

O/0747/23

TRADE MARKS ACT 1994

IN THE MATTER OF REGISTRATION NO. UK00003781862

BY JHO INTELLECTUAL PROPERTY HOLDINGS, LLC

FOR THE FOLLOWING TRADE MARK:

SMART SHOT

IN CLASS 32

AND AN APPLICATION FOR A DECLARATION OF INVALIDITY

UNDER NO. 505272

BY SALEEM AHMED

BACKGROUND AND PLEADINGS

1. JHO Intellectual Property Holdings, LLC (“the proprietor”) is the owner of the trade mark shown on the cover page of this decision. The contested mark was filed on 3 November 2020 and registered 10 August 2021. It claims priority from 17 June 2020 (US trade mark no. 90007042). The contested mark stands registered for the following goods:

Class 32 Energy drinks; isotonic drinks; non-alcoholic drinks, namely, energy shots; sports drinks.

2. On 12 August 2022, Saleem Ahmed (“the applicant”) applied to declare the registration invalid pursuant to sections 47 and 5(1) of the Trade Marks Act 1994 (“the Act”). The applicant relies upon the following trade mark:

SMART SHOT

UKTM no. 3426986

Filing date 9 September 2019; registration date 29 November 2019

3. The applicant claims that the marks are identical and the trade marks are registered for identical goods. The goods for which the earlier mark is registered are set out in the Annex to this decision.

4. The proprietor is represented by Lane IP Limited and the applicant is represented by Bailey Walsh & Co LLP.

5. Neither party filed evidence. Neither party requested a hearing and neither filed written submissions in lieu. This decision is taken following a careful perusal of the papers.

RELEVANCE OF EU LAW

6. 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.

DECISION

7. Section 5(1) has application in invalidation proceedings by virtue of section 47 of the Act. Section 47 of the Act reads as follows:

“47(1) [...]

(2) Subject to subsections (2A) and (2G), the registration of a trade mark may be declared invalid on the ground –

(a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or

(b) [...]

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

(2ZA) [...]

(2A) The registration of a trade mark may not be declared invalid on the ground that there is an earlier trade mark unless –

(a) the registration procedure for the earlier trade mark was completed within the period of five years ending with the date of the application for the declaration,

(b) the registration procedure for the earlier trade mark was not completed before that date, or

(c) the use conditions are met.

(2B) The use conditions are met if –

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

(i) within the period of 5 years ending with the date of application for the declaration; and

(ii) within the period of 5 years ending with the date of filing of the application for registration of the later trade mark or (where applicable) the date of the priority claimed in respect of that application where, at that date, the five year period within which the earlier trade mark should have been put to genuine use as provided section 46(1)(a) has expired, or

(b) it has not been so used, but there are proper reasons for non-use.

(2C) [...]

(2D) In relation to a European Union trade mark or international trade mark (EC), any reference in subsection 2B or 2C to the United Kingdom shall be construed as a reference to the European Union.

(2DA) [...]

(2E) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the

purposes of this section as if it were registered only in respect of those goods or services.

(2F) Subsection (2A) does not apply where the earlier trade mark is a trade mark within section 6(1)(c).

[...]

(5) Where the grounds of invalidity exists in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

(5A) [...]

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall be deemed never to have been made.

Provided that this shall not affect transactions past and closed.”

8. Section 5(1) of the Act states:

“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.”

9. By virtue of its earlier filing date, the trade mark upon which the applicant relies qualifies as an earlier trade mark pursuant to section 6 of the Act. As the earlier mark had not completed its registration process more than 5 years before the application date of the mark in issue it is not subject to proof of use pursuant to section 47(2A) of the Act.

Identity of the marks

10. Both marks consist of the words SMART SHOT, in capital letters. They are self-evidently identical.

Comparison of goods

11. I have included only those goods that represent the applicant's best case in the table below. With that in mind, the competing goods are as follows:

Applicant's goods	Proprietor's goods
<u>Class 32</u> Energy drinks; Isotonic drinks; Non-alcoholic drinks; Sports drinks.	<u>Class 32</u> Energy drinks; isotonic drinks; non-alcoholic drinks, namely, energy shots; sports drinks.

12. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court ("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 for 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."

13. *Energy drinks, Isotonic drinks and Sports drinks* appear identically in both parties' specifications.

14. *Non-alcoholic drinks, namely, energy shorts* in the proprietor's specification falls within the broader category of *Non-alcoholic drinks* in the applicant's specification. They are identical on the principle outlined in *Meric*.

Finding

15. As the marks and the goods are identical, the application based upon section 5(1) of the Act succeeds in its entirety.

CONCLUSION

16. The application for a declaration of invalidity succeeds in its entirety.

17. Pursuant to section 47(6) of the Act, the registration is deemed never to have been made.

COSTS

18. As the applicant has been successful, it is entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 2/2016. In the circumstances, I award the applicant the sum of **£400**, calculated as follows:

Preparing a Notice of Invalidation and considering the counterstatement	£200
Official fee	£200
Total	£400

19. I therefore order JHO Intellectual Property Holdings, LLC to pay Saleem Ahmed the sum of £400. This sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 4th day of August 2023

S WILSON
For the Registrar

ANNEX

Class 32

Aerated fruit juices; Aerated juices; Aerated mineral waters; Aerated water; Aerated water (Preparations for making -); Aerated water [soda water]; Aerated waters; Alcohol free aperitifs; Alcohol free beverages; Alcohol free cider; Alcohol free wine; Alcohol-free beers; Ale; Ales; Aloe juice beverages; Aloe vera drinks, non-alcoholic; Aloe vera juices; Aperitifs, non-alcoholic; Apple juice beverages; Apple juice drinks; Barley wine [Beer]; Barley wine [beer]; Beer; Beer and brewery products; Beer wort; Beer-based beverages; Beer-based cocktails; Beers; Beers enriched with minerals; Beverages consisting of a blend of fruit and vegetable juices; Beverages consisting principally of fruit juices; Beverages containing vitamins; Beverages (Non-alcoholic -); Beverages (Preparations for making -); Beverages (Whey -); Bitter lemon; Black beer; Black beer [toasted-malt beer]; Blackcurrant cordial; Blackcurrant juice; Bock beer; Bottled drinking water; Bottled water; Brown rice beverages other than milk substitutes; Carbohydrate drinks; Carbonated mineral water; Carbonated non-alcoholic drinks; Carbonated soft drinks; Carbonated water; Carbonated waters; Cider, non-alcoholic; Cocktails, non-alcoholic; Coconut juice; Coconut water; Coconut water as a beverage; Coconut water as beverage; Coconut-based beverages; Coffee-flavored ale; Coffee-flavored beer; Coffee-flavored soft drinks; Cola; Cola drinks; Colas [soft drinks]; Concentrated fruit juice; Concentrated fruit juices; Concentrates for making fruit drinks; Concentrates for making fruit juices; Concentrates for use in the preparation of soft drinks; Concentrates used in the preparation of soft drinks; Condensed smoked plum juice; Cordials; Cordials [non-alcoholic]; Cordials (non-alcoholic beverages); Craft beer; Craft beers; Cranberry juice; Cream soda; De-alcoholised beer; De-alcoholised drinks; De-alcoholised wines; De-alcoholized beer; De-alcoholized drinks; De-alcoholized wines; Dilutable preparations for making beverages; Distilled drinking water; Douzhi (fermented bean drink); Drinking mineral water; Drinking spring water; Drinking water; Drinking water with vitamins; Drinking waters; Dry ginger ale; Effervescing beverages (Pastilles for -); Effervescing beverages (Powders for -); Energy drinks; Energy drinks containing caffeine; Energy drinks [not for medical purposes]; Essences for making beverages; Essences for making flavoured mineral water [not in the nature of essential oils]; Essences for making non-alcoholic

beverages; Essences for making non-alcoholic beverages [not in the nature of essential oils]; Essences for making non-alcoholic drinks, not in the nature of essential oils; Extracts for making beverages; Extracts for making non-alcoholic beverages; Extracts of hops for making beer; Extracts of unfermented must; Flavor enhanced water; Flavored beer; Flavored beers; Flavored mineral water; Flavored waters; Flavoured beers; Flavoured carbonated beverages; Flavoured mineral water; Flavoured waters; Frozen carbonated beverages; Frozen fruit beverages; Frozen fruit drinks; Frozen fruit-based beverages; Frozen fruit-based drinks; Fruit beverages; Fruit beverages and fruit juices; Fruit beverages (non-alcoholic); Fruit drinks; Fruit extracts (Non-alcoholic -); Fruit flavored drinks; Fruit flavored soft drinks; Fruit flavoured carbonated drinks; Fruit flavoured drinks; Fruit flavoured waters; Fruit juice; Fruit juice bases; Fruit juice beverages; Fruit juice beverages (Non-alcoholic -); Fruit juice concentrates; Fruit juice drinks; Fruit juice for use as beverages; Fruit juices; Fruit nectars; Fruit nectars, nonalcoholic; Fruit nectars, non-alcoholic; Fruit smoothies; Fruit squashes; Fruit-based beverages; Fruit-based soft drinks flavored with tea; Fruit-flavored beverages; Fruit-flavored soft drinks; Fruit-flavoured beverages; Functional water-based beverages; Ginger ale; Ginger beer; Ginger juice beverages; Glacial water; Grape juice; Grape juice beverages; Grape must, unfermented; Grapefruit juice; Green vegetable juice beverages; Guarana drinks; Guava juice; Honey-based beverages (Non-alcoholic -); Hop extracts for manufacturing beer; Hop extracts for use in the preparation of beverages; Hops (Extracts of -) for making beer; Iced fruit beverages; Imitation beer; India pale ales (IPAs); IPA (Indian Pale Ale); Isotonic beverages; Isotonic beverages [not for medical purposes]; Isotonic drinks; Isotonic non-alcoholic drinks; Juice drinks; Juice (Fruit -); Juices; Kvass [non-alcoholic beverage]; Kvass [non-alcoholic beverages]; Lager; Lagers; Lemon barley water; Lemon juice for use in the preparation of beverages; Lemon squash; Lemonade; Lemonades; Lime juice cordial; Lime juice for use in the preparation of beverages; Liqueurs (Preparations for making -); Lithia water; Low alcohol beer; Low calorie soft drinks; Low-alcohol beer; Low-calorie soft drinks; Malt beer; Malt syrup for beverages; Malt wort; Mango juice; Melon juice; Mineral and aerated waters; Mineral enriched water [beverages]; Mineral water; Mineral water [beverages]; Mineral water (Non-medicated -); Mineral waters; Mineral waters [beverages]; Mixed fruit juice; Mixed fruit juices; Mixes for making sorbet beverages; Mung bean beverages; Must; Nectars (Fruit -), non-alcoholic; Non alcoholic aperitifs; Non-alcoholic beer; Non-alcoholic beer

flavored beverages; Non-alcoholic beers; Non-alcoholic beverages; Non-alcoholic beverages containing fruit juices; Non-alcoholic beverages containing vegetable juices; Non-alcoholic beverages flavored with coffee; Non-alcoholic beverages flavored with tea; Non-alcoholic beverages flavoured with coffee; Non-alcoholic beverages flavoured with tea; Non-alcoholic beverages with tea flavor; Non-alcoholic carbonated beverages; Non-alcoholic cinnamon punch with dried persimmon (sujeonggwa); Non-alcoholic cocktail bases; Non-alcoholic cocktail mixes; Non-alcoholic cocktails; Non-alcoholic cordials; Non-alcoholic drinks; Non-alcoholic drinks enriched with vitamins and mineral salts; Non-alcoholic flavored carbonated beverages; Non-alcoholic fruit cocktails; Non-alcoholic fruit drinks; Non-alcoholic fruit extracts; Non-alcoholic fruit extracts used in the preparation of beverages; Non-alcoholic fruit juice beverages; Non-alcoholic fruit punch; Non-alcoholic grape juice beverages; Non-alcoholic honey-based beverages; Non-alcoholic malt beverages; Non-alcoholic malt drinks; Non-alcoholic malt free beverages [other than for medical use]; Non-alcoholic preparations for making beverages; Non-alcoholic punch; Non-alcoholic punches; Non-alcoholic rice punch (sikhye); Non-alcoholic soda beverages flavoured with tea; Non-alcoholic sparkling fruit juice drinks; Non-alcoholic syrups for making beverages; Non-alcoholic vegetable juice drinks; Non-alcoholic wine; Non-alcoholic wines; Non-carbonated soft drinks; Nut and soy based beverages; Nutritionally fortified beverages; Nutritionally fortified water; Oat-based beverages [not being milk substitutes]; Orange barley water; Orange juice; Orange juice beverages; Orange juice drinks; Orange squash; Organic fruit juice; Orgeat; Pale ale; Part frozen slush drinks; Pastilles for effervescing beverages; Pineapple juice beverages; Pomegranate juice; Porter; Powders for effervescing beverages; Powders for the preparation of beverages; Powders used in the preparation of coconut water drinks; Powders used in the preparation of fruit-based beverages; Powders used in the preparation of fruit-based drinks; Powders used in the preparation of soft drinks; Preparation for making non-alcoholic beverages; Preparations for making aerated water; Preparations for making beverages; Preparations for making carbonated water; Preparations for making liqueurs; Protein drinks; Protein-enriched sports beverages; Purified drinking water; Quinine water; Ramune (Japanese soda pops); Red ginseng juice beverages; Rice-based beverages, other than milk substitutes; Root beer; Root beers; Root beers, non-alcoholic beverages; Saison beer; Sarsaparilla [non-alcoholic beverage]; Seltzer water; Shandy; Sherbet beverages; Sherbets [beverages]; Slush

drinks; Smoked plum beverages; Smoked plum juice beverages; Smoothies; Smoothies containing grains and oats; Smoothies [fruit beverages, fruit predominating]; Smoothies [non-alcoholic fruit beverages]; Soda pops; Soda water; Soft drinks; Soft drinks flavored with tea; Soft drinks for energy supply; Sorbets [beverages]; Sorbets in the nature of beverages; Soy beverage; Soya-based beverages, other than milk substitutes; Soy-based beverages, not being milk substitutes; Sparkling water; Sports drinks; Sports drinks containing electrolytes; Spring water; Spring waters; Squashes [non-alcoholic beverages]; Still water; Still waters; Stout; Stouts; Syrup for making beverages; Syrup for making lemonade; Syrups and other non-alcoholic preparations for making beverages; Syrups for beverages; Syrups for lemonade; Syrups for making beverages; Syrups for making flavoured mineral waters; Syrups for making fruit-flavored drinks; Syrups for making non-alcoholic beverages; Syrups for making soft drinks; Syrups for making whey-based beverages; Syrups used in the preparation of soft drinks; Table water; Table waters; Tomato juice [beverage]; Tomato juice beverages; Tonic water; Tonic water [non-medicated beverages]; Unfermented preserved must; Vegetable drinks; Vegetable juice; Vegetable juices [beverage]; Vegetable juices [beverages]; Vegetable smoothies; Vegetable-based beverages; Vitamin enriched sparkling water [beverages]; Vitamin fortified non-alcoholic beverages; Water; Water enhanced with minerals; Water (Lithia -); Water (Seltzer -); Water-based beverages containing tea extracts; Watermelon juice; Waters; Waters [beverages]; Waters (Table -); Wheat beer; Whey beverages.