

**O-179-20**

**TRADE MARKS ACT 1994**

**CONSOLIDATED PROCEEDINGS**

**IN THE MATTER OF**

**TRADE MARK APPLICATION NOS 3310118 & 3310122**

**IN THE NAME OF GULBAHAR UK LIMITED AND**

**OPPOSITIONS THERETO (UNDER NOS. 413902 & 413903) BY**

**TRADE WINDS CITRUS (INTL.) LTD**

**&**

**TRADE MARK REGISTRATION NO 2481221**

**IN THE NAME OF TRADE WINDS CITRUS (INTL.) LTD**

**AND THE**

**APPLICATION FOR CANCELLATION THEREOF ON GROUNDS OF NON-USE**

**(UNDER NO. 502301) BY GULBAHAR UK LIMITED**

## BACKGROUND

1) This dispute concerns three consolidated cases; two oppositions and an application for cancellation on the grounds of non-use. The parties to the dispute are Trade Winds Citrus (Intl.) Ltd. ('Party A') and Gulbahar UK Limited ('Party B').

2) On 11 May 2018, Party B applied to register the mark TRÜ Blends, under application number 3310118 (hereafter mark '118) and the mark TRÜ Flavors, under application number 3310122 (hereafter mark '122), in respect of a wide variety of goods and services in classes 29, 30, 31, 32, 33, 35 and 43.

3) Both applications were published in the Trade Marks Journal on 03 August 2018 for opposition purposes and subsequently opposed by Party A. It is claimed that both applications offend under sections 5(2)(b) and 5(4)(a) of the Trade Marks Act 1994 ('the Act')<sup>1</sup>. Both oppositions are directed against all goods and services covered by the applications except 'Advertising; business management; business administration; office functions' in class 35 <sup>2</sup>. Under section 5(2)(b), Party A relies upon UK trade mark registration no. 2481221, which was filed on 29 February 2008, registered on 21 November 2008 and covers goods in class 32. A statement of use was made in respect of the goods relied upon. The representation of the earlier mark is shown below:



4) Under section 5(4)(a), Party A relies upon use of two signs which are said to have been used throughout the UK since 2009 in relation to 'non-alcoholic drinks; fruit drinks and fruit juices; chilled fruit juices'. The first sign is identical to the registered

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<sup>1</sup> Grounds under section 5(3) of the Act were withdrawn by Counsel at the hearing.

<sup>2</sup> Opposition against those services was withdrawn by Counsel at the hearing.

mark relied upon under section 5(2)(b); the second sign is the plain words TRU – JUICE.

5) Subsequently, Party B filed an application to cancel Party A's registration on the grounds of non-use under sections 46(1)(a) and (b) of the Act. The section 46(1)(a) claim is based upon the five-year period following registration i.e. 22 November 2008 to 21 November 2013, with a claimed date of revocation of 22 November 2013. Under section 46(1)(b), the claim is based on the five-year period 10 May 2013 to 09 May 2018 with a claimed date of revocation of 10 May 2018.

6) Both parties filed a counterstatement in defence of their respective trade mark applications/registration. In the cancellation, Party A claims that it has used its registration in respect of 'non-alcoholic drinks, in particular, fruit drinks and fruit juices' in class 32. The same goods are relied upon in the oppositions and Party B has requested proof of use in relation to them.

7) Only Party A filed evidence. A hearing took place before me, at which both parties were represented by Counsel; Party A by Mr Chris Aikens and Party B by Mr Jamie Muir Wood.

## **PARTY A'S EVIDENCE**

8) This takes the form of two witness statements. The first is from Mr Peter C. McConnell; the second is from Mr Daniel James Cahill.

### Mr McConnell's evidence

9) Mr McConnell is a director of Party A. He explains that Party A's flagship brand is 'Tru-Juice'. He estimates that the revenue earned under the 'Tru-Juice' brand to be JM\$3.5 billion (approx. £21 million) and that 'Tru-Juice' commands a 60% market share of the total juice market in Jamaica. The 'Tru-Juice' range is divided into three lines, namely, 'Premium Quality', 'No Sugar Added' and 'Exotics'. Under the Premium Quality line, Party A sells the following flavours: Tropical Fruit Punch,

Orange-Pineapple, Mango Carrot, Orange Juice, Pineapple Juice, Cranberry and Cherry Juice ('the Premium Quality Flavours').

10) Party A began selling the Premium Quality Flavours under the earlier mark in the UK in 2009.

Evidence pertaining to the relevant period 22 November 2008 – 21 November 2013

11) From 2009 to 2011, Party A exported products directly to the UK from Jamaica. A number of invoices are provided falling within this period issued by Party A to entities in London<sup>3</sup>.

12) Mr McConnell explains that the products sold under the earlier mark, being chilled juices, are perishable in nature which has presented difficulties when exporting to the UK and elsewhere. In an effort to overcome those difficulties, Party A entered into a joint venture agreement with a UK company called A1 Fruit Limited ('A1') in 2011. A1 was the existing distributor at the time for the 'Tru-Juice' products in the UK. The joint venture was called Tru-Juice Marketing Ltd, the purpose of which was to manufacture the Tru-Juice product in the UK (as opposed to manufacturing them in Jamaica for subsequent shipping to the UK) and to be responsible for the marketing and distribution in the UK.<sup>4</sup>

Evidence pertaining to the relevant period 10 May 2013 – 09 May 2018

13) From 2013 to 2016, following the cessation of the joint venture with A1, Party A reverted to shipping products to the UK from Jamaica. Invoices are provided from this period which are said to relate to Tru-Juice products. Mr McConnell states that the invoices refer to the Tru-Juice mark and the Premium Quality Flavours referred to above.<sup>5</sup>

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<sup>3</sup> Exhibit PM5

<sup>4</sup> Exhibit PM6

<sup>5</sup> Exhibit PM7

14) From 2017 onwards, Party A has been exporting at an increased scale to the UK via its distributor Wiscynco Limited ('Wiscynco'). Various invoices are provided emanating from 2017 and 2018 which were issued by Wiscynco to Dees Imports Limited based in London.<sup>6</sup>

15) Since 2014, Party A has invested US\$37 million (approx. £5.3 million) in new technology from Tetra Pak that enables it to produce its juices in a long-life shelf stable form that does not require refrigeration. The first Tetra Pak line was commissioned in 2014 in 200ml form and second on in 2016 in 500ml and 1L form. The investment in this technology makes export much more feasible versus the limited shelf life of the traditional chilled products, therefore Party A expects its exports to grow exponentially.

Evidence said to relate to 'online presence, advertising and promotion'

16) Mr McConnell states that the www.tru-juice.com website was registered in 2006. Prints of extracts from the internet archive tool 'Wayback Machine' are provided showing use of the earlier mark dating back to September 2007.<sup>7</sup>

17) Mr McConnell states that Party A engages with its customers on social media. Extracts from Facebook, Twitter and YouTube are provided<sup>8</sup>. Mr McConnell draws attention to the Facebook photos showing use in the UK in 2012, including at a 'sampling session' in Brixton, London. He explains that this was one of the many initiatives operated by the previously mentioned joint-venture Tru-Juice Marketing Ltd as part of its marketing thrust, which included other events such as Notting Hill Carnival. Also included in the same exhibit are photographs of a Tru-Juice promotion run by Dees Caribbean held outside a supermarket on 14 July 2018 in North West London.

18) Exhibits PM13 (confidential) and PM14 refer to expressions of interest, discussions and/or press reports. As they all emanate from after the relevant date,

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<sup>6</sup> Exhibit PM9

<sup>7</sup> Exhibit PM11

<sup>8</sup> Exhibit PM12

Mr Aikens expressly stated that no reliance was placed upon them<sup>9</sup>. I therefore say no more about those exhibits.

19) Mr McConnell provides a copy of a '2012 FOODNEWS Special Supplement' published in the UK by a company named Informa Agra. I note that the article states '[Party A] is bringing its popular Jamaican Juice drink range to Britain in time for the Olympics this summer...'

#### Mr Cahill's evidence

20) Mr Cahill states that he was the managing director of Tru-Juice Marketing Limited. He explains that the purpose of the company was, as explained by Mr McConnell, to execute a joint venture agreement between Party A and A1 whereby Tru-Juice Marketing Limited had responsibility for manufacturing and distributing 'TRU-JUICE Premium Quality & Logo' branded juices in the UK. He further explains that the venture allowed the highly perishable juice to be manufactured in the UK, instead of in Jamaica. He confirms that the venture began in June 2011 and ceased at the end of 2012. Tru-Juice Marketing Limited subsequently became dormant and was struck off as of 21 January 2014. Due the passage of time since that date, Mr Cahill states that he no longer has invoices or documents pertaining to the company's sales. However, he estimates that, for the period mentioned (June 2011 to the end of 2012), sales of products under the 'TRU JUICE Premium Quality & Logo' mark would have been in excess of £50,000.

21) That completes my summary of the evidence. I now turn to consider the grounds pleaded before me.

22) It is appropriate to first consider Party B's application to have Party A's trade mark registration cancelled for reasons of non-use because, if that application is successful, the basis of Party A's oppositions will fall away.

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<sup>9</sup> Hearing Transcript, page 3, [3]

## THE CANCELLATION

### Sections 46(1)(a) & (b)

23) Section 46(1) of the Act states that:

“The registration of a trade mark may be revoked on any of the following grounds-

(a) that within the period of five years following the date of completion of the registration procedure it has not 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, and there are no proper reasons for non-use;

(b) that such use has been suspended for an uninterrupted period of five years, and there are no proper reasons for non-use;

(c).....  
.....

(d).....

(2) For the purpose of subsection (1) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and 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.

(3) The registration of a trade mark shall not be revoked on the ground mentioned in subsection (1)(a) or (b) if such use as is referred to in that paragraph is commenced or resumed after the expiry of the five year period and before the application for revocation is made: Provided that, any such commencement or resumption of use after the expiry of the five year period

but within the period of three months before the making of the application shall be disregarded unless preparations for the commencement or resumption began before the proprietor became aware that the application might be made.

(4) An application for revocation may be made by any person, and may be made to the registrar or to the court, except that –

(a) if proceedings concerning the trade mark in question are pending in the court, the application must be made to the court; and

(b) if in any other case the application is made to the registrar, he may at any stage of the proceedings refer the application to the court.

(5) Where grounds for revocation exist in respect of only some of the goods or services for which the trade mark is registered, revocation shall relate to those goods or services only.

6) Where the registration of a trade mark is revoked to any extent, the rights of the proprietor shall be deemed to have ceased to that extent as from –

(a) the date of the application for revocation, or

(b) if the registrar or court is satisfied that the grounds for revocation existed at an earlier date, that date.”

24) Further, Section 100 of the Act states:

“If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.” (my emphasis)

25) In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J summarised the law relating to genuine use, as follows:

“114.....The CJEU has considered what amounts to “genuine use” of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), 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 Bunderversammlung 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 Marken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, 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] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases 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]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* at [29].
- (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]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally

and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

(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] and [22]. 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]; *Reber* at [29].

(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]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

(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] and [76]-[77]; *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].”

26) I also bear in mind that in *Awareness Limited v Plymouth City Council*, Case BL O/236/13, Mr Daniel Alexander Q.C. as the Appointed Person stated that:

“22. The burden lies on the registered proprietor to prove use..... However, 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 (which in many cases will be the Hearing Officer in the first instance) 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.”

and further at paragraph 28:

“28. .... I can understand the rationale for the evidence being as it was but suggest that, for the future, if a broad class, such as “tuition services”, is sought to be defended on the basis of narrow use within the category (such as for classes of a particular kind) the evidence should not state that the mark has been used in relation to “tuition services” even by compendious reference to the trade mark specification. The evidence should make it clear, with precision, what specific use there has been and explain why, if the use has only been narrow, why a broader category is nonetheless appropriate for the specification. Broad statements purporting to verify use over a wide range by reference to the wording of a trade mark specification when supportable only in respect of a much narrower range should be critically considered in any draft evidence proposed to be submitted.”

27) Further, in *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*, Case BL 0/404/13, Mr Geoffrey Hobbs Q.C. as the Appointed Person stated that:

“21. The assessment of a witness statement for probative value necessarily focuses upon its sufficiency for the purpose of satisfying the decision taker with regard to whatever it is that falls to be determined, on the balance of probabilities, in the particular context of the case at hand. As Mann J. observed in *Matsushita Electric Industrial Co. v. Comptroller- General of Patents* [2008] EWHC 2071 (Pat); [2008] R.P.C. 35:

[24] As I have said, the act of being satisfied is a matter of judgment. Forming a judgment requires the weighing of evidence and other factors. The evidence required in any particular case where satisfaction is required depends on the nature of the inquiry and the nature and purpose of the decision which is to be made. For example, where a tribunal has to be satisfied as to the age of a person, it may sometimes be sufficient for that person to assert in a form or otherwise what his or her age is, or what their date of birth is; in others, more formal proof in the form of, for example, a birth certificate will be required. It all depends who is asking the question, why they are asking the question, and what is going to be done with the answer when it is given. There

can be no universal rule as to what level of evidence has to be provided in order to satisfy a decision-making body about that of which that body has to be satisfied.

22. When it comes to proof of use for the purpose of determining the extent (if any) to which the protection conferred by registration of a trade mark can legitimately be maintained, the decision taker must form a view as to what the evidence does and just as importantly what it does not ‘show’ (per Section 100 of the Act) with regard to the actuality of use in relation to goods or services covered by the registration. The evidence in question can properly be assessed for sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use.”

28) Viewing the evidence before me in the round, it paints a picture of Party A’s mark having been used consistently over the duration of both relevant periods under sections 46(1)(a) and (b). This is borne out by the numerous invoices provided spanning those periods, issued to importers in London<sup>10</sup>. Many of the invoices refer specifically to various ‘Tru-Juice Premium’ fruit/sorrel juices. Where the description on the invoices does not include any reference to ‘Tru-Juice’, I note that the flavours of the juices correspond to those listed by Mr McConnell in his witness statement<sup>11</sup>. Further, given that the images of the cartons and bottles of juice shown on Party A’s website, and on the website of Dees Imports<sup>12</sup>, all appear to bear the mark as registered, I am prepared to accept that they are representative of the mark which was used in relation to the goods listed in the invoices. The number of invoices and the frequency with which they appear to have been issued to UK importers is sufficient to satisfy me that the use has been sufficient to create and maintain a market share for the goods of Party A over the relevant periods in the UK. I therefore find that the mark has been put to genuine use in both relevant periods.

29) I now need to consider what constitutes a fair specification, having regard for the goods upon which genuine use has been shown. In *Euro Gida Sanayi Ve Ticaret*

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<sup>10</sup> Exhibits PM5, PM7 and PM9.

<sup>11</sup> Paragraph 9.

<sup>12</sup> Exhibit PM9

*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.”

30) In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), Mr Justice Carr summed up the law relating to partial revocation as follows.

“iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria's Secret UK Ltd* [2014] EWHC 2631 (Ch) ("Thomas Pink") at [52].

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].

v) 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; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply

because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 ("Asos") at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them;  
*Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46.”

31) Mr Aikens submitted that the use shown is sufficient to retain the whole of the defended specification i.e. ‘non-alcoholic drinks, in particular, fruit drinks and fruit juices’. I disagree. That specification is a broad one, covering, essentially, all kinds of non-alcoholic drinks. The use before me does not show use on a broad range of non-alcoholic drinks such as to warrant retention of that term. Mr Wood submitted that, if I am minded to allow the mark to remain registered for any goods, it should only be for ‘fruit juice’ or ‘fruit drinks’.

32) All the use before me is, primarily, in relation to fruit juice. I do, however, accept Mr Aikens’ point that the descriptions in the invoices also refer to ‘sorrel’, which is a herb, not a fruit. I come to the view that a fair specification is ‘fruit juice; herbal juice’.

33) Party A’s registration is therefore revoked, with effect from 22 November 2013 in relation to the goods for which it is registered, with the exception of ‘fruit juice; herbal juice’.

## THE OPPOSITIONS

### Proof of use

34) Section 6A of the Act states:

#### **“Raising of relative grounds in opposition proceedings in case of non-use**

6A. - (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), (b) 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 period of five years ending with the date of publication.

(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 period of five years ending with the date of publication of the application 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 differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, 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) In relation to a European Union trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Union.

(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.”

35) In accordance with section 6A(3)(a) of the Act, the relevant period in which genuine use must be established is the five-year period ending on the date of publication of the contested marks. In the case before me, that period is 04 August 2013 to 03 August 2018.

36) The relevant period for assessing proof of use in the oppositions overlaps significantly with the period under section 46(1)(b) in the cancellation which I have already assessed. For similar reasons to those expressed earlier in this decision, and viewing the evidence in the round, I find that the opponent has shown genuine use in relation to ‘fruit juice; herbal juice’. It is that specification upon which the opponent is entitled to rely under section 5(2)(b) of the Act.

## **Section 5(2)(b)**

37) The relevant section of the Act provides that:

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

(a) .....

(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.”

38) The leading authorities which guide me are from the Court of Justice of the European Union ('CJEU'): *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

### **The principles**

(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 be dominated by one or more of its components;

(f) however, it is also 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 great 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;

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

## Comparison of goods and services

39) In the judgment of the CJEU in *Canon*, Case C-39/97, the Court stated at paragraph 23 of its judgment that:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary”.

40) The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- a) The respective users of the respective goods or services;
- b) The physical nature of the goods or acts of services;
- c) The respective trade channels through which the goods or services reach the market;
- d) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- e) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

41) In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, the General Court 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”.

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

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

43) In *Avnet Incorporated v Isoact Limited*, [1998] F.S.R. 16, Jacob J. (as he then was) stated that:

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

44) In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the General Court stated that “complementary” means:

“...there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking”.

45) In *Sanco SA v OHIM*, Case T-249/11, the General Court indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL-0-255-13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes.”

Whilst on the other hand:

“.....it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.”

46) In relation to the retail services at issue, I note that in *Oakley, Inc v OHIM*, Case T-116/06, at paragraphs 46-57, the General Court held that although retail services are different in nature, purpose and method of use to goods, retail services for particular goods may be complementary to those goods, and distributed through the same trade channels, and therefore similar to a degree.

47) Further, in *Tony Van Gulck v Wasabi Frog Ltd*, Case BL O/391/14, Mr Geoffrey Hobbs Q.C. as the Appointed Person reviewed the law concerning the comparison between retail services and goods. He said (at paragraph 9 of his judgment) that:

“9. The position with regard to the question of conflict between use of **BOO!** for handbags in Class 18 and shoes for women in Class 25 and use of **MissBoo** for the Listed Services is considerably more complex. There are four main reasons for that: (i) selling and offering to sell goods does not, in itself, amount to providing retail services in Class 35; (ii) an application for registration of a trade mark for retail services in Class 35 can validly describe the retail services for which protection is requested in general terms; (iii) for the purpose of determining whether such an application is objectionable under Section 5(2)(b), it is necessary to ascertain whether there is a likelihood of confusion with the opponent’s earlier trade mark in all the circumstances in which the trade mark applied for might be used if it were to be registered; (iv) the criteria for determining whether, when and to what degree services are ‘similar’ to goods are not clear cut.”

However, on the basis of the European courts’ judgments in *Sanco SA v OHIM*<sup>13</sup>, and *Assembled Investments (Proprietary) Ltd v. OHIM*<sup>14</sup>, upheld on appeal in *Waterford Wedgwood Plc v. Assembled Investments (Proprietary) Ltd*<sup>15</sup>, Mr Hobbs concluded that:

- i) Goods and services are not similar on the basis that they are complementary if the complementarity between them is insufficiently pronounced that, from the consumer’s point of view, they are unlikely to be offered by one and the same undertaking;
- ii) In making a comparison involving a mark registered for goods and a mark proposed to be registered for retail services (or vice versa), it is necessary to envisage the retail services normally associated with the opponent’s goods and then to compare the opponent’s goods with the retail services covered by the applicant’s trade mark;

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<sup>13</sup> Case C-411/13P

<sup>14</sup> Case T-105/05, at paragraphs [30] to [35] of the judgment

<sup>15</sup> Case C-398/07P

iii) It is not permissible to treat a mark registered for 'retail services for goods X' as though the mark was registered for goods X;

iv) The General Court's findings in *Oakley* did not mean that goods could only be regarded as similar to retail services where the retail services related to exactly the same goods as those for which the other party's trade mark was registered (or proposed to be registered).

48) Finally, I bear in mind that, where it is not obvious to me that there is similarity between any of the respective goods and/or services, the onus is on the opponent to present evidence in support of its contentions that there is similarity (see, for example, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* Case C-39/97, paragraph 22).

49) I will address each of the classes covered by the contested applications in turn (the specifications of which are identical) and, where appropriate, will group goods and services together.<sup>16</sup> I remind myself that the goods upon which the opponent may rely are 'fruit juice; herbal juice' in class 32. A full list of the goods and services covered by the contested marks is to be found in the Annex to this decision.

#### Classes 29 and 30

50) Mr Aikens contended that all the goods in classes 29 and 30 of the contested marks are similar to the opponent's goods because i) the respective goods are all consumed to provide nutrition, ii) they have the same end user, iii) they are similar in nature because they are all physically ingestible and iv) they share trade channels and are often all sold in supermarkets. Mr Wood submitted that there is no similarity at all between any of the relevant goods.

51) I largely agree with Mr Wood. It is true that all the respective goods will be consumed for nutritional purposes and be consumed by the general public. However, those general factors and the mere fact that they are ingestible does not mean they

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<sup>16</sup> As per *Separode Trade Mark* BL O-399-10

are similar goods. A juice is a liquid which is drunk whereas the vast majority of the applicant's goods are items of prepared food, fresh meat/fish, condiments and confectionery. I would not expect any of the contested foods to be stocked in close proximity to the opponent's goods in a supermarket or for the average consumer to expect that the applicant's foods in classes 29 and 30 come from the same source as the opponent's fruit and herbal juices. I find **no similarity** between any of applicant's items of food in classes 29 and 30 and the opponent's goods.

52) As to the dairy drinks which are covered by the contested specifications in classes 29 and 30, such as milk, milkshakes and ice cream drinks, I accept that those goods are similar in nature to the opponent's goods in the sense that they are also liquids which are drunk. However, the contested goods are all made principally of milk/ice cream which are quite different to the principal ingredients of the opponent's goods, being fruit juice and herbal juice. That said, there may be some degree of competition in play between the respective goods. I find there to be a **low** degree of similarity between the opponent's goods and the applicant's 'milk; milk and milk products; milk shakes; protein milk; albumin milk; skimmed milk; cow's milk; sheep milk; rice milk; organic milk; milk shakes; goat milk; soya bean milk' in class 29 and 'ice-cream drinks; ice cream shakes' in class 30. (I find no similarity with the contested 'milk curds', 'sour milk', 'condensed milk' and dried/powdered milk products given, what appears to me to be, the different nature, methods of use and purpose of those, as compared to the opponent's goods.)

53) The applicant's 'coffee, tea, cocoa and artificial coffee' are similar to the opponent's goods to the extent that they are also liquids that are drunk. However, I would not expect them to be stocked in close proximity to fruit juices or herbal juices, with the exception, perhaps, of iced tea and coffee (which would fall within the contested terms). Their respective ingredients are also quite different such that I would expect any competitive relationship to be limited. There is a **low** degree of similarity between the opponent's goods and the applicant's 'coffee, tea, cocoa and artificial coffee'.

54) I add here that I have not overlooked the exclusion at the end of the contested class 29 which states 'none of the aforesaid foods being molasses, burnt sugar, jerk

seasoning, ackee and callaloo, or other food and drink products manufactured in Jamaica'. That exclusion has no impact upon my conclusions about the similarity between the respective goods.

### Class 31

55) Mr Aikens submitted that all the goods in class 31 are similar to the opponent's goods for the same reasons as those set out above. Mr Wood submitted that there is again, no similarity in play.

56) The contested fresh vegetables, nuts, seeds and grains, prepared meals containing those foods, live animals, malt, foodstuffs for animals, natural plants and flowers are different in nature to the opponent's juice drinks, they are unlikely to be found in close proximity in retail outlets, I can see no real competitive relationship in play and they are unlikely to come from the same producer. I find **no similarity** between the opponent's goods and the aforementioned goods of the applicant.

57) I note that the contested goods in class 31 also include 'Fresh fruits', 'Organic fresh fruit', 'Organic fresh herbs', 'herbs' and 'agricultural, horticultural and forestry products' (the latter term would include the former listed goods). Although I would not expect any of those goods to be stocked in close proximity to the opponent's goods in a supermarket, and the nature differs in the sense that the opponent's goods are liquid drinks whereas the applicant's goods are solid foods, there is clearly a complementary relationship in play given that the applicant's goods constitute the principal ingredients of the opponent's goods. The average consumer may well believe that they come from the same source. I find there to be a **low** degree of similarity between the applicant's 'Fresh fruits', 'Organic fresh fruit', 'Organic fresh herbs', 'herbs' and 'agricultural, horticultural and forestry products' (to the extent that the latter term includes fresh fruit and herbs) and the opponent's goods.

### Class 32

58) At the hearing, Mr Wood conceded that the following goods of the applicant in class 32 are either **identical or highly similar** to the opponent's goods:

'mineral and aerated waters and other non-alcoholic beverages; fruit beverages and fruit juices; syrups and other preparations for making beverages; smoothies; smoothies [non-alcoholic fruit beverages]; smoothies [fruit beverages, fruit predominating]; fruit-based beverages; frozen fruit beverages; powders used in the preparation of fruit-based beverages; fruit squashes; fruit nectars; fruit nectars, non-alcoholic; non-alcoholic fruit extracts; frozen fruit drinks; mixed fruit juice; non-alcoholic fruit drinks; fruit flavoured soft drinks; syrups for making fruit-flavoured drinks; concentrates for making fruit juices; ice fruit beverages; soft drinks; vegetable drinks; energy drinks; cola drinks; isotonic drinks; de-alcoholised drinks; energy drinks containing caffeine; low-calorie soft drinks; carbonated non-alcoholic drinks; part frozen slush drinks; fruit flavoured carbonated drinks; sports drinks containing electrolytes; isotonic non-alcoholic drinks; aloe vera drinks, non-alcoholic; syrups for making soft drinks; squashes [non-alcoholic beverages]; sorbets [beverages]; sherbets [beverages]; beverages containing vitamins; alcohol free beverages; effervescing beverages (powders for -); powders for effervescing beverages; preparations for making beverages; beverages (whey -); tonic water [non-medicated beverages]; pastilles for effervescing beverages; mineral water [beverages]; honey-based beverages (non-alcoholic -); red ginseng juice beverages; smoked plum beverages; pineapple juice beverages; non-alcoholic beverages with tea flavour; tomato juice beverages; kvass [non-alcoholic beverages]; malt syrup for beverages; soya-based beverages, other than milk substitutes; grape juice beverages; orange juice beverages; apple juice beverages; non-alcoholic cocktails.'

59) That leaves 'Beers' and 'beer-based cocktails' in class 32. Mr Wood conceded that there is also some degree of similarity between those goods and the opponent's goods, but to a lower degree than for the other class 32 goods. Given the different respective principal ingredients, the likely limited overlap in trade channels and proximity of the respective goods in supermarkets, the lack of complementarity and any real competitive relationship, I find that such similarity must be very low.

### Class 33

60) Similarly, Mr Wood conceded that all the alcoholic drinks in this class share some degree of similarity with the opponent's goods. For similar reasons to those expressed in the preceding paragraph, I again find that such similarity must be **very low.**

### Class 35

61) I now turn to consider the services in class 35 and remind myself that 'Advertising; business management; business administration; office functions' are no longer the subject of opposition. There is therefore no comparison to be made in relation to those services.

62) The other services in class 35 are retail services and 'the provision of food-ordering services through an on-line computer network'. Dealing first with the latter, the nature, methods of use and purpose of those services is entirely different to the opponent's goods and they are not in competition nor complementary. There is **no** similarity between 'the provision of food-ordering services through an on-line computer network' and the opponent's goods.

63) The contested retail services relate to a wide variety of goods. In conducting the comparison between those services and the opponent's goods, I remind myself of the relevant case law, as set out at above. Mr Aikens submitted that all the contested retail services are similar to the opponent's goods because there is a complementary relationship between them and the goods and services will be offered in the same place.

64) I will first consider the similarity between the opponent's goods and the following retail services:

'retail and online retail services in relation to the sale of mineral and aerated waters and other non-alcoholic beverages, fruit beverages and fruit juices, **syrops and other preparations for making beverages, smoothies,**

**smoothies [non-alcoholic fruit beverages], smoothies [fruit beverages, fruit predominating], fruit-based beverages, frozen fruit beverages, powders used in the preparation of fruit-based beverages, fruit squashes, fruit nectars, fruit nectars, non-alcoholic, non-alcoholic fruit extracts, frozen fruit drinks, mixed fruit juice, non-alcoholic fruit drinks, fruit flavoured soft drinks, syrups for making fruit-flavoured drinks, concentrates for making fruit juices, ice fruit beverages, soft drinks, vegetable drinks, energy drinks, cola drinks, isotonic drinks, de-alcoholised drinks, energy drinks containing caffeine, low-calorie soft drinks, carbonated non-alcoholic drinks, part frozen slush drinks, fruit flavoured carbonated drinks, sports drinks containing electrolytes, isotonic non-alcoholic drinks, aloe vera drinks, non-alcoholic, **syrups for making soft drinks, squashes [non-alcoholic beverages],** sorbets [beverages], sherbets [beverages], beverages containing vitamins, alcohol free beverages, effervescing beverages (powders for -), powders for effervescing beverages, **preparations for making beverages,** beverages (whey -), tonic water [non-medicated beverages], pastilles for effervescing beverages, mineral water [beverages], honey-based beverages (non-alcoholic -), red ginseng juice beverages, smoked plum beverages, pineapple juice beverages, non-alcoholic beverages with tea flavour, tomato juice beverages, kvass [non-alcoholic beverages], malt syrup for beverages, soya-based beverages, other than milk substitutes, grape juice beverages, orange juice beverages, apple juice beverages.'**

65) The goods I have underlined are either types of fruit/herbal juice or are terms which are broad enough to include such goods. On the same basis as *Oakley*, I therefore find that the retail services relating to the sale of the underlined goods are complementary to the opponent's 'fruit juice; herbal juice'. However, the respective nature, method of use and purpose differs and there is no competitive relationship in play. I find a low degree of similarity between the retail services connected with the underlined goods and the opponent's goods.

66) As to the emboldened goods listed above, none of these appear to be fruit juice or herbal juice per se, bearing in mind their ordinary and natural meaning. However, as the case law above indicates, that does not preclude a finding of similarity

between the retail services relating to those goods and the opponent's goods. The emboldened goods such as smoothies are likely to be sold alongside, and as alternatives to, the opponent's goods and are therefore likely to be the subject of the same retail services as 'fruit juice; herbal juice'. The emboldened syrups and preparations for making beverages would also cover fruit syrups, for example. The retail services of the emboldened goods may therefore be important for the sale of the opponent's goods. Consequently, it is plausible that the average consumer may believe that an undertaking selling 'fruit juice and herbal juice' is the same, or connected to, an undertaking that provides 'retail services connected with the sale of [the emboldened goods]'. There is therefore a degree of complementarity in play between those goods and services. Nevertheless, the nature, purpose and method of use differs and there is no competitive relationship. I therefore find that there is a low degree of similarity between the retail services connected with the sale of the emboldened goods and the opponent's goods.

67) Turning to the other goods listed above which are neither underlined nor emboldened, to my mind there is no more than, at most, a trivial degree of complementarity between the retail services connected with the sale of those goods and the opponent's 'fruit juice and herbal juice'. Any complementarity that exists between those goods and services is insufficiently pronounced that, from the average consumer's point of view, the goods and services are likely to be offered by the same undertaking. Their nature, method of use and purpose is also different. I find no similarity between the retail services connected with the sale of the non-emboldened and non-underlined goods listed directly above and the opponent's goods.

68) I also see no similarity between any of the other retail services at issue listed in the Annex (connected with the sale of the various foodstuffs and alcoholic drinks) with the opponent's goods.

69) The exclusion at the end of the contested class 35 which states 'none of the aforesaid retail and online retail services relating to the sale of molasses, burnt sugar, jerk seasoning, ackee and callaloo, or other food and drink products

manufactured in Jamaica' has no impact upon my conclusions about the similarity between the respective goods and services.

### Class 43

70) Mr Aikens submitted that all the services in class 43 are similar to the goods of the opponent because there is a complementary relationship in play and the goods and services are offered in the same place.

71) I accept that the contested term 'services for providing food and drink', for example, is a broad term which would include 'juice bars'. There is clearly a complementary relationship in play between 'juice bars' and the opponent's goods because the latter are indispensable to the former and the trade channels will be the same. I consider there to be a low degree of similarity between the opponent's goods and the applicant's services in class 43, to the extent that some of the contested broad terms cover 'juice bars'.

72) As to the other contested services in class 43, while it is true that many of those services, such as restaurant, hospitality and catering services may include offering juice to their customers, the provision of the latter is not, in my view, important for, or indispensable to, the former in the sense described in the case law. The core purpose of the applicant's services is to provide prepared meals and/or alcoholic drinks to the consumer. Further, the core purpose of 'temporary accommodation' in class 43 is to provide shelter. The nature and purpose of the respective goods and services is also different. I find no similarity between the opponent's goods and the contested services in class 43 which are not, or do not cover, 'juice bars'.

### **Average consumer and the purchasing process**

73) It is necessary to determine who the average consumer is for the respective goods and services and the manner, in which, they are likely to be selected. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

74) The average consumer of the goods and services at issue is the general public. Mr Wood agreed with Mr Aikens that the goods at issue, being everyday consumer items, are unlikely to attract a high degree of attention; rather, the level of attention is likely to range from low to normal. Counsel were also agreed that the selection of all the goods and services is likely to be primarily visual, but that the aural aspect should also be borne in mind.

### **Comparison of marks**

75) 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.”

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

Party A's mark	Party B's marks
	<p>'118: TRÜ Blends</p> <p>'122: TRÜ Flavors</p>

76) Party A's mark naturally breaks down into two elements. The first is the hyphenated words Tru-Juice; the second is the words PREMIUM QUALITY upon a black banner. The latter carries less weight than the former in the mark's overall impression because of i) the entirely descriptive nature of the words PREMIUM QUALITY, ii) the banal nature of the banner and iii) its relatively subordinate position and size as compared to the first element. Within the Tru-Juice element itself, the word 'Tru' is likely to have greater impact upon the perception than 'Juice'. This is because 'Tru' has greater distinctiveness than the entirely descriptive word 'Juice' and it also enjoys a more prominent position at the beginning of the mark.

77) Turning to marks '118 and '122, I find that the word TRÜ has the greatest weight in the overall impression. This is due to two factors. Firstly, TRÜ is clearly of greater distinctiveness than 'Flavours' and 'Blends', in relation to the beverages and foodstuffs at issue (and retail services relating to the same) and secondly, TRÜ is positioned at the beginning of the marks. The combination of these two factors means that TRÜ is likely to have the greater impact on the consumer's perception in both marks.

78) Visually, Party A's mark and the contested marks all contain the word 'TRU' at the beginning, albeit that there is an umlaut above the letter 'U' in the contested marks which is absent from Party A's mark. The '- Juice' part of Party A's mark is

visually different to the words 'Flavours' and 'Blends' in the contested marks. There is also the PREMIUM QUALITY banner element in Party A's mark which is absent from the contested marks. I consider there to be a medium degree of visual similarity between Party A's mark and both contested marks.

79) Aurally, Mr Wood conceded that the umlaut in the contested marks is unlikely to have an impact upon the pronunciation of those marks in the UK. I would expect the words TRÜ and Tru in the respective marks to be pronounced in the same way as the English word TRUE. The likely pronunciation of the other words within the respective marks requires no explanation given that they are ordinary, everyday English words. I consider it unrealistic to expect the average consumer to pronounce the 'PREMIUM QUALITY' element in Party A's mark. I therefore disagree with Mr Wood that those words create a point of aural difference. Party A's mark and mark '118 will therefore both be pronounced as two syllables, the first of which is identical but the second is different. Mark '122 consists of three syllables; the first is identical to that in Party A's mark; the second is different; the third is absent from Party A's mark. Overall, I consider there to be a medium degree of aural similarity between Party A's mark and both contested marks.

80) Conceptually, Party A's mark consists of, what appears to be, the invented word TRU and the everyday English word JUICE, joined by a hyphen. I bear in mind that invented words are capable of being evocative or suggestive of a concept if they resemble known words<sup>17</sup>. There is clearly a strong resemblance between the invented word TRU and the common English word 'TRUE'. Collins English Dictionary defines 'True' as a word which may be used 'to emphasize that a person or thing is sincere or genuine, often in contrast to something that is pretend or hidden' and the words 'real', 'natural' and 'pure' are given as synonyms of the word 'True'<sup>18</sup>. To my mind, Party A's mark is likely to be perceived as alluding to juice that is real, pure or natural. The entirely descriptive words 'PREMIUM QUALITY' are unlikely to form part of the conceptual hook for the consumer. Turning to Party B's marks, similar considerations apply (again, the umlaut does not come into play). I would expect those marks to be perceived as alluding to real/pure/natural flavours and blends. I

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<sup>17</sup> *Usinor SA v OHIM* (Case T-189/05)

<sup>18</sup> <https://www.collinsdictionary.com/dictionary/english/true>. Accessed on 03 March 2020.

find a medium degree of conceptual similarity overall between the earlier mark and both contested marks.

### **Distinctive character of the earlier mark**

81) The distinctive character of the earlier mark must be considered. The more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion (*Sabel BV v Puma AG*). In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does 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).”

82) Although I have found the evidence before me to be sufficient to show that the earlier mark has been put to genuine use in the UK for fruit juice and herbal juice, I do not consider the extent of use to be such as to warrant a finding of enhanced

distinctiveness in the UK and Mr Aikens made no such submissions at the hearing. I therefore have only inherent distinctiveness of the mark to consider.

83) I have already expressed my views on the meaning and distinctiveness of Party A's mark and its constituent parts. Mr Wood submitted that the mark is of low distinctiveness given its 'highly descriptive' nature i.e. juice that is natural or pure. Mr Aikens accepted that the mark may be perceived as alluding to juice that is natural or pure but submitted that it is the unusual/incorrect spelling of 'true' as 'Tru' that renders the mark distinctive. In his submission, 'Tru' is not a familiar or usual way of describing the goods or services at issue here. I agree with Mr Aikens. I consider the word 'Tru', of itself, and the earlier mark, as a whole, to have a normal degree of distinctiveness, despite its allusive nature.

### **Likelihood of confusion**

84) I must now feed all of my earlier findings into the global assessment of the likelihood of confusion, keeping in mind the following factors: i) the interdependency principle, whereby a lesser degree of similarity between the goods and services may be offset by a greater degree of similarity between the marks, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*); ii) the more distinctive the earlier mark is, the greater the likelihood of confusion (*Sabel BV v Puma AG*), and; iii) imperfect recollection i.e. that consumers rarely have the opportunity to compare marks side by side but must rather rely on the imperfect picture that they have kept in their mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.*).

85) Mr Aikens conceded that there is no likelihood of direct confusion between the marks at issue. However, he submitted that there is nevertheless a likelihood of indirect confusion.

86) The earlier mark is visually, aurally and conceptually similar to a medium degree to both of the contested marks. The earlier mark also has a normal degree of inherent distinctiveness. Bearing these factors in mind, together with the consumer being likely to pay no more than a low to normal degree of attention to the goods and services at issue, I come to the view that they are likely to believe that the respective

goods and services which are similar to, at least, a low degree come from the same, or economically linked, undertaking(s). I therefore find that there is a likelihood of indirect confusion in respect of the following contested goods and services of the two trade mark applications:

Class 29: milk; milk and milk products; milk shakes; protein milk; albumin milk; skimmed milk; cow's milk; sheep milk; rice milk; organic milk; milk shakes; goat milk; soya bean milk.

Class 30: coffee, tea, cocoa and artificial coffee; ice cream drinks; ice cream shakes.

Class 31: Fresh fruits; organic fresh fruit; herbs; organic fresh herbs; herbs; agricultural, horticultural and forestry products. (Success against the latter term under section 5(2)(b) is only to the extent that it covers fresh herbs and fresh fruit)

Class 32: mineral and aerated waters and other non-alcoholic beverages; fruit beverages and fruit juices; syrups and other preparations for making beverages; smoothies; smoothies [non-alcoholic fruit beverages]; smoothies [fruit beverages, fruit predominating]; fruit-based beverages; frozen fruit beverages; powders used in the preparation of fruit-based beverages; fruit squashes; fruit nectars; fruit nectars, non-alcoholic; non-alcoholic fruit extracts; frozen fruit drinks; mixed fruit juice; non-alcoholic fruit drinks; fruit flavoured soft drinks; syrups for making fruit-flavoured drinks; concentrates for making fruit juices; ice fruit beverages; soft drinks; vegetable drinks; energy drinks; cola drinks; isotonic drinks; de-alcoholised drinks; energy drinks containing caffeine; low-calorie soft drinks; carbonated non-alcoholic drinks; part frozen slush drinks; fruit flavoured carbonated drinks; sports drinks containing electrolytes; isotonic non-alcoholic drinks; aloe vera drinks, non-alcoholic; syrups for making soft drinks; squashes [non-alcoholic beverages]; sorbets [beverages]; sherbets [beverages]; beverages containing vitamins; alcohol free beverages; effervescing beverages (powders for -); powders for effervescing beverages; preparations for making beverages; beverages (whey

-); tonic water [non-medicated beverages]; pastilles for effervescing beverages; mineral water [beverages]; honey-based beverages (non-alcoholic -); red ginseng juice beverages; smoked plum beverages; pineapple juice beverages; non-alcoholic beverages with tea flavour; tomato juice beverages; kvass [non-alcoholic beverages]; malt syrup for beverages; soya-based beverages, other than milk substitutes; grape juice beverages; orange juice beverages; apple juice beverages; non-alcoholic cocktails.

Class 35: retail and online retail services in relation to the sale of non-alcoholic beverages, fruit beverages and fruit juices, syrups and other preparations for making beverages, smoothies, smoothies [non-alcoholic fruit beverages], smoothies [fruit beverages, fruit predominating], fruit-based beverages, frozen fruit beverages, powders used in the preparation of fruit-based beverages, fruit squashes, fruit nectars, fruit nectars, non-alcoholic, non-alcoholic fruit extracts, frozen fruit drinks, mixed fruit juice, non-alcoholic fruit drinks, fruit flavoured soft drinks, syrups for making fruit-flavoured drinks, concentrates for making fruit juices, ice fruit beverages, soft drinks, low-calorie soft drinks, syrups for making soft drinks, squashes [non-alcoholic beverages], beverages containing vitamins, alcohol free beverages, preparations for making beverages, red ginseng juice beverages, smoked plum beverages, pineapple juice beverages, tomato juice beverages, grape juice beverages, orange juice beverages, apple juice beverages.

Class 43: Services for providing food and drink; preparing and serving food and drink for consumption on or off the premises; bars; bar services. (Success against these terms under section 5(2)(b) is only to the extent that they cover 'juice bars')

87) I find that the opposition under section 5(2)(b) fails in relation to 'Beer' and 'beer-based cocktails' in class 32 and all of the alcoholic drinks in class 33 because I do not consider that the very low degree of similarity between those goods and the opponent's goods is sufficient, when weighed against all other factors, to lead the consumer to believe that the respective goods come from the same, or linked, undertaking(s).

88) The opposition under section 5(2)(b) must also fail against the goods and services for which no similarity was found.

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

89) Section 5(4)(a) states:

“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.”

90) In *Discount Outlet v Feel Good UK*, [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

“55. The elements necessary to reach a finding of passing off are the ‘classical trinity’ of that tort as described by Lord Oliver in the *Jif Lemon* case (*Reckitt & Colman Product v Borden* [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56. In relation to deception, the court must assess whether “a *substantial number*” of the Claimants’ customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per

*Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21).”

91) In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-410-11, Mr Daniel Alexander QC as the Appointed Person considered the relevant date for the purposes of s.5(4)(a) of the Act and concluded as follows:

“42...it is well-established in English law in cases going back 30 years that the date for assessing whether a claimant has sufficient goodwill to maintain an action for passing off is the time of the first actual or threatened act of passing off: *J.C. Penney Inc. v. Penneys Ltd.* [1975] FSR 367; *Cadbury-Schweppes Pty Ltd v. The Pub Squash Co. Ltd* [1981] RPC 429 (PC); *Barnsley Brewery Company Ltd. v. RBNB* [1997] FSR 462; *Inter Lotto (UK) Ltd. v. Camelot Group plc* [2003] EWCA Civ 1132 [2004] 1 WLR 955: “date of commencement of the conduct complained of”. If there was no right to prevent passing off at that date, ordinarily there will be no right to do so at the later date of application.

43. In *SWORDERS TM* O-212-06 Mr Alan James acting for the Registrar well summarised the position in s.5(4)(a) proceedings as follows:

‘Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made.’”

92) The filing date of the contested marks is 11 May 2018. As there is no evidence of any use by Party B before the filing date that is the only date I need to consider.

93) The concept of goodwill was considered by the House of Lords in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217:

“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 start.”

94) Even if I were to accept that Party A had the requisite goodwill in both signs relied upon under section 5(4)(a), which, given the evidence before me would be of a small level in relation to a business selling fruit and herbal juice, I do not consider that this ground offers Party A any greater prospect of success than it has enjoyed under section 5(2)(b).

95) I bear in mind that in *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation* [2016] EWCA Civ 41, Kitchin LJ considered the role of the average consumer in the assessment of a likelihood of confusion. Kitchen L.J. concluded:

“... if, having regard to the perceptions and expectations of the average consumer, the court concludes that a significant proportion of the relevant public is likely to be confused such as to warrant the intervention of the court then it may properly find infringement.”

Although this was an infringement case, the principles apply equally under 5(2): see *Soulcycle Inc v Matalan Ltd*, [2017] EWHC 496 (Ch). In *Marks and Spencer PLC v Interflora*, [2012] EWCA (Civ) 1501, Lewinson L.J. had previously cast doubt on whether the test for misrepresentation for passing off purposes came to the same thing as the test for a likelihood of confusion under trade mark law. He pointed out that it is sufficient for passing off purposes that “a substantial number” of the relevant public are deceived, which might not mean that the average consumer is confused. However, in the light of the Court of Appeal’s later judgment in *Comic Enterprises*, it seems doubtful whether the difference between the legal tests will (all other factors being equal) produce different outcomes. This is because they are both normative

tests intended to exclude the particularly careless or careful, rather than quantitative assessments.

96) I find that the similarities between the sign 'Tru-Juice Premium Quality' (stylised) and Party B's mark (as assessed earlier), are sufficient to cause a substantial number of Party A's customers or potential customers to believe that Party B's goods and services, listed at paragraph 86, come from the opponent such that damage would follow. I find no misrepresentation, and therefore no damage, in respect of any of the applicant's other goods and services.

97) Insofar as the TRU – JUICE sign is concerned, Mr Aikens submitted that there is a greater likelihood of deception in relation to this mark because it is more similar to the contested marks. I do not consider that the plain word mark TRU-JUICE is of any greater degree of similarity to the contested marks. In my view, there is also a medium degree of visual, aural and conceptual similarity between that mark and the contested marks. That being so, I fail to see how this sign can offer Party A any greater degree of success, even supposing that it has the requisite goodwill.

## **OVERALL OUTCOME**

**98) Trade Mark registration 2481221 may remain registered in respect of 'fruit juice and herbal juice' only. It is revoked in respect of all other goods.**

**99) Trade Mark Applications 3310118 and 3310122 may proceed to registration in respect of the following goods and services only:**

Class 29: Meat, fish, poultry and game; meat extracts; meatballs; meat paste; lamb products; chicken; fried chicken; chicken pieces; deep frozen chicken; chicken salad; pork; pork loin; canned pork; pork cutlets; fish cakes; smoked fish; canned fish; fish stock; tinned fish; dried fish; frozen fish; fish fingers; fish sticks; tuna fish; fish spawn; all types of preserved, dried, cooked, frozen and otherwise processed fruits and vegetables; prawns; beef; jellies namely meat, fish, fruit and vegetable jellies; calves' feet jelly; cooked fruits; frosted fruits; fruit preserves; fruit marmalades; gelatines; jams; compotes; lemon curd; fig jams; ginger jams; cranberry sauce; eggs; cheese;

sour milk; milk curds; dried milk; condensed milk; milk powder for food purposes; powdered milk for nutritional purposes; butter; concentrated butter; cocoa butter; clarified butter; honey butter; cream; yoghurts; yoghurt desserts; soya yoghurt; low fat yoghurts; custard style yoghurts; prepared meals; soups and preparations for making soups; cream of asparagus soup; cream of celery soup; cream of green pea soup; cream of mushroom soup; cream of spinach soup; cream of tomato soup; cream of chicken soup; mockturtle soup; oxtail soup; vegetable soup; Julienne soup; bouillon; consommé; tinned brisling; brisling in tomato; edible oils and fats; preserved olives and olive oil; brisling in oil; pimentos; conserves; preserves and preserved food products namely meat, fish, fruit and vegetable preserves; foods preserved with vinegar, namely meat and poultry preserved in vinegar; minced meats and vegetable spreads; bloater spread; kipper spread; salmon and anchovy spread; salmon and shrimp spread; spreads for sandwiches; fish and seafood spreads; low fat dairy spreads; meat spreads; potato crisps dairy spreads; cheese dips; pickles; onion salad; canned vegetable salad; frozen vegetables; peeled vegetables; dried vegetables; fruit salad; vegetable juices for cooking; dried or preserved horseradish; horseradish prepared for making sauce; pickled walnuts; chow-chow relish; relish having a base of processed cucumbers and of processed corn; tomato products; sauerkraut; kidney beans and cooked and prepared beans; baked beans; baked beans with pork and tomato sauce; baked beans, vegetarian with tomato sauce; prepared green beans; dried herbs for food; burgers; meat burgers; meat products being in the form of burgers; soy burger patties; tofu burger patties; turkey burger patties; vegetable burgers; vegetable burger patties; none of the aforesaid goods being molasses, burnt sugar, jerk seasoning, ackee and callaloo, or other food and drink products manufactured in Jamaica.

Class 30: Bread; powder paste; almond paste; wasabi paste; bean paste; cake paste; curry paste; essences for use in food preparation; food essences; vanilla essence; flavourings; flavourings for food or beverages; waffles; desserts; rice; tapioca and sago; flour and preparations made from cereals; bread, pastry and confectionery; edible ices; sugar; vanilla sugar; starch for foods; honey, treacle; yeast, baking-powder; baking soda; baking spices; flour for baking; ready-made baking mixtures; baking soda; cakes; cake preparations; cake mixtures; cake powder; breakfast cake; treacle cake; cake icing; fruit cakes; chocolate cakes; barm

cakes; frozen cakes; rice cakes; ice-cream cakes; chocolate extracts; chocolate mousse; salt; mustard; vinegar, sauces (condiments); spices; ice; ice cream; ice cream mixes; ice cream cones; ice cream powders; ice cream with fruit.

Class 31: Fresh vegetables; ready-made meals containing fresh fruits and vegetables; organic fresh vegetables; ready-made meals containing organic fresh fruits and vegetables; raw vegetables; ready-made meals containing raw vegetables; salad vegetables; ready-made meals containing salad vegetables; root vegetables; ready-made meals containing root vegetables; nuts; ready-made meals containing nuts and herbs; ready-made meals containing organic fresh herbs; seeds; grains and agricultural, horticultural and forestry products but not including fresh fruit or fresh herbs;<sup>19</sup> live animals; natural plants and flowers; foodstuffs for animals; malt.

Class 32: Beers; beer-based cocktails.

Class 33: Alcoholic beverages; alcoholic cordials; alcoholic extracts; alcoholic bitters; vodka; vodka mixtures; mixed alcoholic drinks containing vodka; alcoholic beverages containing vodka; alcoholic cordials containing vodka; alcoholic extracts containing vodka; alcoholic bitters containing vodka; cider; gin; grappa; port; kirsch; arrack; brandy; calvados; cachaça; alcopops; arak; aperitifs; anisette; wine; red wine; white wine; rum; sake; sangria; malt whisky; sherry; schnapps; vermouth; cocktails; prepared wine cocktails; alcoholic cocktails in the form of chilled gelatines; raspberry cocktails; grapefruit cocktails; preparations for making alcoholic beverages; alcoholic energy drinks; alcoholic energy drinks containing vodka; alcoholic beverages containing fruit and milk.

Class 35: Advertising; business management; business administration; office functions; retail and online retail services in relation to the sale of meat, fish, poultry and game, meat extracts, meatballs, meat paste, lamb products, chicken, fried chicken, chicken pieces, deep frozen chicken, chicken salad, pork, pork loin, canned pork, pork cutlets, fish cakes, smoked fish, canned fish, fish stock, tinned fish, dried fish, frozen fish, fish fingers, fish sticks, tuna fish, fish spawn, all types of preserved,

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<sup>19</sup> I consider this to be an appropriate exclusion bearing in mind the guidance in Tribunal Practice Notice 1/2012, "Partial Refusal".

dried, cooked, frozen and otherwise processed fruits and vegetables, prawns, beef, jellies namely meat, fish, fruit and vegetable jellies, calves' feet jelly, cooked fruits, frosted fruits, fruit preserves, fruit marmalades, gelatines, jams, compotes, lemon curd, fig jams, ginger jams, cranberry sauce, eggs, cheese, milk, milk and milk products, milk shakes, protein milk, albumin milk, sour milk, milk curds, skimmed milk, cow's milk, sheep milk, dried milk, rice milk, organic milk, milk shakes, condensed milk, goat milk, soya bean milk, milk powder for food purposes, powdered milk for nutritional purposes, butter, concentrated butter, cocoa butter, clarified butter, honey butter, cream, yoghurts, yoghurt desserts, soya yoghurt, low fat yoghurts, custard style yoghurts, prepared meals, soups and preparations for making soups, cream of asparagus soup, cream of celery soup, cream of green pea soup, cream of mushroom soup, cream of spinach soup, cream of tomato soup, cream of chicken soup, mockturtle soup, oxtail soup, vegetable soup, Julienne soup, bouillon, consommé, tinned brisling, brisling in tomato, edible oils and fats, preserved olives and olive oil, brisling in oil,, pimentos, conserves, preserves and preserved food products namely meat, fish, fruit and vegetable preserves, foods preserved with vinegar, namely meat and poultry preserved in vinegar, minced meats and vegetable spreads, bloater spread, kipper spread, salmon and anchovy spread, salmon and shrimp spread, spreads for sandwiches, fish and seafood spreads, low fat dairy spreads, meat spreads, potato crisps dairy spreads, cheese dips, pickles, onion salad, canned vegetable salad, frozen vegetables, peeled vegetables, dried vegetables, fruit salad, vegetable juices for cooking, dried or preserved horseradish, horseradish prepared for making sauce, pickled walnuts, chow-chow relish, relish having a base of processed cucumbers and of processed corn, tomato products, sauerkraut, kidney beans and cooked and prepared beans, baked beans, baked beans with pork and tomato sauce, baked beans, vegetarian with tomato sauce, prepared green beans, dried herbs for food, burgers, meat burgers, meat products being in the form of burgers, soy burger patties, tofu burger patties, turkey burger patties, vegetable burgers, vegetable burger patties, bread, powder paste, almond paste, wasabi paste, bean paste, cake paste, curry paste, essences for use in food preparation, food essences, vanilla essence, flavourings, flavourings for food or beverages, waffles, desserts, coffee, tea, cocoa and artificial coffee, rice, tapioca and sago, flour and preparations made from cereals, bread, pastry and confectionery, edible ices, sugar, vanilla sugar, starch for foods, honey, treacle,

yeast, baking-powder, baking soda, baking spices, flour for baking, ready-made baking mixtures, baking soda, cakes, cake preparations, cake mixtures, cake powder, breakfast cake, treacle cake, cake icing, fruit cakes, chocolate cakes, barm cakes, frozen cakes, rice cakes, ice-cream cakes, chocolate extracts, chocolate mousse, salt, mustard, vinegar, sauces (condiments), spices, ice, ice cream, ice cream mixes, ice cream cones, ice cream powders, ice-cream drinks, ice cream shakes, ice cream with fruit, fresh fruits and vegetables, ready-made meals containing fresh fruits and vegetables, organic fresh fruit and vegetables, ready-made meals containing organic fresh fruits and vegetables, raw vegetables, ready-made meals containing raw vegetables, salad vegetables, ready-made meals containing salad vegetables, root vegetables, ready-made meals containing root vegetables, nuts and herbs, ready-made meals containing nuts and herbs, organic fresh herbs, ready-made meals containing organic fresh herbs, seeds, grains and agricultural, horticultural and forestry products, live animals, natural plants and flowers, foodstuffs for animals, malt, beers, mineral and aerated waters, vegetable drinks, energy drinks, cola drinks, isotonic drinks, de-alcoholised drinks, energy drinks containing caffeine, carbonated non-alcoholic drinks, part frozen slush drinks, fruit flavoured carbonated drinks, sports drinks containing electrolytes, isotonic non-alcoholic drinks, aloe vera drinks, non-alcoholic, sorbets [beverages], sherbets [beverages], effervescing beverages (powders for -), powders for effervescing beverages, beverages (whey -), tonic water [non-medicated beverages], pastilles for effervescing beverages, mineral water [beverages], honey-based beverages (non-alcoholic -), non-alcoholic beverages with tea flavour, kvass [non-alcoholic beverages], malt syrup for beverages, soya-based beverages, other than milk substitutes, alcoholic beverages, alcoholic cordials, alcoholic extracts, alcoholic bitters, vodka, vodka mixtures, mixed alcoholic drinks containing vodka, alcoholic beverages containing vodka, alcoholic cordials containing vodka, alcoholic extracts containing vodka, alcoholic bitters containing vodka, cider, gin, grappa, port, kirsch, arrack, brandy, calvados, cachaça, alcopops, arak, aperitifs, anisette, wine, red wine, white wine, rum, sake, sangria, malt whisky, sherry, schnapps, vermouth, cocktails, beer-based cocktails, prepared wine cocktails, non-alcoholic cocktails, alcoholic cocktails in the form of chilled gelatines, raspberry cocktails, grapefruit cocktails, preparations for making alcoholic beverages, alcoholic energy drinks, alcoholic energy drinks containing vodka, alcoholic beverages containing fruit and milk; the

provision of food-ordering services through an on-line computer network; none of the aforesaid retail and online retail services relating to the sale of molasses, burnt sugar, jerk seasoning, ackee and callaloo, or other food or drink products manufactured in Jamaica.

Class 43: Services for providing food and drink; food preparation; food preparation services; preparing and serving food and drink for consumption on or off the premises; restaurants; restaurant services; restaurant services for the provision of fast-food; delicatessens; grill restaurants; carry-out restaurants; self-service restaurants; contract food services; catering; catering for the provision of food and drink; catering services for the provision of food and drink; cafeterias; catering in fast-food cafeterias; snack-bars; canteens; takeaway services; wine tasting services; bars; bar services; hospitality services [food and drink]; corporate hospitality (provision of food and drink); night club services [provision of food]; arranging of wedding receptions [food and drink]; consultancy services relating to food preparation; rental of food service equipment; provision of information relating to restaurants; temporary accommodation; none of the aforementioned being juice bars.<sup>20</sup>

## **COSTS**

100) Both parties have enjoyed a degree of success. However, given that Party B has succeeded in its application for cancellation against most of Party A's goods and has also succeeded in defending the vast majority of its goods and services in the two oppositions, it seems to me that Party B is entitled to an award of costs. I estimate the ratio of success to be approximately 80%: 20% in Party B's favour. I therefore make the following award, using the guidance in Tribunal Practice Notice 2/2016:

Preparing a statement and considering the other side's statement x 3	£600
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<sup>20</sup> I, again, consider this to be an appropriate exclusion bearing in mind the guidance in Tribunal Practice Notice 1/2012, "Partial Refusal".

Official Fee for TM26(N)	£200
Preparing for, and attending, the hearing	£600
Overall:	£1400 <u>x 0.8</u>
<b>Total to be paid:</b>	<b>£1120</b>

101) I order Trade Winds Citrus (Intl.) Ltd. to pay Gulbahar UK Limited the sum of **£1120**. This sum is to be paid within 21 days of the expiry of the appeal period or within 21 days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 19<sup>th</sup> day of March 2020**

**Beverley Hedley  
For the Registrar,  
the Comptroller-General**

## Annex

**Class 29:** Meat, fish, poultry and game; meat extracts; meatballs; meat paste; lamb products; chicken; fried chicken; chicken pieces; deep frozen chicken; chicken salad; pork; pork loin; canned pork; pork cutlets; fish cakes; smoked fish; canned fish; fish stock; tinned fish; dried fish; frozen fish; fish fingers; fish sticks; tuna fish; fish spawn; all types of preserved, dried, cooked, frozen and otherwise processed fruits and vegetables; prawns; beef; jellies namely meat, fish, fruit and vegetable jellies; calves' feet jelly; cooked fruits; frosted fruits; fruit preserves; fruit marmalades; gelatines; jams; compotes; lemon curd; fig jams; ginger jams; cranberry sauce; eggs; cheese; milk; milk and milk products; milk shakes; protein milk; albumin milk; sour milk; milk curds; skimmed milk; cow's milk; sheep milk; dried milk; rice milk; organic milk; milk shakes; condensed milk; goat milk; soya bean milk; milk powder for food purposes; powdered milk for nutritional purposes; butter; concentrated butter; cocoa butter; clarified butter; honey butter; cream; yoghurts; yoghurt desserts; soya yoghurt; low fat yoghurts; custard style yoghurts; prepared meals; soups and preparations for making soups; cream of asparagus soup; cream of celery soup; cream of green pea soup; cream of mushroom soup; cream of spinach soup; cream of tomato soup; cream of chicken soup; mockturtle soup; oxtail soup; vegetable soup; Julienne soup; bouillon; consommé; tinned brisling; brisling in tomato; edible oils and fats; preserved olives and olive oil; brisling in oil;; pimentos; conserves; preserves and preserved food products namely meat, fish, fruit and vegetable preserves; foods preserved with vinegar, namely meat and poultry preserved in vinegar; minced meats and vegetable spreads; bloater spread; kipper spread; salmon and anchovy spread; salmon and shrimp spread; spreads for sandwiches; fish and seafood spreads; low fat dairy spreads; meat spreads; potato crisps dairy spreads; cheese dips; pickles; onion salad; canned vegetable salad; frozen vegetables; peeled vegetables; dried vegetables; fruit salad; vegetable juices for cooking; dried or preserved horseradish; horseradish prepared for making sauce; pickled walnuts; chow-chow relish; relish having a base of processed cucumbers and of processed corn; tomato products; sauerkraut; kidney beans and cooked and prepared beans; baked beans; baked beans with pork and tomato sauce; baked beans, vegetarian with tomato sauce; prepared green beans; dried herbs for food; burgers; meat burgers; meat products being in the form of burgers; soy burger patties; tofu burger patties; turkey burger

patties; vegetable burgers; vegetable burger patties; none of the aforesaid goods being molasses, burnt sugar, jerk seasoning, ackee and callaloo, or other food and drink products manufactured in Jamaica.

**Class 30:** Bread; powder paste; almond paste; wasabi paste; bean paste; cake paste; curry paste; essences for use in food preparation; food essences; vanilla essence; flavourings; flavourings for food or beverages; waffles; desserts; coffee, tea, cocoa and artificial coffee; rice; tapioca and sago; flour and preparations made from cereals; bread, pastry and confectionery; edible ices; sugar; vanilla sugar; starch for foods; honey, treacle; yeast, baking-powder; baking soda; baking spices; flour for baking; ready-made baking mixtures; baking soda; cakes; cake preparations; cake mixtures; cake powder; breakfast cake; treacle cake; cake icing; fruit cakes; chocolate cakes; barm cakes; frozen cakes; rice cakes; ice-cream cakes; chocolate extracts; chocolate mousse; salt; mustard; vinegar, sauces (condiments); spices; ice; ice cream; ice cream mixes; ice cream cones; ice cream powders; ice-cream drinks; ice cream shakes; ice cream with fruit.

**Class 31:** Fresh fruits and vegetables; ready-made meals containing fresh fruits and vegetables; organic fresh fruit and vegetables; ready-made meals containing organic fresh fruits and vegetables; raw vegetables; ready-made meals containing raw vegetables; salad vegetables; ready-made meals containing salad vegetables; root vegetables; ready-made meals containing root vegetables; nuts and herbs; ready-made meals containing nuts and herbs; organic fresh herbs; ready-made meals containing organic fresh herbs; seeds; grains and agricultural, horticultural and forestry products; live animals; natural plants and flowers; foodstuffs for animals; malt.

**Class 32:** Beers; mineral and aerated waters and other non-alcoholic beverages; fruit beverages and fruit juices; syrups and other preparations for making beverages; smoothies; smoothies [non-alcoholic fruit beverages]; smoothies [fruit beverages, fruit predominating]; fruit-based beverages; frozen fruit beverages; powders used in the preparation of fruit-based beverages; fruit squashes; fruit nectars; fruit nectars, non-alcoholic; non-alcoholic fruit extracts; frozen fruit drinks; mixed fruit juice; non-alcoholic fruit drinks; fruit flavoured soft drinks; syrups for making fruit-flavoured

drinks; concentrates for making fruit juices; ice fruit beverages; soft drinks; vegetable drinks; energy drinks; cola drinks; isotonic drinks; de-alcoholised drinks; energy drinks containing caffeine; low-calorie soft drinks; carbonated non-alcoholic drinks; part frozen slush drinks; fruit flavoured carbonated drinks; sports drinks containing electrolytes; isotonic non-alcoholic drinks; aloe vera drinks, non-alcoholic; syrups for making soft drinks; squashes [non-alcoholic beverages]; sorbets [beverages]; sherbets [beverages]; beverages containing vitamins; alcohol free beverages; effervescing beverages (powders for -); powders for effervescing beverages; preparations for making beverages; beverages (whey -); tonic water [non-medicated beverages]; pastilles for effervescing beverages; mineral water [beverages]; honey-based beverages (non-alcoholic -); red ginseng juice beverages; smoked plum beverages; pineapple juice beverages; non-alcoholic beverages with tea flavour; tomato juice beverages; kvass [non-alcoholic beverages]; malt syrup for beverages; soya-based beverages, other than milk substitutes; grape juice beverages; orange juice beverages; apple juice beverages; beer-based cocktails; non-alcoholic cocktails.

**Class 33:** Alcoholic beverages; alcoholic cordials; alcoholic extracts; alcoholic bitters; vodka; vodka mixtures; mixed alcoholic drinks containing vodka; alcoholic beverages containing vodka; alcoholic cordials containing vodka; alcoholic extracts containing vodka; alcoholic bitters containing vodka; cider; gin; grappa; port; kirsch; arrack; brandy; calvados; cachaça; alcopops; arak; aperitifs; anisette; wine; red wine; white wine; rum; sake; sangria; malt whisky; sherry; schnapps; vermouth; cocktails; prepared wine cocktails; alcoholic cocktails in the form of chilled gelatines; raspberry cocktails; grapefruit cocktails; preparations for making alcoholic beverages; alcoholic energy drinks; alcoholic energy drinks containing vodka; alcoholic beverages containing fruit and milk.

**Class 35:** Advertising; business management; business administration; office functions; retail and online retail services in relation to the sale of meat, fish, poultry and game, meat extracts, meatballs, meat paste, lamb products, chicken, fried chicken, chicken pieces, deep frozen chicken, chicken salad, pork, pork loin, canned pork, pork cutlets, fish cakes, smoked fish, canned fish, fish stock, tinned fish, dried fish, frozen fish, fish fingers, fish sticks, tuna fish, fish spawn, all types of preserved,

dried, cooked, frozen and otherwise processed fruits and vegetables, prawns, beef, jellies namely meat, fish, fruit and vegetable jellies, calves' feet jelly, cooked fruits, frosted fruits, fruit preserves, fruit marmalades, gelatines, jams, compotes, lemon curd, fig jams, ginger jams, cranberry sauce, eggs, cheese, milk, milk and milk products, milk shakes, protein milk, albumin milk, sour milk, milk curds, skimmed milk, cow's milk, sheep milk, dried milk, rice milk, organic milk, milk shakes, condensed milk, goat milk, soya bean milk, milk powder for food purposes, powdered milk for nutritional purposes, butter, concentrated butter, cocoa butter, clarified butter, honey butter, cream, yoghurts, yoghurt desserts, soya yoghurt, low fat yoghurts, custard style yoghurts, prepared meals, soups and preparations for making soups, cream of asparagus soup, cream of celery soup, cream of green pea soup, cream of mushroom soup, cream of spinach soup, cream of tomato soup, cream of chicken soup, mockturtle soup, oxtail soup, vegetable soup, Julienne soup, bouillon, consommé, tinned brisling, brisling in tomato, edible oils and fats, preserved olives and olive oil, brisling in oil,, pimentos, conserves, preserves and preserved food products namely meat, fish, fruit and vegetable preserves, foods preserved with vinegar, namely meat and poultry preserved in vinegar, minced meats and vegetable spreads, bloater spread, kipper spread, salmon and anchovy spread, salmon and shrimp spread, spreads for sandwiches, fish and seafood spreads, low fat dairy spreads, meat spreads, potato crisps dairy spreads, cheese dips, pickles, onion salad, canned vegetable salad, frozen vegetables, peeled vegetables, dried vegetables, fruit salad, vegetable juices for cooking, dried or preserved horseradish, horseradish prepared for making sauce, pickled walnuts, chow-chow relish, relish having a base of processed cucumbers and of processed corn, tomato products, sauerkraut, kidney beans and cooked and prepared beans, baked beans, baked beans with pork and tomato sauce, baked beans, vegetarian with tomato sauce, prepared green beans, dried herbs for food, burgers, meat burgers, meat products being in the form of burgers, soy burger patties, tofu burger patties, turkey burger patties, vegetable burgers, vegetable burger patties, bread, powder paste, almond paste, wasabi paste, bean paste, cake paste, curry paste, essences for use in food preparation, food essences, vanilla essence, flavourings, flavourings for food or beverages, waffles, desserts, coffee, tea, cocoa and artificial coffee, rice, tapioca and sago, flour and preparations made from cereals, bread, pastry and confectionery, edible ices, sugar, vanilla sugar, starch for foods, honey, treacle,

yeast, baking-powder, baking soda, baking spices, flour for baking, ready-made baking mixtures, baking soda, cakes, cake preparations, cake mixtures, cake powder, breakfast cake, treacle cake, cake icing, fruit cakes, chocolate cakes, barm cakes, frozen cakes, rice cakes, ice-cream cakes, chocolate extracts, chocolate mousse, salt, mustard, vinegar, sauces (condiments), spices, ice, ice cream, ice cream mixes, ice cream cones, ice cream powders, ice-cream drinks, ice cream shakes, ice cream with fruit, fresh fruits and vegetables, ready-made meals containing fresh fruits and vegetables, organic fresh fruit and vegetables, ready-made meals containing organic fresh fruits and vegetables, raw vegetables, ready-made meals containing raw vegetables, salad vegetables, ready-made meals containing salad vegetables, root vegetables, ready-made meals containing root vegetables, nuts and herbs, ready-made meals containing nuts and herbs, organic fresh herbs, ready-made meals containing organic fresh herbs, seeds, grains and agricultural, horticultural and forestry products, live animals, natural plants and flowers, foodstuffs for animals, malt, beers, mineral and aerated waters and other non-alcoholic beverages, fruit beverages and fruit juices, syrups and other preparations for making beverages, smoothies, smoothies [non-alcoholic fruit beverages], smoothies [fruit beverages, fruit predominating], fruit-based beverages, frozen fruit beverages, powders used in the preparation of fruit-based beverages, fruit squashes, fruit nectars, fruit nectars, non-alcoholic, non-alcoholic fruit extracts, frozen fruit drinks, mixed fruit juice, non-alcoholic fruit drinks, fruit flavoured soft drinks, syrups for making fruit-flavoured drinks, concentrates for making fruit juices, ice fruit beverages, soft drinks, vegetable drinks, energy drinks, cola drinks, isotonic drinks, de-alcoholised drinks, energy drinks containing caffeine, low-calorie soft drinks, carbonated non-alcoholic drinks, part frozen slush drinks, fruit flavoured carbonated drinks, sports drinks containing electrolytes, isotonic non-alcoholic drinks, aloe vera drinks, non-alcoholic, syrups for making soft drinks, squashes [non-alcoholic beverages], sorbets [beverages], sherbets [beverages], beverages containing vitamins, alcohol free beverages, effervescing beverages (powders for -), powders for effervescing beverages, preparations for making beverages, beverages (whey -), tonic water [non-medicated beverages], pastilles for effervescing beverages, mineral water [beverages], honey-based beverages (non-alcoholic -), red ginseng juice beverages, smoked plum beverages, pineapple juice beverages, non-alcoholic beverages with tea flavour, tomato juice beverages, kvass [non-alcoholic

beverages], malt syrup for beverages, soya-based beverages, other than milk substitutes, grape juice beverages, orange juice beverages, apple juice beverages, alcoholic beverages, alcoholic cordials, alcoholic extracts, alcoholic bitters, vodka, vodka mixtures, mixed alcoholic drinks containing vodka, alcoholic beverages containing vodka, alcoholic cordials containing vodka, alcoholic extracts containing vodka, alcoholic bitters containing vodka, cider, gin, grappa, port, kirsch, arrack, brandy, calvados, cachaça, alcopops, arak, aperitifs, anisette, wine, red wine, white wine, rum, sake, sangria, malt whisky, sherry, schnapps, vermouth, cocktails, beer-based cocktails, prepared wine cocktails, non-alcoholic cocktails, alcoholic cocktails in the form of chilled gelatines, raspberry cocktails, grapefruit cocktails, preparations for making alcoholic beverages, alcoholic energy drinks, alcoholic energy drinks containing vodka, alcoholic beverages containing fruit and milk; the provision of food-ordering services through an on-line computer network; none of the aforesaid retail and online retail services relating to the sale of molasses, burnt sugar, jerk seasoning, ackee and callaloo, or other food or drink products manufactured in Jamaica.

**Class 43:** Services for providing food and drink; food preparation; food preparation services; preparing and serving food and drink for consumption on or off the premises; restaurants; restaurant services; restaurant services for the provision of fast-food; delicatessens; grill restaurants; carry-out restaurants; self-service restaurants; contract food services; catering; catering for the provision of food and drink; catering services for the provision of food and drink; cafeterias; catering in fast-food cafeterias; snack-bars; canteens; takeaway services; wine tasting services; bars; bar services; hospitality services [food and drink]; corporate hospitality (provision of food and drink); night club services [provision of food]; arranging of wedding receptions [food and drink]; consultancy services relating to food preparation; rental of food service equipment; provision of information relating to restaurants; temporary accommodation.