

O-0741-23

TRADE MARKS ACT 1994

IN THE MATTER OF

TRADE MARK APPLICATION NO. UK00003507073

HOLY MOLY
AND
HOLYMOLY

(SERIES OF TWO)

IN THE NAME OF HOLY MOLY LTD

AND

AN OPPOSITION UNDER NO. 422291

BY FRANZ WILHELM LANGGUTH ERBEN GMBH & CO. KG

Background and pleadings

1. On 1 July 2020, Holy Moly Ltd (“the applicant”) applied to register the trade marks shown on the cover page of this decision.
2. The application was published for opposition purposes on 28 August 2020 for a number of goods in Classes 29, 30 and 32.
3. Franz Wilhelm Langguth Erben GmbH & Co. KG (“the opponent”) filed a notice of opposition on 30 November 2020 on the basis of sections 5(1) and 5(2)(a) of the Trade Marks Act 1994 (“the Act”). As the opposition is directed against only the goods in Class 32, the applicant applied to divide the application on 21 April 2021 to separate Classes 29 and 30 from Class 32. Further to the division, the application no. 3507073 now covers only the goods in Class 32, which are given below:

Non-alcoholic beverages containing vegetable juices; Vegetable juices [beverages]; Coconut-based beverages; smoothies; fruit juice drinks; Non-alcoholic beverages containing fruit juices; Vegetable juice; Juices; beverages consisting of a blend of fruit and vegetable juices; Oat-based beverages [not being milk substitutes]; Green vegetable juice beverages; Smoothies containing grains and oats; Soft drinks; Fruit smoothies; Vegetable smoothies; Fruit juices; Nut and soy based beverages; Vegetable juices [beverage].

4. For its claim under sections 5(1) and 5(2)(a), the opponent relies upon all the goods in Class 32 covered by the following European Union (“EU”) trade mark:

Mark: HOLY MOLY

Registration No. EU 018263434

Filing date: 29 June 2020

Registration date: 17 June 2022

Goods relied upon:

Class 32 Mineral water [beverages]; Aerated water; Alcohol free wine; Beer and brewery products.

5. As this opposition proceeding was launched before 31 December 2020, i.e., the IP Completion Day, the opponent can validly rely on the EU trade mark.
6. Given its filing date, the above mark is an earlier trade mark in accordance with section 6 of the Act. As the opponent's mark has not completed its registration process more than 5 years before the application date of the contested mark, the mark is not subject to proof of use provisions contained in section 6A of the Act. The opponent can, therefore, rely on all the goods covered by its registration.
7. The opponent claims that the marks are identical and the goods are identical or highly similar, with the result that there is a likelihood of confusion.
8. The applicant filed a counterstatement denying the grounds of opposition.
9. The applicant is represented by Pinsent Masons LLP and the opponent is represented by KUNZE Rechtsanwälte - Solicitor (England & Wales) PartG mbB. Only the applicant filed evidence. Both parties filed submissions in lieu. This decision is taken after careful reading of all the papers filed by the parties.
10. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied upon in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts.

Evidence

11. The applicant's evidence consists of the witness statement of Mr Matthew Harris dated 23 January 2023 together with 2 exhibits. Mr Harris is a Chartered Trade Mark Attorney at Pinsent Masons LLP, the applicant's representative in these proceedings.
12. I will return to the evidence later in the decision.

Proceedings at EUIPO

13. At the time of filing this opposition, the opponent's earlier mark was subject to opposition proceedings at the EUIPO, so the UKIPO proceedings were suspended for a while, pending the outcome of the decision. The opposition at the EUIPO was directed against all the goods in Classes 32 and 33 covered by the earlier mark. On 16 March 2022, the EUIPO partially upheld the opposition limiting the goods of the earlier mark in Class 32. The goods for which the earlier mark now has protection in Class 32 are given at paragraph 4 of this decision. A copy of this decision is provided as Exhibit MH1.

Sections 5(1) and 5(2)(a)

14. The opposition is based upon sections 5(1) and 5(2)(a) of the Act, which reads as follows:

“5. (1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.

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

(a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected.”

Comparison of marks

15. In order to succeed under the sections 5(1) and 5(2)(a), the competing trade marks must be identical.

16. In *S.A. Société LTJ Diffusion v Sadas Vertbaudet SA*, Case C-291/00, the Court of Justice of the European Union (“CJEU”) held, that:

“54 [...] a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer”.

17. The opponent’s mark is HOLY MOLY. The mark applied for by the applicant is a series of words ‘HOLY MOLY’ and ‘HOLYMOLY’. The first mark in the applicant’s series is identical to the opponent’s mark. Although the words ‘HOLY MOLY/HOLYMOLY’ is repeated in the applicant’s mark and the second mark in the series is presented as one word, that difference is so insignificant that they will go unnoticed by the average consumer. I, therefore, conclude that there is identity between the competing marks.

Comparison of goods

18. When making the comparison, all relevant factors relating to the goods in the specifications should be taken into account. In *Canon*, the Court of Justice of the European Union (“CJEU”) stated at paragraph 23 of its judgment:

“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”.

19. In Guidance on this issue has also come from Jacob J. (as he then was) in *British Sugar Plc v James Robertson & Sons Ltd* (the Treat case), [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

(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.

20. In *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

“[...] Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question”.

20. 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 Office for Harmonization in the Internal Market* (Trade Marks and Designs) (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”.

21. The goods to be compared are as follows:

Applicant’s goods	Opponent’s goods
Class 32: Non-alcoholic beverages containing vegetable juices; Vegetable juices [beverages]; Coconut-based beverages; smoothies; fruit juice drinks; Non-alcoholic beverages containing fruit juices; Vegetable juice; Juices; beverages consisting of a blend of fruit and vegetable juices; Oat-based beverages [not being milk substitutes]; Green vegetable juice beverages; Smoothies containing grains and oats; Soft drinks; Fruit smoothies; Vegetable smoothies; Fruit juices; Nut and soy based beverages; Vegetable juices [beverage].	Class 32: Mineral water [beverages]; Aerated water; Alcohol free wine; Beer and brewery products.

22. The applicant submits that the goods covered by the opponent's mark "are in the overwhelming majority – alcoholic beverages, which are different to Class 32 goods in the application."¹ The applicant also cites the EUIPO guidelines and submits that alcoholic and non-alcoholic drinks are dissimilar.²

23. While I agree with the applicant that most of the goods for which the earlier mark has protection are alcoholic beverages in Class 33, for the purpose of these proceedings, the opponent only relies on its goods in Class 32. Therefore, the comparison I must undertake here is between the respective parties' goods in Class 32.

24. Broadly speaking, all of the goods covered by the applicant's specifications are types of non-alcoholic drinks, vegetable or fruit juices. The nature of the applicant's goods is similar to the opponent's mineral water (beverages) in that they are all drinks, although their specific natures will differ as the opponent's goods are water while the applicant's goods are mainly fruit/nut or oat-based drinks. There will also be overlap in use, method of use, trade channels and users. There will also be a degree of competition between them as both types of drinks are consumed to quench one's thirst. Considering these factors, I consider the goods to be similar to a medium degree.

25. In order to succeed under a claim based on section 5(1), the respective marks and the goods must be identical. As the respective goods are not identical, the opposition under section 5(1) fails.

The average consumer and the nature of the purchasing act

26. I will proceed to determine who the average consumer is for the respective party's goods discussed above.

27. 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*,

¹ Witness statement, paragraph 12, applicant's submissions in lieu, paragraph 13.

² Exhibit MH2.

[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”.

28. All the goods are beverages of one form or another. The average consumer of such goods will be the public at large. All of the goods may be sold through a range of channels, including retail premises such as supermarkets where the goods are normally displayed on shelves and are obtained by self-selection. None are particularly costly and are fairly frequent purchases. The selection process is likely to be predominantly visual, although aural considerations will also play their part. During the selection process, the average consumer is likely to ensure that they select the correct type, flavour, etc., of beverage. Considering these factors, I am of the view that the average consumer is likely to pay a medium level of attention to the selection of goods.

Distinctive character of earlier mark

29. The distinctive character of the earlier mark must be considered. The more distinctive the mark is, either inherently or through use, the greater the likelihood of confusion (*Sabel BV v Puma AG*). 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 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).”

30. Invented words usually have the highest degree of distinctive character, while words which are allusive of the goods have the lowest. Distinctiveness can also be enhanced through the use of the mark.

31. The opponent has not filed evidence of enhanced distinctiveness, so I only have the inherent position to consider. The opponent’s mark consists of the two words HOLY MOLY, words used to express surprise. The words have no suggestive connotation in respect of the opponent’s goods. The mark, therefore, possesses a medium degree of inherent distinctive character.

Likelihood of confusion

32. In determining whether there is a likelihood of confusion, I need to bear in mind several factors. The first is the interdependency principle, i.e. a lesser degree of similarity between the respective goods may be offset by a greater degree of similarity between the trade marks (Canon at [17]). It is also necessary for me

to bear 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 (Sabel at [24]). 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, relying instead upon the imperfect picture of them he has retained in his mind (Lloyd Schuhfabrik at [26]).

33. Confusion can be direct (which occurs when the average consumer mistakes one mark for the other) or indirect (where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods down to the responsible undertaking being the same or related).

34. The difference between direct and indirect confusion was explained in *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, by Iain Purvis Q.C., sitting as the Appointed Person, where he 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.”

35. I have found the respective marks to be identical. I also found that the goods are similar to a medium degree and that the goods will be selected primarily by visual means, with a medium degree of attention by the general public. I also

concluded that the inherent distinctiveness of the earlier mark is medium and given that the opponent did not file evidence, the distinctiveness of the earlier mark has not been enhanced through the use.

36. I am of the view that the identity between the marks and the similarity between the goods is likely to lead to direct confusion. The average consumer who pays a medium degree of attention is likely to mistake the opponent's mark for the applicant's mark and /or vice versa and think that the goods originate from a single undertaking. I, therefore, conclude that there is a likelihood of direct confusion.

Conclusion

37. The opposition has been successful. The application is refused.

Costs

38. The opponent has been successful and is entitled to a contribution towards its costs. Awards of costs are governed by Tribunal Practice Notice ("TPN") 2/2016. I award costs to the opponent on the following basis:

Preparing a statement of case and Considering other side's statement:	£200
Filing written submissions:	£300
Official fee:	£100
Total:	£600

39. I order Holy Moly Ltd to pay Franz Wilhelm Langguth Erben GmbH & Co KG the sum of £600. This sum is to be paid within twenty-one days of the expiry of

the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 3rd August 2023

Karol Thomas

For the Registrar

The Comptroller-General