

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 2361480B BY AW HOLDINGS CORP
TO REGISTER THE TRADE MARK “BOOSTERJUICE/BOOSTER JUICE”
IN CLASS 43**

**AND IN THE MATTER OF OPPOSITION NO. 94885 THERETO BY BOOST JUICE
HOLDINGS PTY LIMITED**

**OPPONENT’S APPEAL TO AN APPOINTED PERSON FROM THE DECISION
OF MR MIKE FOLEY DATED 7 SEPTEMBER 2010**

DECISION

Introduction

1. This is an appeal brought under section 76 of the Trade Marks Act 1994 (“**the Act**”) against a decision of the Registrar’s Hearing Officer, Mr Mike Foley, to reject an opposition under section 5(2)(b) of the Act to application no. 2361480B for the following series of trade marks (which I shall refer to collectively as “**the Mark**”):

BOOSTERJUICE
BOOSTER JUICE
boosterjuice
booster juice
BoosterJuice
Booster Juice

in respect of the following goods and services:

Class 32: Non-alcoholic and low alcohol beverages; smoothies and drinks consisting of or containing fruit, vegetables and juices; juice and juice drinks.

Class 35: The bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase those goods in a food and drink establishment or bar, from a catalogue, by mail order, telephone or other means of communication via the Internet; franchising services for a food and drink establishment or bar including administration, advertising, assistance, management, marketing, operation, planning, promotional, publicity; information, consultancy and advice relating to the aforesaid.

2. The Mark was applied for by AW Holdings Corp (“**the Applicant**”), on 21 April 2004. The Applicant has been using the names BOOSTERJUICE (one word) and BOOSTER JUICE (two words) to brand a chain of juice and smoothie bars in North America and parts of the Middle East, having started out in 1999.
3. The Opponent, Boost Juice Holdings PTY Limited, is an Australian company that has since May 2000 used the name BOOST in connection with a chain of franchised juice bars that it operates in many countries around the world, including in the form BOOST JUICE BARS.
4. By its opposition filed on 4 January 2007, the Opponent claimed that the Mark should be refused registration because its use is likely to cause confusion with the Opponent’s earlier international registration (“**IR**”) no. 825460, for the mark BOOST, which is registered in respect of the following services in Class 43:

“Take-away and restaurant services providing mineral and aerated waters and other non-alcoholic drinks, fruit drinks and fruit juices including fruit-based nutritional drinks and juices, vegetable drinks and vegetable juices including vegetable-based nutritional drinks and juices, fruit flavoured drinks, vegetable flavoured drinks, ades (fruit-flavoured fizzy or soft drinks) and punches, sports drinks, bottled drinking water, a blended mixture of fresh fruit, fruit juice, sorbet and ice, in a variety of flavours, a blended mixture of fresh vegetables, vegetable juice, sorbet and ice, in a variety of flavours, yoghurt-based drinks, vegetable and meat filled wraps and sandwiches, healthy snacks, muffins, muesli bars and nutritional supplements.”

5. The Opponent limited its opposition on the Form TM7 to those aspects of the specification for the Mark which related to smoothies and drinks consisting of or containing fruit, vegetables and juices; juice and juice drinks in Class 32; to the retailing services in Class 35 which related to those same goods; and to franchising services for a drink establishment or bar.
6. The Applicant defended the opposition in full by Notice of defence and counterstatement filed on 10 April 2007. There was no requirement for the Opponent to provide proof of use of its earlier trade mark.
7. Both parties filed evidence. A hearing took place on 16 June 2010, at which both parties were represented by their respective trade mark attorneys, the Opponent by Mr Ian Wilkes of Groom, Wilkes & Wright LLP and the Applicant by Ms Anne Wong of MW Trade Marks Limited.
8. The Hearing Officer dismissed the opposition in a written decision dated 7 September 2010 (O/312/10 – “**the Decision**”) and ordered the Opponent to pay £2,150 as a contribution towards the Applicant’s costs.

9. On 4 October 2010, the Opponent gave notice of appeal to an Appointed Person, seeking to reverse the Hearing Officer's conclusions. The hearing of the appeal took place before me on 27 January 2011, at which the parties each had the same representation as at first instance.
10. The Opponent's evidence suggests that this Opposition is part of a global dispute between the parties concerning their respective trade mark rights. At the hearing, I asked the parties whether there were any decided cases in other jurisdictions relating to the same two marks in issue in this case. The parties' representatives said that they were not aware of the status of other actions, but after the hearing Ms Wong sent me a copy of a decision of the Opposition Division of OHIM dated 21 October 2008, ruling on opposition no. B 981 896. This was a similar case in which the Opponent relied on IR no. 825460 to oppose the Applicant's application to register the mark BOOSTER JUICE as a Community trade mark ("CTM") in Classes 32, 35 and 43. The case is not directly comparable, however, because there are significant differences between the parties' respective specifications of goods and services involved in that case, not least in that the Opponent's IR is registered in other European countries in relation to "non-alcoholic drinks" in Class 32 as well as for the Class 43 services listed above. The opposition was successful as against "low alcoholic beverages" in Class 32, but not as against the services in Classes 35 and 43, in which the Applicant's CTM was allowed to proceed to registration for:

Class 35: Business advice, assistance and consultancy relating to franchising; franchise consultancy services; management advisory services relating to franchising; advertising services relating to franchising.

Class 43: Provision of information and advice relating to juice bars, snack bars, cafes, provision of food and drink, catering services, restaurants.

Approach to this Appeal

11. As the Opponent accepts, the role of the Appointed Person is to review the Decision, not to re-hear the case. I should show "a real reluctance, but not the very highest degree of reluctance, to interfere in the absence of a distinct and material error of principle": *REEF Trade Mark* [2002] EWCA Civ 763, [2003] RPC 5 at [28]. A decision does not contain an error of principle merely because it could have been better expressed.
12. Ms Wong for the Applicant asked me to bear in mind in particular the observation of Daniel Alexander QC (sitting as a Deputy High Court Judge) in *Digipos Store Solutions Group Ltd v Digi International Inc.* [2008] EWHC 3371 (Ch) at [6] that:

In the context of appeals from the Registrar relating to section 5(2)(b) of the Act, alleged errors that consist of wrongly assessing similarities between marks, attributing too much or too little discernment to the average consumer or giving too

much or too little weight to certain factors in the multi-factorial global assessment are not errors of principle warranting interference.

Legislative basis

13. Section 5(2)(b) of the Act provides as follows:

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 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.

14. This provision is derived from the predecessor to Article 4(1)(b) of First Council Directive 2008/95/EC of 22 October 2008 to approximate the laws of the Member States relating to trade marks (codified version) (“**the Directive**”). A parallel provision in relation to Community trade marks is found at article 8(1)(b) of Council Regulation (EC) No. 207/2009 on the Community trade mark.

The Evidence

15. The evidence is summarised at paragraphs 7 to 14 of the Decision. No criticism is made of this summary by the Opponent, so I shall simply highlight a few points.

16. The Opponent’s evidence came from its Managing Director and founder, Janine Allis. This shows that: (1) the Opponent’s BOOST business and brand were well-established outside the UK by the time that the Applicant filed the Mark; (2) the BOOST mark is used on the Opponent’s juice bars in a prominent and colourful stylised form with the words “juice bars” in smaller lettering underneath; but (3) the first use of any significance in the UK was when BOOST juice bars were opened in Manchester and Oxford in April 2007.

17. The Applicant’s evidence, presented by the trade mark attorney, Alice Mastrovito, similarly briefly summarises the development of the Applicant’s BOOSTER JUICE business outside the UK, exhibits photographs of the mark as used on juice bars (in colourful stylised form with the words “Booster” and “Juice” both having equal prominence), and explains that the Applicant was at the time (January 2008) planning to enter the UK market.

18. So, on the evidence, neither party had used its respective trade mark on the UK market. Mr Wilkes conceded before me that the evidence did not demonstrate that the BOOST trade mark had any enhanced reputation as a result of the Opponent’s non-UK activities.

The Decision

19. The Hearing Officer started his analysis of the opposition by citing a series of well-established applicable principles and the usual authorities in support. He found (at paragraph 22) that the “notional consumer” of the relevant goods and services was the public at large.
20. Having separately considered the distinctiveness and dominance of the parties’ respective trade marks, including the two (BOOSTER and JUICE) elements of the Applicant’s Mark, the Hearing Officer conducted the usual visual, aural and conceptual comparison of the marks and concluded that, although there were some similarities in each of these attributes, these were not sufficient for the marks to be considered visually, aurally or conceptually similar, and therefore the marks could not be considered similar to each other as a whole.
21. While this could have been the end of the matter, since without similarity of marks the provisions of section 5(2)(b) cannot be fulfilled (as discussed further below), the Hearing Officer nevertheless went on to compare the goods and services concerned. He directed himself on the law as follows:

27. When comparing the respective goods, the established tests in assessing the similarity or otherwise is set out in *British Sugar Plc v James Robertson & Sons Limited (Treat)* [1996] 8 R.P.C. 281, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*. I also have regard to the decision of the General Court in *Saint-Gobain SA v OHIM* Case T-364/05 and the decisions in *Claudia Oberhauser v OHIM (Fifties)* [2003] E.T.M.R. 58 and *Criminal Clothing Ltd v Aytan’s Manufacturing (UK) Ltd*, [2005] EWHC 1303. I must consider the uses and users of the respective goods or services, the physical nature of the relevant goods, the trade and distribution channels through which they reach the market and how the goods and trade marks are encountered by the consumer, particularly at the point at which the purchase is made. In the case of self-serve consumer items this will also include consideration of where the respective goods are likely to be found, particularly in multi product outlets such as supermarkets. The extent to which the respective goods or services are competitive or complementary is also a relevant consideration guided by how they are classified in trade, and known by the relevant consumer.

22. Considering these matters, he said of the goods and services in both parties’ trade mark specifications:

29. These are goods and services that are seen and available on high streets throughout the country. In the case of beverages these will be familiar goods and regular purchases by the public at large, part of which will be the retail service aspect. The take-away and restaurant services will be less frequently used but nonetheless will be utilized by all sectors of society. Foodstuffs and beverages of the type specified tend not to be high value items such that where a purchase is made it will be done with a reasonable rather than a high degree of care and attention. The same may be the case with take-aways but not so with restaurants where a service element to the cost makes the purchase more expensive and probably more considered.

23. The Hearing Officer then cited the decision of the General Court in Case T-116/06 *Oakley, Inc. v OHIM (O STORE)* [2008] ECR p.II-2455 which involved a comparison of a retail service and the same goods as sold through that service, concluding that this authority indicated that “goods and services should generally be considered different in nature even if the service involves the provision or sale of the goods” and that it was “necessary to determine the extent to which the service is connected with the provision of the goods, or peripheral in the sense that it aids the transaction”.
24. After further explanation of his reasoning, that I shall consider below, the Hearing Officer concluded at paragraphs 37 and 40 that:
- (1) the Class 32 goods in the specification for the Mark were not similar to restaurant services in the Opponent’s IR, even insofar as they related to beverages;
 - (2) the Class 32 goods for the Mark were similar, but not highly similar, to take-away services in the Opponent’s IR, insofar as they related to beverages;
 - (3) insofar as franchising services for a food and drink establishment includes restaurants, take-aways and bars, there was similarity (but not high similarity) with the Opponent’s restaurant and take-away services;
 - (4) the Applicant’s Class 35 services that involve the administration, advertising, assistance, management, marketing, operation, planning, promotional, publicity, information, consultancy and advice relating to the operation of such franchises were plainly dissimilar to the Opponent’s restaurant and take-away services;
 - (5) the retail services element of the Applicant’s Class 35 services (i.e. “the bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase those goods …”) were different from the restaurant and take-away services in the Opponent’s IR specification.
25. Having noted that the Opponent’s evidence did not support a finding that the earlier BOOST mark had a reputation that warrants an enhanced penumbra of protection or a higher distinctive character, the Hearing Officer concluded (at paragraph 43) that:
- … whilst there may be some similarities, the differences are such that use of BOOSTER JUICE/BOOSTERJUICE by the applicants (in any of the forms for which it is sought to be registered) in connection with the stated goods and services will not lead to confusion. Even allowing for the possibility imperfect recollection (*sic*) does not create the required potential for confusion.

Grounds of Appeal

26. The Opponent raised numerous objections to the Hearing Officer's reasoning in each of the three key aspects of the Decision, i.e.:

- (1) similarity of marks;
- (2) similarity of goods/services; and
- (3) global assessment.

27. I have taken account of all the grounds raised in the Notice of appeal, as expanded upon in the Opponent's skeleton argument and in oral submission, as well as considering the authorities raised before me. The key points are summarised below.

Similarity of marks

28. The Opponent argued that the Hearing Officer gave insufficient regard to:

- (1) the fact that the first five letters of both marks comprise the identical element BOOST;
- (2) the visual, phonetic and conceptual similarities between the two marks; and
- (3) the fact that the latter part of the Mark, JUICE, is entirely descriptive of juice and that the normal and fair use of the earlier mark would include its use in front of "juice", i.e. as "BOOST juice", which one can see from the evidence is the way in which it is in fact used.

29. This is what the Hearing Officer actually said about the two marks:

20. The earlier mark cited by the opponents is for the word BOOST in plain block script. This is an ordinary English word that I consider likely to be sufficiently well known to the "notional average consumer" of the respective goods and services so as to be able to understand its meaning without need for recourse to a reference work. Boost has a number of meanings essentially relating to increasing, raising or lifting. The applicants argue that when used in connection with beverages BOOST will be seen as suggestive of health-giving or energy drinks, and as such is a mark of low distinctiveness. If BOOST is descriptive it is of an effect that may be gained from the consumption of such goods rather than the product itself, and any descriptiveness is indirect and somewhat allusive. Whilst it may not be a mark of the highest distinctive character for beverages it is nonetheless distinctive and being the only element there can be no argument that it dominates the mark.

21. The first part of the mark applied for is the word BOOSTER which has the meaning of someone (or more usually something) that boosts. Whereas a drink might be said to give a "boost" it would not, in usual parlance, be referred to as a "booster", but in my view the word will still be regarded in this semi-descriptive way. There is another textual element to this mark; the word "JUICE" which is clearly no more than a description of some of the goods mentioned in the specifications, explicitly in Class 32, and implicitly in the term "beverages" in the Class 35. In the conjoined

versions the eye naturally separates this words so whilst it may not be as obvious as when the words are separated it is still evident. BOOSTER on its own would be regarded as the distinctive and dominant component of the mark for which registration is sought.

22. ...

23. Insofar as BOOSTER contains the entirety of the opponents mark BOOST there must be a degree of visual similarity. The opponents argue that this being in the first part of the applicant's mark makes the BOOST prefix noticeable, which is the thrust of the *London Lubricants* case [1925] 42 R.P.C. 264 referred to by the opponents. Although an old case this principle is still considered to be a relevant factor in determining visual similarity. However, there is also the word JUICE in the applicant's mark, which although negligible in terms of its contribution to the distinctive whole, does have an effect on how the marks looks, and particularly so when presented as a single word. This addition elongates the mark and counters the effect of the common use of BOOST such that I consider the respective marks not to be visually similar.

24. Likewise, that BOOST is the first element of the respective marks must mean that to this extent there will be similarity in their sound when spoken, but the additional element JUICE will add a difference and makes it likely that the "ER" suffix to BOOSTER will be enunciated. The consequence is that the marks move apart in their sound to the extent that they can be regarded to have some similarity but not enough to be similar.

25. Earlier I said that the use of BOOST in relation to beverages will give consumers the idea of a drink with health or energy giving properties. I then stated that BOOSTER will convey a meaning of someone (or more usually something) that boosts, but that whilst a drink might be said to give a "boost" it would not usually be referred to as a "booster". So the opponent's BOOST mark and the BOOSTER element of the applicant's mark both give an idea centred on the same theme. However, the mark applied for has the added word "JUICE" which even though it is no more than a description, in the totality of the mark has the effect of limiting the idea to these goods whereas in respect of the opponent's mark the consumer has simply has the BOOST. So whilst there conceptual similarities I do not consider that the marks are conceptually similar.

26. Balancing of these assessments I consider that whilst there is some similarity the respective marks cannot be considered similar.

30. It is clear from the first half of paragraph 23 quoted above that the Hearing Officer took account of the identity between BOOST and the first five letters of BOOSTER JUICE and the relative importance of the first part of the mark in assessing similarity, so I reject the Opponent's first complaint.

31. The thrust of Mr Wilkes' explanation of the second ground of attack was that the Hearing Officer gave insufficient regard to decided case law that teaches that the dominant and distinctive features of a mark are most important when assessing similarity. Combining this with the third ground, he argued that, while the Hearing Officer expressly recognised that the JUICE element of the Mark was descriptive, he did not give this fact sufficient weight when assessing each type of similarity. Nor

did he take sufficient account of the fact that a normal and fair use of the Opponent's earlier mark was as "BOOST juice". Had he done so, there would have been an increased focus on the BOOSTER element of the Mark, and less on JUICE, thus increasing the level of similarity with BOOST.

32. The problems with these arguments include the following: (1) the Hearing Officer clearly set out the case law to which Mr Wilkes referred (in particular *Sabel BV v Puma AG* [1998] RPC 199); (2) he expressly recognised that JUICE was a description of some of the goods mentioned in the Opponent's specifications; (3) it does not seem to me that it would be obvious to the average consumer that "BOOST juice" would be a natural use of the earlier mark in respect of the services for which it is protected in the UK; and (4) the Hearing Officer has considerable experience in the application of *Sabel v Puma* to different factual scenarios and so cannot be assumed to have done so incorrectly without some stronger indication that an error has occurred.
33. Mr Wilkes for the Opponent relied on an example given by Jacob LJ in *Reed v Reed* [2004] EWCA Civ 159 (at paragraph 37) in which he indicated that the word "Soap" added nothing at all to the mark "Palmolive", such that the use of the sign "Palmolive Soap" would be considered to be use of the identical mark, "Palmolive". Similarly, Mr Wilkes argued, "juice" could effectively be ignored or paid very little regard in the comparison between BOOSTER JUICE and BOOST. This analogy does not assist because it was necessary in the *Reed* case for the Court to identify from a series of words the sign that had to be compared for infringement purposes with the registered mark REED (was it "Reed Business Information" or just "Reed"?). In contrast, in an opposition, the mark to be compared with the opponent's earlier mark is determined by the subject matter of the trade mark application and so there is no choice but to look at the whole of the Mark, i.e. BOOSTER JUICE and not just BOOSTER. Of course, the analogy also breaks down because "Palmolive" is a brand with high recognition on the UK market, whereas the Opponent's BOOST trade mark had not been used here at the relevant time.
34. I am therefore not persuaded that the second and third grounds of appeal are good grounds for reversing the Hearing Officer's decision on similarity of marks.
35. Given the appearance of BOOST(-) in both the BOOSTER JUICE and BOOST marks, I was slightly surprised to read the Hearing Officer's findings of lack of similarity on all fronts. The similarity of marks that is sufficient to warrant an analysis of the similarity of goods and the likelihood of confusion is not high, particularly bearing in mind that a lower degree of similarity between marks may be offset by greater similarity between goods and services: *Case C-39/97 Canon v. MGM* [1998] ECR I-4657. Had I been deciding this case at first instance, I would

have found that there was sufficient similarity between the respective marks to pass the test. I note that the Opposition Division of OHIM found a low degree of visual similarity, a low degree of aural similarity and either the conceptual comparison was neutral (for non-English speakers) or there was conceptual similarity (for English speakers), such that overall the marks were “similar to a certain degree”.

36. However, I accept that different people will view the two marks concerned in different ways and, in the absence of a discernible error, I do not propose to substitute my own view.
37. A finding of similarity between the marks is a crucial element of the test under section 5(2)(b) which, if not present, obviates the need to examine similarity of goods/service and the likelihood of confusion: Case C-106/03 P *Vedial v OHIM* [2004] ECR p. I-9573 at paragraph 51-54. In *Vedial*, the marks under comparison were the word mark SAINT HUBERT and a figurative mark comprising a drawing of a chef giving a ‘thumbs up’ sign and a prominent stylised word HUBERT. Notwithstanding the common element of HUBERT in both marks, the Court of First Instance (now known as the General Court) had decided that the marks were not similar and on that basis had concluded that there was no likelihood of confusion, regardless of the similarity of goods and services covered by the respective trade marks. The ECJ held that this approach was correct, given the cumulative nature of the test, and declined to interfere with the finding in respect of similarity of marks.
38. Although I could stop the analysis here, I shall proceed to consider the grounds of appeal under the other two broad heads, since the Hearing Officer also did so and the parties argued the points before me. Also, there is matter concerning the specification for the Mark which I believe needs to be dealt with by the Registrar before the Mark can proceed to registration.

Comparison of goods/services

39. The Opponent took issue with most of the comparisons of goods/services conducted by the Hearing Officer.

Class 32 goods

40. Firstly, in relation to the comparison between “beverages” in Class 32 of the specification for the Mark and “take-away services” relating to beverages in the Opponent’s specification, the Opponent asserted in the Grounds of Appeal that the Hearing Officer paid insufficient regard to the following guidance from the European Court of Justice in *Céline SARL v Céline SA*, Case C-17/06:

The unauthorised use by a third party of a company name, trade name or shop name which is identical to an earlier mark in connection with the marketing of goods which are identical to those in relation to which that mark was registered constitutes use

which the proprietor of that mark is entitled to prevent in accordance with Article 5(1)(a) of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks, where the use is in relation to goods in such a way as to affect or to be liable to affect the functions of the mark.

41. I do not think that this guidance is of particular assistance in this case. The issue in *Céline* was whether the adoption of a mark as a company, trade or shop name could amount to use in the course of trade which the proprietor of the mark is entitled to stop by reason of his exclusive rights. The question was whether a company/trade/shop name could function to distinguish goods and services, not whether particular goods could be considered to be similar to particular services.
42. In the Opponent's skeleton argument and at the hearing, Mr Wilkes criticised the Hearing Officer's reliance on the *Oakley* decision referred to above, seeking to distinguish it on the facts. *Oakley* involved a comparison of "retail and wholesale services, including on-line retail store services; retail and wholesale of eyewear, sunglasses, optical goods and accessories, clothing, headwear, footwear, watches, timepieces, jewellery, decals, posters, athletic bags, backpacks and knapsacks, and wallets" in Class 35 with a range of leather goods and clothing in Classes 18 and 25 respectively. The General Court highlighted the different nature of the goods from the services in question (the former being fungible and the latter not), their different purpose (since the retail service precedes the purpose served by the product and concerns the activity of the trader, rather than the purpose of the good which is to be worn by the purchaser), and their different method of use (obtaining information about the goods as opposed to wearing them); but held that the distribution channels for the retail services and the goods concerned were the same.
43. I do not agree with the Opponent that the Hearing Officer placed too much emphasis on the differences between the services and goods highlighted in *Oakley* and failed to recognise the differences in this case. The Hearing Officer merely cited the case as an obvious authority on the issue that was before him, and used it to assist him in determining the relevant factors to be considered; but he then conducted a careful assessment of the particular features of the case in hand without relying on inappropriate parallels between the cases. In particular, he held at paragraphs 33-36 that:
 - (1) the Applicant's Class 32 goods are fungible, whereas the Opponent's restaurant and take-away services are not, so they are different in nature;
 - (2) the primary purpose of a restaurant service is to provide an environment conducive to the consumption of food with beverages as an accompaniment, whereas the primary purpose of a beverage is to be drunk ;

- (3) in contrast, the service element of take-away services is as a vehicle to prepare the goods ready for consumption off the premises, which is close to the purpose of the goods themselves;
 - (4) consumers of restaurant services would not necessarily assume that the provider of those services was responsible for the beverages served there, whereas there was likely to be a closer connection between take-away services and the food/drink products served;
 - (5) in a restaurant service the food and drink may be “somewhat complementary”, but more definitely so in the case of take-aways;
 - (6) it was logical to assume that beverages are capable of reaching the market and consumer from the same outlets including restaurants and take-aways, but restaurants and take-aways nonetheless sell the beverages of other manufacturers;
 - (7) beverages could be open for self-selection in shops and take-aways, or may be sold from dispensing apparatus behind the counter, but will be obtained on request in a restaurant;
 - (8) in the absence of evidence on the point, it was likely that a service for the provision of beverages would be classified in a different trade sector to the goods provided as part of the service, and this would be the consumer’s understanding.
44. It was only following this breakdown of the factors to consider that the Hearing Officer reached his overall conclusions of similarity (and lack thereof) between the various services listed in the Opponent’s specification and the Class 32 goods of the application. (See paragraph 24 above for those conclusions.)
45. Mr Wilkes referred me to OHIM Board of Appeal decisions R 536/2001-3 and R 674/2001-3 *NEGRA MODELO/MODELO*, confirmed by the General Court (T-169/02), in which “services related to bars, restaurants and night clubs” and “syrups, beer, soft drinks and non-alcoholic drinks” were held to be similar, in particular because “it cannot be excluded that breweries or producers of non-alcoholic drinks or soft drinks will provide their products in their own restaurants or bars, marked with the same sign or logo of their beverages”. However, reading the full text of that decision, it does not give a warm endorsement of the Opponent’s submissions. The services concerned were said to be “not absolutely dissimilar” to the beverages listed and that there was “a certain link” between them. (And, in the event, this limited similarity did not result in a finding of likelihood of confusion.)
46. Mr Wilkes pressed home the argument that a juice bar is, by its nature, likely to sell “own brand” beverages and thus customers familiar with BOOST as the name of a

juice bar would be likely to assume there was an economic link with the producer of a juice product bearing the name BOOSTER JUICE, and thus juice bar services and juices should be considered to be similar. This argument was based on the premise that “take-away services providing fruit drinks and fruit juices” (being a subset of the Opponent’s specification) was another way of referring to “juice bar services”. He also argued that the Hearing Officer paid insufficient regard to the services actually provided by the Opponent, being the service of operating a juice bar, and that – had he focused more on this, rather than thinking about a general restaurant or take-away business – he would have found similarity between the juice bar services of the Opponent and the relevant beverages of the Applicant.

47. It seems to me that, while the Hearing Officer did express his reasoning in terms of restaurant and take-away services generally, he did so with specific reference to beverages. He would have had in mind the actual services of interest to the Opponent, having reviewed the evidence which highlighted these. And, in any event, he made a clear finding that the Applicant’s Class 32 goods were similar to the Opponent’s take-away services insofar as they related to beverages (see paragraph 24(2) above). I therefore do not regard these grounds as being sufficient to challenge the Hearing Officer’s conclusions in relation to the Class 32 goods in the specification for the Mark.

48. Before leaving the Class 32 goods, I reiterate the fact recorded at the outset that the opposition was limited in the Form TM7 to “smoothies and drinks consisting of or containing fruit, vegetables and juices; juice and juice drinks”. Therefore, although it is not entirely clear from the face of the Decision, the finding of similarity between take-away services and the Class 32 goods must be limited to these particular goods. As will be seen, nothing turns on this, but I record it for the sake of completeness.

Class 35 retailing services

49. As a general point in relation to the comparison of the parties’ respective services, Mr Wilkes argued that the Hearing Officer was too swayed by the fact that the parties’ services had been listed in different classes – the Opponent’s in Class 43 and the Applicant’s in Class 35. He asserted that the services of respective interest are identical or at least closely similar, and that the different classification should not militate against a finding to that effect.

50. The United Kingdom is a party to the Nice Agreement and accordingly requires trade mark applicants (under section 34 of the Act and rule 7 of the Trade Marks Rules 2008) to classify goods and services in accordance with the Nice Classification system, which is administered and published by the World Intellectual Property Office (“WIPO”) and is currently in its 9th edition. The Classes under the Nice Classification System are intended to be comprehensive and the system is

designed to enable trade mark offices, with the assistance of applicants, to allocate all categories of goods into specific Classes. Particular goods or services may only fall into one Class, although it is possible for closely related goods/services to fall into separate Classes. To that extent, the relevant Class limits the meaning of the goods listed in the specification under it: *Altecnic Ltd's Trade Mark Application* [2001] RPC 37 and on appeal at [2001] EWCA Civ 1928, [2002] RPC 34 (see in particular paragraph 42).

51. The wording used in the specification for the Mark, “the bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase those goods ...” comes from the Explanatory Note to Class 35 in the Nice Classification, and is well-recognised to be trade mark specification language for retail services. See, for example, Case C-418/02 *Praktiker Bau- v. Heimwerkermarkte AG* [2005] ECR p.I-5873.

52. In contrast, the Explanatory Note to Class 43 explains that this Class “includes mainly **services provided by persons or establishments whose aim is to prepare food and drink for consumption** and services provided to obtain bed and board in hotels, boarding houses or other establishments providing temporary accommodation” (emphasis added). “Take-away and restaurant services”, as claimed in the Opponent’s trade mark specification, are well-recognised examples of services to be included in Class 43.

53. In *Praktiker Bau-* the ECJ stated (at paragraph 34):

... the objective of retail trade is the sale of goods to consumers. That trade includes, in addition to the legal sales transaction, all activity carried out by the trader for the purpose of encouraging the conclusion of such a transaction. That activity consists, inter alia, in selecting an assortment of goods offered for sale and in offering a variety of services aimed at inducing the consumer to conclude the abovementioned transaction with the trader in question rather than with a competitor.

54. Further, as expressed in the Applicant’s trade mark specification, the services applied for involve bringing goods together “for the benefit of others”, i.e. for the manufacturers or suppliers of the goods to be put on display to customers. This aspect of retail services, whereby customers may be exposed to the goods of third parties, is not a particular feature of restaurant or take-away services, or even (if I were to accept the Opponent’s submission that the actual services of interest to the Opponent should be taken into account) juice bar services. While it may well be the case that beverages of different brand owners could be served at a restaurant, take-away outlet or juice bar, that is not the primary focus of those services.

55. In summary, in my view, it was appropriate for the Hearing Officer to take account of the different classification of the parties’ services under comparison in determining whether they were similar. I do not believe that he placed undue

emphasis on the classification, however, and I agree with the outcome of his analysis. The Opponent came up with no other convincing argument as to why the Hearing Officer reached the wrong decision on this point, and so I uphold his conclusion that the “retailing” element of the Class 35 specification for the Mark is different from the Class 43 services of the Opponent’s earlier mark, even to the extent that they both could involve the sale of juice or other beverages to consumers.

56. I will revert to the Applicant’s Class 35 specification below, since I believe that the reference to bringing together “a variety of goods” needs to be limited in scope in the light of the decision in *Praktiker Bau*.

Class 35 franchising services

57. The Opponent’s argument in relation to the similarity of “franchising services” in the Application and “take-away and restaurant services” in the Opponent’s specification was that the Hearing Officer had paid insufficient regard to the fact that confusion could arise in circumstances where the subject matter of the franchising is the same as the take-away services for which the Opponent’s mark is protected.

58. Here, I do find the Hearing Officer’s decision slightly confusing in that he found “franchising services” for restaurants, take-aways and bars to be similar services to the Opponent’s “take-away and restaurant services”, but said that the various examples listed out in the Applicant’s specification, i.e. “administration, advertising, assistance, management, marketing, operation, planning, promotional, publicity; information, consultancy and advice relating to [a food and drink establishment or bar]”, were all dissimilar. Since the examples comprise a fairly comprehensive list of types of franchising services, I do not see how the umbrella term “franchising services” can be similar to the Opponent’s services if none of the identified types of franchising services are similar.

59. I do think that the Hearing Officer made an obvious error here but, unfortunately for the Opponent, not so as to assist in this appeal. In my view, there are significant differences between “franchising services” and “take-away and restaurant services”, even when one makes the specific comparison between such services as they each relate to a juice bar. None of the *Canon* tests appear to me to point towards similarity:

- (1) the uses of the respective services are different, the former being used to enable the operator of a franchised juice bar to run the business, while the latter being used by members of the public to decide what juices to buy;
- (2) the users are different, franchising services for juice bars being supplied to businesses operating juice bar franchises, while juice bar services are supplied to the general public;

- (3) the nature of the acts of service is different in each case;
- (4) the trade channels are different, in that the Applicant's services are provided at a business to business level, while the Opponent's services are supplied at a business to consumer level; and
- (5) the services are not competitive with each other.

60. I therefore reject the Opponent's appeal on this point.

Global assessment of likelihood of confusion

61. The Notice of Appeal gave no additional grounds for objecting to the Hearing Officer's decision in relation to the global assessment of the likelihood of confusion. It simply argued that, given the errors in the comparisons of marks and goods/services, the decision was wrong and should be reversed. At the hearing, Mr Wilkes argued that the Hearing Officer mis-applied the global appreciation test set out in *Lloyd* (Case C-342/97 at paragraph 26) by failing to take account of the fact that the level of attention of the average consumer of the relevant goods and services would not be particularly high and therefore there was an increased likelihood of confusion.
62. As stated above, the Hearing Officer made a clear finding (at paragraph 22) that the relevant consumer was the public at large, and at the outset of his comparison of the goods and services (at paragraph 29), he referred to the fact that purchases of the food and beverages concerned would be made with a reasonable rather than a high degree of care and attention. The Opponent has not pointed to any place in the decision where the Hearing Officer appears to assume a higher degree of attention. So there is nothing in this point.
63. I therefore conclude that there is no basis for setting aside the Hearing Officer's decision in relation to the ground of opposition under section 5(2)(b).

The Class 35 specification for the Mark

64. The first half of the specification for the Mark in Class 35 currently reads:

“The bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase those goods in a food and drink establishment or bar, from a catalogue, by mail order, telephone or other means of communication via the Internet.”

65. The ECJ's decision in *Praktiker Bau-* gave guidance to the effect that it is necessary, when applying to register services provided in connection with the retail trade in goods, to provide details with regard to the goods or types of goods to which those services relate. Such details were held to be necessary in particular to make it easier to apply the provisions regarding grounds for refusal or invalidity based on

earlier rights of third parties, the infringement provisions, and the revocation for non-use provisions (*Praktiker Bau-*, paragraph 51).

66. It seems to me that, while the mention of goods to be purchased “in a food and drink establishment or bar” could lead to certain assumptions being made about the types of goods involved, the same would not be true in relation to purchasing goods from a catalogue, by mail order or other means. Therefore, I believe that the specification is currently inadequate and should be limited to, for example, “the bringing together, for the benefit of others, of a variety of **food and beverages**, enabling customers to conveniently view and purchase, etc...”.
67. I only suggest this limitation by way of example, as it is for the Applicant to settle the appropriate wording with the Registrar. As long as this merely narrows down the scope of the specification, in accordance with section 39(1) of the Act, the hearing officer’s decision (which plainly focused on services relating to food and beverages, including juices) and this appeal decision will hold good.

Conclusion

68. In conclusion, I reject the Opponent’s appeal. So the opposition fails and the Mark should proceed to grant, subject to the Applicant specifying the particular goods or types of goods referred to in the first part of the Class 35 specification.
69. The Opponent’s appeal having failed, I shall leave the first instance costs award of £2,150 in favour of the Applicant in place. Bearing in mind the steps taken by the Applicant in this appeal, and the normal approach to costs of appeals to the Appointed Person, I also order the Opponent to pay a contribution to the Applicant’s appeal costs of £1,200. The combined sum of £3,350 will be payable within 14 days of the Opponent receiving notice of this decision.



ANNA CARBONI

22 August 2011

The Opponent (Appellant) was represented by Mr Ian Wilkes of Groom, Wilkes & Wright LLP. The Applicant (Respondent) was represented by Ms Anne Wong of MW Trade Marks Limited.