

O-070-05

**TRADE MARKS ACT 1994  
IN THE MATTER OF APPLICATION NO. 2285637  
IN THE NAME OF NISA-TODAY-S (HOLDINGS) LIMITED  
TO REGISTER A TRADE MARK IN CLASS 29**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER NO. 90513 IN THE NAME OF  
HALEWOOD INTERNATIONAL LIMITED**

## **Trade Marks Act 1994**

**In the matter of application No. 2285637  
in the name of Nisa-Today-s (Holdings) Limited  
to register a trade mark in Class 29**

**And**

**In the matter of opposition thereto  
under No. 90513 in the name of  
Halewood International Limited**

### **Background**

1. On 15 November 2001, Nisa-Today-s (Holdings) Limited applied to register SHAKERS as a trade mark in Class 29 in respect of the following specifications of goods:

Milk beverages, milk shakes and flavoured milk drinks; none of the aforementioned goods containing alcohol.

2. On 30 April 2002, Halewood International Limited filed notice of opposition based on the following grounds:

**1. Under Section 5(2)(b)** because the opponents are the owners of earlier marks that are identical or similar to the mark of the application, and is sought to be registered in respect of similar goods to those of the opponents=earlier marks.

**2. Under Section 5(4)(a)** by virtue of the law of passing off.

3. Details of the earlier marks relied upon can be found as an annex to this decision.

4. The applicants filed a counterstatement in which they admit that the mark applied for is identical with or similar to the opponents=earlier marks, but not that there is any similarity in the respective goods. The applicants deny the grounds on which the opposition is based. Both sides ask that an award of costs be made in their favour.

5. Both sides filed evidence in these proceedings. The matter came to be heard on 2 November 2004, when the applicants were represented by Mr Martin Krause of Haseltine Lake, their trade mark attorneys. The opponents were represented by Mr Robert Onslow of Counsel, instructed by Urquhart Dykes & Lord, their trade mark attorneys.

## **Opponents= evidence**

6. This consists of a Witness Statement dated 6 August 2003, from Simon John Oldroyd, Commercial Director of Halewood International Limited, a position he has held since July 2000. Previously Mr Oldroyd held the position of Financial Director having been employed by his company since 1986.

7. Mr Oldroyd states that his company has sold products in the UK under the SHAKERS trade marks, mentioning in particular, SHAKERS SMOOVIE and SHAKERS SCHNAPPS. Mr Oldroyd says that exhibit SJO1 and SJO2 are summaries of the ranges of these products that are stated to have been on sale in the UK. The exhibits list quantities of the varieties of SHAKERS SMOOVIES and SCHNAPPS appearing to relate to sales, but as they give no indication of the dates it is not known whether this pre or post-dates the relevant date.

8. Mr Oldroyd next refers to exhibits SJO3 and SJO4, which he introduces as representations of the labels which are applied to products within the Halewood ranges of SHAKERS SMOOVIE and SHAKERS SCHNAPPS products. The exhibits consist of copies of labels from SHAKERS SMOOVIE and SHAKERS SCHNAPPS bottles. Exhibit SJO3 shows the word SHAKERS placed above the word SMOOVIE, but in smaller lettering. When applied to its bottle the mark would be seen on the front and side. Exhibit SJO4 also shows SHAKERS placed above the word SCHNAPPS, the word SHAKERS in this case being in larger lettering. There is no way of dating these labels.

9. Mr Oldroyd says that the opponents have supplied their SHAKERS products to the applicants for sale, saying that from this he considers there to be a strong likelihood of Halewood's products being offered for sale through the same retail outlets as the applicants' goods. He asserts that it is common for alcoholic beverages to contain dairy products, citing his company's SMOOVIE product, and a photograph of other products (exhibit SJO5) as examples, extrapolating from this that the respective goods are identical.

10. Mr Oldroyd states that companies in the alcoholic beverages industry are anxious to prevent confusion between alcoholic and non-alcoholic beverages, and have drawn up a code of practice, a copy of which is shown as exhibit SJO6. He says that he considers it desirable that the practice of the Registry reflect industry practices when addressing the issue of consumer confusion.

## **Applicants= evidence**

11. This consists of a Witness Statement dated 9 February 2004, from Martin Krause, a partner of Haseltine Lake, and the trade mark attorney responsible for the conduct of this case on behalf of the applicants.

12. Mr Krause addresses the use and meaning of the words SHAKE and SHAKER, dictionary definitions being shown as exhibits MK1 and MK2. He gives the results of his investigations into the retailing of alcoholic drinks as exhibits MK3, MK4 and MK5. The remainder of Mr Krause's Statement consists of submissions on the opponents' evidence and the merits of the case. Whilst I do not consider it to be necessary or appropriate to

summarise them here, I will take them fully into account in my determination of this case.

13. That concludes my review of the evidence insofar as it is relevant to these proceedings.

### **Decision**

14. Prior to the hearing on the substantive issues the opponents made a request for two new grounds to be entered into the proceedings. Mr Onslow put the basis for his request as follows:

This supplemental skeleton argument arises out of paragraph 11 of the Applicants' skeleton argument.

As a result of that paragraph, the Opponent applies to amend to add the objection under s.3(1)(c) of the Trade Marks Act 1994, since it is believed that the Applicant has not relied on use of the SHAKERS mark to support the application.

Further, the paragraph argues that, if the goods are similar, a mark formerly referring to cocktail shakers will be taken as referring to milk shakes. If this is right, then the decisions of *Davidoff v Gofkid* and *Adidas v Fitnessworld* are on point, and the Applicant applies to amend to add an objection under s.5(3) of the Act.

15. Paragraph 11 of the Applicants' skeleton reads as follows:

If it is nevertheless decided that there is a degree of similarity between the goods at issue, there is no likelihood of confusion between the trade marks when one considers the different conceptual significance of the word SHAKERS when applied to the respective goods of the parties; it is likely to be taken as a reference to a cocktail shaker when used in respect of cocktails and other alcoholic beverages and likely to be taken as a reference to a milk shake when used in relation to non-alcoholic milk drinks.®

16. There was no dispute that I had the discretion to amend the pleadings.

17. Mr Onslow referred me to Tribunal Practice Notice (TPN) 4/2000. This provided practitioners with an indication of the information that the Registrar will expect to be contained in statements of case and counter-statements, and the procedure which the Registrar was to adopt with respect, inter alia, in relation to requests for amendment to these documents. The following is an extract of the relevant sections of TPN4/2000:

#### **Statements of case and counter-statements in opposition, revocation and invalidity proceedings before the registrar of Trade Marks**

1. When launching any of the above proceedings before the Registrar the relevant rule (rules 13(1), 31(1), 32(1), 33(1) or 34(1)) requires that, together with the appropriate form and fee, the party launching the proceedings must file a statement of case on which the opposition or application for revocation or invalidity is made. If the other

party intends to defend the application or registration, then they are required, under the relevant rule (rules 13(3), 31(2), 32(2), or 33(2)) to file a counter-statement.

2. Historically the Registrar did not seek to challenge or scrutinise the content of statements of case or counter-statements. But, following the reform of Civil Justice brought about by Lord Woolf's report Access to Justice and in line with several judgments of the High Court, notably Club Europe Trade Mark [2000] RPC 329, the Registrar has begun to scrutinise the content of these documents. This is because the content of a statement of case and counter-statement plays a key part in any legal proceedings including those before the Registrar of Trade Marks. Poorly drafted and elliptically worded documents can lead to confusion and to a waste of time and resources for both the parties and the Registry with the issues only being defined at the start of the main hearing to determine the substantive issues. In *Demon Ale* [2000] RPC 345 Mr Geoffrey Hobbs Q.C., acting as the Appointed Person, stated:

"Considerations of justice, fairness, efficiency and economy combine to make it necessary for the pleadings of the parties in Registry proceedings to provide a focussed statement of the grounds upon which they intend to maintain that the Tribunal should or should not do what it has been asked to do"

Later in his decision, Mr Hobbs stated:

"If a party fails to provide sufficient information in his pleadings as to the nature or extent of the grounds upon which he relies, the Registrar *"may direct that such.....information as he may reasonably require should be filed within such period as he may specify"* under rule 51 of the Trade Marks Rules 1994"@

18. The TPN goes on to set out the Registrar's position in relation to requests for amendment:

#### **Amendments to statements of case & counter-statements**

22. As parties will be expected to file focussed statements of case and counter-statements, the Trade Marks Registry will consider requests to amend these documents later in the proceedings. Amendments may include adding or removing a ground of opposition/revocation or invalidity or correcting information contained therein. If an amendment becomes necessary parties should seek leave to make the amendment at the earliest opportunity. When seeking leave to amend full details of the amendment together with the reasons for the amendment should be submitted. Whilst each request to amend will be considered on its merits the Registry will aim to give favourable consideration to such requests on the basis that it is likely to avoid a multiplicity of proceedings and thus help resolve the dispute between the parties quickly and at less cost. If the amendment requires the other party to file an amended counter-statement or additional evidence, an award of costs to cover this may be made.@"

19. In *Cobbold v London Borough of Greenwich* (Court of Appeal, 9 August 1999,

unreported) Peter Gibson L J considered the approach that should be adopted under the Civil Procedure Rules 1998 in relation to requests to amend (see paragraph 17.3.5 of Civil Procedure):

The overriding objective is that the court should deal with cases justly. That includes, so far as practicable, ensuring that each case is dealt with not only expeditiously but also fairly. Amendments in general ought to be allowed so that the real dispute between the parties can be adjudicated upon provided that any prejudice to the other party or parties caused by the amendment can be compensated for in costs, and the public interest in the efficient administration of justice is not significantly harmed.

20. As is stated in the *Cobbold* decision, the rules governing the amendment of Statements of Case are to be found in Part 17 of the CPR, Rule 17.3 stating:

Where the court gives permission for a party to amend his statement of case, it may give directions as to:

- (a) amendments to be made to any other statement of case; and
- (b) service of any amended statement of case.

21. CPR 17.3.5 goes on to state:

Under the previous rules the Court would refuse permission to amend only in exceptional cases where an amendment could not be made without doing injustice to the other party: it is a well established principle that the object of the Court is to decide the rights of the parties and not to punish them for mistakes they make in the conduct of their cases by deciding otherwise than in accordance with their rights.

I know of no kind of error or mistake which, if not fraudulent or intended to overreach, the court ought not to correct if it can be done without injustice to the other party. Courts do not exist for the sake of discipline but for the sake of deciding matters in controversy, and I do not regard such amendment as a matter of favour or grace.....it seems to me that as soon as it appears that the way in which a party has framed his case will not lead to a decision of the real matter in controversy, it is as much a matter of right on his part to have it corrected if it can be done without injustice, as anything else in the case is a matter of right (per Bowen L J in *Cropper V Smith* (1884) 26 Ch.D 706 at 710-71) however negligent or careless may have been the first omission and however late the proposed amendment, the amendment should be allowed if it can be made without injustice to the other side. There is no injustice if the other side can be compensated by costs. *Clarapede v Commercial Union Association* (1883) 32 W.R. - 262 at 263.

However, other pre-CPR cases emphasize that, where permission to amend was sought at trial, justice cannot always be measured in terms of money and a judge is entitled to weigh in the balance additional issues.

In the present application, the opponents=regretfully decided to amend the grounds of opposition late and after the pleadings were originally settled but such an error can be accommodated for in costs and without any amendment to the evidence timetable.

The detriment to the applicant is minimal insofar as it has failed to file its evidence in support of the application in any event.

The CPR and supporting case law envisage such an amendment as a matter of right and that delay (save for one resulting in an amendment to the pleadings at the date of trial, where the application will only be granted subject to additional matters being weighed in the exercise of the discretion) will be condoned.@

22. Whilst the CPR places the balance in favour of the amendment, it draws a distinction with requests for an amendment to the pleadings at the date of trial, saying that the application will only be granted subject to additional matters being weighed in the exercise of the discretion.

23. Dealing first with the request in relation to the absolute ground under Section 3(1)(c). Mr Onslow did not put any evidence before me to support this allegation, nor make any submissions on the merits of such a ground. His case rested solely on his interpretation of paragraph 11 of the applicants=skeleton argument as being an admission that SHAKERS is wholly descriptive of a characteristic of the goods for which the applicants seek to register the mark, and consequently, is devoid of distinctive character. In reply Mr Krause stated that he had referred solely to the conceptual message that the mark may send to the consumer when used in relation to the respective goods, which is not the same as saying that the mark describes some aspect of the goods.

24. As I read paragraph 11 of Mr Krause=s skeleton, he is doing no more than saying that in the event that I consider the goods to be similar, I should not find there to be a likelihood of confusion because the respective goods endow the marks with a different conceptual message. Is this an admission that the mark applied for is descriptive and devoid of distinctive character? It is possible for a mark to say something about the goods or services for which it is to be used, or some characteristic of them, and for traders this is no doubt a very desirable trait in a mark. How covert the allusion is a matter of degree depending on the skill of the inventor; get it wrong and the mark falls foul of the provisions of Section 3(1).

25. In my decision issued at the hearing I stated that on the facts before me there was nothing that lead me to the view that the acceptance of the mark had been in error, and that I did not consider Mr Krause=s skeleton to be an admission that the mark is devoid of distinctive character. The request to add Section 3(1)(c) to the pleadings was rejected.

26. In relation to his request to have Section 5(3) added to the pleadings, Mr Onslow first referred me to Tribunal Practice Notice (TPN) 4/2004 issued following the decisions of the European Court of Justice in *Davidoff & Cie SA and Zino Davidoff v Gofkid Ltd* (C-292/00) and *Adidas-Salomon AG and Adidas Benelux BV v Fitnessworld Trading Ltd* (C-408/01). In these cases the ECJ dealt with questions relating to Article 5(2) of the Directive (First Council Directive 89/104/EEC, 21 December 1998 to approximate the laws of Member States relating to trade marks). The Court held that Section 5(3) should be interpreted so that it may be relied upon in relation to identical or similar goods and services as well as in relation to goods and services which are not similar. The practice notice set out the Registrar=s position with regard to any new claims raised under Section 5(3) as well as setting out the position with regard to any

existing claims currently proceeding before the Registry. The TPN states:

## **A2. New claims**

2.1 The Registrar will accept any new claim where a ground of opposition or invalidation is based upon Section 5(3) on the basis of identical or similar goods and services as well as claims in relation to goods and services that are not similar. The Trade Marks Act 1994 has also been amended (by the Trade Marks (Proof of use, etc.) Regulations 2004) to take account of the wider interpretation. The changes to the Act amend not only Section 5(3), but also its equivalent in infringement proceedings Section 10(3).

2.2 However, the Registrar will now require that the claimant identifies the goods and services in the trade mark they wish to oppose (or invalidate) that they consider would take unfair advantage or cause detriment. Form TM7 has been amended to ensure that this information is provided.

## **3. Existing claims**

3.1 Although the ECJs judgements require Section 5(3) to be interpreted more widely, we will only take the wider interpretation into account if the claimant's factual pleadings have been amended. Therefore, any party intending to rely, under Section 5(3), on identical or similar goods and services should request, at the earliest opportunity, an amendment of their statement of case.

3.2 Each request for leave to amend should be made (and will be considered) on a case by case basis; however, given the guidance from the ECJ we expect that favourable consideration will be given to most requests. In the event that leave to amend is granted, the other party to the proceedings will be given an opportunity to amend their counter-statement. The Registrar will not automatically allow any additional time periods for the filing of evidence in support of the amended claim. If further time to file evidence is required then a formal request should be made.®

27. As the proceedings were underway at the time that the TPN was issued any request to amend the statement of grounds to include Section 5(3) would be regarded as an *existing claim*® and would be dealt with under paragraph 3. It was clearly envisaged that following the *Davidoff* and *Adidas* cases there would be requests to extend consideration of an objection under Section 5(3) to identical or similar goods/services, and that favourable consideration would be likely but not automatic. The CPR and supporting case law also envisage such an amendment being looked on favourably although makes the exception in respect of requests for an amendment to the pleadings at the date of trial, saying that the application will only be granted subject to additional matters being weighed in the exercise of the discretion.

28. The extract contained in Tribunal Practice Notice 4/2000 states that if a party seeks to amend their statement of case or counterstatement they should do so at the earliest opportunity. Mr Onslow could argue that the opponents only considered the issue of Section 5(3) on seeing the applicant's skeleton, but as I put it to him at the hearing, could the relevance of such an objection only have become apparent on receipt of the skeleton? In my view, if the opponents believe that

they are the owners of a mark with a reputation (the reputation is a pre-requisite whether similar or dissimilar goods are involved) they could and should have pleaded the ground under Section 5(3) from the outset.

29. As it happens, the opponents did not file any evidence of use of their mark during the course of the proceedings, nor did Mr Onslow come to the hearing with any prepared, draft or otherwise, or even any details of the use that would establish that the opponents had an arguable case. In *Jones v Hughes* at page 187, Vaughan Williams L.J said:

AMr Low says that we ought to give leave to amend. One good reason for our not doing so is that, looking at the case that he tells us he would wish to present, that case, if presented by amendment, would, in my judgement also fail; so there is nothing to be gained by the amendment@.

30. I did not know whether the opponents would be in a position to succeed in respect of an attack under Section 5(3), I could only surmise that if they were, they would have included the ground when launching the opposition. But whatever is the case, the onus is upon them to fully justify the amendment to the grounds of opposition being allowed, and particularly so given the late stage at which it was being made. On all of the facts before me I considered the basis of the request to be ill founded, unsupported, and the request was denied.

31. Turning to the substantive issues. The first ground is under Section 5(2)(b) of the Act. That section reads as follows:

**A5.-(2) A trade mark shall not be registered if becauseB**

(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.@

32. An earlier trade mark is defined in Section 6 of the Act as follows:

**A6.- (1) In this Act an Aearlier trade mark@meansB**

(b) 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,@

33. In a consideration of a likelihood of confusion or deception I must take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] 45 F.S.R. 77 and *Marca Mode CV v Adidas AG* [2000] E.T.M.R. 723. It is clear from these cases that:

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*;
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v Puma AG*, who is deemed to be reasonably well informed and reasonably circumspect and observant - but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind; *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v Puma AG*;
- (d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v Puma AG*;
- (e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*;
- (f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v Puma AG*;
- (g) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v Puma AG*;
- (h) further, the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense; *Marca Mode CV v Adidas AG*;
- (i) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*.

34. The case law states that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details, but qualifies this by saying that the distinctiveness and dominance of the individual components should be taken into account. The opponents rely on a number of earlier marks for the words SHAKER, SHAKER-S, SHAKERS, SHAKERS SMOOVIE and SHAKERS SMOOVIES.

35. Self-evidently these earlier marks contain an element that is either identical to, or all but the word that the applicants seek to register. In his evidence Mr Krause provided dictionary references relating to the meaning of the word SHAKE and SHAKER. The word SHAKE is,

amongst other meanings, a shortened form of MILK SHAKE. The word SHAKER refers, inter alia, to a container in which the ingredients of alcoholic drinks are shaken together such as in cocktails. As far as I am aware, apart from being the pluralised or possessive form of SHAKER, the word SHAKERS does not describe an item of goods. However, in respect of beverages, alcoholic or otherwise, the word SHAKER or SHAKERS alludes, albeit none too covertly to goods that fall within the meaning of a SHAKE, and perhaps to a lesser extent also cocktails. Although the reference to the goods is not so direct as to mean that the word lacks distinctive character, I would not put the level of distinctiveness too high up the scale.

36. It is my understanding that SMOOTHIE is a generic name for a type of blended beverage primarily made from fruit, a fact that I consider is likely to be known to the relevant consumer. Quite clearly the word SMOOVIE is a phonetic variation intended to create the same idea. Given its relevance for the goods I do not consider that this element adds anything significant to the mark; it will still be seen as a SHAKERS mark. Without the need for an exhaustive analysis I believe I am on reasonably safe ground in saying that the distinctive and dominant element of the respective marks is either identical or very similar to the ear and the eye, and conveys the same idea.

37. Non-alcoholic beverages are inexpensive items, usually purchased by self-selection. The manner in which alcoholic beverages are obtained will vary according to the retail establishment. Supermarkets tend to set out their alcohol on shelves for self-selection, whereas smaller shops may display such beverages behind the counter where the customer has to ask for the product. In licensed premises the customers obtain their drinks on request, in such circumstances the customer may ask for the desired product by brand, or may simply ask for a shake. Accordingly, I consider the visual and aural similarity of the respective marks to be more or less on par although given the similarity in the marks this is of little consequence.

38. The opponents have not provided any evidence that shows the SHAKER(s) marks had been used prior to the relevant date, nor any advertising and/or turnover figures relating to sales of these products. Consequently, I do not see that I am in a position to say that they have made any relevant use of the marks, let alone that there has been use on a scale that will have enhanced any reputation.

39. On the question of whether the respective goods are similar I look to the guidance of Jacob J. in *British Sugar Plc v James Robertson & Sons Ltd* (1996) RPC 281 and in the judgement of the European Court of Justice in *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* Case C-39/97 case. With these cases in mind I propose to consider the question of similarity by a consideration of the following factors:

- (a) The nature of the goods or services;
- (b) The end-users of the goods or services;
- (c) The way in which the goods or services are used;
- (d) Whether the respective goods or services are competitive or complementary.  
This may take into account how those in trade classify goods and the 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) In determining whether similarity between the goods or services covered by two trade marks is sufficient to give rise to the likelihood of confusion, the distinctive character and reputation of the earlier mark must be taken into account.

40. The opponents=earlier marks are registered in respect of alcoholic beverages of one sort or another. The mark applied for is sought to be registered in respect of milk drinks with the exclusion of those containing alcohol. Mr Onslow referred me to exhibit SJO3 which, inter alia, consists of labels for his clients=SHAKERS SMOOVIE, a beverage consisting of white rum, blackcurrant, raspberry and milk. Although there is nothing that establishes that these products were available at the relevant date, Mr Onslow only relied upon the evidence insofar as the labels showed that such beverages existed, and therefore I should view the opponents=specifications as covering the same. This does not appear to be an unreasonable yardstick by which to gauge the scope of the opponents=specifications, but in any event, I would probably have come to the same conclusion without the benefit of this evidence. It therefore seems that notionally the opponents have coverage for alcoholic versions of the applicants=milk drink. I am also aware that certain cocktails are made with milk as an ingredient and I see no reason why these could not also be made available to the consumer pre-mixed. These are all milk-based beverages and I do not consider the alcoholic-non-alcoholic factor distinguishes them in nature, or the way in which the products are used.

41. The opponents highlight that the alcoholic beverages industry adheres to a voluntary code of conduct that prohibits the promotion of alcohol to those under age. They invited me to take a more stringent view on the likelihood of confusion, citing the *public interest* approach used in relation to pharmaceuticals; I see no basis on which I can do so. Given the licensing laws in force in this country relating to the sale of alcohol it is clear that the relevant consumer of such goods will be restricted by age. However, the goods of the application are not so restricted and are available for purchase by all and sundry, including the self-same consumer that may purchase the opponents=beverages.

42. Mr Onslow referred me to the *MYSTERY* case [2004] ETMR 18 in which The Court of First Instance of the European Communities (CFI) agreed with the Board of Appeal's decision that mixed drinks, whether alcoholic or not, were similar goods. The decision involved beers and other non-alcoholic beverages, primarily those made from beer such as shandies. Part of the rationale for the decision was that in the relevant market it was generally known that breweries often bottle non-alcoholic beverages, in particular carbonated beverages in addition to beers, and that these goods followed the same distribution links to the retail sales outlets. It has not been established that that is the case in respect of the goods covered by the respective marks in the UK market.

43. I have no evidence as to how the trade classify the respective goods, or whether a manufacturer of beverages would generally produce alcoholic and non-alcoholic drinks, but I see

no reason why this could not be the case. Both types of drinks are supplied by wholesalers and retailers.

44. Alcoholic and non-alcoholic beverages are generally displayed in distinct areas of a retail establishment although will usually be adjacent to one another. Apart from the fact that all are beverages I presume that the rationale for this proximity of display is that a non-alcoholic drink can be complementary to the spirit, for example as a Amixer®, or is consumed as an alternative. There are exceptions, for example, beverages that require refrigeration to keep them fresh for consumption.

45. I have already commented on the lack of evidence of the opponents having used their mark and my consequent inability to determine whether it has enhanced its distinctiveness as a result. Taking a balanced view on all of the facts, I come to the view that the terms Aalcoholic beverages® and Acocktails® should be regarded as covering similar goods to the milk-based drinks for which the applicants seek registration.

46. Taking all of the above factors into account and adopting the Aglobal® view advocated, I find that there are important similarities in the marks, goods and trade circumstances such that if the applicants were to use their mark in respect of the goods for which they seek registration it will cause the public to wrongly believe that their goods come from the opponents or an economically linked undertaking. Consequently, I find that there is a likelihood of confusion and the ground under Section 5(2)(b) succeeds.

47. My decision under Section 5(2)(b) effectively decides the case. Had I gone on to consider the ground under Section 5(4)(a), given the total absence of evidence showing that the earlier marks had been used prior to the relevant date, I do not see that I could have found that the marks had acquired a reputation or goodwill, and consequently, that this ground had been made out.

48. The opposition having been successful, I order the applicants to pay the opponents the sum of , 2,100 as a contribution towards their costs. This sum to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 17<sup>th</sup> day of March 2005**

**Mike Foley  
for the Registrar  
the Comptroller-General**



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## Trade Mark Details as at 16.03.2005

CASE DETAILS FOR TRADE MARK 508437

**Mark Text :**

SHAKER

**Status:** Registered

**Class:** 33

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### Relevant Dates

**Filing Date:** 04.12.1929

**Next Renewal Date:** 04.12.2009

### Publication in Trade Marks Journal

	Journal	Page	Publication Date
<b>First Advert</b>	2718	698	30.04.1930
<b>Renewal</b>	6306		08.12.1999
<b>Assignment</b>	6291		25.08.1999

### List of goods and/or services

**Class 33:**  
Cocktails.

### Names and Addresses

**Proprietor:** Halewood International Limited  
The Sovereign Distillery, Wilson Road, Huyton Business Park,  
Liverpool, L36 6AD

**Residence Country:** United Kingdom

**Effective Assignment date:** 15.06.1999

**Assignment Date:** 15.06.1999

**ADP Number:** [0580327001](#)

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**Agent:** Urquhart-Dykes & Lord LLP  
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**ADP Number:** 0001644004

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Tower North Central, Merrion Way, Leeds, West Yorkshire, LS2 8PA

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**Other Particulars**

**Special Circumstances:**  
Advertised before acceptance. Section 18(1) (pr0viso).

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[Contact Details](#)
[Search](#)
[Site Map](#)
[Index](#)
[Home](#) : [Trade Marks](#) : [Databases](#) : [Register](#)

## Trade Mark Details as at 16.03.2005

### CASE DETAILS FOR TRADE MARK 1148367

**Mark Text :**

SHAKER 'S

**Status:** Registered

**Class:** 33

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#### Relevant Dates

**Filing Date:** 09.02.1981  
**Next Renewal Date:** 09.02.2012

#### Publication in Trade Marks Journal

	Journal	Page	Publication Date
<b>First Advert</b>	5499	233	01.02.1984
<b>Renewal</b>	6430		15.05.2002
<b>Expiry</b>	6421		13.03.2002
<b>Assignment</b>	6291		25.08.1999

#### List of goods and/or services

**Class 33:**  
 Wines, spirits(beverages), liqueurs and cocktails.

#### Names and Addresses

**Proprietor:** Halewood International Limited  
 The Sovereign Distillery, Wilson Road, Huyton Business Park,  
 Liverpool, L36 6AD

**Residence Country:** United Kingdom  
**Effective Assignment date:** 15.06.1999  
**Assignment Date:** 15.06.1999  
**ADP Number:** [0580327001](#)

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Tower North Central, Merrion Way, Leeds, West Yorkshire, LS2 8PA

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#### Other Particulars

**Special Circumstances:**

Advertised before acceptance by reason of special circumstances. Section 18(1) (proviso).

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[Contact Details](#)
[Search](#)
[Site Map](#)
[Index](#)
[Home](#) : [Trade Marks](#) : [Databases](#) : [Register](#)

## Trade Mark Details as at 16.03.2005

### CASE DETAILS FOR TRADE MARK 2194951

**Mark Text :**

SHAKERS

SHAKER

**Series of:** 2  
**Status:** Registered  
**Classes:** 32 33

[View Historical Details](#)

#### Relevant Dates

**Filing Date:** 16.04.1999  
**Registration Date:** 23.11.2001  
**Next Renewal Date:** 16.04.2009

#### Publication in Trade Marks Journal

	Journal	Page	Publication Date
<b>First Advert</b>	6391	14061	08.08.2001
<b>Registration</b>	6411		02.01.2002
<b>Assignment</b>	6510		12.12.2003

#### List of goods and/or services

**Class 32:**  
Beers.

**Class 33:**  
Cocktails in class 33.

#### Names and Addresses

**Proprietor:** Halewood International Brands Limited  
 The Sovereign Distillery, Wilson Road, Huyton Business Park,  
 Liverpool, L36 6AD

**Residence Country:** United Kingdom  
**Customer's Ref:** SJB/T10695  
**Effective Assignment date:** 16.10.2003  
**Assignment Date:** 30.06.2000  
**ADP Number:** [0814060001](#)

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#### Other Particulars

**Special Circumstances:**  
Proceeding because of prior rights in Registration No. 508437(2718,698).

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[Contact Details](#)
[Search](#)
[Site Map](#)
[Index](#)
[Home](#) : [Trade Marks](#) : [Databases](#) : [Register](#)

## Trade Mark Details as at 16.03.2005

### CASE DETAILS FOR TRADE MARK 2228561

**Mark Text :**

SHAKERS SMOOTHIE

**Status:** Registered

**Class:** 33

[View Historical Details](#)

#### Relevant Dates

**Filing Date:** 07.04.2000  
**Registration Date:** 10.08.2001  
**Next Renewal Date:** 07.04.2010

#### Publication in Trade Marks Journal

	Journal	Page	Publication Date
<b>First Advert</b>	6376	7496	25.04.2001
<b>Registration</b>	6396		12.09.2001
<b>Assignment</b>	6510		12.12.2003

#### List of goods and/or services

**Class 33:**  
 Alcoholic beverages.

#### Names and Addresses

**Proprietor:** Halewood International Brands Limited  
 The Sovereign Distillery, Wilson Road, Huyton Business Park,  
 Liverpool, L36 6AD

**Residence Country:** United Kingdom  
**Customer's Ref:** T54581/PRW  
**Effective Assignment date:** 16.10.2003  
**Assignment Date:** 30.06.2000  
**ADP Number:** [0814060001](#)

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[Contact Details](#)
[Search](#)
[Site Map](#)
[Index](#)
[Home](#) : [Trade Marks](#) : [Databases](#) : [Register](#)

## Trade Mark Details as at 16.03.2005

### CASE DETAILS FOR TRADE MARK 2233007

**Mark Text :**

 SHAKERS SMOOVIES
 

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**Status:** Registered

**Class:** 33

[View Historical Details](#)


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#### Relevant Dates

**Filing Date:** 18.05.2000  
**Registration Date:** 03.11.2000  
**Next Renewal Date:** 18.05.2010

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#### Publication in Trade Marks Journal

	Journal	Page	Publication Date
First Advert	6337	11308	19.07.2000
Registration	6357		06.12.2000

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#### List of goods and/or services

**Class 33:**  
 Alcoholic beverages

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#### Names and Addresses

**Proprietor:** Halewood International Limited  
 The Sovereign Distillery, Wilson Road, Huyton Business Park,  
 Liverpool, L36 6AD

**Residence Country:** United Kingdom  
**Customer's Ref:** PRW/T054592  
**ADP Number:** [0580327001](#)

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