O-224-18

In the matter of THE TRADE MARKS ACT 1994

And in the matter of Application No. 3100349 in the name of GEETA SIDHU-ROBB

To register the word

NOSH

and in the matter of Opposition No. 406296
by NOSH BEVERAGES LIMITED

Appeal from the Decision of the Hearing Officer, Ms June Ralph, on behalf of the Registrar, the Comptroller General, dated 10 February 2017

DECISION OF THE APPOINTED PERSON

1. This is an Appeal from the decision of the Hearing Officer, Ms June Ralph, in an Opposition brought by Nosh Beverages Limited ('the Opponent') against the Application by Ms Geeta Sidhu-Robb ('the Applicant') to register the word NOSH as a trade mark. The Application was to register the mark for goods and services in classes 30, 32, 43 and 44, but the Opposition was limited to classes 30 and 32.

2. The goods applied for were as follows:

Class 30*: Coffee, tea, artificial coffee; beverages based on tea; beverages with tea base; black tea; darjeeling tea; earl grey tea; fruit teas; ginger tea; ginseng tea; green tea; herb tea [infusions]; herbal flavourings for making beverages; herbal*

infusions; herbal tea [infusions]; instant tea; jasmine tea; lime tea; oolong tea; orange flavoured tea; red ginseng tea; rosemary tea; sage tea; tea leaves; tea mixtures; tea substitutes.

Class 32: *Aerated juices; aerated mineral waters; aerated water; aloe vera juices; aperitifs, non-alcoholic; beverages consisting principally of fruit juices; apple juice beverages; beverages consisting principally of fruit juices; beverages containing vitamins; beverages enriched with added minerals; beverages enriched with added trace elements; beverages enriched with added vitamins; cocktails, non-alcoholic; concentrated fruit juice; concentrates for making fruit juices; cordials; drinking water; energy drinks; flavoured waters; fruit beverages; fruit beverages and fruit juices; fruit juice; fruit juice for use as a beverages; fruit-based beverages; fruit-flavoured beverages; fruit nectars; fruit squashes; grape juice; honey-based beverages (non-alcoholic -); juice (fruit -); juices; low-calorie soft drinks; milk of almonds [beverage]; mixed fruit juice; non-dairy milk; preparations for making beverages; smoothies; soft drinks; soya-based beverages, other than milk substitutes; sorbets in the nature of beverages; syrups for making beverages; syrups for beverages; vegetable juice.*

3. The Opposition was based on s5(1) and s5(2)(a) of the Trade Marks Act 1994, founded on the identicality between the mark applied for and the Opponent's registered mark 3029528 for the word NOSH. The Opponent's mark NOSH is registered in class 29 for

   'non-alcoholic yoghurt drink with fruit and cereals.'

4. The Hearing Officer considered that none of the goods covered by the Application were identical to the goods for which the Opponent's mark was registered. The objection under s5(1) therefore failed. So far as the s5(2)(a) objection was concerned, she went through the specifications of goods for which the Application was made in classes 30 and 32, assessing the level of similarity in each case. So far as the class 30 goods are concerned, she considered that there was only a 'very low' level of similarity. So far as the class 32 goods are concerned, she broke down the list

of goods into a number of categories and considered that there was a range of levels of similarity from 'low' to 'high', depending on the category.

5. Having done that analysis, she concluded that there was a likelihood of confusion in respect of all goods where there was anything more than a 'very low' level of similarity. This resulted in a finding that the mark should be refused for all the goods in class 32 but allowed for all the goods in class 30.

6. The Applicant has not challenged the finding in relation to class 32, but the Opponent challenges the finding in relation to class 30.

7. The basis of the Appeal is a relatively short point. The Opponent notes that the Hearing Officer considered that those goods in class 32 which were ready-made refrigerated drinks of the kind which could be sold in supermarkets (potentially near the Applicant's goods) were at least of a 'medium' level of similarity with the Applicant's goods. See for example her finding in paragraph 19 relation to the following category of goods in class 32: *'aerated mineral waters; aerated water; drinking water; flavoured waters'*:

'19. The exact nature of these goods is not the same as the opponent's goods for obvious reasons. However, like the opponent's goods, they are ready made, non-alcoholic beverages that will be sold through supermarkets and suchlike to the general public. They may often be found in the refrigerated section of a retail outlet close to the opponent's goods and there may be an element of competition between them. There is a medium degree of similarity with the opponent's goods.'

8. The Opponent submits that the class 30 goods would also include ready-made drinks which one could expect to find in a supermarket refrigerator. There is thus an apparent inconsistency in the Hearing Officer's approach.

9. The Hearing Officer did not seek to divide up the class 30 goods into different categories (unlike her approach in the case of the class 32 goods). Her decision in relation to similarity was as follows (paragraph 18):

'Both parties' goods are likely to be found in retailers such as supermarkets. The opponent's non-alcoholic yoghurt drink with fruit and cereals will come ready-made and will be stocked in the refrigerated section. The applicant's goods are, generally speaking, coffee, tea and herbal drinks. Whilst some of these may possibly be found in ready-made bottles in a refrigerator, they are generally more likely to come in dried form as leaves and/or granules to be made up into a hot beverage by the consumer at home. The respective flavours are likely to be quite distinct and I would expect the extent of any competitive relationship to be limited. Overall, I consider there to be a very low degree of similarity with the opponent's goods.'

10. It will be noted that the Hearing Officer recognised that some of the goods might indeed be found in ready-made bottles in a refrigerator, but made her decision on the basis that they were *'more likely to come in dried form as leaves and/or granules'.*

11. In Separode O-399-10, (a case cited by the Hearing Officer) the Appointed Person Mr Geoffrey Hobbs QC made the following point about the approach to be taken to assessing similarity between lists of goods:

"The determination must be made with reference to each of the different species of goods listed in the opposed application for registration; if and to the extent that the list includes goods which are sufficiently comparable to be assessable for registration in essentially the same way for essentially the same reasons, the decision taker may address them collectively in his or her decision."

12. The default position is that *'each of the different species of goods'* should be compared separately. Only where the factors relevant to the question of similarity apply in essentially the same way to different species of goods can they be merged

together in a single comparison exercise. That applies to goods within a class as much as it applies to goods within different classes.

13. On the face of the Hearing Officer's own analysis, it was plainly not appropriate to merge all the goods in class 30 together for the purpose of comparison. Having recognized that non-alcoholic drinks which might be found in ready-made bottles in a refrigerator were of a medium level of similarity to the class 29 goods of the Opponent's mark, it was necessary to identify any species of goods within the class 30 specification to which this applied and to treat them separately from those which *'come in dried form as leaves and/or granules to be made up into a hot beverage by the consumer at home'.* Furthermore, it is not permissible to dismiss the existence of such products on the basis that one species of goods was *'more likely'* to be found than another. If the notional and fair use of the mark would include its use on the species of goods in relation to which confusion was likely, then the mark must be refused at least in relation that species.

14. I therefore consider that the Hearing Officer made a clear error of principle in her Decision.

15. The Opponent contends that this error undermines the whole decision in relation to the class 30 goods. It says that once it is accepted that some of the goods within the class 30 specification would or could be found in ready-made bottles in a refrigerator, there is (on the Hearing Officer's own findings in relation to the class 32 goods) sufficient similarity to give rise to a risk of confusion. Therefore the class 30 application should be refused in its entirety.

16. This seems to me to suffer from the same fault as the approach of the Hearing Officer. It is first necessary to consider the specification of goods applied for in class 30 and to identify which species of goods within that specification should have been treated separately. If that species can be severed from the specification, then the mark may be allowed to proceed to grant without it.

17. Turning to the goods listed in the class 30 specification *'beverages based on tea; beverages with tea base'* are obviously goods which could be expected to be found in ready-made bottles in a refrigerator (for example a ready-made iced tea would fall into this category). On the Hearing Officer's findings in relation to the class 32 goods, the Opposition must succeed in relation to those goods.

18. The remaining question is whether there is any difficulty with the rest of the class 30 specification. It is not entirely clear, but I consider that the general words *'coffee tea and artificial coffee'* would probably also cover pre-prepared iced coffee or tea beverages of the kind which are supplied in glass or plastic bottles (even though such products are also specifically covered by the terms 'coffee-based beverages' and 'tea-based beverages' in the Nice Classifications). The same applies in the case of the particular teas listed in the specification. That being the case, the Opposition ought in principle to succeed in relation to the whole of the class 30 specification save for *'instant tea'* and *'tea leaves'*. However, it seems to me that pre-prepared cold coffee and iced tea are niche products at the edge of the specification which could easily be severed by the drafting of suitable exclusory wording, thus allowing the rest of the specification (save for the goods I have identified in paragraph 17 above) to survive.

19. The Opponent points out that the Applicant has not put forward any suitable wording of this kind in advance of the hearing, so there is no alternative specification for me to consider. That is true. However, given the limited nature of the amendment and in the absence of any obvious prejudice to the Opponent in allowing it to be considered, I believe that the interests of justice will be served by permitting the Applicant the opportunity to apply to make it.

20. I therefore hold that the mark should be refused in class 30 save for *'instant tea'* and *'tea leaves'* unless the class 30 specification is appropriately limited by deleting the words *'beverages based on tea; beverages with tea base'* and by amending the remaining specification to exclude pre-prepared iced tea and coffee beverages. The Applicant will have 28 days to make the appropriate application to the Registry to achieve this limitation and thereby permitting the mark to proceed to grant. Any

such application and all correspondence in relation thereto should be copied to the Opponent. I do not expect that the application should give rise to any difficulty, but I shall reserve to myself any appeal which may be necessary from a decision of the Registry in relation to it.

21. Both sides have been partially successful on this Appeal so I shall make no order as to costs.

THE APPOINTED PERSON

IAIN PURVIS QC

9 April 2018