

O-182-15

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION 3013239
BY TIMOTHY AUGUSTINE KEARNS AND THE TRUSTEES OF JP JUICES
PENSION SCHEME (TAX AND WEALTH TRUSTEES LLP)
TO REGISTER THE FOLLOWING SERIES OF TRADE MARKS IN CLASS 32:**

JP's JP's JP's

AND

**OPPOSITION THERETO (NO. 401208) BY
FAGS (MACHINES) LTD**

Background and pleadings

1. Registration of the series of three trade marks shown above was applied for on 9 July 2013 by Timothy Augustine Kearns and The Trustees of JP Juices Pension Scheme (Tax and Wealth Trustees LLP) (“the applicants”). Little turns on the differences between the three marks, so I will refer, in the most part, to the marks in the singular. The applicants seek registration for the following class 32 goods:

Beers; mineral and aerated waters and other non-alcoholic beverages; fruit beverages and fruit juices; syrups and other preparations for making beverages.

2. The mark was published for opposition purposes on 16 August 2013.

3. Registration is opposed by Fag (Machines) Ltd (“the opponent”). Relying on registration 2543788, the opponent pleads grounds under sections 5(1) and 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The details of registration 2543788 are:

Filed on 1 April 2010 and completed its registration process on 16 July 2010. The mark and the class 32 goods for which it is registered are:



Fruit drinks and fruit juices

4. In its statement of case the opponent states that:

“The second mark in the series applied for is identical to the earlier registered mark and the other two marks in the series are closely similar. The goods covered by the application include goods identical to those covered by the earlier registration, and other goods which are similar. There is inevitably going to be a likelihood of confusion in these circumstances.”

5. Given its date of filing, the opponent’s mark qualifies as an earlier mark in accordance with section 6 of the Act. Furthermore, given that the earlier mark had not been registered for more than five years at the date on which the applicants’ mark was published, the proof of use provisions in section 6A of the Act are not applicable. The earlier mark may be relied upon for all its goods.

6. The applicants filed a counterstatement making a simple denial of the grounds of opposition.

7. The applicants are represented by Novagraaf UK, the opponent by Forresters. Neither side filed evidence. Neither side requested a hearing. Neither side filed written submissions.

The case-law and legislation

8. Sections 5(1) and 5(2(b) of the Act state that:

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

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

(a)

(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.”

9. The following principles are gleaned from the judgments of the EU courts in *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.

(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.

10. The above guidance relates more to section 5(2)(b) than section 5(1). In relation to the latter, I additionally note the following guidance provided by the Court of Justice of the European Union (“CJEU”) in *S.A. Société LTJ Diffusion v. Sadas Vertbaudet SA* [2003] FSR 34 which explains when marks can be considered as identical:

“54. In those circumstances, the answer to the question referred must be that Art.5(1)(a) of the Directive must be interpreted as meaning that a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer.”

Average consumer and the purchasing act

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

12. All the goods are beverages (or preparations for making them) of one form or another. They are purchased by the general public. None are particularly costly and are fairly frequent purchases routinely selected from the shelves of supermarkets (and other establishments) or the online equivalents. This suggests a fairly casual selection process (although not the most causal of all purchases). Given the manner of selection, the visual impact of the marks will take on more significance, but I will not ignore the aural aspects completely. Even for goods such as beer, which is often purchased in licensed premises such as pubs and clubs, the goods will be on display so that they can be seen (see *Simonds Farsons Cisk plc v OHIM* Case T-3/04).

Comparison of goods

13. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the CJEU stated at paragraph 23 of its judgment:

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

14. Guidance on this issue has also come from Jacob J In *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281 where the following factors were highlighted as being relevant when making the comparison:

“(a) The respective uses of the respective goods or services;

(b) The respective users of the respective goods or services;

(c) The physical nature of the goods or acts of service;

(d) The respective trade channels through which the goods or services reach the market;

(e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;

(f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.”

15. In terms of being complementary (one of the factors referred to in *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*), this relates to close connections or

relationships that are important or indispensable for the use of the other. In *Boston Scientific Ltd v OHIM* Case T- 325/06 it was stated:

“It is true that goods are complementary if 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 (see, to that effect, Case T-169/03 Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI) [2005] ECR II-685, paragraph 60, upheld on appeal in Case C-214/05 P Rossi v OHIM [2006] ECR I-7057; Case T-364/05 Saint-Gobain Pam v OHIM – Propamsa (PAM PLUVIAL) [2007] ECR II-757, paragraph 94; and Case T-443/05 El Corte Inglés v OHIM – Bolaños Sabri (PiraÑAM diseño original Juan Bolaños) [2007] ECR I-0000, paragraph 48).”

16. In relation to understanding what terms used in specifications mean/cover, the case-law informs me that “in construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of the trade”¹ and that I must also bear in mind that words should be given their natural meaning within the context in which they are used; they cannot be given an unnaturally narrow meaning². I also note the judgment of Mr Justice Floyd in *YouView TV Limited v Total Limited* where he stated:

“..... 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) (IPTRANSLATOR) [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.”

17. Even if goods are not worded identically, they can still be considered identical if one term falls within the ambit of another, as per the judgment in *Gérard Meric v OHIM*, Case T-133/05.

18. The applicants’ seek registration for the following class 32 goods:

Beers; mineral and aerated waters and other non-alcoholic beverages; fruit beverages and fruit juices; syrups and other preparations for making beverages.

¹ See *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281

² See *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267

19. The earlier mark is registered for:

Fruit drinks and fruit juices

20. The applied for *fruit beverages and fruit juices* are clearly identical to the goods of the earlier mark. Furthermore, the applied for *other non-alcoholic beverages* includes fruit drinks and fruit juices within its ambit so may also be considered identical on the principle outlined in *Gérard Meric v OHIM*.

21. The applied for *syrups and other preparations for making beverages* could be fruit based preparations such as squash, cordial or concentrated juice. As such they are very similar in nature and purpose. The method of use is slightly different in that something needs to be done to the preparation to make it drinkable. However, this may be something as simple as adding water. The goods may not be sold alongside each other but will likely be sold in fairly close proximity. I consider there to be a reasonably high degree of similarity between these goods and the goods of the earlier mark.

22. The applied for *mineral and aerated waters* are soft drinks consumed to quench one's thirst; this also applies to the earlier mark's fruit drinks/juice. There is an element of competition as one will often make a competitive choice over which soft drink to consume. The method of use is the same. Again, whilst they may not be sold alongside each other, they will likely be sold in fairly close proximity. I consider the goods to be reasonably similar.

23. That leaves the applied for *beer*. Although both beer and fruit drinks/juice are beverages, the nature is somewhat different at least in terms of ingredients. The alcoholic nature of beer also introduces a difference in purpose (in terms of the desire to impart the effects of alcohol), although, I accept that both can be consumed to quench one's thirst. In the retail environment they are not located particularly close to each other. They may be closer in a bar/club environment (in a chilled cabinet) but will normally be on a different shelf within it. There may at times be a competitive relationship as a beer drinker may well at times drink fruit juice instead of beer. However, this is likely to be more to do with the fact that he or she has decided not to drink an alcoholic product per se (perhaps because they are driving) so will move on to something which is non-alcoholic and, so, the true competitive choice is between the various soft drinks that are on offer. There are more differences than similarities. Whilst I do not say that the goods are wholly dissimilar, I nevertheless consider that any similarity is of a quite low degree.

Comparison of marks

24. 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.”

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

26. The marks to be compared are:



and



27. The overall impression of all the marks is based predominantly on the letters JP's (the heart device will be approximated to an apostrophe). The heart device itself plays a role in the overall impression (it is certainly not negligible), albeit one with a lesser relative weight than the letters. The colours, in my view, play a more limited role.

28. From a visual perspective, it takes little assessment to come to the view that all three applied for marks are similar to the earlier mark to a very high degree. The only difference is in colouring, which, in my view, does little to lessen the similarity that exists between them. The marks are aurally identical, each will be articulated as JAY-PEASE. There is no clear concept beyond being letters, so any conceptual meaning is shared.

29. For the purposes of section 5(1), the opponent additionally argues that the second of the applied for marks is identical to the earlier mark. Although the shape and configuration of the marks is identical, the colouring is not. However, the differences are so small that they may go unnoticed and, so, in accordance with *S.A. Société LTJ Diffusion v. Sadas Vertbaudet SA* I agree that it is possible to consider the marks as identical.

Distinctiveness character of the earlier mark

30. The degree of distinctiveness of the earlier mark must be assessed. This is because the more distinctive the earlier mark, based either on inherent qualities or because of use made, the greater the likelihood of confusion (see *Sabel BV v. Puma*

AG, paragraph 24). 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).”

31. No evidence has been filed so I have only the inherent qualities of the earlier mark to consider. From that perspective, the letters JP’s make no allusion to the goods covered by the earlier mark. Although letters do not normally make for the most distinctive of trade marks, there is no reason to accord them a low degree of distinctive character. The heart device adds something also. I consider the earlier mark to be possessed of a medium degree of inherent distinctive character.

Likelihood of confusion – section 5(2)(b)

32. Although the opponent also argues on the basis of section 5(1) in relation to one of the earlier marks, I will begin my assessment of the opposition under section 5(2)(b). The factors assessed so far have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17), a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). However, there is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused.

33. The marks are highly similar visually and are identical on an aural and conceptual level. In relation to identical goods I agree with the opponent that a likelihood of confusion is inevitable. Indeed, I struggle to see how any other finding could be made. In relation to *mineral and aerated waters* and the *syrups and other preparations for making beverages*, I come to the view that there is also a likelihood of confusion. The average consumer will simply believe that the goods are part of the same range of goods produced by the same (or a related) undertaking. That leaves the applied for *beer*. I have already held that the degree of similarity between the goods is quite low. However, the marks are highly similar. As indicated at paragraph

9 (point g), a lesser degree of similarity between the goods may be offset by a greater degree of similarity between the marks. I stress the word “may”. This is not, therefore, a hard and fast rule. Nevertheless, I come to the view that there is a likelihood of confusion. Whilst it may not be common for beer and fruit drinks/juice to be the responsibility of the same (or related) undertakings, the marks are so strikingly similar that this is what the average consumer will nevertheless assume. **There is a likelihood of confusion in relation to all three marks in the application in relation to all of the applied for goods.**

Section 5(1)

34. This ground is not strictly needed as the opponent has succeeded under section 5(2)(b). However, it follows that the opponent would also have succeeded under section 5(1) in relation to the second mark in the series (which I held could be considered as identical to the earlier mark) in so far as identical goods are concerned. For the goods which are not identical, the opposition succeeds under section 5(2)(b).

Costs

35. The opponent has succeeded and is entitled to a contribution towards its costs. My assessment is as follows:

Preparing a statement and considering the other side’s statement - £300

Official fee - £100

36. I therefore order Timothy Augustine Kearns and The Trustees of JP Juices Pension Scheme (Tax and Wealth Trustees LLP), being jointly and severally liable, to pay Fags (Machines) Ltd the sum of £400. This should be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 17th day of April 2015

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