the same (for which it also claims a reputation), as shown below:¹

¹ The opponent initially relied upon a fourth earlier mark, namely UK00916057614 for the mark IF 3/4 OF YOUR GIN AND TONIC IS TONIC, MIX WITH THE BEST. However, reliance on this mark was dropped in the opponent’s submissions in lieu.

UK00917858391² (“earlier mark 1”)

MIX WITH THE BEST

Filing date: 23 February 2018

Registration date: 17 January 2019

Class 33: *Cocktails of alcoholic and non-alcoholic beverages.*

UK00003292278 (“earlier mark 2”)

MIX WITH THE BEST

Filing date: 23 February 2018

Registration date: 25 May 2018

Class 32: *Non-alcoholic beverages; preparations for making non-alcoholic beverages.*

Class 33: *Alcoholic beverages; cocktails of alcoholic and non-alcoholic beverages.*

UK00916057572 (“earlier mark 3”)

IF 3/4 OF YOUR DRINK IS THE MIXER, MIX WITH THE BEST

Filing date: 16 November 2016

Registration date: 19 July 2017

Class 32: *Non-alcoholic beverages and preparations for making non-alcoholic beverages.*

Class 33: *Alcoholic beverages; cocktails of alcoholic and non-alcoholic beverages.*

5. By virtue of their earlier filing dates, the trade marks relied upon by the opponent are “earlier marks” in accordance with Section 6 of the Act. The earlier marks 2 and 3 have been registered for more than five years at the filing date of the IR, and, as such, are subject to the use conditions under Section 6A of the Act. However, the earlier mark 1 is not subject to proof of use - this means that the opponent can rely upon the goods it has identified without having to prove genuine use.

² Under Article 54 of the Withdrawal Agreement between the UK and the EU, the UK IPO created comparable UK trade marks for all right holders with an existing registered EUTM or International Registration designating the EU. As a result, earlier marks 1 and 3 were converted into a comparable UK trade mark. Comparable UK marks are now recorded in the UK trade mark register, have the same legal status as if they had been applied for and registered under UK law, and the original filing dates remain the same.

6. Under Section 5(2)(b), the opponent claims there is a likelihood of confusion because the goods are identical or similar, and the marks are highly similar. In addition, under this ground, the opponent relies on a “family of marks” argument, stating as follows:

“The Earlier Marks all possess common characteristics, namely the tagline MIX WITH THE BEST, that mean they are to be regarded as part of a family (or series) of marks. As will be demonstrated through evidence in the course of these proceedings, consumers recognise this family of marks owned by the Opponent. When faced with the mark the subject of the Opposed Mark, they would detect the identical or highly similar common element and may be mistaken as to the provenance or origin of the goods covered by the Application or consider erroneously that that Opposed Mark is part of the Opponent’s family of marks”.

7. Under Section 5(3), the opponent claims that its earlier marks enjoy a reputation in relation to all of the goods identified above and that use of the IR in relation to the goods concerned will take unfair advantage of, and be detrimental to, the distinctive character or the repute of the opponent’s earlier marks.

8. Under Section 5(4)(a) the opponent relies on the following two signs:

MIX WITH THE BEST

IF 3/4 OF YOUR DRINK IS THE MIXER, MIX WITH THE BEST

9. The opponent claims to have used the signs throughout the UK since 2016 in relation to the following goods and services:

Beverages, namely drinking waters, flavoured waters, mineral and aerated waters; non-alcoholic beverages; non-alcoholic beverages, namely, soft drinks, energy drinks and sports drinks; fruit drinks and juices; tonic waters; syrups, concentrates and powders for making beverages.

Household or kitchen utensils and containers; tableware; glassware; glasses, drinking vessels and barware; gin glasses; cocktail glasses; bottle openers; cocktail shakers; cocktail stirrers; ice-cube trays.

Education; providing of training; seminars; arranging and conducting of classes and masterclasses; arranging and conducting cocktail masterclasses; arranging and conducting mixology masterclasses; entertainment; organising of festivals; provision of festivals; organising and conducting events; organising and conducting events for entertainment and educational purposes; gin tasting events; tasting events relating to alcoholic and non-alcoholic beverages; organisation and presentation of competitions; sporting and cultural activities; provision of information, consultancy and advice relating to the aforesaid.

Services for the provision of food and drink; catering services; bar services; mobile bar services; restaurant services; cafe services; provision of information, consultancy and advice relating to the aforesaid.

10. The opponent claims that it enjoys significant goodwill in the UK and that use of the IR would constitute a misrepresentation as to the commercial origin of the holder's goods, which would cause damage to the opponent.

11. The holder filed a defence and counterstatement, denying the opponent's claims and putting the opponent to proof of use of its earlier marks 2 and 3.

12. The opponent is represented by Springbird IP Limited, and the holder is represented by ip21 Limited. Only the opponent filed evidence during the evidence rounds. The holder filed nothing beyond the Form TM8 and counterstatement. Neither party requested a hearing, but the opponent filed submissions in lieu of a hearing. I make this decision having taken full account of all the papers, referring to them as necessary.

Relevance of EU Law

13. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, Section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained Eu Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

EVIDENCE

14. The opponent's evidence came in the form of a witness statement from Elizabeth George dated 4 September 2024. Ms George's witness statement is accompanied by 14 exhibits (being those labelled EG01-EG14). Ms George is the Vice President Legal North America of Fevertree USA Inc, a company which together with the opponent (i.e. Fevertree Limited) is part of the wider group Fevertree Drinks PLC. Her evidence is aimed at showing use of the earlier marks by the opponent in order to support the claims based on genuine use, goodwill and reputation.

15. I do not intend to summarise the evidence (or submissions) in full here. However, I confirm that I have taken all filed documents into account and will summarise them to the extent that I deem necessary below.

DECISION

Proof of use

16. Relevant statutory provision: Section 6A:

“(1) This section applies where

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (aa) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

(1A) In this section “the relevant period” means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

(a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes –

(a) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5)-(5A) [Repealed]

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.”

17. As the earlier mark 3 is a comparable mark, paragraph 7 of Part 1, Schedule 2A of the Act is also relevant. It reads:

“7.— (1) Section 6A applies where an earlier trade mark is a comparable trade mark (EU), subject to the modifications set out below.

(2) Where the relevant period referred to in section 6A(3)(a) (the "five-year period") has expired before IP completion day—

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM; and

(b) the references in section 6A(3) and (4) to the United Kingdom include the European Union.

(3) Where [IP completion day] falls within the five-year period, in respect of that part of the five-year period which falls before IP completion day —

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM ; and

(b) the references in section 6A to the United Kingdom include the European Union”

18. In *easyGroup Ltd v Nuclei Ltd & Ors* [2023] EWCA Civ 1247, Arnold LJ summarised the law relating to genuine use as follows:

“105. The principles applicable to determining whether there has been genuine use of a trade mark have been considered by the CJEU in a considerable number of cases, the principal decisions being Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159, Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bunderversvereinigung Kamaradschaft 'Feldmarschall Radetsky'*[2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], Case C-141/13 *P Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089], Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434] and Joined Cases C–720/18 and C–721/18 *Ferrari SpA v DU* [EU:C:2020:854].

106. Ignoring issues which do not arise in the present case, such as use in relation to spare parts or second-hand goods and use in relation to a sub-category of goods or services, the principles may be summarised as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29]; *Ferrari* at [32].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29]; *Gözze* at [37], [40]; *Ferrari* at [32].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56]; *Ferrari* at [33].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation

has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

19. Section 100 is also relevant, which reads:

“If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

20. Proven use of a mark which fails to establish that “*the commercial exploitation of the mark is real*” because the use would not be “*viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services protected by the mark*” is not, therefore, genuine use.

21. As I have set out above, one of the opponent’s earlier marks is a comparable mark based upon an earlier EU Trade Mark (“EUTM”). This means that use of this mark in the EU prior to (and including) IP Completion Day (being 31 December 2020) is relevant to the present assessment. By virtue of being a Member State prior to this date, the UK still forms part of the relevant territory of the EU. From 1 January 2021 onwards, however, the relevant territory is the UK only.

22. The relevant period in which genuine use must be established is the five-year period ending with the filing date of the IR: 5 October 2018 to 06 October 2023.³

23. Ms George’s evidence is that Fevertree Limited (i.e. the opponent) licenses the earlier trade marks to Fevertree UK Limited;⁴ the latter is the entity responsible for the UK sales under the opponent’s trade marks. Ms George also explains that the

³ Paragraph 2 of Schedule 2 of the Trade Marks (International Registration) Order 2008 gives the filing date for 3ter(2) designations as the date the request for extension was recorded in the International Register.

⁴ EG01

opponent is one of a number of companies in the group of companies under the parent company Fevertree Drinks PLC.

24. Ms George provides background information that Fevertree was set up in 2003 out of its founders' desire and commitment to fill a gap in the “*premium mixers market*”. The opponent was officially incorporated on 19 November 2004,⁵ and its first product was a Premium Indian Tonic Water which was launched in 2005. Ms George also states that Fevertree is renowned amongst consumers for “*its wide range of soft drinks, including mixers for alcoholic and non-alcoholic spirits and cocktails*” and that it is often recognised in the industry for its mixers as premium products – it is clear from these statements that the goods sold by the opponent’s licensees are non-alcoholic drinks that can be mixed with alcohol; this conclusion is further corroborated by the examples of products produced in evidence as shown below:



⁵ EG02



25. Tonic Water, Lemon Tonic and Giner Ale are all soft drinks that can be consumed on their own or used as mixers with spirits. The evidence also shows examples of FEVER-TREE cola and lemonade products.⁶

⁶ EG03

26. Ms George says that the earlier marks 'IF ¾ OF YOUR DRINK IS THE MIXER, MIX WITH THE BEST' and 'MIX WITH THE BEST' have been used as straplines in FEVER-TREE's online and offline communications since as early as 2015 and 2016, respectively. In this connection, Ms George makes certain claims in relation to consumers recognising the straplines and associating them with the main brand FEVER-TREE. She states:

“As mentioned above, ever since their adoption, the Straplines resonated with both the end consumer and our industry and have therefore become synonymous with our company. Our 'IF ¾ OF YOUR DRINK IS THE MIXER, MIX WITH THE BEST' tagline, in particular, enjoyed widespread recognition and praise from both branding and industry experts for essentially shifting consumer perception and behaviour towards mixers for alcoholic and non-alcoholic drinks. This is evidenced with a range of articles attached as Exhibit EG04 (accompanied by extracts confirming that the publications are UK-based and showing their circulation/reach, where that information is available online). The same articles also make clear reference to our company's status in the market over a number of years, in terms of market share, growth and positioning.”

27. Clearly, the use made by the opponent of the earlier marks has been as advertising slogans or straplines. The straplines do not contain any reference to the brand name 'FEVER-TREE' as the originator of the goods but communicate the idea that the products are premium mixers.

28. As regards Ms George's claim that the straplines are associated with the brand name FEVER-TREE, a UK online article from 2017 states that figures from 2016 show that Fever-Tree was the fastest growing mixer brand accounting for 24% market share of the total mixer category.⁷ Another UK article from May 2022 refers to the strapline 'IF ¾ OF YOUR DRINK IS THE MIXER, MIX WITH THE BEST' as the “*brand's famous strapline*”, whilst also referring to a new campaign called “*We'd say T&G*”.⁸ It states:

⁷ EG04

⁸ EG04

“SM, UK Marketing Director said “The new campaign is an exciting evolution for the brand. Our ‘¾ of your drink is a mixer, mix it with the best’ line has undoubtedly helped shift consumer perception of mixers, so we are delighted to have brought that to life in a slightly more playful way, with this latest advertising. We want to remind drinkers to continue to seek the highest quality tonic, which matters just as much as the gin. Cheers to a “T&G!””

29. The evidence further shows that the new campaign did not actually replace the traditional strapline ‘IF ¾ OF YOUR DRINK IS THE MIXER, MIX WITH THE BEST’ but it incorporated it, as shown below:



30. An article from 19 July 2019 also refers to the opponent’s strapline ‘IF ¾ OF YOUR DRINK IS THE MIXER, MIX WITH THE BEST’ stating as follows:

“The beauty of this slogan is that it stays true to the brand’s heritage; the founder created a premium tonic for the very reason that good gin was being ruined by poor quality mixers.

Having a slogan that makes people buy more is what is all about, right? But it is a lot easier said than done. My guess is that a huge amount of investment (thought, creativity, time and money) went into the creation of that slogan. They

may have tried a lot of different ones but I think they've found a superb slogan that consumers can relate to"

31. Further details of marketing activities promoting the straplines 'IF ¾ OF YOUR DRINK IS THE MIXER, MIX WITH THE BEST' and 'MIX WITH THE BEST' are provided.⁹ They include:

- A television advert targeting the UK running in 2021 and 2022 depicting the 'MIX WITH THE BEST' strapline.
- National radio adverts running between May 2022 and June 2024 referencing the 'MIX WITH THE BEST' strapline.
- The "T&G" campaign mentioned above run between May and June 2022.

32. The straplines have also been used on social media as well as YouTube videos.¹⁰

33. In addition, Ms George says that the straplines are regularly applied to the products and provides examples of such goods being offered for sale on Amazon UK.¹¹ As it can be seen from the images which I have reproduced below, the strapline 'IF ¾ OF YOUR DRINK IS THE MIXER, MIX WITH THE BEST' appears on the outer packaging:



⁹ Exhibit EG05-A

¹⁰ EG06

¹¹ EG08

34. The screenshots exhibited demonstrate that these goods have been available for sale in the UK since 2016.

35. Lastly, in terms of sales, Ms George states that as of December 2022, the UK accounted for 34% of the revenue of Fevertree, with sales of approximately £116million and a market share of 45%. She further states that virtually all (if not all) of the products sold to the UK market within 2022 had the straplines on their outer packaging. The goods were sold on various UK online stores, namely Morrisons, Amazon.co.uk, and Ocado as well as in hundreds of physical UK supermarkets including Morrisons, Sainsburys, Tesco and Waitrose.

Conclusions on genuine use

36. Admittedly the opponent's licensee has used the earlier marks 'IF $\frac{3}{4}$ OF YOUR DRINK IS THE MIXER, MIX WITH THE BEST' and 'MIX WITH THE BEST' as slogans in conjunction with the house mark 'FEVERTREE' since 2015-2016 in relation to a range of mixers. A slogan is a short, memorable phrase used in advertising to represent a brand (or a product). In the same way as word and figurative marks, slogan marks are subject to the same basic requirements of not being descriptive and/or non-distinctive in order to be registrable. Likewise, once slogan marks have achieved registration, the requirements for "genuine use" are the same as those applicable to other (ordinary) marks.

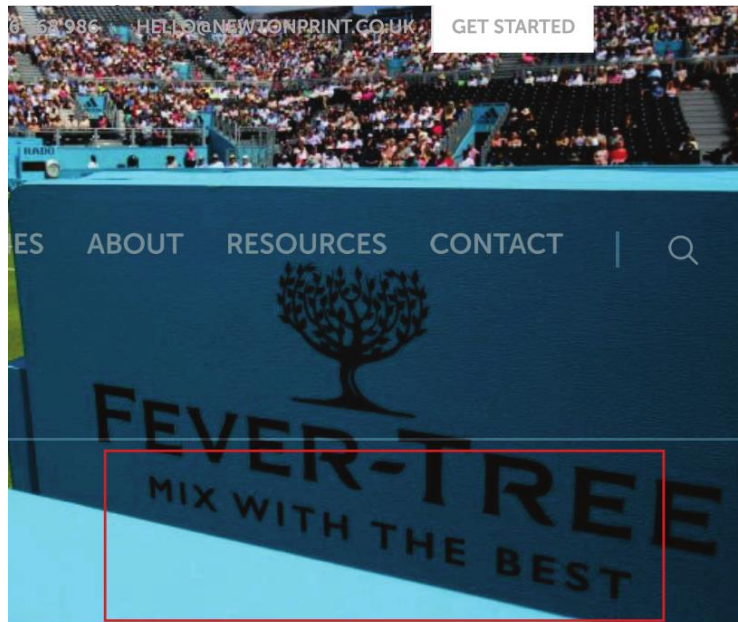
37. In the present case, the use of the earlier slogan marks in conjunction with the house mark FEVER-TREE is acceptable use; I say this because it is well established that *"the 'use' of a mark, in its literal sense, generally encompasses both its independent use and its use as part of another mark taken as a whole or in conjunction with that other mark"* as long as it remains an indicator of origin (which is the case here).¹² Further, a registered trade mark must be assumed to have *"at least some distinctive character"*¹³ and I must proceed on the basis that the phrases "IF $\frac{3}{4}$ OF YOUR DRINK IS THE MIXER, MIX WITH THE BEST' and 'MIX WITH THE BEST' are

¹² *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12

¹³ *Formula One Licensing BV v OHIM*, Case C-196/11P

not purely descriptive and do not lack in distinctive character. However, they have a low degree of distinctiveness since the relevant public would perceive them as laudatory slogans referring to the quality of the products (i.e. premium quality) - this, as Ms George's evidence establishes, was the whole purpose of the slogans which were devised to reflect FEVER-TREE's messaging strategy of communicating to consumers the importance of selecting premium mixers (for their premium alcohol). Lastly, the evidence contains a reference to 'IF ¾ OF YOUR DRINK IS THE MIXER, MIX WITH THE BEST' being FEVER-TREE's famous strapline. Whilst this evidence suggests that the slogan was used to such an extent that it had become associated with the brand, it is difficult to assess how distinctive it had become as a result of it being used as part of, or in conjunction with, the brand FEVER-TREE.

38. Nevertheless, goods sold under the slogan mark "IF ¾ OF YOUR DRINK IS THE MIXER, MIX WITH THE BEST" in 2022 (within the relevant period) accounted for a very considerable sum of money with the opponent holding an astonishing market share of 45% for the goods concerned. Advertisements for the slogan 'MIX WITH THE BEST' appeared on TV and on the radio and the importance of the slogans in the marketing strategy of FEVER-TREE was acknowledged in a number of publications. Overall, I am satisfied that the sales of mixers by the opponent's licensee under the earlier slogan mark 'IF ¾ OF YOUR DRINK IS THE MIXER, MIX WITH THE BEST' amounts to genuine use. Admittedly, there is no evidence of the other slogan 'MIX WITH THE BEST' being used on the products or on packaging, however, it is wholly contained within the slogan 'IF ¾ OF YOUR DRINK IS THE MIXER, MIX WITH THE BEST' (which was used on packaging) and it was promoted independently in marketing activities as shown below:



39. The evidence relates only to mixers which would be viewed by the average consumers independently as a coherent sub-category of the registered terms *non-alcoholic beverages* in class 32 in view of their purpose and intended use. In this connection, I bear in mind that when framing a fair specification care must be taken to ensure that the proprietor is not being stripped of protection for goods which, though not the same as those for which use has been proved, are not in essence different from them and cannot be distinguished from them other than in an arbitrary way.¹⁴

¹⁴ Merck KGaA v Merck Sharp & Dohme Corp & Ors [2017] EWCA Civ 1834

40. However, the registered terms *Non-alcoholic beverages; preparations for making non-alcoholic beverages* are very broad and include a variety of goods which represent subcategories capable of being viewed independently for example water, fruit beverages, vegetable-based beverages, smoothies, protein drinks, sport drinks, energy drinks, soft drinks, syrups, alcohol free and de-alcoholised wine and alcohol free beer. As the case-law establishes in those circumstances use in relation to one or more of subcategories cannot constitute use of the mark in relation to all of the other subcategories.

41. Accordingly, I will proceed on the basis that the opponent has shown genuine use of the trade marks 'IF ¾ OF YOUR DRINK IS THE MIXER, MIX WITH THE BEST' and 'MIX WITH THE BEST' in relation to *non-alcoholic beverages, namely mixers* in class 32. In this connection, whilst some of the goods shown in evidence (i.e. Ginger ale and flavoured tonic water) can be enjoyed on their own, the opponent's use of the slogan marks in the context of the goods at issue refers to the goods being designed to be mixed; this demonstrates that the intended use of the goods is that of being used as mixers in cocktails, which is how Cambridge online dictionary defines "mixers":

"a drink that does not contain alcohol and can be mixed with an alcoholic drink, especially a spirit (= strong alcoholic drink)"

Accordingly, I will proceed on that basis.

Section 5(2)(b)

42. Section 5(2)(b) of the Act reads as follows:

"5(2) A trade mark shall not be registered if because –

(a) ...

(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.”

43. The following standard summary of the principles applicable to the assessment of the likelihood of confusion was approved by the Supreme Court in *Iconix Luxembourg Holdings SARL v Dream Paris Europe Inc & Anor*, [2025] UKSC 25:

(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, 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, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may, in certain circumstances, be dominated by one or more of its components;

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite possible that in a particular case an element corresponding to an earlier trade mark may

retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) 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; and

(k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically linked undertakings, there is a likelihood of confusion.

Comparison of goods

44. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. In the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary.”

45. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

46. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v OHIM*, Case T-325/06, the General Court (“GC”) stated that “complementary” means:

“[...] there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking.”

47. In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services

are very different. The purpose of examining whether there is a complementary relationship between goods and services is to assess whether the relevant public are liable to believe that responsibility for the goods and services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander QC noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited*, BL O/255/13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense – but it does not follow that wine and glassware are similar goods for trade mark purposes.”

48. Whilst on the other hand:

“[...] it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.”

49. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the GC stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut fur Lernsysteme v OHIM- Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark.”

50. The competing goods are as follows:

The IR's goods	The opponent's earlier goods
<p>Class 5: <i>Medicated dental care preparations, teeth filling material, dental impression material, dental adhesives, and material for repairing teeth; dietary</i></p>	

supplements for pharmaceutical and veterinary purposes, dietary supplements, nutritional supplements, medical preparations for slimming purposes, food for babies, herbs, and herbal beverages adapted for medicinal purposes; pharmaceutical and veterinary preparations for medical purposes, chemical preparations for medical and veterinary purposes, chemical reagents for pharmaceutical and veterinary purposes, and medicated cosmetics; disinfectants, antiseptics, detergents for medical purposes, medicated soaps, disinfectant soaps, antibacterial hand lotions; deodorants, other than for human beings or for animals, air purifying preparations, and air deodorizing preparations; preparations for destroying vermin, herbicides, fungicides, preparations for destroying rodents.

Class 29: *Prepared nuts and dried fruits as snacks; hazelnut spreads and peanut butter, sesame seed paste namely tahini; dried, preserved, frozen, cooked, smoked, or salted fruits, vegetables, and tomato paste; edible oils; milk of animal origin and milk of plant origin, milk products, butter; processed olives, and olive paste; soups, bouillon; potato chips; meat, fish, poultry and game, processed meat products; dried pulses.*

Class 30: *Coffee, cocoa, coffee or cocoa-based beverages, chocolate-based beverages; molasses for food; cereal-based snack food, popcorn, crushed oats, corn chips, breakfast cereals, processed wheat for human consumption, crushed barley for human consumption, and processed oats for human; salt; pasta, stuffed dumplings, noodles; pastries and bakery products based on flour, desserts based on flour and chocolate, bread, Turkish ring-shaped bagel covered with sesame seeds namely simit, Turkish bagel namely poğaç, pita, sandwiches, Turkish pastry namely katmer, pies, cakes, Turkish dessert based on dough coated with syrup namely baklava, Turkish dessert based on dough namely kadayıf, desserts based on dough coated with syrup, puddings, custard, Turkish pudding namely kazandibi, keşkül, rice pudding; honey, bee glue for human consumption, and propolis for food purposes; condiments for foodstuff, vanilla flavoring, spices, sauces, tomato sauce; yeast, baking powder; flour, semolina, and starch for food; sugar, cube sugar, powdered sugar; tea, ice tea; confectionery, chocolate, biscuits, crackers, wafers; chewing gums; ice-cream, edible ices.*

<p>Class 32: <i>Beers, extracts for making beer; fruit and vegetable juices, fruit and vegetable concentrates and extracts for making beverages, and non-alcoholic soft drinks; mineral water, spring water, table water, soda water; energy drinks, protein-enriched sports beverages.</i></p>	<p>Class 32: <i>non-alcoholic beverages, namely mixers</i> (Earlier marks 2 and 3)</p>
	<p>Class 33: <i>Cocktails of alcoholic and non-alcoholic beverages.</i> (Earlier mark 1)</p>

51. Section 60A(1)(a) of the Act provides that goods and services are not to be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification, nor dissimilar to each other on the ground that they appear in different classes under the Nice Classification. I will bear this in mind when approaching the comparison.

Class 5

Medicated dental care preparations, teeth filling material, dental impression material, dental adhesives, and material for repairing teeth; dietary supplements for pharmaceutical and veterinary purposes, dietary supplements, nutritional supplements, medical preparations for slimming purposes, food for babies, herbs, and herbal beverages adapted for medicinal purposes; pharmaceutical and veterinary preparations for medical purposes, chemical preparations for medical and veterinary purposes, chemical reagents for pharmaceutical and veterinary purposes, and medicated cosmetics; disinfectants, antiseptics, detergents for medical purposes, medicated soaps, disinfectant soaps, antibacterial hand lotions; deodorants, other than for human beings or for animals, air purifying preparations, and air deodorizing preparations; preparations for destroying vermin, herbicides, fungicides, preparations for destroying rodents.

52. In relation to these goods, the opponent states as follows:

- a. The opponent's "*non-alcoholic beverages*" and "*preparations for making non-alcoholic beverages*" can have the same intended purpose as the holder's nutritional and dietary supplements (and similar goods in class 5), since both categories of goods can be used to promote overall health, balance hormones, support sleep and so on. Nonetheless, even where the purpose is deemed to be different, the goods coincide in nature and method of use and will be sold alongside one another in outlets such as the supermarkets.
- b. It is not uncommon for consumers to purchase ready-made non-alcoholic beverages combined with or containing vitamins or other dietary supplements. Indeed, juice-based 'health shots' (such as 'ginger shots'), juice cleanses and 'supercharged juices' are increasingly popular among consumers. Alternatively, it has become common for consumers to prepare these types of drinks at home by mixing a "non-alcoholic beverage" such as a mixer with a dietary supplement like magnesium powder. Indeed, the market has seen an increasing demand for 'healthy' cocktails or mocktails that look and feel like drinks but are used to support wellbeing (e.g. the "sleepy girl mocktail" which has become a staple evening drink made with various mixers combined with magnesium supplements to promote good sleep).
- c. The opponent refers to the following paragraph of the decision O/013/19 which involved the comparison of goods in class 5 against goods in class 32, in which the Hearing Officer stated:

"All of the applicant's class 5 goods are nutritional or dietary supplements in the form of "bars, gels, beverages and pharmaceutical preparations for making beverages". In my view, the opponent's best case in respect of these goods lies in its goods in classes 29, 30 and 32. For example, there will be some similarity in nature and method of use between these goods and the opponent's "non-alcoholic drinks" and "flour and preparations made from cereals, bread, pastry and confectionary, ices". There may be some overlap in users for these goods on a general level as they will all be used by members of the general public and they may be available generally in the same retail outlets (such as supermarkets).

The intended purposes of these goods are different as the applicant's goods will be used for the specific dietary or nutritional purposes for which they are designed. In my view, there is a medium degree of similarity between the applicant's class 5 goods and the opponent's goods."

- d. The fact that the holder seeks protection for goods in class 5 as well as products such as "*protein-enriched sports beverages*" in Class 32 (being "*non-alcoholic beverages*" protected under the earlier marks) confirms they are likely to be offered by the same undertaking and further supports the similarity and/or complementarity between goods in classes 5 and 32, since customers are likely to think that the responsibility for those goods lies with the same undertaking.
- e. As for the holder's goods that are fragranced products (e.g. soaps and air purifying preparations), it is not excluded that these could be manufactured and marketed to smell like fruit drinks or cocktails, particularly if they are offered as part of gift packs. For example, there are ranges of 'pina colada' and 'mojito' car air fresheners and fragrance room sprays. Accordingly, consumers are likely to make the connection between those types of products and the opponent's goods and conclude that they are offered by the same undertaking or as part of a collaboration, rendering them similar and/or complementary.

53. The arguments put forward by the opponent in support of the similarity of the goods at issue are either farfetched or inapplicable (because the fair specification I have devised is more restricted than the registered term *non-alcoholic beverages*). In this connection, as regards the reference to the decision O/013/19, I am not bound about it, but in any event, the comparable term in this case is more restricted, being *mixers*.

54. As regards the argument set out at points (a) and (b), the opponent's *mixers* are designed to be mixed with spirits (which are well-known for being unhealthy) but, even when consumed without alcohol, they are not commonly combined with or contain vitamins or other dietary supplements. Further, even if I were to proceed on the basis that the opponent can rely on *soft drinks* (which is defined as "*a cold, usually sweet, drink that does not contain alcohol*") and is a broader category than *mixers*), the nature

and purpose of the goods is different. This is because soft drinks do not belong to the same category identified by the opponent as the closest clash, i.e. juice-based 'health shots' (such as 'ginger shots'), juice cleanses and 'supercharged juices', and soft drinks are not marketed as having any sort of health benefits.

55. Effectively, even in relation to some of the applied-for goods which might be offered in a liquid form and are for human consumption (i.e. *dietary supplements for pharmaceutical purposes, herbal beverages adapted for medicinal purposes; pharmaceutical preparations for medical purposes*), they are medical or pharmaceutical goods containing drugs which are manufactured in laboratories by pharmaceutical companies and have nothing in common with the opponent's mixers (or soft drinks). The goods have different uses, nature, purpose and method of use, they are neither complementary nor in competition and even if they can be sold through the same supermarkets, they are unlikely to be found in close proximity.

56. Nevertheless, whilst (i) I reject the opponent's claims that it is common to mix a mixer with a dietary supplement like magnesium powder, and that the market has seen an increasing demand for healthy cocktails or mocktails that are used to support wellbeing, and (ii) I bear in mind that mixers are not marketed as having health benefits, I consider that there is a low degree of similarity between the opponent's mixers and the applied-for *dietary supplements, nutritional supplements*, insofar as the latter may include, for example, goods such as protein drinks in the form of lighter, juice-like texture. Whilst the goods are neither complementary nor in competition with the opponent's mixers, they have a similar use and method of use (i.e. they are drinks for human consumption that are not medicated), target the same users, and may be available generally in the same retail outlets (such as supermarkets).

57. As regards point (d) there is no rule which establishes that if an applicant seeks protection for multiple classes including the class covered by an earlier mark, that fact alone makes the opponent's goods similar to the other applied-for classes.

58. Lastly, I reject the opponent's argument about fragranced products (e.g. soaps and air purifying preparations), being similar to non-alcoholic beverages on the basis that they could be manufactured and marketed to smell like fruit drinks or cocktails.

The argument appears farfetched. The goods have different uses, nature, purpose and method of use, they are neither complementary nor in competition and even if they can be sold through the same supermarkets, they are unlikely to be found in close proximity. The same applies to the other goods in this class. Accordingly, with the exception of *dietary supplements, nutritional supplements*, I find that these goods are **dissimilar**.

Class 29

Prepared nuts and dried fruits as snacks; hazelnut spreads and peanut butter, sesame seed paste namely tahini; dried, preserved, frozen, cooked, smoked, or salted fruits, vegetables, and tomato paste; edible oils; milk of animal origin and milk of plant origin, milk products, butter; processed olives, and olive paste; soups, bouillon; potato chips; meat, fish, poultry and game, processed meat products; dried pulses.

59. In relation to these goods, the opponent states that they are complementary because fresh, frozen and/or dried fruits (e.g. citrus fruits) and vegetables (e.g. tomatoes and celery stalks) are often served on top of, or in, cocktails and mocktails, and are also used in promotional materials alongside the same. Further, the opponent states that at least some of the goods in class 29 for which the IR seeks protection (i.e. those products that can be consumed as drinks) are similar in nature to the opponent's goods. Indeed, the fact that some of the applied-for goods can be used as ingredients for cocktails or can be used to decorate cocktails or appear in marketing material that promote cocktails, does not make them similar to the opponent's cocktails and mixers. These goods, which are foodstuff, have a different nature, use, purpose and method of use, they are not complementary and do not compete. Although they can be sold in supermarket like the opponent's mixers, they are unlikely to be found in close proximity. Lastly, the fact that they target the same relevant public, being the general public, does not create a sufficiently pronounced similarity to conclude that the goods are similar.

60. However, I am persuaded by the opponent's argument that its goods are similar to the applied-for goods insofar as the latter include products that can be consumed as drinks. In this connection, the opponent referred me to the decision in O/0778/23 where the Hearing Officer found that milk products would include milk-based drinks,

such as milkshakes which were similar to goods in class 32. I agree, and I consider that the contested *milk products* are similar to the opponent's *mixers* insofar as they are both non-alcoholic drinks consumed by the general public to quench their thirst or as a treat (since mixers can also be consumed on their own). The goods have a similar purpose, use, and method of use and target the same users. Whilst they have a different nature, the goods are fungible and to this extent they can be in competition. However, they are not complementary and are unlikely to be found in close proximity in supermarkets. **With the exception of *milk products* which are similar to a medium degree, I find that the remaining goods in class 29 are all dissimilar.**

Class 30

Coffee, cocoa, coffee or cocoa-based beverages, chocolate-based beverages; molasses for food; cereal-based snack food, popcorn, crushed oats, corn chips, breakfast cereals, processed wheat for human consumption, crushed barley for human consumption, and processed oats for human; salt; pasta, stuffed dumplings, noodles; pastries and bakery products based on flour, desserts based on flour and chocolate, bread, Turkish ring-shaped bagel covered with sesame seeds namely simit, Turkish bagel namely poğaç, pita, sandwiches, Turkish pastry namely katmer, pies, cakes, Turkish dessert based on dough coated with syrup namely baklava, Turkish dessert based on dough namely kadayif, desserts based on dough coated with syrup, puddings, custard, Turkish pudding namely kazandibi, keşkül, rice pudding; honey, bee glue for human consumption, and propolis for food purposes; condiments for foodstuff, vanilla flavoring, spices, sauces, tomato sauce; yeast, baking powder; flour, semolina, and starch for food; sugar, cube sugar, powdered sugar; tea, ice tea; confectionery, chocolate, biscuits, crackers, wafers; chewing gums; ice-cream, edible ices.

61. Applying the same considerations as above, I find that the following goods are similar to the opponent's *mixers* insofar as they are both types of non-alcoholic drinks consumed by the general public as a treat, in social contexts or to quench their thirst; as noted above *mixers* can also be consumed on their own whilst nowadays supermarkets sell readily consumable coffee drinks, cocoa-based beverages and chocolate-based beverages, as well as tea and ice tea:

Coffee, cocoa, coffee or cocoa-based beverages, chocolate-based beverages; tea, ice tea.

62. The goods have a similar purpose and use and target the same users. Whilst they have a different nature, the goods are fungible and to this extent they can be in competition. However, they are not complementary and are unlikely to be found in close proximity in supermarkets. The goods can also be sold in bars and restaurants. I find that these goods are similar to a **medium degree**. However, the remaining goods are **dissimilar**.

Class 32

Beers, extracts for making beer; fruit and vegetable juices, fruit and vegetable concentrates and extracts for making beverages, and non-alcoholic soft drinks; mineral water, spring water, table water, soda water; energy drinks, protein-enriched sports beverages.

63. The opponent's *mixers* are encompassed by the applied-for *non-alcoholic soft drinks*. Further, *mixers* encompass the applied-for *soda water*. These goods are identical on the principle outlined in *Meric*.

64. The applied-for *Fruit and vegetable juices, fruit and vegetable concentrates and extracts for making beverages*, can be either consumed on their own or used to make cocktails and beverages similarly to the opponent's *mixers* and so they have the same purpose and a similar nature. They target the same consumers and have a similar use and method of use; in addition, whilst they are not complementary, there is a degree of competition. Lastly, they are distributed through the same trade channels and might be found in close proximity. I consider those goods to be similar to a medium degree.

65. Similar considerations apply to *Mineral water, spring water, table water, energy drinks, protein-enriched sports beverages*. Although the goods have a different nature, they are all drinks consumed by the general public to quench their thirst (since *mixers* can also be consumed on their own). Hence, the goods have a similar purpose, use and method of use and target the same users, are fungible and so this extent they can

be in competition. However, they are not complementary but are likely to be found in close proximity in supermarkets. I consider those goods to be similar to a **medium degree**.

66. Although *Beers* is an alcoholic beverage, I find that it has some similarity with the opponent's *mixers* insofar as the latter can be mixed with spirits to create an alcoholic drink. Alternatively, beers include non-alcoholic beers that can be consumed as an alternative to one of the opponent's *mixers* (which can also be consumed on their own without alcohol). Although the goods have a different nature, they are all drinks consumed by the general public to quench their thirst, or in social contexts. Hence, the goods have a similar purpose, use and method of use and target the same users, are fungible and so this extent they can be in competition. However, they are not complementary but are likely to be found in close proximity in supermarkets. I consider those goods to be similar to a **low degree**. Alternatively, *beers* are similar to the opponent's *Cocktails of alcoholic and non-alcoholic beverages* in class 33, being all alcoholic drinks that can be sold through the same trade channels, target the same users and are in competition insofar as a consumer can choose between different type of alcohol.

67. Lastly, *extracts for making beer* are goods used for homebrewing. I find these goods to be one step removed from the opponent's *mixers*. The goods have a different, nature, purpose and method of use, they are neither complementary nor in competition and I am not convinced they are distributed through the same channels. These goods are **dissimilar** to any of the opponent's goods including those in class 33.

Conclusion on the similarity of the goods

68. As some degree of similarity between the respective goods is a prerequisite for assessing the likelihood of confusion under the present ground,¹⁵ a finding of no similarity means the opposition must fail in relation to the following applied-for goods, which I have determined to be dissimilar to the opponent's goods:

¹⁵ *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA

Class 5: *Medicated dental care preparations, teeth filling material, dental impression material, dental adhesives, and material for repairing teeth; dietary supplements for pharmaceutical and veterinary purposes, medical preparations for slimming purposes, food for babies, herbs, and herbal beverages adapted for medicinal purposes; pharmaceutical and veterinary preparations for medical purposes, chemical preparations for medical and veterinary purposes, chemical reagents for pharmaceutical and veterinary purposes, and medicated cosmetics; disinfectants, antiseptics, detergents for medical purposes, medicated soaps, disinfectant soaps, antibacterial hand lotions; deodorants, other than for human beings or for animals, air purifying preparations, and air deodorizing preparations; preparations for destroying vermin, herbicides, fungicides, preparations for destroying rodents.*

Class 29: *Prepared nuts and dried fruits as snacks; hazelnut spreads and peanut butter, sesame seed paste namely tahini; dried, preserved, frozen, cooked, smoked, or salted fruits, vegetables, and tomato paste; edible oils; milk of animal origin and milk of plant origin, butter; processed olives, and olive paste; soups, bouillon; potato chips; meat, fish, poultry and game, processed meat products; dried pulses.*

Class 30: *molasses for food; cereal-based snack food, popcorn, crushed oats, corn chips, breakfast cereals, processed wheat for human consumption, crushed barley for human consumption, and processed oats for human; salt; pasta, stuffed dumplings, noodles; pastries and bakery products based on flour, desserts based on flour and chocolate, bread, Turkish ring-shaped bagel covered with sesame seeds namely simit, Turkish bagel namely poğaç, pita, sandwiches, Turkish pastry namely katmer, pies, cakes, Turkish dessert based on dough coated with syrup namely baklava, Turkish dessert based on dough namely kadayif, desserts based on dough coated with syrup, puddings, custard, Turkish pudding namely kazandibi, keşkül, rice pudding; honey, bee glue for human consumption, and propolis for food purposes; condiments for foodstuff, vanilla flavoring, spices, sauces, tomato sauce; yeast, baking powder; flour, semolina, and starch for food; sugar, cube sugar, powdered sugar;*

confectionery, chocolate, biscuits, crackers, wafers; chewing gums; ice-cream, edible ices.

Class 32: *extracts for making beer.*

69. The Section 5(2)(b) ground will therefore proceed in relation to the following goods only:

Class 5: *dietary supplements, nutritional supplements*

Class 29: *milk products*

Class 30: *Coffee, cocoa, coffee or cocoa-based beverages, chocolate-based beverages; tea, ice tea*

Class 32: *Beers, fruit and vegetable juices, fruit and vegetable concentrates and extracts for making beverages, and non-alcoholic soft drinks; mineral water, spring water, table water, soda water; energy drinks, protein-enriched sports beverages.*

Average consumer

70. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97.

71. In *Iconix Luxembourg Holdings SARL v Dream Paris Europe Inc & Anor*, [2025] UKSC 25, the Supreme Court approved the comments of Arnold LJ in *Lidl Great Britain Ltd & Anor v Tesco Stores Ltd & Anor (Rev1)* [2024] EWCA Civ 262, where he pointed out that:

(a) Consumers who are ill-informed or careless, or consumers with specialised knowledge or who are excessively careful are excluded from consideration;

(b) The average consumer provides a standard which enables the courts to strike a balance between the competing interests involved, such as trade mark owners, their competitors and consumers;

(c) The average consumer is neither a single hypothetical person nor a mathematical average; assessment from the perspective of the average consumer does not involve a statistical test. There is no single meaning rule and if, having regard to the perceptions and expectations of the average consumer, the court considers that a significant proportion of the relevant public is likely to be confused, a finding of infringement may properly be made;

(d) Assessment from the perspective of the average consumer is intended to facilitate adjudication of trade mark disputes by providing an objective criterion, by promoting consistency of assessment and by enabling courts and tribunals to determine such issues so far as possible without the need for evidence;

(e) The average consumer's level of attention varies according to the category of goods or services in question; and

(f) the average consumer rarely has the opportunity to make direct comparisons between trade marks (or between trade marks and signs) and must instead rely upon the imperfect picture of the trade mark they have kept in their mind.

72. The average consumer will be a member of the general public. The opponent argues that the level of attention will be medium or high. However, this submission appears to be articulated merely to support the claim that consumers will notice the similar element of the mark 'MIX THE BEST' and wonder whether it is used as a tagline. In my view there is no reason for attributing to consumers a higher than medium level of attention when selecting the goods at issue. The cost of the goods is likely to be relatively low, and they are likely to be relatively frequent purchases.

However, factors such as flavour, and quality are likely to be taken into account, resulting in a medium (or average) degree of attention being paid during the purchasing process.

73. The goods are likely to be selected from the shelves of a retail outlet or following perusal of the mark on bottles behind a bar, on a drinks list or on a website. Consequently, visual considerations are likely to dominate the purchasing process. However, given that orders may be placed verbally, and advice may be sought from retail assistants, I do not discount an aural component to the purchase.

Comparison of marks

74. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

75. It would be wrong, therefore, to artificially dissect the trade marks, although it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks. The respective marks are shown below:

The IR	The opponent's earlier marks
	<p data-bbox="810 360 1126 394">MIX WITH THE BEST</p> <p data-bbox="810 472 1385 555">IF 3/4 OF YOUR DRINK IS THE MIXER, MIX WITH THE BEST</p>

Overall impression

The IR

76. The IR consists of the words 'MIX ME UP' presented one above the other, with each word being placed on a different level. Below these words, are the words 'MIX THE BEST' presented in capital letters on one single level, in a smaller size. I agree with the opponent that the stylisation of the letter 'X' within the word 'MIX' evokes the image of a glass with a fizzy drink inside whilst the word 'MIX' remains perfectly legible. These word elements are presented in gold, within a green rectangular background.

77. The phrase "MIX ME UP" will be perceived as a whole and given its visual prominence it is the dominant element of the mark. Although the words "MIX THE BEST" are presented in a smaller font, they are still visible and I agree with the opponent that they will also be perceived independently as a whole performing the function of a tagline due to their positioning, and size.

The opponent's earlier marks

78. The earlier marks 'MIX WITH THE BEST' and 'IF 3/4 OF YOUR DRINK IS THE MIXER, MIX WITH THE BEST' are both word marks. Within each mark, the words are combined to form slogans that will be perceived as wholes with no word dominating the others, the distinctiveness of the marks residing in the combinations themselves.

Visual similarity

79. Visually, the IR and the earlier mark 'MIX WITH THE BEST' coincide in the words 'MIX', 'THE' and 'BEST'. The elements 'MIX WITH THE BEST' (in the opponent's mark) and 'MIX THE BEST' (in the IR) are, in themselves, similar to a very high degree. However, bearing in mind the presence in the IR of the visually dominant element 'MIX ME UP' and the impact of the colour and figurative elements, I consider that overall visual similarity between these marks to be low.

80. The same considerations apply to the mark 'IF 3/4 OF YOUR DRINK IS THE MIXER, MIX WITH THE BEST', however, the words 'IF 3/4 OF YOUR DRINK IS THE MIXER' add further distance between the marks, reducing the overall similarity to a very low degree.

Aural similarity

81. Aurally, the marks will be pronounced as 'MIX ME UP. MIX THE BEST' and 'MIX WITH THE BEST'. Although the coinciding sound appears at the end of the IR, it nonetheless represents half of the IR. In addition, the first word 'MIX' of the first half of the IR is identical to (and repeats) the shared element 'MIX'. In my view, the overall aural similarity between these marks is medium to high.

82. Similar considerations apply to the mark 'IF 3/4 OF YOUR DRINK IS THE MIXER, MIX WITH THE BEST', insofar as the last part of it incorporates the mark 'MIX WITH THE BEST'. However, the words 'IF 3/4 OF YOUR DRINK IS THE MIXER' at the beginning of the mark, add further distance between the marks, reducing the overall similarity to low to medium.

Conceptual similarity

83. Conceptually, all marks share the concept of mixing goods that are of the best quality or mixing goods with other goods that are of the best quality. Further, all marks will convey the idea of mixing drinks because the earlier marks will be encountered on

mixers, whilst the IR contain the image of a glass with fizzy drinks and the goods which I found to be similar are all types of drinks.

84. Accordingly, I find that although the words 'MIX ME UP' in the IR and 'IF 3/4 OF YOUR DRINK IS THE MIXER' in the earlier mark convey additional concepts, they all revolve around (and reinforce) the concept of mixing drinks, cocktails and beverages.

85. Overall, I consider that the elements 'MIX THE BEST' and 'MIX WITH THE BEST' are conceptually identical or highly similar, but that the presence of the other elements in the respective marks means that they are, as wholes, conceptually similar to a medium to high (comparing the IR with the earlier mark 'MIX WITH THE BEST') or a medium degree (comparing the IR with the earlier mark 'IF 3/4 OF YOUR DRINK IS THE MIXER, MIX WITH THE BEST').

Distinctive character of the earlier mark

86. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97, the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section

of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

87. Registered trade marks possess various degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words, which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use made of it.

88. As it will be recalled, I have concluded that the earlier marks “IF $\frac{3}{4}$ OF YOUR DRINK IS THE MIXER, MIX WITH THE BEST’ and ‘MIX WITH THE BEST’ are not purely descriptive and do not lack in distinctive character but have a low degree of distinctiveness. This is because the relevant public would perceive them as laudatory slogans referring to the quality of the products (i.e. premium quality) in the context of the goods for which they have been used (i.e. mixers).

89. For the reasons I have already gone through, the earlier marks have acquired some distinctiveness as a result of the use made by the opponent. The evidence in fact refers to the opponent holding an astonishing market share of 45% for the goods concerned and to the slogan mark ‘IF $\frac{3}{4}$ OF YOUR DRINK IS THE MIXER, MIX WITH THE BEST’ being FEVER-TREE’s famous strapline. This would also apply to the shorter version ‘MIX WITH THE BEST’ which is wholly incorporated in the mark ‘IF $\frac{3}{4}$ OF YOUR DRINK IS THE MIXER, MIX WITH THE BEST’ and has been promoted independently. Although, as I have said, it is difficult to assess how distinctive the opponent’s slogan marks have become as a result of it being used as part of, or in conjunction with, the brand FEVER-TREE, the evidence is sufficiently solid to conclude that they had become associated with the brand FEVER-TREE which I have no doubt, enjoys a strong reputation in the UK for *mixers*, and must benefit from its reputation. Hence, although the starting position is not particularly strong, I conclude that the earlier slogan marks had become distinctive to a medium degree as a result of the use made.

Likelihood of confusion

90. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind, including that a lesser degree of similarity between the respective marks may be offset by a greater degree of similarity between the respective goods and vice versa. I must keep in mind the distinctive character of the earlier mark, the average consumer for the goods and the nature of the purchasing process. I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between marks and must instead rely upon the imperfect picture of them that they have retained in their mind.

91. Confusion can be direct or indirect. In *L.A. Sugar Limited v By Back Beat Inc*, BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, explained that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: ‘The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark’.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

- (a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This

may apply even where the other elements of the later mark are quite distinctive in their own right ('26 RED TESCO' would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as 'LITE', 'EXPRESS', 'WORLDWIDE', 'MINI' etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension ('FAT FACE' to 'BRAT FACE' for example)."

92. While the above examples in L.A. Sugar are noted, they are not intended to be treated as an exhaustive list of the only instances whereby indirect confusion occurs.

93. However, in *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ approved Mr Purvis's formulation but added:

"13. As James Mellor QC sitting as the Appointed Person pointed out in *Cheeky Italian Ltd v Sutaria* (O/219/16) at [16] 'a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion'. Mr Mellor went on to say that, if there is no likelihood of direct confusion, 'one needs a reasonably special set of circumstances for a finding of a likelihood of indirect confusion'. I would prefer to say that there must be a proper basis for concluding that there is a likelihood of indirect confusion given that there is no likelihood of direct confusion."

94. It is not sufficient that a mark merely calls to mind another mark: *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17. This is mere association not indirect confusion.

95. Earlier in this decision I found that:

- The IR and the opponent's earlier marks are visually similar to a low and very low degree respectively. They are also aurally and conceptually similar to a medium to high and medium degree respectively.
- The goods at issue range from identical to similar to a low degree.
- The average consumer will select the goods mainly visually, with a medium degree of attention, although aural considerations cannot be discounted.
- The earlier marks are inherently distinctive to a low degree. The evidence filed by the opponent is sufficient to establish that the distinctiveness of the earlier marks has been enhanced to a medium degree as a result of the use the opponent has made of them.

96. Before I proceed any further, I need to deal with the opponent's argument about the existence of a family of marks. In *Il Ponte Finanziaria SpA v OHIM*, Case C-234/06, the CJEU stated that:

"62. While it is true that, in the case of opposition to an application for registration of a Community trade mark based on the existence of only one earlier trade mark that is not yet subject to an obligation of use, the assessment of the likelihood of confusion is to be carried by comparing the two marks as they were registered, the same does not apply where the opposition is based on the existence of several trade marks possessing common characteristics which make it possible for them to be regarded as part of a 'family' or 'series' of marks.

63 The risk that the public might believe that the goods or services in question come from the same undertaking or, as the case may be, from economically-linked undertakings, constitutes a likelihood of confusion within the meaning of Article 8(1)(b) of Regulation No 40/94 (see *Alcon v OHIM*, paragraph 55, and, to that effect, *Canon*, paragraph 29). Where there is a 'family' or 'series' of trade marks, the likelihood of confusion results more specifically from the possibility

that the consumer may be mistaken as to the provenance or origin of goods or services covered by the trade mark applied for or considers erroneously that that trade mark is part of that family or series of marks.

64 As the Advocate General stated at paragraph 101 of her Opinion, no consumer can be expected, in the absence of use of a sufficient number of trade marks capable of constituting a family or a series, to detect a common element in such a family or series and/or to associate with that family or series another trade mark containing the same common element. Accordingly, in order for there to be a likelihood that the public may be mistaken as to whether the trade mark applied for belongs to a 'family' or 'series', the earlier trade marks which are part of that 'family' or 'series' must be present on the market.

65 Thus, contrary to what the appellant maintains, the Court of First Instance did not require proof of use as such of the earlier trade marks but only of use of a sufficient number of them as to be capable of constituting a family or series of trade marks and therefore of demonstrating that such a family or series exists for the purposes of the assessment of the likelihood of confusion.

66 It follows that, having found that there was no such use, the Court of First Instance was properly able to conclude that the Board of Appeal was entitled to disregard the arguments by which the appellant claimed the protection that could be due to 'marks in a series'."

97. The only use shown in evidence relates to the slogan mark 'IF ¾ OF YOUR DRINK IS THE MIXER, MIX WITH THE BEST'. Whilst there is also evidence of use of the other slogan mark 'MIX WITH THE BEST', that is not use of a different mark, but rather use of a shorter version of the same mark. But even if was, this would be just use of two marks, and two marks do not make a family. Hence, the evidence fails to establish the existence of a sufficient number of marks as to be capable of constituting a family or series. Accordingly, I reject the opponent's argument, and I will say no more about it.

98. Given the fact that visual considerations dominate the selection process, I am of the view that the visual differences between the marks are sufficient to avoid them being mistaken for one another. There is no likelihood of direct confusion.

99. However, I agree with the opponent that, on balance, the phrases 'MIX WITH THE BEST' in the opponent's marks and 'MIX THE BEST' in the IR are sufficiently close visually, aurally and conceptually to be directly confused in the perception and recollection of consumers exposed to both marks. But where does it lead us on the likelihood of confusion? I think there are two points which must be considered carefully in this case; they are as follows.

100. First, is the brand name 'FEVER-TREE' so closely associated with the slogan marks relied upon by the opponent in these proceedings that its absence in the later mark means there cannot be confusion? I think that once it is accepted (as I do) that the slogan mark 'MIX WITH THE BEST' has acquired enhanced distinctiveness as a result of its use in conjunction with the brand name 'FEVER-TREE', that distinctiveness also acquires an independent dimension, in the sense that (a) the slogan is capable of functioning as a badge of origin and (b) there is no rule which would prevent the user of a slogan mark to use it without the house mark. Nonetheless, the absence of the house mark which is closely associated with the slogan mark is a factor which must be born in mind as it makes confusion less likely. In this connection, the opponent is aware of the relevance of the mark 'FEVER-TREE', although it seems to overlook the fact that it is absent in the later mark. It states:

“Furthermore, as was displayed within the evidence submitted by the Opponent, the mark ‘MIX WITH THE BEST’ is utilised as a strapline alongside the Opponent’s house brand ‘FEVER-TREE’. It is with this context in mind that the manner of use of the element ‘MIX THE BEST’ within the Opposed Mark creates an arguably higher likelihood of confusion, as it too is presented as a strapline underneath the former element ‘MIX ME UP’”

101. The second point is that the later mark does not consist merely of the phrase 'MIX THE BEST' which is likely to be confused with the opponent's slogan mark 'MIX WITH THE BEST'. As it will be recalled, I found that 'MIX THE BEST' has less weight

in the overall impression of the IR because of its smaller size. Still, smaller size does not equate to that element being invisible. Nonetheless, I think that the absence of the main brand 'FEVER-TREE' combined with a different overall impression created by the non-coinciding and dominant elements of the IR, it is unlikely to result in the consumers believing that the IR has some connection with the opponent, even if the element 'MIX THE BEST' is directly confused with the opponent's slogan mark 'MIX WITH THE BEST'. In this connection, whilst the latter might have become more distinctive than it inherently is, it is laudatory and it is not so strikingly distinctive that consumers will believe that no-one else, but the brand owner, would be using it. More likely than not, consumers will believe that the same (or a similar) tagline is used by another undertaking.

102. There is no likelihood of confusion. The opposition under Section 5(2)(b) fails.

Section 5(4)(a)

103. Section 5(4)(a) of the Act states 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, where the condition in subsection (4A) is met,

aa)...

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".

104. Subsection (4A) of section 5 of the Act states:

“(4A) The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of application for registration of the trade mark or date of the priority claimed for that application.”

105. In *Discount Outlet v Feel Good UK*, [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

“55. The elements necessary to reach a finding of passing off are the ‘classical trinity’ of that tort as described by Lord Oliver in the *Jif Lemon* case (*Reckitt & Colman Product v Borden* [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56. In relation to deception, the court must assess whether “*a substantial number*” of the Claimants’ customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21).”

106. Halsbury’s Laws of England Vol. 97A (2021 reissue) provides further guidance with regard to establishing the likelihood of deception. In paragraph 636 it is noted (with footnotes omitted) that:

“Establishing a likelihood of deception generally requires the presence of two factual elements:

- (1) that a name, mark or other distinctive indicium used by the claimant has acquired a reputation¹ 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 indicium which is the same or sufficiently similar

that the defendant's goods or business are from the same source² or are connected.

While it is helpful to think of these two factual elements as two successive hurdles which the claimant must surmount, consideration of these two aspects cannot be completely separated from each other.

The question whether deception is likely is one for the court, which 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 claimant and the defendant carry on business;
- (c) the similarity of the mark, name etc used by the defendant to that of the claimant;
- (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 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.”

Relevant Date

107. In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O/410/11, Mr Daniel Alexander Q.C., as the Appointed Person, endorsed the

registrar's assessment of the relevant date for the purposes of Section 5(4)(a) of the Act, as follows:

"43. In *SWORDERS TM* O-212-06 Mr Alan James acting for the Registrar well summarised the position in s.5(4)(a) proceedings as follows:

'Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made.'

108. There is no evidence filed to show any earlier use of the IR and, as such, the relevant date for the purposes of the opponent's claim under the Section 5(4)(a) ground is the designation date of the IR, being 06 October 2023.

Goodwill

109. The first hurdle for the opponent is to show that it had the necessary goodwill in its signs at the relevant date and that the signs relied upon were distinctive of or associated with that goodwill.

110. Goodwill was described in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (HOL), in the following terms:

"What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start."

111. Under this ground, the opponent relies upon the signs 'MIX WITH THE BEST' and 'IF 3/4 OF YOUR DRINK IS THE MIXER, MIX WITH THE BEST' which are identical to their earlier marks. Although the opponent initially claimed use in relation to a broad range of goods and services these were subsequently narrowed down in the opponent's submissions in lieu to the following: (a) Non-alcoholic beverages; soft drinks; fruit drinks and juices; tonic waters; (b) Household or kitchen utensils and containers; tableware; glassware; glasses, drinking vessels and barware; gin glasses; cocktail glasses; and (c) services for the provision of food and drink; bar services; mobile bar services; provision of information, consultancy and advice relating to the aforesaid. However, as it will be recalled, the only use which I found the opponent has made is in relation to *non-alcoholic beverages namely mixers*. That conclusion also applies to the opponent's goodwill under this ground.

112. In *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation* [2016] EWCA Civ 41, Kitchin LJ considered the role of the average consumer in the assessment of a likelihood of confusion. Kitchen L.J. concluded:

“... if, having regard to the perceptions and expectations of the average consumer, the court concludes that a significant proportion of the relevant public is likely to be confused such as to warrant the intervention of the court then it may properly find infringement.”

113. Although this was an infringement case, the principles apply equally under Section 5(2): see *Soulcycle Inc v Matalan Ltd*, [2017] EWHC 496 (Ch). In *Marks and Spencer PLC v Interflora*, [2012] EWCA (Civ) 1501, Lewison L.J. had previously cast doubt on whether the test for misrepresentation for passing off purposes came to the same thing as the test for a likelihood of confusion under trade mark law. He pointed out that it is sufficient for passing off purposes that “*a substantial number*” of the relevant public are deceived, which might not mean that the average consumer is confused. However, in the light of the Court of Appeal's later judgment in *Comic Enterprises*, it seems doubtful whether the difference between the legal tests will (all other factors being equal) produce different outcomes. This is because they are both normative tests intended to exclude the particularly careless or careful, rather than quantitative assessments. In this case, the signs and the goods in relation to which

goodwill subsist are the same as those I have considered under Section 5(2)(b). Accordingly, the opposition based on Section 5(4)(a) also fails.

Section 5(3)

114. Section 5(3) states:

“(3) A trade mark which-

is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom 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”.

115. In *General Motors*, Case C-375/97, the CJEU held that:

“25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.

28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation ‘in the Member State’. In the absence of any definition of the Community provision in this respect, a trade mark cannot

be required to have a reputation 'throughout' the territory of the Member State. It is sufficient for it to exist in a substantial part of it."

116. Earlier in this decision I have found that it is likely that the distinctiveness of the opponent's earlier marks have been materially increased to a medium degree in relation to the opponent's *mixers*. I also find that the opponent's earlier marks enjoy a moderate reputation in relation to the same goods.

Link

117. As I noted above, my assessment of whether the public will make the required mental 'link' between the marks must take account of all relevant factors. The factors identified in *Intel* are:

- The degree of similarity between the conflicting marks. The IR and the earlier marks are similar to a low and very low degree respectively. They are also aurally and conceptually similar to a medium to high and medium degree respectively. However, the coinciding element 'MIX THE BEST' in the IR is highly similar to the opponent's slogan mark 'MIX WITH THE BEST'. Whilst 'MIX THE BEST' in the IR is presented in a smaller in size, it is not invisible and will not be overlooked by the average consumer.
- The nature of the goods or services for which the conflicting marks are registered, or proposed to be registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public. Some of the contested goods consists of beverages or products which can be drunk and are for human consumption. I found these goods to be identical or similar to various degree. Other goods consist of foodstuff, medicated products and/or cleaning products which I found to be dissimilar. The relevant public is a member of the general public paying a medium degree of attention.

- The strength of the earlier marks' reputation. The earlier marks' reputation is moderate.
- The degree of the earlier marks' distinctive character, whether inherent or acquired through use. The earlier marks are inherently distinctive to a low degree, and their distinctiveness has been enhanced to a medium degree in relation to *non-alcoholic beverages namely mixers*.
- Whether there is a likelihood of confusion. I have found that there is no likelihood of confusion, even in relation to the goods which I found to be identical or similar.

Conclusions on Link

118. Bearing in mind all of the above, I find that a link will be made between the marks particularly given the high degree of similarity between the elements 'MIX THE BEST' and 'MIX WITH THE BEST' in the respective marks, the opponent's reputation and the closeness of the goods which I found to be identical or similar to the core products in relation to which the opponent enjoys a reputation. In addition, I bear in mind that (a) both the verbal elements 'MIX THE BEST' and 'MIX WITH THE BEST' in the respective marks will be perceived as slogans or taglines and (b) whilst the figurative element of the IR creates a visual different overall impression, it nonetheless reinforces the link with the opponent's earlier marks, because it evokes the concept of a glass containing a fizzy drink - this will undoubtedly reinforce the bringing to mind of the opponent's earlier marks which have been used on *mixers* because mixers are carbonated drinks used to make cocktails. Accordingly, I find that a link will inevitably be made in the mind of the consumer for goods which I found to be identical or similar to the opponent's *mixers*. However, the reputation is not sufficient to bridge the gap between dissimilar goods.

Damage

119. I must now consider whether any type of damage pleaded will arise.

Unfair Advantage

120. In *Jack Wills Limited v House of Fraser (Stores) Limited* [2014] EWHC 110 (Ch) Arnold J. (as he then was) considered the earlier case law and concluded that:

“80. The arguments in the present case give rise to two questions with regard to taking unfair advantage. The first concerns the relevance of the defendant's intention. It is clear both from the wording of Article 5(2) of the Directive and Article 9(1)(c) of the Regulation and from the case law of the Court of Justice interpreting these provisions that this aspect of the legislation is directed at a particular form of unfair competition. It is also clear from the case law both of the Court of Justice and of the Court of Appeal that the defendant's conduct is most likely to be regarded as unfair where he intends to benefit from the reputation and goodwill of the trade mark. In my judgment, however, there is nothing in the case law to preclude the court from concluding in an appropriate case that the use of a sign the objective effect of which is to enable the defendant to benefit from the reputation and goodwill of the trade mark amounts to unfair advantage even if it is not proved that the defendant subjectively intended to exploit that reputation and goodwill.”

121. In its Form TM7, the opponent states:

“By using the mark applied for, the Applicant will achieve instant recognition on the market and will take advantage of the Opponent's established reputation in the furtherance of its own business. Use by the Applicant in respect of the goods for which protection is sought will therefore freeride on the back of the Opponent's good name, utilising the advantage gained through its commercial and promotional investment in the Earlier Marks, without investing the same itself. The Applicant will therefore derive an unfair commercial advantage. This will be the case even where the goods covered under the Application are deemed to be dissimilar to the goods covered by the Earlier Registrations, by virtue of the scope of the Opponent's reputation and the rights afforded under Section 5(3) TMA.”

122. There is evidence that the opponent has invested significantly in promotional activities. Although the size of the investment is not quantified, the evidence indicates that the earlier marks have become famous slogans associated with the opponent. It is, therefore, clear that there is a likelihood that the holder will gain an unfair advantage from the use of its IR as a result of benefitting from the investment made by the opponent in promoting the earlier marks. The strength of the earlier marks' reputation (which, to a degree, benefits from the wider reputation of the house mark to which they are associated) is such that there will be an unfair advantage, through, for example, an image transfer between the image of the earlier marks as a premium drink company, and the holder's drinkable goods which I found to be identical or similar to the opponent's goods. Even if I were wrong and link will be made in relation to dissimilar goods, it would be so fleeting not to cause any damage.

123. As I have found unfair advantage, I do not need to consider the other pleaded heads of damage.

CONCLUSIONS

124. The opposition based upon Section 5(3) of the Act partially succeeds in relation to the goods listed at paragraph 69 which will be refused registration.

125. But fails in relation to the goods listed at paragraph 68 which will proceed to registration.

COSTS

126. As both parties have achieved a measure of success, I order that each party bear the own costs.

Dated this 13th day of March 2026

TERESA PINTO
For the Registrar