

O/0888/26

TRADE MARKS ACT 1994

IN THE MATTER OF UK APPLICATION NUMBER 4113392

BY GOLDEN GOURMET FOOD CO LTD

TO REGISTER THE FOLLOWING TRADE MARK:



IN CLASS 32

AND

THE OPPOSITION THERETO UNDER NUMBER 453483

BY THE WONDERFUL COMPANY LLC

Background and pleadings

1. On 17 October 2024, Golden Gourmet Food Co Ltd (“the applicant”) applied to register the trade mark shown on the cover page (“the contested mark”) in the UK. It was published in the Trade Marks Journal on 10 January 2025. The following goods were filed for under the mark:

Class 32: Pomegranate juice, fruit beverages and fruit juices.

2. On 10 April 2025, The Wonderful Company LLC (“the opponent”) opposed the trade mark on the basis of sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 (“the Act”). For the purposes of both grounds of the opposition, the opponent relies upon its earlier UK comparable mark and three earlier UK trade marks:¹

1. **POM**

UK registration number: UK00913092143

Filing date: 17 July 2014

Registration date: 18 September 2018

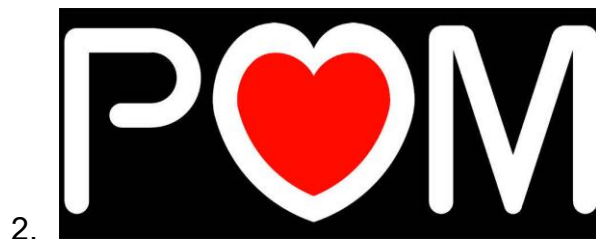
For the following goods:

Class 32: Fruit drinks; fruit juices; syrups and other preparation for making beverages; fruit juice for use as an ingredient for food; non-alcoholic fruit extracts; non-alcoholic fruit concentrate; non-alcoholic fruit extracts used in the preparation of beverages; preparations for making fruit drinks; fruit flavoured beverages (excluding soft drinks and carbonated water); non-alcoholic beverages containing fruit juices; non-alcoholic beverages containing fruit extracts; smoothies; non-alcoholic beverages with tea flavour; low calorie fruit juice drinks; low calorie tea flavoured beverages; fruit juice concentrate; concentrates for making fruit drinks; fruit juice mixes; fruit flavored drinking

¹ On 1 January 2021, the UK left the EU after the expiry of the transition period. Under Article 54 of the Withdrawal Agreement, the Registry created comparable UK trade marks for all rights holders with an existing EUTM. As a result of the opponent’s EUTM being registered as at the end of the Implementation Period, a comparable UK trade mark was automatically created. The comparable UK mark is now recorded on the UK trade mark register, has the same legal status as if it had been applied for and registered under UK law, and retains its original filing date.

water (excluding carbonated drinking water); fruit and vegetable juice beverages; fruit and vegetable drinks; fruit and vegetable juice.

“The opponent’s earlier ‘143 mark”



UK registration number: UK00003781342

Filing date: 26 April 2022

Registration date: 29 July 2022

“The opponent’s earlier ‘342 mark”



UK registration number: UK00003781377

Filing date: 26 April 2022

Registration date: 22 July 2022

“The opponent’s earlier ‘377 mark”



UK registration number: UK00003781335

Filing date: 26 April 2022

Registration date: 22 July 2022

“The opponent’s earlier ‘335 mark”

3. The opponent’s earlier ‘342, ‘377 and ‘335 marks are registered for the following goods:

Class 30: Iced tea and tea-based beverages with fruit flavouring; fruit teas.

Class 31: Fresh fruits; fresh citrus fruits; fruit for use as an ingredient in foods; fruit extract for use as an ingredient in foods; nuts; pomegranates; pomegranate arils; pomegranate extract; gift baskets with fresh fruits; arrangements of fresh fruit.

Class 32: Beers; non-alcoholic beverages; mineral and aerated waters; fruit beverages and fruit juices; syrups and other preparations for making non-alcoholic beverages; fruit drinks; syrups and other preparation for making beverages; fruit juice for use as an ingredient for food; non-alcoholic fruit extracts; non-alcoholic fruit concentrate; non-alcoholic fruit extracts used in the preparation of beverages; preparations for making fruit drinks; fruit flavoured beverages; non-alcoholic beverages containing fruit juices; non-alcoholic beverages containing fruit extracts; smoothies; non-alcoholic beverages with tea flavour; low calorie fruit flavoured beverages; low calorie fruit juice drinks; low calorie tea flavoured beverages; soda; soft drinks; non-carbonated soft drinks; carbonated soft drinks; fruit flavoured soft drinks; fruit juice concentrate; concentrates for making fruit drinks; fruit juice mixes; fruit flavoured drinking water; isotonic beverage; other carbonated drinks (refreshing beverages); carbonated drink mixes; fruit and vegetable juice beverages; fruit and vegetable drinks; fruit and vegetable juice; fruit nectars, non-alcoholic; frozen fruit beverages; iced fruit beverages; powders used in the preparation of fruit based beverages.

4. Under section 5(2)(b), the opponent claims that there is a likelihood of confusion on the basis that the marks are similar, and the goods are either identical or similar

leading to a likelihood of confusion, including a likelihood of association, and that the contested mark should be refused registration.

5. Under section 5(3), the opponent relies upon all four of the above marks, claiming a reputation for all of the goods for which the marks are registered. It claims that use of the applicant's mark would, without due cause, take unfair advantage of, or be detrimental to, the distinctive character and/or repute of the earlier marks.

6. The applicant filed a counterstatement denying these grounds of opposition. It denies any similarity between the marks and goods. It also denies that the contested mark would take unfair advantage of, or be detrimental to, the reputation or distinctive character of the earlier marks.

7. By virtue of their earlier filing dates, the opponent's above registrations constitute earlier marks in accordance with section 6 of the Act.

8. The opponent's earlier '143 mark had been registered for more than five years at the filing date of the contested mark and is, therefore, subject to the proof of use requirements in section 6A of the Act. The opponent provided a statement that it had used the earlier mark for all of the registered goods, and the applicant requested that it file proof of the same.

9. The opponent's earlier '342, '377 and '335 marks had not been registered for more than five years before the filing date of the applicant's mark. These marks are therefore not subject to the use provisions set out in section 6A of the Act.

10. The opponent is represented by Bird & Bird LLP. The applicant is not professionally represented. Both parties filed evidence. No hearing was requested. Only the opponent filed submissions in lieu. This decision is taken after careful consideration of the papers.

EVIDENCE

11. The opponent's evidence was filed in the form of a witness statement, dated 13 October 2025. This was filed by Craig B. Cooper, the Executive Vice President, General Counsel and Secretary of the opponent. The witness statement includes twelve exhibits labelled CBC-1 to CBC-12. The purpose of the evidence is to address

the applicant's request for the opponent to show proof of use for the opponent's earlier '143 mark and reputation for its earlier marks.

12. The applicant's evidence was filed in the form of a witness statement, dated 5 January 2026. This was filed by Mohamed Thasim, a director of the applicant. The witness statement includes one exhibit, labelled EXH A. The purpose of the evidence is to show the use of the contested mark on the relevant goods and to state differences in the market presentation of the goods under the contested mark compared to the goods under the earlier marks.

13. I confirm that I have taken all filed documents into account and will summarise them to the extent that I deem necessary below.

Preliminary issues

14. In its counterstatement, the applicant references differences between the goods provided on the market by the parties.

15. I remind myself of the findings of Dr Brian Whitehead sitting as the Appointed Person in the *City Storage Systems LLC v Kenmark Kitchen Limited*², where he stated:

“18. [...] The authors of Kerly state at 11-055: “it is the goods or services covered by the specification of the marks at issue that must be considered when making this assessment, and not the goods or services actually marketed under those marks”, referring to *Present-Service Ullrich GmbH & Co KG v OHIM* (T-66/11) [2013] E.T.M.R. 29. In that case, the General Court said at 45:

“Secondly, the applicant's claim that it operates in a completely different commercial sector from the intervener is also irrelevant. In order to assess the similarity of the goods or services at issue for the purposes of art.8(1)(b) of Regulation 207/2009, the group of goods or services protected by the marks at issue must be taken into account, and not the goods or services actually marketed under those marks”.

² Decision BL O/0065/24.

16. It follows that, in my assessment, I must assess the similarity of the goods solely on the basis of the specifications as registered and applied for; it is impermissible for me to take into account the goods actually marketed by the parties. I thus disregard this submission from the applicant.

RELEVANCE OF EU LAW

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

Decision

PROOF OF USE

Relevant period

18. As previously set out, as the earlier '143 mark had been registered for more than five years on the date on which the contested mark was filed, Section 6A of the Act applies. It states:

“(1) This Section applies where—

- (a) an application for registration of a trade mark has been published,
- (b) there is an earlier trade mark of a kind falling within section 6(1)(a), (aa) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and
- (c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

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

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

(3) The use conditions are met if –

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

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

(4) For these purposes –

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

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

(5)-(5A) [Repealed]

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

19. As the earlier ‘143 mark is a comparable mark, paragraph 7 of Part 1, Schedule 2A of the Act is also relevant. It reads:

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

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

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

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

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

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

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

20. The relevant period for proof of use of the opponent’s mark is from 18 October 2019 to 17 October 2024. I note that the relevant territory will be considered the EU from 18 October 2019 to 31 December 2020, and the UK only from 1 January 2021 to 17 October 2024.

Relevant case law

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

“105. The principles applicable to determining whether there has been genuine use of a trade mark have been considered by the CJEU in a considerable number of cases, the principal decisions being Case C40/01 Ansul BV v Ajax Brandbeveiliging BV [2003] ECR I-2439, Case C-259/02 La Mer Technology Inc v Laboratories Goemar SA [2004] ECR I-1159, Case C-416/04 P Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and

Designs) [2006] ECR I-4237, Case C-442/07 Verein Radetsky-Order v Bundervsvereinigung Kamaradschaft 'Feldmarschall Radetsky'[2008] ECR I-9223, Case C-495/07 Silberquelle GmbH v Maselli-Strickmode GmbH [2009] ECR I-2759, Case C-149/11 Leno Merken BV v Hagelkruis Beheer BV [EU:C:2012:816], Case C-609/11 Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG [EU:C:2013:592], Case C-141/13 P Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs) [EU:C:2014:2089], Case C-689/15 W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse [EU:C:2017:434] and Joined Cases C-720/18 and C-721/18 Ferrari SpA v DU [EU:C:2020:854].

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

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

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

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

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

at [20]-[21]. But use by a non-profit making association can constitute genuine use: Verein at [16]-[23].

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

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

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no de minimis rule: Ansul at [39]; La Mer at [21], [24] and [25]; Sunrider at [72]; Leno at [55].

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

107. The trade mark proprietor bears the burden of proving genuine use of its trade mark: see section 100 of the 1994 Act and Ferrari at [73]-[83]. The General Court of the European Union has repeatedly held that genuine use of a trade mark cannot be proved by means of probabilities or suppositions, but must be demonstrated by solid and objective evidence of effective and sufficient use of the trade mark on the market concerned: see e.g. Case T-78/19 Lidl Stiftung & Co KG v European Union Intellectual Property Office [EU:C:2020:166] at [25]. It has also repeatedly held that the smaller the commercial volume of the exploitation of the mark, the more necessary it is for the proprietor to produce additional evidence to dispel any doubts as to the genuineness of its use: see e.g. Lidl at [33]. In Awareness Ltd v Plymouth City Council [2013] RPC 24 Daniel Alexander QC sitting as the Appointed Person said:

‘19. For the tribunal to determine in relation to what goods or services there has been genuine use of a mark during the relevant period, it should be provided with clear, precise, detailed and well-supported evidence as to the nature of that use during the period in question from a person properly qualified to know. [...]

22. [...] it is not strictly necessary to exhibit any particular kind of documentation but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal [...] comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public.”

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

Form of the mark

23. Before I move on to assess if the opponent has shown genuine use of the earlier mark, I must first consider if I find the use of the earlier mark as shown in the evidence to be use of the mark as registered and/or use of an acceptable variant of the same.

24. The earlier ‘143 mark is a word-only mark presented in upper case. Given that normal and fair use of the registration will cover use in any standard typeface or font³, where the mark is used in capitals or title case, or a mixture of both, this is use of the mark as registered and is use upon which the opponent may rely. The mark is also shown as follows throughout the evidence on the labels of the bottles themselves:



25. I acknowledge that where a registered mark is used with additional matter, this may still constitute acceptable use of the mark as registered, where this element continues to act independently as an indicator of origin.⁴

26. The above variation shows the word “POM” presented on the bottles themselves. The word “POM” is prominently displayed at the top of the mark in a large, stylised font of differing colours. The letter O of the word “POM” is displayed as a heart, with the centre of the heart filled in red. While the heart is obvious, it is clearly intended to

³ *Dreamersclub Ltd v KTS Group Ltd*, BL O/091/19 and *La Superquímica v EUIPO*, T-24/17, EU:T:2018:668

⁴ *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12

be a stylised version of the letter O. I do not consider that the average consumer would attribute a specific meaning to this; it would be considered decorative.

27. Beneath the word “POM” are the words “WONDERFUL” and “ANTIOXIDANT”. These words may be perceived as giving information regarding the quality and content of the product. These additional words are indicative of information contained on the label of a product and are non-distinctive, since they are descriptive elements regarding the goods on offer.

28. I consider that the stylised word, “POM”, remains the dominant element in the variant shown and is therefore an acceptable variation of the mark and is use upon which the opponent can rely.

Genuine use

29. In the opponent’s witness statement, Mr Cooper states that the opponent acquired intellectual property rights from its wholly owned subsidiary POM Wonderful LLC on 1 September 2015, including the rights upon which the opposition is based.

30. He further states that POM Wonderful LLC was founded in Los Angeles, California in 2002. Following success in the US market, the brand was expanded into the international market and has reached consumers in over 55 countries worldwide, including across the UK and the EU. Mr Cooper states that the opponent is a world leader in producing and selling pomegranate products, including fresh pomegranates, pomegranate arils (seeds), 100% pure pomegranate juice and pomegranate juice blends.

31. CBC-1 shows the earlier marks on the UKIPO trade mark register.

32. CBC-2 includes multiple social media posts showing images of bottles of 100% pomegranate juice, posted between 22 May 2020 and 3 January 2024. The posts are made by accounts named POM Wonderful UK. Although social media has a global reach, the posts are made by accounts named POM Wonderful UK and pomwonderfuluk, which suggests that these posts are intended for a UK audience. In each post, the same logo is used on the bottles, being:



33. Mr Cooper states that a significant amount of money has been invested in advertising and promotion of products under the POM brand in the UK. In the period of 2009 to 2011, over £4.3 million was spent on advertising and promotional activities in the UK. Mr Cooper states that the opponent continues to invest significantly in advertising and promotion of its products in the UK since then, and provides the following figures for promotional expenditure relating to fruit juices and beverages sold under the POM brand in Europe, including the UK. No explanation is given as to why the figures are presented in different currencies.

Year	Figure
2017	€383,341
2018	USD 1,982,074
2019	USD 1,486,603

34. Mr Cooper refers to exhibit CBC-3, stating that it includes spreadsheets giving an itemised breakdown of the above figures. The first spreadsheet shows the amount spent on each type of promotion and marketing between the year 2012 and quarter 1 of 2018. The following two spreadsheets show the division of the above promotional expenditure figures into the countries within Europe for the years 2018 and 2019. I note that many of these figures are outside of the relevant period.

35. Mr Cooper does not refer to the final spreadsheet in exhibit CBC-3 in his witness statement. This spreadsheet appears to show sales of products categorised as 'POM' across Europe, including the UK, in 2018 and 2019. With no further information, I cannot determine what these products were, only that they were categorised as 'POM'.

36. In his witness statement, Mr Cooper states that the opponent has carried out a number of different advertising and promotional activities. Exhibit CBC-4 includes social media posts from “pomwonderfuluk”. Most of these posts show a bottle of 100% pomegranate juice with the logo on the bottle as shown in paragraph 26. These posts are all within the relevant period. Mr Cooper states that the opponent’s Facebook page has over 343,000 followers, its Instagram page has 28,000 followers and its Twitter page has 12,000 followers. I note that, as social media has a global reach, it is not possible to determine what proportion of these followers are UK consumers.

37. Mr Cooper further states that, in 2020, the opponent teamed up with social media influencers to promote goods under the POM brand. Exhibit CBC-5 includes examples of posts shared by influencers, many of which include pomegranate juice bottles bearing the POM brand. However, I note that the majority of the posts relate to almonds or pistachios not sold under the POM brand.

38. Mr Cooper states that the POM brands have always had an active presence in the UK and promotion has taken place through many different channels. Exhibit CBC-6 includes Facebook posts showing free samples of pomegranate juice under the POM brand being given to members of the public at various locations. I note that some of these posts are dated before the relevant period, although many of them fall within the relevant period.

39. Exhibit CBC-7 includes social media posts advertising competitions to win vouchers for POM branded products. These posts all fall within the relevant period. Mr Cooper also states that a marketing campaign was undertaken on Facebook and Instagram in 2022, promoting the use of POM branded fruit juice in mocktails. Exhibit CBC-8 provides information about this campaign, including that it reached over 286,000 customers.

40. Mr Cooper states that online press reports and articles have been posted on various websites and online blogs discussing the POM brand. Examples of these are shown at Exhibit CBC-9. The first three articles were posted by the opponent in 2021 and 2022, and reference the US market throughout, as well as providing figures in US dollars. Although these blogs are available anywhere on the internet, they are clearly targeted at a US audience. The fourth article was posted by a third-party in June 2024.

This article compares pomegranate juice brands, including POM. The author is based in the US, but it is not clear whether this article is aimed solely at US customers, or a worldwide audience.

41. Mr Cooper states that sales of the POM brand throughout the UK have generated millions of pounds of income. He states that Exhibit CBC-10 shows sales figures for POM branded products in the UK between 2019 and 2024 through the top 12 grocery retailers. It also shows that sales figures for POM brand products have reached £26,155,898 in the UK in the last 5 years. I note that these figures are not broken down by goods, and therefore it is not possible to determine what proportion of these figures relate to each good.

42. Example invoices to these major grocery retailers are provided at Exhibit CBC-11. I note that the POM brand does not appear at the top of the invoice, but the word “POM” appears in the item description. I also note that the first few invoices are dated before the relevant period, but the majority of the invoices are dated during the relevant period.

43. Mr Cooper states that the majority of the opponent’s sales in the UK are made through authorised stockists, including the major grocery retailers discussed above. He also states that POM branded goods are offered for sale through Amazon in the UK. Screenshots showing pomegranate juice bearing the POM brand for sale on Amazon, Costco, Sainsburys, Waitrose, Ocado and Asda websites are provided in Exhibit CBC-12. I note that most, although not all, of these screenshots show that the products were for sale during the relevant period.

44. The evidence is not without its limitations. For example, there is no reference to the overall size of the relevant UK market. In addition, much of the marketing expenditure is only provided before the relevant period. Further, the articles discussing POM branded juices appear to be targeted at a US audience, not at the relevant consumer.

45. An assessment of genuine use is a global assessment, which includes looking at the evidence as a whole.⁵ The evidence presented demonstrates that goods bearing

⁵ *New Yorker SHK Jeans GmbH & Co. KG v OHIM*, Case T-415/09

the opponent's mark were purchased by a number of different consumers across the UK. The invoices show that the sales were geographically widespread in this territory. Whilst I have not been made aware of the market share held by the opponent, taking the turnover figures, evidence of sales and the promotional materials into consideration, I am satisfied that the opponent has shown genuine use of its mark.

Fair specification

46. Having reached the above conclusion, I must determine a fair specification upon which the opponent is entitled to rely, bearing in mind the use that has been demonstrated.

47. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law as being:

“In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”

48. In *Merck KGaA v Merck Sharp & Dohme Corp & Ors* [2017] EWCA Civ 1834 the Court of Appeal set out the proper approach to partial revocation, as follows:

“245. First, it is necessary to identify the goods or services in relation to which the mark has been used during the relevant period.

246. Secondly, the goods or services for which the mark is registered must be considered. If the mark is registered for a category of goods or services which is sufficiently broad that it is possible to identify within it a number of subcategories capable of being viewed independently, use of the mark in relation to one or more of the subcategories will not constitute use of the mark in relation to all of the other subcategories.

247. Thirdly, it is not possible for a proprietor to use the mark in relation to all possible variations of a product or service. So care must be taken to ensure this

exercise does not result in the proprietor being stripped of protection for goods or services which, though not the same as those for which use has been proved, are not in essence different from them and cannot be distinguished from them other than in an arbitrary way.

248. Fourthly, these issues are to be considered having regard to the perception of the average consumer and the purpose and intended use of the products or services in issue. Ultimately it is the task of the tribunal to arrive at a fair specification of goods or services having regard to the use which has been made of the mark.

249. This approach does strike an appropriate balance. It gives effect to the clear intention of the EU legislature that marks must actually be used or, if not used, be subject to revocation. [...] It is also fair to proprietors for it does not require a proprietor to prove that he has used his mark in relation to all possible variations of the goods or services covered by its registration but only those which are sufficiently distinct to constitute coherent categories or subcategories. I am also satisfied that it gives appropriate protection to the legitimate interest of a proprietor in being able in the future to extend his range of goods or services within the scope of the terms describing the goods or services for which its mark is registered.”

49. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch) at [47], the late Carr J pointed out that it is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do; for example, in *Pan World Brands v Tripp Ltd (Extreme Trade Mark)* [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally.

50. It is also the case that the purpose or intended use of a product is vital in determining whether goods are a coherent subcategory. In *Polfarmex S.A. v EUIPO*, Case T-677/19, EU:T:2020:424, the General Court said:

“116. As regards the question whether goods are part of a coherent subcategory which is capable of being viewed independently, it is apparent from

the case-law that, since consumers are searching primarily for a product or service which can meet their specific needs, the purpose or intended use of the product or service at issue is vital in directing their choices. Consequently, since consumers do employ the criterion of the purpose or intended use before making any purchase, it is of fundamental importance in the definition of a subcategory of goods or services (judgments of 13 February 2007, RESPICUR, T-256/04, EU:T:2007:46, paragraph 29, and of 16 May 2013, Aleris v OHIM – Carefusion 303 (ALARIS), T-353/12, not published, EU:T:2013:257, paragraph 22). In contrast, the nature of the goods at issue and their characteristics are not, as such, relevant to the definition of subcategories of goods or services (see judgment of 18 October 2016, August Storck v EUIPO – Chiquita 25 Brands (Fruitfuls), T-367/14, not published, EU:T:2016:615, paragraph 32 and the case-law cited).”

51. Having reviewed the evidence, I am satisfied that the use of the mark has been established for 100% pomegranate juice. I have not been shown evidence for any other products under the mark.

52. The opponent’s goods relied upon are shown in paragraph 2 above. I have not been shown evidence for the full scope of these goods; I have only been shown use for 100% pomegranate juice. I consider that the scope of goods for which use has been shown is contained within the term ‘fruit juices’.

53. As such, a fair specification for the earlier ‘143 registration is as follows:

Class 32: Fruit juices.

Section 5(2)(b)

54. Section 5(2)(b) of the Act is as follows:

“5(2) A trade mark shall not be registered if because-

(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”.

Section 5A

55. Section 5A of the Act is as follows:

“5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

The principles

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

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors;
- (b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
- (d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

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

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

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

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

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

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense; and

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

Comparison of goods

56. 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 für 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.”

57. With this in mind, the goods for comparison are as follows:

Opponent’s goods:	Applicant’s contested goods:
Under the earlier ‘143 mark: <i>Class 32: Fruit juices.</i> Under the earlier ‘342, ‘377 and ‘335 marks: <i>Class 30: Iced tea and tea-based beverages with fruit flavouring; fruit teas.</i> <i>Class 31: Fresh fruits; fresh citrus fruits; fruit for use as an ingredient in foods; fruit extract for use as an ingredient in foods; nuts; pomegranates; pomegranate arils; pomegranate extract; gift baskets with fresh fruits; arrangements of fresh fruit.</i> <i>Class 32: Beers; non-alcoholic beverages; mineral and aerated waters; fruit beverages and fruit juices; syrups and other preparations for making non-alcoholic beverages; fruit drinks; syrups and other preparation for making beverages; fruit juice for use as an ingredient for food; non-alcoholic fruit extracts; non-alcoholic fruit concentrate; non-alcoholic fruit extracts used in the preparation of beverages; preparations for making fruit drinks; fruit flavoured beverages; non-alcoholic beverages containing fruit juices; non-alcoholic beverages containing fruit extracts; smoothies; non-alcoholic beverages with tea</i>	<i>Class 32: Pomegranate juice, fruit beverages and fruit juices.</i>

<i>flavour; low calorie fruit flavoured beverages; low calorie fruit juice drinks; low calorie tea flavoured beverages; soda; soft drinks; non-carbonated soft drinks; carbonated soft drinks; fruit flavoured soft drinks; fruit juice concentrate; concentrates for making fruit drinks; fruit juice mixes; fruit flavoured drinking water; isotonic beverage; other carbonated drinks (refreshing beverages); carbonated drink mixes; fruit and vegetable juice beverages; fruit and vegetable drinks; fruit and vegetable juice; fruit nectars, non-alcoholic; frozen fruit beverages; iced fruit beverages; powders used in the preparation of fruit based beverages.</i>	
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Pomegranate juice, fruit beverages and fruit juices

58. The above goods fall under the scope of, or overlap in scope with, ‘fruit juices’ under the opponent’s earlier ‘143 mark. The goods are therefore identical according to the principles of *Meric*.

59. The above goods fall under the scope of, or overlap in scope with, ‘*fruit beverages and fruit juices*’ under the opponent’s earlier ‘342, ‘377 and ‘335 marks. The goods are therefore identical according to the principles of *Meric*.

Comparison of marks

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

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

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

62. The respective trade marks are shown below:

The opponent's earlier marks:	The applicant's contested mark:
1. POM “The opponent's earlier ‘143 mark”  2. “The opponent's earlier ‘342 mark”  3. WONDERFUL “The opponent's earlier ‘377 mark”	

4.  "The opponent's earlier '335 mark"	
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63. In its submissions in lieu, the opponent submits that the marks are highly visually similar, either phonetically identical or highly similar and either conceptually identical or highly similar. In its counterstatement, the applicant states that the marks are visually and conceptually dissimilar.

Overall impression

64. The opponent's earlier '143 registration is a word-only mark consisting of the word "POM". The word element of this mark is dominant.

65. The opponent's earlier '342 registration is a figurative mark consisting of the letters P and M with a heart between the two. The letters are in a stylised font, and are white, while the background is black. The centre of the heart is also filled in red. As a whole, I consider it likely that this mark would be read as "POM", with the heart forming a figurative version of the letter O. The word element is dominant in the mark, with the stylisation playing a lesser role.

66. The opponent's earlier '377 and '335 registrations are figurative marks consisting of the letters P and M with a heart between the two, as in the earlier '342 registration, with the word "wonderful" underneath. In the earlier '377 registration, "POM" is in black with a red interior to the heart, "wonderful" is in red and the mark has a white background. In the earlier '335 registration, "POM" is in white with a red interior to the heart, "wonderful" is in red and the mark has a black background. As above, these marks will be read as "POM", with the heart forming a figurative version of the letter O. The letters "POM" are dominant in the mark, with the word "wonderful" playing a lesser role, and the stylisation playing an even lesser role.

67. The contested mark is a figurative mark consisting of the letters P and M with an image of a pomegranate between the two. The letters are red with a white border and the background has a brown pattern. As a whole, this mark can be viewed as “POM”, with the pomegranate forming a figurative version of the letter O. The letters of the mark are dominant, with the stylisation playing a lesser role.

Visual comparison

68. The letters P and M act as a point of visual similarity between the marks. All of the marks also contain a shape between these letters that can be seen to be a stylised letter O. The marks also overlap in their use of the colours white and red, albeit in different shades.

69. The marks differ where the stylised letter O is a heart shape in the earlier marks and an image of a pomegranate in the contested mark.

70. The marks differ where the earlier ‘342 and ‘335 marks have a black background, while the contested mark has a brown patterned background. The earlier ‘377 mark also differs as it consists of black lettering on a white background.

71. The earlier ‘335 and ‘377 marks further differ from the contested mark as they contain the word “wonderful”.

72. Overall, I consider the earlier ‘143 and ‘342 marks to have a high visual similarity to the contested mark.

73. I consider the earlier ‘335 and ‘377 marks to have between a medium and high visual similarity to the contested mark.

Aural comparison

74. All of the marks contain the aural element “POM”, which will be pronounced as a single syllable.

75. This is the only element in the earlier ‘143 and ‘342 marks. Consequently, these marks are aurally identical to the contested mark.

76. The earlier '335 and '377 marks further contain the word “wonderful”, which will be pronounced in the usual way. As this word plays a lesser role within the mark, I consider these marks to be aurally highly similar to the contested mark.

Conceptual comparison

77. The marks all consist of the word “POM”. This word does not have a meaning in itself but may be perceived by consumers as a shortening of the word pomegranate. Although I acknowledge that the assessment of conceptual meaning is usually possible without reference to the goods, in circumstances such as this it is necessary to have the goods in mind to determine whether there is any conceptual allusion to them.⁶ In this situation, the goods are fruit juice and, as such, I consider it even more likely that the word “POM” will bring to mind the word pomegranate for consumers. I consider this to be the case for the word “POM” in all of the marks.

78. The earlier '335 and '377 marks further contain the word “wonderful”, which will be understood to be suggestive of the quality of the goods and services, and therefore will not alter the conceptual nature of the word “POM”.

79. Overall, I consider all of the earlier marks to be conceptually identical to the contested mark.

Average consumer and the purchasing act

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

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

⁶ BL O/1174/25.

- (a) Consumers who are ill-informed or careless, or consumers with specialised knowledge or who are excessively careful are excluded from consideration;
- (b) The average consumer provides a standard which enables the courts to strike a balance between the competing interests involved, such as trade mark owners, their competitors and consumers;
- (c) The average consumer is neither a single hypothetical person nor a mathematical average; assessment from the perspective of the average consumer does not involve a statistical test. There is no single meaning rule and if, having regard to the perceptions and expectations of the average consumer, the court considers that a significant proportion of the relevant public is likely to be confused, a finding of infringement may properly be made;
- (d) Assessment from the perspective of the average consumer is intended to facilitate adjudication of trade mark disputes by providing an objective criterion, by promoting consistency of assessment and by enabling courts and tribunals to determine such issues so far as possible without the need for evidence;
- (e) The average consumer's level of attention varies according to the category of goods or services in question; and
- (f) the average consumer rarely has the opportunity to make direct comparisons between trade marks (or between trade marks and signs) and must instead rely upon the imperfect picture of the trade mark they have kept in their mind.

82. The goods at issue will be purchased by the general public. Consideration will be taken of price, ingredients and quality. The general public will pay an average (or medium) degree of attention during the purchasing process.

83. The goods at issue will be purchased in-person in supermarkets and convenience stores, although they may also be purchased online. I do not discount aural considerations as advice may be sought from a sales advisor; however, I consider that visual considerations will play a larger role as the consumer will see the products visually before purchase.

Distinctive character of the earlier trade marks

84. 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).”

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

86. As noted above, the word “POM” is dominant in all of the earlier marks. This word may be seen as allusive of the goods, being fruit juices, as consumers will understand the word “POM” to be a shortening of the word pomegranate. As such, I consider the opponent’s earlier ‘143 mark to have a just below medium inherent distinctive character.

87. The stylisation of the word “POM” in the opponent’s earlier ‘342 mark slightly increases the distinctiveness of the mark as the letter O is replaced by a heart. I consider this mark to have a medium inherent distinctive character regardless of the understanding of the word “POM”.

88. The additional word “WONDERFUL” underneath “POM” in the opponent’s earlier ‘377 and ‘335 marks is not particularly striking and I do not consider it to significantly increase the distinctiveness of the mark overall. I consider these marks to have a medium inherent distinctive character regardless of the understanding of the word “POM”.

89. As the opponent has filed evidence of use of its marks, I will consider whether this evidence demonstrates enhanced distinctiveness of the marks.

90. The evidence shows that the use of the marks for the registered fruit juices has been longstanding and consistent, with continuous sales over a number of years. The opponent states that its sales figure for the 5 year relevant period is over £26,155,898. This does not seem insignificant, although no information is provided relating to the overall UK market for fruit juices.

91. The opponent states that it has invested a significant amount of money in advertising and promotion, amounting to £4,300,000 from 2009 to 2011. Since that time, the opponent states that investment has continued. Promotional expenditure for Europe, including the UK, in relation to fruit juices and beverages sold under the POM brand is provided, being €383,341 in 2017, USD 1,982,074 in 2018 and USD 1,486,603 in 2019. The evidence shows that this promotion consists of social media posts with influencers, competitions run through Facebook and brand events.

92. Overall, the evidence shows consistent and geographically widespread sales of the goods in the UK over a number of years. Having considered the evidence as a whole, I find that the opponent has demonstrated some enhancement to the distinctive character of its earlier marks as a result of use. The distinctive character of the marks has therefore been enhanced to an above medium degree.

Likelihood of Confusion

93. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. 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 (*Canon* at [17]). It is necessary to keep in mind the distinctive character of the opponent's trade marks, the average consumer of the goods and the nature of the purchasing act. In doing so, I must be alive to 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 that they have retained in their mind (*Lloyd Schuhfabrik* at [26]).

94. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is 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 undertakings being the same or related.

95. Earlier in this decision, I found that the goods were identical. I identified the average consumer to be members of the general public, paying an average (or medium) degree of attention. I found that the goods would be selected primarily by visual means, although I do not discount aural components. I found the earlier '143 and '342 marks to have a high visual similarity and to be aurally and conceptually identical to the contested mark. I found the earlier '335 and '377 marks to have a medium-to-high visual similarity, a high aural similarity and to be conceptually identical to the contested mark. I found the opponent's earlier registrations to possess a just below medium or medium degree of inherent distinctive character for the relevant goods, which had been enhanced to an above medium degree through use.

96. As noted above, the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that they have retained in their mind (*Lloyd Schuhfabrik* at [26]).

97. Firstly, considering direct confusion, I note the significant visual and aural similarities between the marks, as well as the conceptual identity. I note that the marks

contain differing stylistic and figurative elements. Taking all of the relevant factors into account and bearing in mind the principle of imperfect recollection, I am satisfied that the average consumer, paying a medium degree of attention, is likely to forget which marks include which figurative and stylistic elements. I am satisfied that the average consumer will pin their recollection of the marks at issue on the word “POM”. Despite being slightly allusive of the goods, being a shortening of pomegranate, this word is the dominant element of both marks.

98. Taking all of the above into account, I find direct confusion between the contested mark and all of the earlier marks in respect of the contested goods.

99. If I am wrong, I will proceed to consider whether there is a likelihood of indirect confusion, whilst reminding myself that, as James Mellor QC sitting as the Appointed Person pointed out in *Cheeky Italian Ltd v Sutaria* (O/219/16) at [16], “a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion”.

100. In *L.A. Sugar Limited v By Back Beat Inc*, BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, explained that:

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

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

- (a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right ('26 RED TESCO' would no doubt be such a case).
- (b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as 'LITE', 'EXPRESS', 'WORLDWIDE', 'MINI' etc.).
- (c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension ('FAT FACE' to 'BRAT FACE' for example)."

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

102. Earlier I found that the word "POM" is the main distinctive element in all of the marks. Further, I found that the stylisation of the marks plays a small role. Overall, I consider that the word "POM" has an independent distinctive significance in both of the marks.

103. I find it likely in this instance that if a consumer does notice the stylistic differences or additional descriptive words, they will put the differences down to an alternative mark from the same undertaking, or a rebrand. The consumer is therefore likely to conclude that the goods are supplied by the same, or economically linked, undertakings.

104. Taking all of this into account, I consider there to be a likelihood of indirect confusion in relation to the applicant's goods.

Conclusion

105. The opposition under section 5(2)(b) succeeds in its entirety.

Section 5(3)

106. Section 5(3) of the Act states:

“(3) A trade mark which-

is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark”.

107. Section 5(3A) of the Act states:

“(3A) Subsection (3) applies irrespective of whether the goods and services for which the trade mark is to be registered are identical with, similar to or not similar to those for which the earlier trade mark is protected”.

Paragraph 10 of Part 1, Schedule 2A of the Act is also relevant. It reads as follows:

“(1) Sections 5 and 10 apply in relation to a comparable trade mark (EU), subject to the modifications set out below.

(2) Where the reputation of a comparable trade mark (EU) falls to be considered in respect of any time before IP completion day, references in sections 5(3) and 10(3) to –

(a) the reputation of the mark are to be treated as references to the reputation of the corresponding EUTM; and

(b) the United Kingdom includes the European Union.”

108. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, Case C-252/07, *Intel*, Case C-408/01, *AdidasSalomon*, Case C-487/07, *L’Oreal v Bellure* and Case C-323/09, *Marks and Spencer v Interflora*

and Case C-383/12P, *Environmental Manufacturing LLP v OHIM*. The law appears to be as follows:

(a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; General Motors, paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; General Motors, paragraph 26.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; Adidas Salomon, paragraph 29 and Intel, paragraph 63.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; Intel, paragraph 42.

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; Intel, paragraph 68; whether this is the case must also be assessed globally, taking account of all relevant factors; Intel, paragraph 79.

(f) The more immediately and strongly the earlier mark is brought to mind by the later mark, the greater the likelihood that use of the latter will take unfair advantage of, or will be detrimental to, the distinctive character or the repute of the earlier mark; L'Oreal v Bellure NV, paragraph 44.

(g) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that

this will happen in future; Intel, paragraphs 76 and 77 and Environmental Manufacturing, paragraph 34.

(h) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; Intel, paragraph 74.

(i) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; L'Oreal v Bellure NV, paragraph 40. The stronger the reputation of the earlier mark, the easier it will be to prove that detriment has been caused to it; L'Oreal v Bellure NV, paragraph 44.

(j) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (Marks and Spencer v Interflora, paragraph 74 and the court's answer to question 1 in L'Oreal v Bellure).

109. The conditions of section 5(3) are cumulative. Firstly, the opponent must show that the marks are identical or similar, and I have discussed their level of similarity in paragraphs 64 to 79 above. Secondly, the opponent must show that its marks have achieved a level of knowledge/reputation amongst a significant part of the public throughout the relevant territory. Thirdly, it must be established that the level of reputation and the similarities between the parties' marks will cause the public to make a link between them. Finally, assuming the first three conditions have been met,

section 5(3) requires that one or more of the types of damage will occur. It is unnecessary for the purposes of section 5(3) that the goods be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks. The relevant date for the assessment under section 5(3) is the filing date of the contested mark, i.e. 17 October 2024.

Reputation

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

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

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

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

28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation ‘in the Member State’. In the absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation ‘throughout’ the territory of the Member State. It is sufficient for it to exist in a substantial part of it.”

111. In determining whether the opponent has demonstrated a reputation for the goods in issue, it is necessary for me to consider whether its mark will be known by a significant part of the public concerned with the goods. In reaching this decision, I must take all of the evidence into account including “the market share held by the trade mark, the intensity, geographical extent and duration of use, and the size of the

investment made by the undertakings in promoting it”.⁷ I have summarised what I consider to be the key factors from the opponent’s evidence at paragraphs 29 to 45 above.

112. I have already found that the evidence was sufficient for the purposes of establishing that the distinctive character of the opponent’s mark had been enhanced at the relevant date. Whilst I acknowledge that reputation and enhanced distinctive character are different, the nature, factors, and evidence used to prove them are the same.⁸ For the same reasons as given at paragraphs 89 to 92, I am satisfied that the opponent’s mark had a moderate qualifying reputation at the relevant date for fruit juices.

113. I found no proof of use for the opponent’s remaining goods and also find no reputation for said goods.

Link

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

The degree of similarity between the conflicting marks

115. I have already found that the earlier ‘143 and ‘342 marks are visually similar to a high degree and aurally and conceptually identical to the contested mark. I also found that the earlier ‘335 and ‘377 marks are visually similar to a medium-to-high degree, aurally similar to a high degree and conceptually identical to the contested mark.

The nature of the goods for which the conflicting marks are registered, or proposed to be registered, including the degree of closeness or dissimilarity between those goods, and the relevant section of the public

⁷ *General Motors* paragraph 27.

⁸ *O2 Worldwide Limited v CX02.COM (UK) Limited*, BL O/393/19, paragraph 39

116. I have found the parties' goods considered above to be identical. I apply the same findings in relation to the relevant public and purchasing process as set out above in paragraphs 82 and 83.

The strength of the earlier marks' reputation

117. The earlier marks enjoy a moderate reputation in relation to the goods for which they are registered.

The degree of the earlier marks' distinctive character, whether inherent or acquired through use

118. As set out previously, I find the opponent's mark to hold a just below medium or medium degree of inherent distinctive character. I am satisfied, however, that the mark's distinctiveness has been enhanced to above a medium degree in respect of the relied upon goods.

Whether there is a likelihood of confusion

119. Earlier in my decision I found a likelihood of direct confusion between the parties' marks in respect of all the designated goods.

Conclusions on link

120. Having already found that the average consumer is likely to mistake the competing marks for one another or assume that there is an economic connection between the undertakings thereof, it is highly likely that the relevant public will make the requisite link between them. Even if I had found that there was no likelihood of confusion, taking all the factors into account, it is my view that the opponent's marks would still be brought to mind by a significant part of the relevant public upon encountering the contested mark. Taking into account all the above factors, I consider that a link would be made between the earlier marks and the contested mark in relation to identical goods, given the inclusion of the dominant word "POM" in all of the marks.

Damage

121. I must now consider whether any of the possible damage which has been pleaded will arise.

Unfair advantage

122. In its submissions in lieu, the opponent writes as follows in respect of unfair advantage:

“67. Naturally, the relevant public (the public at large for the relevant goods here) would regard the Opposed Mark as being linked or somewhat endorsed by the Opponent, which would be taking unfair advantage of the Opponent’s reputation that has been built up in the Earlier Marks.”

123. I note that in *Argos Limited v Argos Systems Inc* [2018] EWCA Civ 2211, the Court of Appeal held that a change in the economic behaviour of the customers for the goods and/or services offered under the later trade mark was required to establish unfair advantage. This may be inferred where the later trade mark would gain a commercial advantage from the transfer of the image of the earlier trade mark to the later mark: see *Claridges Hotel Limited v Claridge Candles Limited & Anor* [2019] EWHC 2003 (IPEC).

124. Unfair advantage does not require proof of a subjective intention by the applicant to benefit from the reputation of the opponent’s mark. In *Jack Wills Limited v House of Fraser (Stores) Limited* [2014] EWHC 110 (Ch) Arnold J. (as he then was) considered the earlier case law and concluded that:

“80. The arguments in the present case give rise to two questions with regard to taking unfair advantage. The first concerns the relevance of the defendant’s intention. It is clear both from the wording of Article 5(2) of the Directive and Article 9(1)(c) of the Regulation and from the case law of the Court of Justice interpreting these provisions that this aspect of the legislation is directed at a particular form of unfair competition. It is also clear from the case law both of the Court of Justice and of the Court of Appeal that the defendant’s conduct is most likely to be regarded as unfair where he intends to benefit from the

reputation and goodwill of the trade mark. In my judgment, however, there is nothing in the case law to preclude the court from concluding in an appropriate case that the use of a sign the objective effect of which is to enable the defendant to benefit from the reputation and goodwill of the trade mark amounts to unfair advantage even if it is not proved that the defendant subjectively intended to exploit that reputation and goodwill.”

125. For there to be an unfair advantage, it means that consumers are more likely to buy the goods of the contested mark than they would otherwise have been if they had not been reminded of the earlier marks. I have already found that there is a likelihood of direct confusion between the marks, whereby the marks may be mistaken for one another. In such circumstances, it is clearly foreseeable that the applicant will secure an unfair commercial advantage by benefitting from the opponent’s repute without paying financial compensation. Consequently, I find that damage is made out in respect of all the designated goods.

126. As I have found there to be unfair advantage, I do not consider it necessary to assess the other pleaded heads of damage.

Conclusion

127. The opposition under section 5(3) succeeds.

CONCLUSION

128. The opposition under sections 5(2)(b) and 5(3) of the Act is successful. Subject to any appeal against this decision, the application shall be refused protection in the UK.

COSTS

129. The opponent has achieved success in these proceedings and is therefore entitled to a contribution towards its costs. In the circumstances, I award the opponent the sum of **£1600** as a contribution towards the costs of the proceedings, in accordance with Tribunal Practice Notice 1/2023. The sum is calculated as follows:

Official fee for filing Form TM7:	£200
Preparing the Statement of Grounds and considering the Counterstatement:	£250
Filing evidence:	£800
Preparing written submissions-in-lieu:	£350
Total:	£1600

130. I therefore order Golden Gourmet Food Co Ltd to pay The Wonderful Company LLC the sum of **£1600**. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 30th day of September 2026

K HAZLEBACH

For the Registrar