

O-068-19

**TRADE MARKS ACT 1994
IN THE MATTER OF APPLICATION No. 3253295
BY TINY REBEL BREWING COMPANY LIMITED
TO REGISTER THE TRADE MARK**



IN CLASS 32

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER No. 411025 BY
TROPICANA PRODUCTS INC.**

BACKGROUND

1) On 29 August 2017, Tiny Rebel Brewing Company Ltd (hereinafter the applicant) applied to register the trade mark shown on the front page in respect of the following goods in Class 32: Beers; shandy, de-alcoholised drinks, non-alcoholic beers.

2) The application was examined and accepted, and subsequently published for opposition purposes on 15 September 2017 in Trade Marks Journal No.2017/037.

3) On 13 December 2017 Tropicana Products Inc. (hereinafter the opponent) filed a notice of opposition. The opponent is the proprietor of the following trade marks:

Mark	Number	Dates of filing & registration	Class	Specification relied upon
TROPICANA	EU 1184746	25.05.99 17.12.02	32	Non-alcoholic beverages, namely fruit drinks, fruit juices and fruit based-beverages.
	EU 5678818	09.02.07 29.01.08	32	Fruit juices and fruit juice drinks.
TROPICANA	EU 12828901	29.04.14 23.09.14	32	Non-alcoholic drinks, namely, fruit drinks, fruit juices and fruit-based drinks; fruit drinks and fruit juices; syrups and other preparations based on fruit for making beverages; fruit smoothies.
TROPICANA	UK 890438	09.02.66 09.02.66	32	Non-alcoholic drinks and preparations for making such drinks, all included in Class 32.

- a) The opponent contends that its marks and the mark applied for are very similar and that the goods applied for are identical and/or similar to the goods for which the earlier marks are registered. As such the mark in suit offends against Section 5(2)(b) of the Act.
- b) The opponent relies upon its UK mark 890438 and claims that use of the mark in suit would take unfair advantage of its mark as the word TROPICANA is dominant in the mark in suit and use of it would ride upon the coat tails of the opponent. Use of the mark in suit would also dilute the distinctiveness of its mark. As such the mark in suit offends against section 5(3) of the Act.

c) The opponent has used the mark TROPICANA in the UK since 1966 in respect of fruit juices and fruit juice based beverages. It claims it has acquired goodwill and reputation in the mark, such that use of the mark in suit would cause deception and misrepresentation to the public and would offend against section 5(4)(a) of the Act.

4) On 20 February 2018 the applicant filed a counterstatement basically denying all the grounds of opposition. It puts the opponent to strict proof of use of its marks.

5) Both parties filed evidence, and both also seek an award of costs in their favour. Neither side wished to be heard. Both parties provided written submissions which I shall refer to as and when necessary in my decision.

OPPONENT'S EVIDENCE

6) The opponent filed a witness statement, dated 17 May 2018, by Janet Silverberg, the Assistant Secretary of the opponent, a position she has held since January 2008. She states that her company began selling fruit juice products in the USA in 1947, before starting to sell in other countries such as France (starting in 1965), UK (1991), Belgium (1998) and the Netherlands (2001). She states that the opponent's products are widely available in the UK selling through supermarkets such as Tesco, Sainsbury, Asda, Morrisons, Waitrose and Co-op as well as outlets such as Costa, McDonalds and Subway. The products are also available through independent retailers, cafes, restaurants as well as small chains of supermarkets (Nisa, Costcutter) and online (Amazon, Ocado). She provides the following sales figures for TROPICANA products in various countries which are shown in US\$ millions.

Year	2012	2013	2014	2015	2016
UK	460	470	545	490	440
Belgium	17	40	43	26	23
France	460	490	480	420	420
Germany	1	16	13	9	8
Italy	4	4	7	7	7
Spain	19	16	16	14	13

7) She also provides the following figures for advertising and promotion of TROPICANA products, the figures are again in US\$millions:

Year	2012	2013	2014	2015	2016
UK	20	15	10	10	10
Benelux	n/a	n/a	n/a	0.5	1
France	15	15	15	15	15

8) She states that the opponent enjoyed a 18.4% share of the UK market share of the fruit juice sector in 2017/2018. In Benelux and France in 2017 the figures were 26% and 16.6 % respectively. She provides the following exhibits:

- TP3: a representative sample of invoices covering the period 15 September 2012 – 14 September 2017. They show codes for Tropicana fruit based drink products sold in the UK and EU.
- TP4: A representative sample of advertisements from the UK dated within the relevant period 15 September 2012 – 14 September 2017. They show Tropicana fruit based drink products being advertised for sale in the UK.
- TP5: Evidence of the reputation in Tropicana through websites in the UK and worldwide and also on Youtube, Facebook and Twitter.
- TP6: Examples of various press articles from the relevant period throughout the EU including the UK. They mention TROPICANA fruit based drink products.
- TP8: A witness statement, dated 26 April 2018, by Mr Gavin Partington the Director General of the British Soft Drinks Association a position he has held since October 2012. He states that the mark TROPICANA has been used in respect of fruit juice and fruit juice beverages in the UK since 1991 and that the mark is very distinctive and unlike any marks used by others in the soft drinks industry.
- TP9: A copy of a search of the Mintel Global New Product Database for all products containing the word TROPICANA in the EU during the period 2012-2017. Mintel is said to be the world's

leading independent market intelligence agency. The report shows 437 of the opponent’s products offered throughout the UK. There are no products from other manufacturers.

- TP11: A witness statement, dated 18 May 2018 by Wendy Oliver-Grey a Trade Mark Attorney with D Young & co LLP. She discusses the issue of brand extension into different products. Ms Oliver-Grey also notes the increase in fruit flavoured beers and backs this up with evidence in her exhibits. She also shows evidence of well-known spirit manufacturers offering ready-mixed spirit and mixer drinks. She instances, inter alia, the following extensions of brands:

Brand	Original product	New product/service
Bertolli	Olive oil	Margarine and pasta sauces
Fairy	Washing up liquid	Soap powder
BMW	Cars	Driving holidays
Boots	Pharmacy stores	Fitness equipment
Yamaha	Motorbikes	Musical instruments
Gillette	Razors	Sports wear
Caterpillar	Heavy duty construction vehicles and machinery	Clothing/footwear/fashion label
Courvoisier	Cognac	Clothing/fashion label
Armani	Fashion label	Hotels
Marlboro	Cigarettes	Clothing/fashion label
Marks and Spencer	Food and clothing	Financial services

APPLICANT’S EVIDENCE

9) The applicant filed a witness statement, dated 28 August 2018, by Bradley Cummings the Managing Director of the applicant. He states that he started the brewery in 2012 and has had considerable success brewing beers, which have won awards. He states that in late 2015 his company became aware that consumers tastes were changing to more fruity flavours. He states that the beer was to “transport people to summer” and so they formed a picture of a tropical beach party and this reminded them of the hit song by Wham called “Club Tropicana”. They changed the word “club” to the Welsh version “clwb”. He states that the labels his company uses are “graffiti style”, and

the beer called Clwb Tropicana was launched in February 2016 and is now a popular beer with the company's consumers. He provides the following figures for Clwb Tropicana:

Year	Turnover £	Marketing £
2016	70,000	15,000
2017	665,000	25,000
2018 to July 18	500,000	25,000

10) He claims that the beer is typically called Clwb/ club or club Tropicana and states that no-one has ever queried if it was connected to the opponent. He provides the following exhibits:

- BC3: Examples of other labels. Whilst most of these have the same "bear" character wearing a coat as the mark applied for they differ slightly as they do not have the words tiny rebel. They include names such as "chtch" (a Welsh word for cuddle), "dirty stop out" and "hadouken" (streetfighter). There is also a grenade image with the initials "F.U.B.A.R" which is an acronym for "f*cked up beyond all recognition".
- BC4: This shows images of the mark in suit on small 8oz coke/lemonade type cans.

OPPONENT'S EVIDENCE IN REPLY.

11) The opponent filed a witness statement, dated 11 October 2018, by Ms Silverberg who has previously provided evidence in this case. She states that the invoices included in her earlier statement at exhibit TP3 included some headed Walkers Snacks Ltd, and confirms that this is a subsidiary of the opponent. At exhibit TP12 she provides evidence to back up this claim. She includes copies of EUIPO decisions which give the view that beers and fruit juices are similar. She also points out that pubs and restaurants print the name soft drinks on offer in menus and so the likelihood of confusion is increased in her view. She reiterates that no-one else uses the mark TROPICANA in the UK.

12) That concludes my summary of the evidence filed, insofar as I consider it necessary.

DECISION

13) The first ground of opposition is under section 5(2)(b) which reads:

“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.”

14) An “earlier trade mark” is defined in section 6, the relevant part of which states:

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

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

15) The opponent is relying upon its trade marks listed in paragraph 3 above which are clearly earlier trade marks. Whilst a number would fall foul of the proof of use requirements there is a mark (EU 12828901) which provides the opponent with probably its strongest case without the need for me to consider proof of use, although given the evidence provided for the UK and the EU this would not have been an issue (and I note that the applicant makes no comment regarding proof of use suggesting that it accepts that the opponent easily passed the test).

16) When considering the issue under section 5(2)(b) I take into account the following principles which are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*,

Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

(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 be dominated by one or more of its components;

(f) however, it is also 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 great 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;

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

The average consumer and the nature of the purchasing decision

17) As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods. I must then determine the manner in which these goods are likely to be selected by the average consumer in the course of trade. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

18) The average consumer will be the general public (over the age of eighteen in respect of alcoholic drinks) including businesses All of the goods at issue may be sold through a range of channels, including retail premises such as supermarkets and off-licences (where the goods are normally displayed on shelves and are obtained by self-selection) and in public houses, restaurants etc (where the goods are displayed on, for example, shelves behind the bar and where the trade marks will appear on dispensers at the bar, within menus etc.). When the goods are sold in, for example, public houses the ordering/selection process is likely to be an oral one. However, there is nothing to suggest that the goods are sold in such a manner as to preclude a visual inspection. In *Simonds Farsons Cisk*

plc v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), Case T-3/04, the Court of First Instance (now the General Court) said:

“In that respect, as OHIM quite rightly observes, it must be noted that, even if bars and restaurants are not negligible distribution channels for the applicant’s goods, the bottles are generally displayed on shelves behind the counter in such a way that consumers are also able to inspect them visually. That is why, even if it is possible that the goods in question may also be sold by ordering them orally, that method cannot be regarded as their usual marketing channel. In addition, even though consumers can order a beverage without having examined those shelves in advance they are, in any event, in a position to make a visual inspection of the bottle which is served to them.”

19) Consequently, while the goods may be ordered orally in public houses, it is likely to be in the context of, for example, a visual inspection of the bottles containing the goods prior to the order being placed. Considered overall, the selection process is likely to be predominantly a visual one, although I accept that aural considerations will also play their part. Turning now to the level of attention the average consumer will play when selecting the goods, given that for the most part the cost of the goods is likely to be relatively low, but bearing in mind that the average consumer will wish to ensure they are selecting the correct type, flavour, strength etc. of beverage, they are, in my view, **likely to pay at least an average degree of attention to the selection of the goods at issue.**

Comparison of goods

20) 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”.

21) 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”.

22) The goods and services to be compared are as follows:

Applicant’s specification	Opponent’s specification
Class 32: Beers; shandy, de-alcoholised drinks, non-alcoholic beers.	Class 32: Non-alcoholic drinks, namely, fruit drinks, fruit juices and fruit-based drinks; fruit drinks and fruit juices; syrups and other preparations based on fruit for making beverages; fruit smoothies.

23) The applicant referred me to decision O-119/07 *Beverage Brands (UK) Ltd v. Pomwonderful LLC* where the Hearing Officer stated:

“31) Consequently, non-alcoholic drinks, soft drink mixers; fruit drinks and fruit juices; syrups and other preparations for making beverages must be considered to be identical to fruit juices and fruit juice concentrates.

32) All the remaining goods are beverages and so have this in common with fruit juices. All of the class 33 goods and the beer related class 32 goods are alcoholic and so this differentiates them from fruit juices. In my experience fruit juices will generally be in a different area of shops to the remaining class 32 and the class 33 goods of the registration. In the case of mineral and aerated waters they may be found in the same cold cabinet, when these beverages are being sold for take-away snack purposes. All of the goods could be used for slaking the thirst, obviously. The class 33 goods of the registration could all include fruit juices, could indeed be simply fruit juices “with a kick”. In the broadest sense the respective goods could be substituted for each other, as options in slaking the thirst. However, I don’t consider that there is any real equivalence between the various alcoholic beverages of the registration and fruit juices. A packet of crisps and a banana both give an option to satisfying hunger, or supplying a snack, but I don’t think they are really alternatives in competition with one another, they are just alternatives. I would not see a pint of beer or an alcoholic cocktail as being in competition with

each other or with fruit juices. There is no evidence to this effect. There is none of the sort of evidence of competitiveness that the ECJ judged was required in *De Landtsheer Emmanuel SA v Comité Interprofessionnel du Vin de Champagne, Veuve Clicquot Ponsardin SA* Case C-381/051. As with foodstuffs, it is very difficult to analyse similarities between beverages without creating a legal chimera, which can rely upon logic but not upon reality. There are degrees of similarity between *fruit juices* and the non-identical goods of the registration. The table below represents what I consider the relative similarity, the relativity is as between the goods of BB's registration and not to *fruit juices*:

Most	Lesser	Least
mineral and aerated waters	Alcoholic beverages; alcoholic beverages made from or containing spirits; alcoholic drinks with a spirit base; alcoholic coolers; alcoholic cocktails	beers and ales; drinks made from or containing beer or ale; malt beverages; drinks with a malt beer base; drinks with a brewed malt base

(I have listed the beer/malt beverages at the furthest end of the scale owing to their composition and taste; which is very far from *fruit juices*; even when taking into account those beers which are flavoured with fruit such as Belgian framboise beers.)”

24) Whilst I note the comments of the Hearing Officer I am not bound by them. Nonetheless I note that he believes that non-alcoholic drinks must be considered to be identical to fruit juices; a view which I fully endorse. Equally to my mind, de-alcoholised drinks would also be identical or at least highly similar to non-alcoholic drinks, namely, fruit drinks, fruit juices and fruit-based drinks. The applicant contends that de-alcoholised drinks and non-alcoholic beers are sold in the same manner as beers and should be regarded as dissimilar to the opponent's goods. Whilst I accept that in a supermarket non-alcoholic beers are unlikely to be alongside fruit juices and fruit based drinks, this does not mean that the goods are not similar. Both are intended to slake one's thirst, both will be sold in pubs, clubs and restaurants as being ideal for a designated driver and so to my mind they are in direct competition with each other. It is not unusual, in my experience, fruit based beverages to be sold in half pints and pints just as beer may be. Similar arguments can be made in relation to shandy and beer, other than these are not suitable for anyone considering driving. **In conclusion, in my opinion, “de-alcoholised drinks and non-alcoholic beers” are identical to the opponent's goods, whilst “Beers and shandy” are similar to the opponent's goods to a medium degree.**

Comparison of trade marks

25) 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 them, 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.”

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

Opponent's trade mark	Applicant's trade mark
TROPICANA	

27) The applicant's submissions are:

“The Applicant submits that their trade mark is not likely to cause confusion with the Opponent's marks. The dominant element of the Applicant's mark is not "TROPICANA". There are other

distinctive elements within the composite mark that carry the same/more weight in the imperfect recollection of the average consumer, including, but not limited to:

"CLWB" (importantly at the beginning of the mark), the addition of the house brand "Tiny Rebel", the "bear" logo and the overall impression of the Applicant's mark.

5. The word "TROPICANA" is of low inherent distinctiveness and is defined as "Things associated with or characteristic of tropical regions; objects from the tropics". Therefore, any significant differences to a mark of low inherent distinctiveness will be sufficient to avoid confusion within the marketplace.

6. The Applicant intends to provide proof, through evidence, that the use of their mark has acquired enhanced distinctive character by virtue of its extensive use and recognition, having been in use since February 2016. The Applicant submits that their trade mark is not likely to cause confusion with the Opponent's marks. The dominant element of the Applicant's mark is not "TROPICANA".

And:

“8. The Applicant's mark is a member of a larger family of marks that have adopted a "urban/graffiti style". The "urban/graffiti house style" is well known as being that of the Applicant and details of other marks registered and in use by the Applicant using this style will be provided in support of the application. The relevant public are familiar with this house style because of its wide range of use in relation to registered marks for relevant goods and services in the Applicant's ownership. This reinforces the distinctiveness of the Applicant's mark and therefore decreases the likelihood of confusion with the Opponent's marks.

9. Conceptually, the marks are not similar, with "CLWB" being the Welsh word for "club", that gives reference to the Applicant's Welsh roots and the phrase "Clwb Tropicana" being a reference made to the well-known #4 UK hit single "Club Tropicana" released by the band Wham! in July 1983. This context gives the concept of parties and nightlife, that is resonant of the goods for which the Applicant uses the mark, (beers).

10. This is markedly different to the concept of the Opponent's trade marks, which is much more literal in terms of evoking the concept of the origin of the ingredients within their fruit juices.

11. The fact that the distinctive element "CLWB" is at the beginning of the mark is significant, given that it is the element that the relevant public refers to when purchasing the goods bearing the mark. Also, the Opponent rarely uses a distinctive prefix before "TROPICANA", thus removing the potential for indirect confusion."

28) I do not agree that the word TROPICANA is of low distinctiveness, or that it has a true definition. The word does not appear in the Collins English dictionary and an online search also failed to find a dictionary reference. The applicant has not shown that its mark has been used extensively, it has not shown a UK market share for its goods under the mark in suit and the sales figures suggest that it is a relatively minor brand in a very large market. I also dismiss the idea that it is somehow part of a family of marks. The only similarity between the branding evidenced at exhibit BC3 is the figure of a bear in a coat and a "graffiti style". There is only evidence of use of one of these other marks, but again no market share. The applicant's mark is very "busy", with a blue and white "splash" background with gold lines across the top of the pink diamond, and a device of a pink cocktail glass tipping its contents. At the bottom is an image of a bear wearing a coat with a cross for its left eye and a form of patch for its right eye, in the style of an unloved teddy bear that has seen better days. At the top of the mark in small type in yellow are the words "Tiny Rebel", then underneath and in slightly larger font and in pink is the word "CLWB", then in much larger font is the word TROPICANA in yellow across the middle of the mark. Further down, in quite small print is the figure "5.5%" in yellow and the words "Tropical IPA" in gold in a font size similar to the words "Tiny Rebel".

29) In my opinion, it is not clear how a consumer will view the word "CLWB", i.e whether it will believe it is attached to the words "Tiny Rebel"- as in "Tiny Rebel CLWB"- or whether they will view each word separately. The "5.5%" will be seen for what it is, an indication of alcoholic strength, whilst the words "Tropical IPA" are descriptive of the product as IPA is a common abbreviation for India Pale Ale. It appears to me that there are several independent elements in the mark and the word TROPICANA is one of them. Given its size as the largest font, and its position across the middle of the mark, it is, to my mind, independent and distinctive of the other elements. Even if I were to accept that the average consumer would view the word "CLWB" as being its prefix, this simply means that the mark would be viewed as CLWB TROPICANA or TROPICANA CLUB if the Welsh word is recognised for what it is and the individual is aware that the Welsh language tends to alter the order of words so that "The Red House" becomes "Ty Coch" where "ty" is "house" and "coch" is "red". Whichever way it is seen the word TROPICANA is the dominant element. The applicant also contends that the mark will bring to mind a song from thirty five years ago, but I fail to see why the instant mark used on the goods in the application will bring about such an association, and the applicant has provided no evidence to show

that the average consumer would view it as they contend. There are obvious visual, aural and conceptual similarities and differences. Taken overall, **in my opinion, the marks have a low to medium degree of similarity.**

Distinctive character of the earlier trade mark

30) 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).”

31) The opponent's mark has no meaning for the goods for which it is registered. As I stated earlier in this decision, the word is not a dictionary term, although it does suggest the tropics. The average consumer will consider the opponent's mark to be an invented word and so it is **inherently distinctive to at least a medium degree**. The opponent has shown considerable use of its mark in the UK where it enjoys a considerable market share in the fruit juice market, and **so can benefit from enhanced distinctiveness**.

Likelihood of confusion

32) In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the opponent's trade mark as the more distinctive the trade mark is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind. Earlier in this decision, I concluded that:

- the average consumer for the goods is a member of the general public including businesses who will select the goods by predominantly visual means, although I do not discount aural considerations and that they are likely to pay an average degree of attention to the selection of said goods.
- the marks of the two parties have a low to medium degree of similarity.
- the opponent's mark has a medium level of inherent distinctiveness and can benefit from an enhanced distinctiveness through use.
- the goods of the two parties fall into two categories. The applicant's following goods are identical or highly similar to those of the opponent: "de-alcoholised drinks and non-alcoholic beers"; whilst the following goods are similar to the opponent's goods to a medium degree: "Beers and shandy".

33) The applicant contends that there has been no confusion brought to their attention since they began selling their wares under the mark in suit. In *The European Limited v The Economist Newspaper Ltd* [1998] FSR 283 Millett L.J. stated that:

"Absence of evidence of actual confusion is rarely significant, especially in a trade mark case where it may be due to differences extraneous to the plaintiff's registered trade mark."

34) In view of all of the above, and allowing for the concept of imperfect recollection there is a likelihood of consumers being confused into believing that the all the goods applied for and provided by the applicant are those of the opponent or provided by an undertaking linked to it. **The opposition under Section 5(2) (b) therefore succeeds in respect of all the goods applied for by the applicant.**

35) I next turn to the ground of opposition under section 5(4)(a) which reads:

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

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

(b) [.....]

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

36) 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).”

37) Halsbury's Laws of England Vol. 97A (2012 reissue) provides further guidance with regard to establishing the likelihood of deception. In paragraph 309 it is noted (with footnotes omitted) that:

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

(1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and

(2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other feature which is the same or sufficiently similar that the defendant's goods or business are from the same source or are connected.

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

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

(a) the nature and extent of the reputation relied upon;

(b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;

(c) the similarity of the mark, name etc. used by the defendant to that of the plaintiff;

(d) the manner in which the defendant makes use of the name, mark etc. complained of and collateral factors; and

(e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances."

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

38) In *SWORDERS TM* O-212-06 Mr Alan James acting for the Registrar considered the relevant date for the purposes of s.5(4)(a) of the Act and concluded 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.”

39) The relevant date in the instant case must therefore be 29 August 2016, although I am conscious that the applicant states that it began sales under the mark in suit in February 2016. The opponent has shown that it has been highly active in the UK for many years and that even at the earlier date it enjoyed considerable goodwill in its fruit based beverage business.

40) The question of goodwill was defined in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (HOL):

“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.”

41) In *South Cone Incorporated v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* [2002] RPC 19 (HC), Pumfrey J. stated:

“27. There is one major problem in assessing a passing of claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the registrar is

entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under s.11 of the 1938 Act (see *Smith Hayden & Co. Ltd's Application (OVAX) (1946) 63 R.P.C. 97* as qualified by *BALI Trade Mark [1969] R.P.C. 472*). Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.

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

42) However, in *Minimax GmbH & Co KG v Chubb Fire Limited* [2008] EWHC 1960 (Pat) Floyd J. (as he then was) stated that:

“[The above] observations are obviously intended as helpful guidelines as to the way in which a person relying on section 5(4)(a) can raise a case to be answered of passing off. I do not understand Pumfrey J to be laying down any absolute requirements as to the nature of evidence which needs to be filed in every case. The essential is that the evidence should show, at least prima facie, that the opponent's reputation extends to the goods comprised in the application in the applicant's specification of goods. It must also do so as of the relevant date, which is, at least in the first instance, the date of application.”

43) The opponent has provided evidence that it enjoys considerable reputation in the fruit juice and fruit juice based beverages market with sales in the hundreds of millions of pounds and a market share of over 18% in the UK. To my mind, the opponent easily passes the first hurdle.

44) I must now consider the issue of misrepresentation. In *Neutrogena Corporation and Another v Golden Limited and Another* [1996] RPC 473, Morritt L.J. stated that:

“There is no dispute as to what the correct legal principle is. As stated by *Lord Oliver of Aylmerton in Reckitt & Colman Products Ltd. v. Borden Inc. [1990] R.P.C. 341 at page 407* the question on the issue of deception or confusion is

“is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the public will be misled into purchasing the defendants' [product] in the belief that it is the respondents'[product]”

The same proposition is stated in Halsbury's Laws of England 4th Edition Vol.48 para 148 . The necessity for a substantial number is brought out also in *Saville Perfumery Ltd. v. June Perfect Ltd. (1941) 58 R.P.C. 147 at page 175 ; and Re Smith Hayden's Application (1945) 63 R.P.C. 97 at page 101.*”

And later in the same judgment:

“... for my part, I think that references, in this context, to “more than *de minimis*” and “above a trivial level” are best avoided notwithstanding this court's reference to the former in *University of London v. American University of London* (unreported 12 November 1993) . It seems to me that such expressions are open to misinterpretation for they do not necessarily connote the opposite of substantial and their use may be thought to reverse the proper emphasis and concentrate on the quantitative to the exclusion of the qualitative aspect of confusion.”

45) Earlier in this decision I considered the issue of confusion. There is clearly a difference between the test for likelihood of confusion under trade mark law and the test for misrepresentation under the law of passing off. 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. Kitchin 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.”

46) Although this was an infringement case, the principles apply equally under 5(2): see *Soulcycle Inc v Matalan Ltd, [2017] EWHC 496 (Ch)*. In *Marks and Spencer PLC v Interflora, [2012] EWCA (Civ)*

1501, Lewinson 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.

47) When considering the issue of misrepresentation it is clear that it is the plaintiff’s customers or potential customers that must be deceived. In *Neutrogena Corporation and Another v Golden Limited and Another*, [1996] RPC 473, Morritt L.J. stated that:

“This is the proposition clearly expressed by the judge in the first passage from his judgment which I quoted earlier. There he explained that the test was whether a substantial number of the plaintiff’s customers or potential customers had been deceived for there to be a real effect on the plaintiff’s trade or goodwill.”

48) It is clear from my conclusions regarding both the marks and goods of the two parties that a substantial number of the opponent’s customers will be deceived into believing that the applicant’s goods are economically linked to the opponent.

49) I now turn to the issue of damage. In *Harrods Limited V Harrodian School Limited* [1996] RPC 697, Millett L.J. described the requirements for damage in passing off cases like this:

“In the classic case of passing off, where the defendant represents his goods or business as the goods or business of the plaintiff, there is an obvious risk of damage to the plaintiff’s business by substitution. Customers and potential customers will be lost to the plaintiff if they transfer their custom to the defendant in the belief that they are dealing with the plaintiff. But this is not the only kind of damage which may be caused to the plaintiff’s goodwill by the deception of the public. Where the parties are not in competition with each other, the plaintiff’s reputation and goodwill may be damaged without any corresponding gain to the defendant. In the *Lego* case, for example, a customer who was dissatisfied with the defendant’s plastic irrigation equipment might be dissuaded from buying one of the plaintiff’s plastic toy

construction kits for his children if he believed that it was made by the defendant. The danger in such a case is that the plaintiff loses control over his own reputation.

50) The opponent has filed evidence that it, and it alone uses the mark TROPICANA upon soft drinks. At exhibit TP8 it provided a witness statement from the British Soft Drinks Association. Whilst the applicant criticised this evidence as being only indicative of “the soft drinks” industry whilst it was producing, inter alia, beers, the applicant offered no evidence of any other use of the mark TROPICANA in goods which are in anyway similar to beverages. The applicant’s claim to peaceful co-existence is not supported by evidence showing that the brands have been sold from the same outlets or to the same customers.

51) In my view, the opponent has shown goodwill, misrepresentation and that it would suffer damage to its reputation, and also by dilution of its mark’s distinctiveness. **The ground of opposition under section 5(4)(a) succeeds in full.**

52) Given the above findings I decline to consider the ground of opposition under section 5(3).

CONCLUSION

53) The opposition succeeds in respect of all the goods sought to be registered, under sections 5(2)(b) and 5(4)(a).

COSTS

54) As the opponent has succeeded in it is entitled to a contribution towards its costs.

Preparing a statement and considering the other side’s statement	£300
Expenses	£200
Preparing evidence	£800
Providing submissions	£500
TOTAL	£1,800

55) I order Tiny Rebel Brewing Company Limited to pay Tropicana Products Inc. the sum of £1,800. This sum to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 31st day of January 2019

George W Salthouse

For the Registrar,

the Comptroller-General