

O-148-08

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO 2406905  
BY MYLES MORIARTY  
TO REGISTER THE TRADE MARK:**

**THE FRUIT, THE WHOLE FRUIT AND NOTHING BUT THE FRUIT**

**IN CLASS 32**

**AND**

**IN THE MATTER OF OPPOSITION NO 94283  
BY ONLINE CATERING T/A JUICE4U**

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**IN THE MATTER OF Application No 2406905**

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**To register a trade mark in Class 32**

**and**

**IN THE MATTER OF Opposition No 94283**

**By Online Catering t/a Juice4U**

### **BACKGROUND**

1. On 18 November 2005 Miles Moriarty applied to register the following trade mark (which I will later refer to as “The Fruit mark”) for the following goods:

THE FRUIT, THE WHOLE FRUIT AND NOTHING BUT THE FRUIT

Class 32 – Smoothie drinks, fruit juice drinks, vegetable juice drinks.

2. On 13 April 2006 Online Catering t/a Juice4U filed a notice of opposition based on the sole ground of section 5(4)(a) of the Trade Marks Act 1994 (“the Act”). The opponent relies on their use of the sign “The juice, the whole juice and nothing but the juice” (I will refer to this as “the Juice sign”) which they say has been used on fruit juice labels since June 2002 and, as such, the applicant’s potential use is liable to be prevented under the law of passing-off.

3. The applicant filed a counterstatement denying the ground of opposition on the basis that the goods sold under his mark contain the whole fruit rather than just squeezed juice and that his mark is dissimilar from the Juice sign.

4. Only the opponent filed evidence, this is summarised below. Neither side requested a hearing. Both sides filed written submissions in lieu of attending a hearing; the opponent’s submissions were made by their trade mark attorneys Jeffrey Parker & Company. All submissions will be drawn upon and taken into account in this decision, but I do not intend to summarise them separately.

### **Opponent’s evidence**

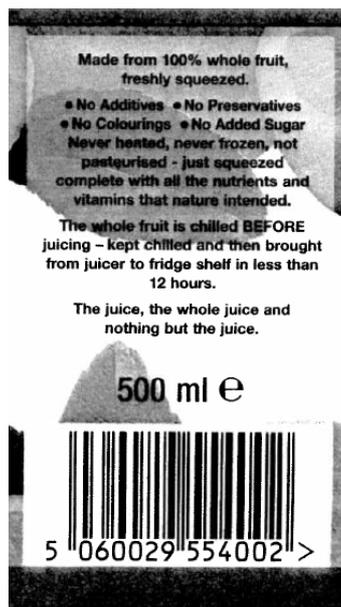
#### Witness statement of Ashley Woodhams

5. Mr Woodhams is a previous employee of the opponent company. His evidence details how the Juice sign was coined. In summary, Mr Woodhams states that as part of his employment working on marketing concepts he “invented” the Juice sign in February 2001. It was chosen due to the play on words with the phrase “the truth, the whole truth and nothing but the truth”. The Juice sign is said to underline the benefits of the product

being, as it is, completely natural. The use of the word “juice” three times is said to reiterate the focus of the product (juice) and furthermore, because the original phrase uses the word truth (even though this is replaced by the word “juice” in the sign) there is a subliminal message of honesty.

Witness statement of Shadi Namini

6. Mr Namini is the Managing Director of the opponent company. He states that the Juice sign has been used continuously since June 2002. Exhibit SN1 consists of a bottle and various labels which carry the Juice sign; he states that they are representative of the use that has been made. The bottle and one of the labels are shown below; the label is only part reproduced, but, it is the part that features the Juice sign, it is the part of the label that would, when applied, be on the reverse side of a bottle:



7. I note that the primary sign denoting origin on these exhibits is not the Juice sign, although, as can be seen, it does appear on them. In relation to the bottle, the words JUICE REPUBLIC form the primary sign of origin and, in relation to the label, the words Juice4U performs this primary function of origin denotation. The relevance of this will be discussed later.

8. Mr Namini then explains how the Juice sign was coined. As this is covered by the evidence of Mr Woodhams, and the facts that Mr Namini gives are the same, I shall say no more. He then refers to evidence from what he describes as “the trade”. This consists of two letters addressed “to whom it may concern” from two companies (Encase Corrugated Packaging and The West Island Group) who appear to be involved in the supply of packaging for the goods and the printing of labels for them. Essentially, the letters advise that the Juice sign has been used on the opponent’s labels.

9. Turnover figures for UK sales are then given, they are:

2002	£250, 000
2003	£743, 000
2004	£965, 000
2005	£1, 412, 000

10. It is stated that turnover increased dramatically in 2006 (to £2,164,000) and continues to rise. It is confirmed that the Juice sign is used on each bottle of the goods sold as part of the above turnover.

11. Mr Namini then explains how the goods are promoted. He states that the goods are promoted at food festivals such as *Taste of London*, at exhibitions, music festivals and other high profile events including the Henley Regatta. It is stated that promotion at festivals has only really taken place after the date of filing of the applicant’s mark. He states that the advertising and promotion has been successful and that this has led to the commissioning of a special vehicle (representations of it are shown in SN3) for promotional purposes. It is stated that although the Juice sign is not depicted on the vehicle itself, it is depicted on each bottle of the goods sold from the vehicle. Other promotional material is then provided in SN3 which, Mr Namini states, is representative of the promotional material used since the Juice sign was first used. The material in SN3 is as follows:

a) Representations of the vehicle used for promotional purposes. As Mr Namini has stated, the vehicle does not carry the Juice sign. The vehicle predominantly features the JUICE REPUBLIC sign.

b) Two flyers for fruit juices manufactured by Juice4U. The flyers include the Juice sign either underneath or alongside the words Juice4U. One of the flyers (unfolded) is shown below:

100% Pure Fruit Juice

- No Additives
- No Colourings
- No Added Sugar
- No Preservatives
- Not Artificially Chilled
- No Water
- No Pips
- No Peel
- No Pith

We chill the whole fruit BEFORE juicing in our temperature controlled fully automated plant – kept in chilled throughout the process before bottling and delivering it to your fridge – in our special refrigerated vans – in under 12 hours. This means you have the coolest, freshest juice full of natural goodness including all the vitamins and minerals that nature intended. We are the only people in the UK who produce juice this way.

Unlike other freshly squeezed juice manufacturers we do not use chill blockers or heat exchangers to reduce the temperature of the juice after extraction.

Juice4u comes in individual bottles (250 ml) for retail and in 1 litre and 3.6 litre flasks for use in bars, restaurants and hotels.

Juice4u is great for breakfast time and in cocktails and lasts seven days in the fridge.

Visit Juice4u, challenge anyone to take a blindfold test to demonstrate the undeniable quality of our juices.

We also invite you personally to visit our factory in Peck Royal, London, to see exactly how our juices are made.

Manufacturers of Freshly Squeezed Juices  
**Juice4u**

**The Juice,  
the whole Juice and  
nothing but the Juice!**

c) A promotional pack relating to JUICE REPUBLIC. On what would be taken as page 4 of the main booklet in the pack (the pages themselves are not numbered) the Juice sign is included at the end of a body of text and is referred to as a “brand promise”. Four separate sheets of paper are also in the pack each of which highlights a particular product in the range and each of which depicts a bottle branded Juice Republic; the Juice sign is shown on each sheet in the nature of a circular stamp and is referred to as “JUICE REPUBLIC PROMISE”. An example of this use is shown below:

**FRESH FRUIT JUICES**  
**FRUIT JUICES**

- ✦ PURE & FRESH
- ✦ 100% SINGLE FRUIT VARIANT
- ✦ ABSOLUTELY NO COLOURINGS, ADDITIVES, PRESERVATIVES OR ADDED SUGAR
- ✦ NOT MADE FROM CONCENTRATE
- ✦ UNIQUE FRESH-SEALED PACKAGING

250ML BOTTLES    LITRE BOTTLES

**NE**

**JUICE REPUBLIC**  
THE FRUIT JUICE REVOLUTION IS HERE!  
FRESH COLD-SQUEEZED  
PURE ORANGE JUICE

**TO ORDER CALL 020 8838 4442**  
or please email: [sales@juice-republic.com](mailto:sales@juice-republic.com)  
We introduce new variants throughout the year. Please ask for details. [www.juice-republic.com](http://www.juice-republic.com)

12. I should say that the nature of the promotional material appears to be the sort of material that would be directed at the trade (wholesalers, retailers, caterers etc) rather than at the end-user or consumer of the goods; the relevance of this will be discussed later. The annual expenditure on advertising and promotion is given as:

2002	£18, 600
2003	£23, 400
2004	£41, 500
2005	£72, 500

13. Mr Namini states that the mark has been used throughout the UK. He states that the opponent’s distributors and sellers deliver goods to the following companies in the following regions:

- Compass, PSL and Fresh Direct - throughout the UK;
- Mitre Catering, Harbour & Jones, Allen Reeder - London and South of England;
- Forest Produce - West County;
- Finefoods - East Anglia.

14. Mr Namini states that each of the above customers have their own clients and, thus, the opponent has a wide market network throughout the UK. He also states that the Juice sign is used on the packaging of goods in The Savoy, The Dorchester, Selfridges, Harvey Nichols and Fortnum & Mason, all of which are in London, and also in Radisons and The Palace Hotel in Manchester. He completes his evidence by stating that the Juice sign is very important and it encapsulates the whole ethos of the opponent’s “company promise”. He considers the respective marks to be very similar and that confusion is likely to occur.

## **DECISION**

### **Section 5(4)(a)**

15. The opposition is based on section 5(4)(a) of the Act which reads:

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

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

(b) .....

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

16. The opponent relies on the common law tort of passing-off and refers to two decisions<sup>1</sup> of the House of Lords that set out the necessary elements that need to be demonstrated. They are summarised by the opponent as: 1) goodwill, 2) misrepresentation and 3) damage. This is clearly the correct legal test; Lord Oliver summarised the position quite succinctly in the latter of the cases referred to by the opponent when he stated at page 406:

“The law of passing off can be summarised in one short general proposition--no man may pass off his goods as those of another. More specifically, it may be expressed in terms of the elements which the plaintiff in such an action has to prove in order to succeed. These are three in number. First he must establish a goodwill or reputation attached to the goods or services which he supplies in the mind of the purchasing public by association with the identifying 'get-up' (whether it consists simply of a brand name or trade description, or the individual features of labelling or packaging) under which his particular goods or services are offered to the public, such that the get-up is recognised by the public as distinctive specifically of the plaintiff's goods or services. Secondly, he must demonstrate a misrepresentation by the defendant to the public (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by him are the goods or services of the plaintiff. ... Thirdly he must demonstrate that he suffers, or in a *quia timet* action that he is likely to suffer, damage by reason of the erroneous belief engendered by the defendant's misrepresentation that the source of the defendant's goods or services is the same as the source of those offered by the plaintiff.”

17. Before determining the matter I must decide what the material date is in relation to the opponent's claim. A number of cases<sup>2</sup> have established that the material date is the date of the behaviour complained of. I also bear in mind that section 5(4)(a) is derived from article 4(4)(b) of First Council Directive 89/104 which states:

“(b) rights to a non-registered trade mark or to another sign used in the course of trade were acquired prior to the date of application for registration of the subsequent trade mark, or the date of the priority claimed for the application for registration of the subsequent trade mark and that non-registered trade mark or other sign confers on its proprietor the right to prohibit the use of a subsequent mark;”

18. On the basis of the above, the date complained of can be no later than the date on which the applicant applied for his trade mark. It can however be before the date of application if there is such a complaint from the opponent together with appropriate evidence; there is neither. The behaviour complained of must therefore be the date of

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<sup>1</sup> *Erven Warnick BV v J Townend & Sons (Hull) Ltd* [1980] R.P.C. 31 and *Reckitt & Colman Products Ltd v Borden Inc* [1990] R.P.C.341.

<sup>2</sup> *Cadbury Schweppes Pty Ltd v Pub Squash Co Pty Ltd* [1981] R.P.C. 429 and *Inter Lotto (UK) Ltd v Camelot Group PLC* [2004] R.P.C. 8 and 9.

application of the opposed mark, namely 18 November 2005. This is the material date against which the opponent's case will be judged.

19. The starting point is to determine whether the opponent possessed a goodwill at the material date that is associated with the Juice sign in relation to the sale of their goods? The concept of goodwill was explained in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 at 223 as follows:

"What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first. The goodwill of a business must emanate from a particular centre or source. However widely extended or diffused its influence may be, goodwill is worth nothing unless it has power of attraction sufficient to bring customers home to the source from which it emanates. Goodwill is composed of a variety of elements. It differs in its composition in different trades and in different businesses in the same trade. One element may preponderate here and another element there. To analyse goodwill and split it up into its component parts, to pare it down as the Commissioners desire to do until nothing is left but a dry residuum ingrained in the actual place where the business is carried on while everything else is in the air, seem to me to be as useful for practical purposes as it would be to resolve the human body into the various substances of which it is said to be composed. The goodwill of a business is one whole, and in a case like this it must be dealt with as such. For my part, I think that if there is one attribute common to all cases of goodwill it is the attribute of locality. For goodwill has no independent existence. It cannot subsist by itself. It must be attached to a business. Destroy the business, and the goodwill perishes with it, though elements remain which may perhaps be gathered up and be revived again."

20. Despite the above statement being made more than 100 years ago, it still holds true today. Indeed, the above statement, or at least part of it, was utilised by the Court of Appeal in *Phones 4u Ltd v Phone4u.co.uk Internet Ltd*, [2007] R.P.C. 5. It is also useful to note Lord Oliver's explanation of the goodwill element of passing-off (see paragraph 16 above). Taken in the round, and put as simply as possible, goodwill is the attractive force, which is likely to consist of a variety of elements, which a businesses' customers and/or potential customers recognise as being distinctive of a particular trader's goods or services. I also note from the case-law that to qualify for protection under the tort, the goodwill must be of more than a trivial nature<sup>3</sup>.

21. On the face of it, the opponent operates a business of reasonable operating size. Sales of goods commenced approximately three and a half years before the applicant filed his trade mark. Sales have risen, in terms of turnover, from £0.25 million per annum to over £1 million per annum. The exact number of items sold is not given, however, fruit juice is not a particularly expensive item and therefore numbers sold will not be insignificant. The use is not contextualised against the market as a whole, however, against the

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<sup>3</sup> *Hart v Relentless Records* [2002] EWHC 1984

backdrop of the evidence, and even if the opponent is only a small player, the use is likely to represent reasonable custom; it is certainly not trivial in nature.

22. Of some concern on the issue of goodwill is the fact that the evidence shows two distinct primary brands that are featured on the goods. Some of the goods are branded JUICE4U whilst others are branded JUICE REPUBLIC. The evidence does not explain the reasons for this. I can see two possible explanations: the first is that one of the brands was used initially which, for some commercial or marketing reason, was dropped in favour of the other; the second explanation is that the opponent produces two separate brands and offers both for sale. Irrespective of which explanation holds true, the Juice sign has appeared on the labels and associated promotional material for both. Despite this, I consider that the evidence as a whole points towards the opponent possessing a goodwill in relation to the sale of his goods at the material date.

23. Although the opponent may have a goodwill in relation to the sale of his goods, and although the Juice sign is used on the products and promotional material relating to these sales, it is more debatable as to whether the actual manner of use of the Juice sign, and also the nature of the sign itself, will result in any use of the Fruit mark constituting a misrepresentation. In *Reckitt & Colman v Borden* Lord Oliver states:

“...[the plaintiff] must demonstrate a misrepresentation by the defendant to the public (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by him are the goods or services of the plaintiff. Whether the public is aware of the plaintiff’s identity as the manufacturer or supplier of the goods or services is immaterial, as long as they are identified with a particular source which is in fact the plaintiff. For example, if the public is accustomed to rely upon a particular brand name in purchasing goods of a particular description, it matters not at all that there is little or no public awareness of the identity of the proprietor of the brand name”

24. There are a number of factors to consider. In relation to the use of the Juice sign on the goods themselves, I have already indicated (see paragraph 7) that although it is used, it is not the primary sign of origin denotation on the goods. This is understating the position as the Juice sign only appears on the rear of the labels and is depicted in a much smaller font compared to the primary signs of origin; in my view, it would take a very attentive customer to notice it at all. The position in relation to the promotional material, which I have already said to be the sort of material aimed at the trade rather than the end-consumer, is only a little better. In relation to the JUICE REPUBLIC promotional material, the first use of the Juice sign is at the end of a large body of text on page 4 of the booklet, the second use is on the individual sheets in the form of a circular stamp; neither form, in my view, will make a particularly significant impact on the trade customer. The use on the JUICE4U flyers is a little better, although, it is still secondary in nature.

25. Whilst I accept that a trade customer (who may be considering large purchases etc) may pay more attention to the promotional material evidenced than the end consumer will

to the inconspicuous use on the goods themselves, this brings me to another consideration, namely, the nature of the sign itself. The sign is in the nature of a slogan rather than a more traditional sign of trade origin. The tort of passing-off can be utilised to protect distinctive slogans (the Privy Council have confirmed as much<sup>4</sup>), whereas non-distinctive slogans are generally not. However, it is not always black and white. A slogan with weak or low distinctive character (even if not completely lacking in distinctiveness) can be an important factor to consider amongst all the other relevant factors. The opponent submits that the sign is a distinctive one. Although I accept that the sign has a play on words with the phrase “the truth, the whole truth and nothing but the truth” and that this is likely to be noticed by the purchasing public, it nevertheless sends a clear promotional message of content and quality. Although the play on words is there, the sign is likely to be seen as a mildly amusing promotion claim rather than a sign denoting the trade origin of the goods. It strikes me as the sort of sign that other traders may well come up with to promote their goods. I fall short of saying that the sign lacks any distinctiveness at all, for example, if used and promoted as a primary sign, then an origin function is more likely to be taken, but, at best, it is a sign of weak distinctive character.

26. Another factor to consider is the degree of similarity between the Juice sign and the Fruit mark. Despite the applicant’s suggestion that they are not similar enough to cause confusion, there is, in my view, no getting away from their similarity on a comparison of their phonetic, visual and conceptual qualities. The goods involved are also identical or very similar. However, I bear in mind that this similarity has to be balanced against the other competing factors.

27. The evidence shows that there are two distinct customer groups to consider; misrepresentation could occasion itself to either or both. Firstly there is the end-consumer, secondly there is the trade customer. In relation to the end-consumer, all I have to go on are the sale of the goods under cover of the representative bottles and labels shown in SN1. I can take little cognisance of the promotional expenditure because the material evidenced (which Mr Namini states is representative of the promotion and advertising that has taken place) seems to be directed at the trade and, furthermore, he also states that some of the promotional activity (at festivals) only took place after the material date. As I have already stated, the use of the Juice sign is fairly inconspicuous and this, together with the fact that the sign itself is weak in distinctiveness, leads me to conclude that an end-consumer encountering the Fruit mark is not likely to believe, on the basis of the facts presented, that the goods sold under it are the goods of the opponent.

28. Does the opponent’s case improve when considering the position in relation to trade customers? Before answering this question, I should highlight that it is perfectly legitimate to consider the perspective of the case from the point of view of trade customers in addition to the end-consumer<sup>5</sup>; the concept of no man being able to pass his goods off as those of another applies equally whether it be to the trade or end-consumers. It is fair to say that the prominence of the Juice sign is a little greater in relation to the promotional material aimed at the trade. This is certainly true in relation to the JUICE4U

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<sup>4</sup> In *Cadbury Schweppes Pty Ltd v Pub Squash Co Pty Ltd* [1981] R.P.C. 429

<sup>5</sup> See *Ewing v Buttercup Margarine Co Ltd* [1917] 34 RPC 232

material, but less so in relation to the JUICE REPUBLIC material. Nevertheless, there is still the question of distinctiveness and what impact this will have when combined with the other relevant factors. I am also conscious that Pumfrey J in *South Cone Inc v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* [2002] RPC 19 stated:

“Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date.”

29. I am assessing the matter from the point of view of the trade yet there is no real evidence from the trade. Mr Namini refers to two pieces of evidence from the trade, but there are two problems with this. Firstly, the evidence consists of two letters headed “to whom it may concern”; they therefore appear to have been solicited for the proceedings. To take full and proper cognisance of the statements made in the letters, the writers should really have filed their statements as formal evidence in accordance with the Trade Mark Rules 2000 (as amended); as they stand now, they are nothing more than hearsay. The second problem is that they tell me little other than that two company representatives who are, or have been, producing packaging and labels for the opponent’s goods know that the Juice sign has been used. These are the very people who would know such a thing given their relationship with the opponent, but it tells me little about how the trade in general view the Juice sign.

30. One further problem exists, namely, that if the JUICE4U promotional material represents the opponent’s best case because it is the use that gives the Juice sign its greatest impact and significance, I do not know the proportion of the time, custom and promotional activity that has taken place in respect of this form of use due to the evidence relating to both the JUICE REPUBLIC use and the JUICE4U use. All in all, the low degree of distinctiveness, the lack of impact, the lack of evidence from the trade and the unspecified nature (between brands and their promotional use) of the evidence leads me to conclude that use of the applicant’s Fruit mark on his goods will not be taken by trade customers as the goods of the opponent.

**31. Taking these conclusions into account, the opposition fails.**

## **COSTS**

32. The applicant has been successful and is entitled to a contribution towards his costs. I order Online Catering t/a Juice4U to pay Miles Moriarty the sum of £433. This sum is calculated as follows:

Considering notice of opposition	£133
Statement of case in reply	£200
Considering opponent's evidence	£100
<b>Total</b>	<b>£433</b>

33. It should be noted that in the above breakdown of costs, the sums awarded represent no more than two thirds of what I may otherwise have awarded. This reflects the fact that the applicant has not had legal representation in these proceedings. The Civil Procedure Rules state at Part 48.6<sup>6</sup>:

“48.6-(1) This Rule applies where the court orders (whether by summary assessment or detailed assessment) that costs of a litigant in person are to be paid by any other person.

(2) The costs allowed under this Rule must not exceed, except in the case of a disbursement, two-thirds of the amount which would have been allowed if the litigant in person had been represented by a legal representative.”

34. The opponent must pay the applicant the above sum within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 23<sup>rd</sup> day of May 2008**

**Oliver Morris  
For the Registrar  
The Comptroller-General**

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<sup>6</sup> Mr Simon Thorley QC, sitting The Appointed Person in *Adrenalin Trade Mark* (BL 0/040/02), confirmed the applicability of this Rule to costs before the Registrar of Trade Marks.