

O-352-18

TRADE MARKS ACT 1994

IN THE MATTER OF AN APPLICATION  
BY BIO-SYNERGY LIMITED  
TO REGISTER TRADE MARK 3117233:

**cocotein**

IN CLASSES IN CLASSES 5 AND 32:

AND AN OPPOSITION THERETO UNDER NO.405412  
BY THE ISOPURE COMPANY, LLC

## BACKGROUND

1. On 10 July 2015, Bio-Synergy Limited (the applicant) applied to register the above trade mark in the following classes:<sup>1</sup>

**Class 5**

Nutrition supplements for sports, fitness, health and exercise.

**Class 32**

Drinks for sports, health, exercise and fitness.

2. The application was published on 31 July 2015, following which The Isopure Company, LLC (the opponent) filed a notice of opposition against all of the goods in the application.

3. The opponent bases its case on section 5(4)(a) of the Trade Marks Act 1994 (the Act), relying on the sign COCOTEIN. It claims to have used the sign in respect of nutritionally fortified beverages; dietary and nutritional supplements; energy drinks; energy shakes; protein drinks and nutritional supplements for sports. Use is claimed throughout the UK since 1 June 2013.

4. The opponent states:

*“2. The Trade Mark applied for by the Applicant is identical to the unregistered Trade Mark of the Opponent and as a result of the protectible [sic] goodwill built up in the unregistered Trade Mark, use of the Trade Mark applied for by the Applicant will lead consumers to mistakenly believe that goods sold under and by reference to that Trade Mark originate from the Opponent or are in some way connected with the Opponent and the Opponent will suffer damage as a result of this erroneous belief.”*

---

<sup>1</sup> *International Classification of Goods and Services for the Purposes of the Registration of Marks under the Nice Agreement (15 June 1957, as revised and amended).*

5. The applicant filed a counterstatement in which it denies the opponent's claim. It submits:

*"1. The Applicant respectfully submits that the Opponent has not used the trade mark COCOTEIN for all the goods claimed within the United Kingdom since at least 2013 to support a passing-off action under Section 5(4) of the Trade Marks Act 1994.*

*2. The Applicant agrees that the trade marks are identical and for identical and similar goods.*

*3. The Applicant denies that the Opponent has built up sufficient goodwill and reputation in the United Kingdom. Accordingly, it is denied that consumers will be misled and that the Opponent can claim damage."*

6. The opponent filed evidence and written submissions, the applicant filed submissions. Both sides provided skeleton arguments. A hearing subsequently took place before me, by video conference. The opponent was represented by Mr Chris Aikens of Counsel, instructed by Fox Williams LLP. The applicant was represented by Simon Walters of Simon Walters. Both sides seek an award of costs.

### **Preliminary issue**

7. Following the conclusion of the evidence rounds in this case, a request was received from the opponent to file additional evidence. The matter was considered at a case management conference (CMC) on 2 February 2017. After the CMC letter was issued in which the outcome of the CMC was communicated to the parties, the applicant requested a full statement of reasons, which I duly provided. In brief, my conclusion was as follows:

#### **"Decision**

Whilst I have some sympathy with the applicant in respect of the timing of the further evidence, the evidence to which the opponent referred was

material to the matter to be decided. The prejudice to the opponent in not being able to rely on material evidence, in my view, outweighed the prejudice to the applicant, who will be given an opportunity to respond to the additional evidence and may also request costs to reflect additional work undertaken as a result of the late filing of evidence by the opponent.

I note that the applicant has stated that it filed submissions rather than evidence so that the opponent would not be able to file evidence in reply. How the applicant chose to conduct its case is not a factor that I have taken into account. The request from the opponent was a request to file additional evidence and it is on that basis that a decision was made and directions given.”

8. The applicant sought leave to appeal which was considered, by a different Hearing Officer, at a CMC held on 30 August 2017. Leave to appeal was refused and that Hearing Officer reiterated my earlier conclusion, that if the applicant wished to appeal the decision made at the CMC on 2 February 2017 they should do so as part of an appeal to this substantive decision.

9. The applicant’s submissions make many references to the fact that large parts of the opponent’s evidence should not have been admitted into these proceedings. I do not intend to reproduce them in this decision as the matter has been determined.

## **EVIDENCE**

### **Opponent’s evidence**

10. Parts of the opponent’s evidence relate to its business in the US. Given that this case is brought only in respect of a passing off claim under 5(4)(a) of the Act, I intend only to summarise the evidence to the extent that it is relevant to the opponent’s goodwill in the UK.

Witness statement of Paul Kelly and exhibits PK1-PK3

11. Mr Kelly is a Trade Mark Attorney and Associate of the opponent's first representative.<sup>2</sup> His statement is dated 1 July 2016. He states:

*"The opponent is a manufacturer and producer of nutritional supplements and protein drinks among other health products and was established over thirty years ago in the United States of America. One of the products produced and sold by the Opponent is a protein drink and supplement sold under and by reference to the Trade Mark COCOTEIN."*

12. Mr Kelly provides the following figures:

<b>Year</b>	<b>Units of product sold</b>
2014	2592
2015	3552
2016	384

13. His first exhibit comprises 'sample representations' of the products sold by the opponent under the sign COCOTEIN. These pages are not dated and there is no indication of where these images were taken from. The product is shown as follows:

---

<sup>2</sup> The opponent's representative was changed to Fox Williams LLP by a TM33 filed on 7 March 2016.



14. Mr Kelly describes exhibit PK2 as extracts from online sites 'showing products under the trade mark COCOTEIN'. None of the pages is dated, other than the date on which they were printed, which is 1 July 2017 (this is the print date for all of the pages which make up Mr Kelly's exhibits). A listing for *Amazon UK* shows a picture of the same product as that shown in the previous paragraph. It is described as, 'Isopure Cocotein Coconut Water' and is shown as 'out of stock'. Additional details at the bottom of the page show the date the product was first available on 15 August 2015.

15. Exhibit PK3 is described by Mr Kelly as examples of advertisements. The page taken from [www.food4buildingmuscle.com](http://www.food4buildingmuscle.com) appears to be a UK website. It is titled, 'New Arrival! Isopure Cocotein Coconut Water'. The article is not dated.

Witness statement of Sarah Jane Redmond and exhibits SJR1-SJR18

16. Ms Redmond is a Senior Trade Mark Attorney at the opponent's second representative, Fox Williams LLP. Her statement is dated 2 March 2017. Some of the evidence she provides relates to 'Isopure', without reference to particular products or to the trade mark, 'Cocotein'.

17. Ms Redmond describes the opponent's product sold under the sign COCOTEIN as:

*"...a coconut water protein drink which contains 100% pure whey protein isolate. It is perfect for post-workout recovery."*

18. At paragraph 18 of her statement she says:

*"The opponent has its own UK specific Facebook account @isopure and has 759,670 followers. It also has a UK fanpage account isopure.uk and has 11,000 followers."*

19. Ms Redmond provides examples of posts made by the opponent on these two sites between 21 October 2013 and 3 March 2014.<sup>3</sup>

20. On 21 October 2013 the opponent posted a photograph titled, 'Sampling Day at Monster Supplements in Hull'. The COCOTEIN product can be seen on the second shelf of the fridge and is included within the range of drinks displayed on the counter in front of the fridge.

21. On 3 March 2014 the opponent posted the following image:



22. The accompanying text reads:

---

<sup>3</sup> See exhibit SR7.

*“Meet Cocotein, the newest member of the Isopure family! Add body-boosting protein benefits and tastebud-loving coconut refreshment. All that, with 0% lactose and 0% fat. Now that’s one seriously smart formula!”*

23. Ms Redmond provides examples of references to COCOTEIN in Facebook postings by UK individuals and companies. On 27 September 2013 an individual living in Devon posted the same photograph as that shown in paragraph 21 above, under the words, ‘More new things in, including this:’ Under the photograph are the details of a business page for ‘Pro-performance Torbay’ with the text:

*“New at Pro-Performance. COCOTEIN – Coconut water + 100% Isopure Whey Isolate! Visit us this weekend to find out what else is new in store.”<sup>4</sup>*

24. On 11 August 2014, Latest Coupon Codes UK posted an offer for, ‘Isopure Cocotein Coconut Water x 2 Bottles TRY BUY at monstersupplements.com – UK coupon codes’.<sup>5</sup>

25. On 11 April 2015 PhD Fitness posted the following advertisement on its Facebook page:<sup>6</sup>



<sup>4</sup> See exhibit SR8, page 4.

<sup>5</sup> As above.

<sup>6</sup> See exhibit SR8, page 3.

26. At paragraph 25 of her witness statement, Ms Redmond submits that Monster Supplements sold COCOTEIN to the public prior to the filing of the contested application. She describes Monster Supplements as, 'one of the largest online suppliers of sports nutrition products in the UK', and says that it 'offers the UK's widest selection of top brand sports nutrition online'. The following tweets are provided from Monster Supplement's *Twitter* page:<sup>7</sup>



27. Prints are provided from *waybackmachine* which show the opponent's product for sale on Monster Supplements online on 3 December 2013 and 4 July 2014. Both are for 12 x 473ml bottles and the prices are shown in pounds with free UK delivery. In each case the product shown is as follows:<sup>8</sup>



<sup>7</sup> See exhibit SJR12, page 121.

<sup>8</sup> As above, pages 110 and 114.

28. A cached copy of a page from [www.scunthorpeunited-mad.co.uk](http://www.scunthorpeunited-mad.co.uk) shows an offer for a 32% discount on Cocotein Coconut Water. The offer expired on 28 April 2014.<sup>9</sup>

29. A page printed from Amazon UK shows the same product (listed as 470ml) and sold by Isopure as first in stock on 28 November 2013.<sup>10</sup>

30. A page taken from [vit-shop.co.uk](http://vit-shop.co.uk), a vitamin and supplement store based in Hull, shows COCOTEIN was last in stock on 30 June 2015.<sup>11</sup>

31. A page taken from [www.butterflylondon.com](http://www.butterflylondon.com), which describes its business as, 'Innovation in sports nutrition', features a photograph of COCOTEIN Coconut Water in three flavours. The text below the image reads:

*“Unless you’ve been hiding under a rock lately, you will know that coconut water is all the rage, with many boasting about its natural benefits of B vitamins, antioxidants and phytonutrients, electrolytes and natural salts...and the list goes on. But more recently, brands have latched onto its natural effectiveness as a sports drink. Cocotein has combined coconut water’s natural composition with added isolate proteins to increase muscle recovery and build, having 2-in-1 electrolyte drink with a protein shake that’s 100% natural.”*

32. The content was uploaded in March 2015.<sup>12</sup>

33. An article is provided from Identica, a brand strategy and design company, based in London.<sup>13</sup> The article is titled, 'Health on the Horizon – Health Trends in 2014' and was written at the start of the year. It begins:

*“It’s the beginning of a new year which means gyms are overcrowded and new diets are painfully bedding in.”*

---

<sup>9</sup> As above, page 123.

<sup>10</sup> See exhibit SJR13.

<sup>11</sup> See exhibit SJR14.

<sup>12</sup> See exhibit SJR15.

<sup>13</sup> See exhibit SJR16.

34. The third section of the article is titled, 'Functional Foods'. The article defines these foods as follows:

*“By infusing food staples with super-foods and protein-rich ingredients, brands are creating everyday consumables that pack a powerful nutritional punch.*

*2014 is to be a year where health innovations in the food and beverage market will reach us all.”*

35. The second product featured in the article is COCOTEIN Coconut Water.<sup>14</sup>

36. Ms Redmond provides a print taken from Food & Drink Business Europe, which she describes as a 'long established business magazine for the food and drink processing industries in the UK and Europe.' The monthly circulation is 24,900. A news item posted on 28 August 2013 announces the launch of US company Isopure's Cocotein product.<sup>15</sup>

37. Ms Redmond provides reviews taken from www.bodybuilding.com which she submits are provided by UK reviewers on a UK page of the US website. Twelve reviews are provided, each of which includes a picture of the product and the heading 'Nature's Best Cocotein'. Eleven of them are dated between 13 May 2013 and 30 April 2015 (before the relevant date). The twelfth is dated 22 July 2016.<sup>16</sup>

#### Witness statement of Suzie Sonnabend and exhibit SS1

38. Ms Sonnabend is the Managing Director of Peak Health Distribution (trading as Monster Supplements). She has held the position since February 2017, prior to which she was the company's Commercial Director. Her statement is dated 22 February 2017. She submits:

---

<sup>14</sup> The image included in the article is the same as that shown at paragraph x above.

<sup>15</sup> See exhibit SJR17.

<sup>16</sup> See exhibit SJR18.

*“Monster Supplements was originally founded in 1996 as a small retail store in Hull and has since grown into one of the largest online suppliers of sports nutrition products. We offer the UK’s widest selection of top brand sports nutrition online.*

*Between August 2013 and June 2015 we advertised and sold COCOTEIN to customers in the UK. The COCOTEIN products were bought directly from the Opponent, advertised on our website and then sold to our customers.”*

39. Ms Sonnabend provides a table showing the number of cases and bottles of COCOTEIN sold between those dates:

<b>Month</b>	<b>12 x 473ml case</b>	<b>1 x 473ml bottle</b>	<b>Total bottles</b>
August 2013	1	0	12
September 2013	13	0	156
October 2013	32	0	384
November 2013	15	0	180
December 2013	0	0	0
January 2014	14	0	168
February 2014	4	0	48
March 2014	7	0	84
April 2014	7	0	84
May 2014	0	0	0
June 2014	0	0	0
July 2014	19	6	234
August 2014	17	0	204
September 2014	4	5	53
October 2014	0	0	0
November 2014	0	0	0
December 2014	5	5	65
January 2015	2	3	27
February 2015	4	0	48
March 2015	5	1	61
April 2015	3	0	36

May 2015	3	0	36
June 2015	5	1	61
<b>Total</b>			<b>1941</b>

40. Six invoices provided by Ms Redmond show sales of COCOTEIN Coconut Water from Isopure Belgium to Peak Health Distribution.<sup>17</sup> The delivery address in each case is Monster Supplements in Hull. The invoices are dated between 26 August 2013 and 20 November 2014. The quantities ordered and prices paid are difficult to interpret as no currency is provided and quantities are written as, for example, 48.000.

41. Ms Sonnabend provides an example of the promotional material put on her company’s website at exhibit SS1. The article is titled, ‘Electrolytes – Answer to Zero Hangovers’. The image accompanying the article is a photograph of a bodybuilder (Dan Walls) to the left of three bottles of COCOTEIN Coconut Water. The article appears to be dated January 2016.

## **DECISION**

42. Section 5(4) of the Act states:

“5(4) 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...

(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.”

---

<sup>17</sup> See exhibit SJR19. Eight invoices have been provided but numbers 2821 and 2812 are duplicated.

43. In *Discount Outlet v Feel Good UK*,<sup>18</sup>, 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).”

44. Halsbury’s Laws of England Vol. 97A (2012 reissue) provides further guidance with regard to establishing the likelihood of deception. In paragraph 309 it is noted (with footnotes omitted) that:

“To establish a likelihood of deception or confusion in an action for passing off where there has been no direct misrepresentation generally requires the presence of two factual elements:

(1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and

(2) that members of that class will mistakenly infer from the defendant’s use of a name, mark or other feature which is the same or sufficiently similar

---

<sup>18</sup> [2017] EWHC 1400 IPEC

that the defendant's goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact.

In arriving at the conclusion of fact as to whether deception or confusion is likely, the court will have regard to:

- (a) the nature and extent of the reputation relied upon;
- (b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;
- (c) the similarity of the mark, name etc. used by the defendant to that of the plaintiff;
- (d) the manner in which the defendant makes use of the name, mark etc. complained of and collateral factors; and
- (e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances."

In assessing whether confusion or deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action."

### **The relevant date**

45. Whether there has been passing off must be judged at a particular point (or points) in time. In *Advanced Perimeter Systems Limited v Multisys Computers Limited*,<sup>19</sup> Mr Daniel Alexander QC as the Appointed Person considered the relevant date for the purposes of s.5(4)(a) of the Act:

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.’”

46. The filing date of the subject trade mark is 10 July 2015. There is no evidence or claim by the applicant that its mark has been used prior to this date. Accordingly, the matter need only be assessed as of 10 July 2015.

## **Goodwill**

47. The first hurdle for the opponent is to show that they had the required goodwill at the relevant date. In *Inland Revenue Commissioners v Muller & Co’s Margarine Ltd* [1901] AC 217 (HOL), the Court stated:

“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

---

<sup>19</sup> *BL O-410-11*

thing which distinguishes an old-established business from a new business at its first start.”

48. In *South Cone Incorporated v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* [2002] RPC 19 (HC), Pumfrey J. stated:

“27. There is one major problem in assessing a passing off claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under s.11 of the 1938 Act (see *Smith Hayden & Co. Ltd's Application (OVAX)* (1946) 63 R.P.C. 97 as qualified by *BALI Trade Mark [1969] R.P.C. 472*). Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.

28. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date. Once raised, the applicant must rebut the prima facie case. Obviously, he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the hearing officer that it is not shown on the balance of probabilities that passing off will occur.”

49. However, in *Minimax GmbH & Co KG v Chubb Fire Limited* [2008] EWHC 1960 (Pat) Floyd J. (as he then was) stated that:

“[The above] observations are obviously intended as helpful guidelines as to the way in which a person relying on section 5(4)(a) can raise a case to be answered of passing off. I do not understand Pumfrey J to be laying down any absolute requirements as to the nature of evidence which needs

to be filed in every case. The essential is that the evidence should show, at least prima facie, that the opponent's reputation extends to the goods comprised in the application in the applicant's specification of goods. It must also do so as of the relevant date, which is, at least in the first instance, the date of application.”

50. In its skeleton argument the opponent submits that whilst trivial goodwill is not enough to found a passing off claim, the threshold for establishing a non-trivial protectable goodwill is a low one. The opponent draws my attention to *Stannard v Reay*,<sup>20</sup> in which protectable goodwill was generated as a result of a three-week period of trading by a single mobile fish and chip van on the Isle of Wight; and *W3 v easyGroup*,<sup>21</sup> in which Arnold J found that the claimant had generated, ‘a modest, but nevertheless sufficiently substantial, goodwill’ as a result of there being only 109 registered users of a UK website over a period of less than two months (although with many more visitors) and without the website having generated any revenue at all.

51. In *Hart v Relentless Records* [2002] EWHC 1984 (Ch), Jacob J. (as he then was) stated that:

“62. In my view the law of passing off does not protect a goodwill of trivial extent. Before trade mark registration was introduced in 1875 there was a right of property created merely by putting a mark into use for a short while. It was an unregistered trade mark right. But the action for its infringement is now barred by s.2(2) of the Trade Marks Act 1994. The provision goes back to the very first registration Act of 1875, s.1. Prior to then you had a property right on which you could sue, once you had put the mark into use. Even then a little time was needed, see per Upjohn L.J. in BALI Trade Mark [1969] R.P.C. 472. The whole point of that case turned on the difference between what was needed to establish a common law trade mark and passing off claim. If a trivial goodwill is enough for the latter, then the difference between the two is vanishingly small. That cannot be the case.

---

<sup>20</sup> [1967] FSR 140

<sup>21</sup> [2018] EWHC 7 (Ch), p.366

It is also noteworthy that before the relevant date of registration of the BALI mark (1938) the BALI mark had been used “but had not acquired any significant reputation” (the trial judge's finding). Again that shows one is looking for more than a minimal reputation.”

52. It has long been established that a small business which has more than a trivial goodwill can protect signs which are distinctive of that business under the law of passing off even though its reputation may be small. In *Stacey v 2020 Communications* [1991] FSR 49, Millett J. stated that:

“There is also evidence that Mr. Stacey has an established reputation, although it may be on a small scale, in the name, and that that reputation preceded that of the defendant. There is, therefore, a serious question to be tried, and I have to dispose of this motion on the basis of the balance of convenience.”

53. See also: *Teleworks v Telework Group*<sup>22</sup> and *Lumos Skincare Limited v Sweet Squared Limited and others*.<sup>23</sup>

54. The applicant makes a number of points regarding the opponent's goodwill. Its main submission is that the opponent's additional evidence should not have been admitted, a point which I have dealt with above. It also submits:<sup>24</sup>

*“16. It is noted that all the invoices in SJR19 are addressed from a company called ISOPURE COMPANY BELGIUM SPRL from an address in Belgium, which is not the name of the opponent. Accordingly, the invoices do not show that the opponent has sold any COCOTEIN branded products to distributors in the United Kingdom.”*

55. In her witness statement Ms Redmond states:

---

<sup>22</sup> [2002] RPC 27 (HC)

<sup>23</sup> [2013] EWCA Civ 590 (COA)

<sup>24</sup> See submissions dated 3 October 2017

*“7. The opponent is the manufacturer of a number of sports nutrition products, such as ready to drink beverages. Their products are sold worldwide and its products can be found in independent retail stores, gyms, fitness centres, major grocery stores and drug stores.”*

56. The opponent has submitted that the invoices show evidence of sales it has made dating back to 2013. It is not clear to me why the applicant concludes that ISOPURE COMPANY BELGIUM is not part of ISOPURE COMPANY, which sells products worldwide. In the absence of any evidence to the contrary, which the applicant had ample opportunity to provide, I am satisfied that the invoices represent sales made by the opponent. The name of the entity is the same. The addition of a geographic region is unsurprising.

57. In addition, the applicant also submits that the table of sales provided in Ms Sonnabend’s statement (and reproduced above at paragraph 39), does not appear to ‘have any correlation’ to the invoices. It submits:

*“17...For instance, the August 2013 invoice at page 177 is the earliest and refers to 4 cases of ‘COCOTEIN COCONUT WATER 16 OZ’ at item code 03475. But in Ms Sonnabend’s table, the August 2013 figure is only 1 case. None of the invoices fit the table.”*

58. I do not find these exhibits to be conflicting. The table referred to in Ms Sonnabend’s statement relates to sales of the opponent’s COCOTEIN product made by Monster Supplements and broken down by month. The invoices provided in support of the opponent’s case relate to the purchase of the opponent’s COCOTEIN product by Monster Supplements. The fact that in any given month Monster Supplements ordered an amount of product which differed from the number of units sold in that same month, seems entirely reasonable and to be expected. One can foresee any number of scenarios which may give rise to such ordering practices. Presumably, a level of stock needs to be maintained to offer goods for sale online, or stock may be ordered ahead of a promotional event to prepare for a higher volume of sales, and so on.

59. In addition, the applicant submits:

*“21. On page 55, which relates to SJR6 of Ms Redmond’s Statement, are various tweets. The third one from the bottom is a tweet from the opponent ‘The Isopure Company’ and is dated ‘24 Jun 2014’. The tweet from the opponent reads, ‘Cocotein is not available in the UK yet :(’.*

60. The applicant concludes:

*“22. The Witness Statements of Ms Redmond and Ms Sonnabend both claim that sales in the United Kingdom began in August 2013 and purported to provide evidence of such sales throughout 2013 and into 2014, then 2015. However, this tweet directly from the opponent is an admission that as of 24 June 2014, Cocotein was unavailable in the UK. The tweet runs counter to the claims made in these Statements. Accordingly, the veracity of all the claims made in the Witness Statements should be called into question.”*

61. The appropriate way in which to challenge the opponent’s evidence is not in submissions filed at the end of the proceedings. On 30 August 2017 the applicant was given a period in which to respond to the opponent’s additional evidence. It was open to the applicant to file evidence of its own to support its case and to provide facts in support of its view of the opponent’s evidence. The applicant elected to file submissions rather than evidence.

62. Following the conclusion of the evidence rounds, the applicant had the opportunity to request cross-examination of the opponent’s witnesses in order to put its own questions to those witnesses, regarding the factual accuracy of the opponent’s evidence and in particular the witness statements of Ms Redmond and Ms Sonnabend. The applicant did not request cross-examination.

63. In its written submissions, dated 8 November 2016, the applicant concludes its view of the opponent’s evidence in the following terms:

*“16. None of the evidence presented or figures claimed support the Opponent’s contention in paragraph 4 of the Witness Statement that it has sold its products in the UK before the relevant date.*

*17. From the Witness Statement and Exhibits, one cannot tell whether the customers were from the UK or the number of goods sold. There are no turnover figures or advertising expenditure given with supporting evidence. No verified evidence has been filed in the form of invoices, packaging, marketing materials or other supporting documents. Accordingly, no evidence has been presented to show that the Opponent has sold any drink products under the trade mark COCOTEIN in the UK...”*

64. The evidence in its totality shows that the opponent’s business provides a range of products for sports nutrition, fitness and exercise. Monster Supplements’ twitter feed includes a tweet dated 31 August 2013 which reads, ‘Try Isopure’s Cocotein. On sale now.’ Another tweet dated 4 December 2013 is written in reply to a customer and reads, ‘we do stock cocotein, in glass bottles.’ This would appear to support the opponent’s claim that use of its sign COCOTEIN began in the UK two years prior to the date of filing of the contested application.

65. Evidence is provided which shows the packaging of the product, for example, a *facebook* post by the opponent, dated 21 October 2013, titled, ‘Sampling Day at Monster Supplements Hull’. Bottles of COCOTEIN can be seen in the fridge and on the displays in front of the fridges, all of which show a bottle with the word COCOTEIN along its length. A *facebook* post from 27 September 2013 advertises COCOTEIN as ‘new at pro-performance’ in Torbay. The attached image shows the bottle which clearly has the sign COCOTEIN along the length of the bottle. An advertisement by PhD fitness, on its own *facebook* page, shows two of the same bottles, with the word ‘COCOTEIN’ clearly visible along their lengths. It is dated 11 April 2015 and reads, ‘Isopure COCOTEIN Coconut Water now just £32.99.’

66. Invoices provided by the opponent indicate regular purchases of COCOTEIN from the opponent by the UK stockist Monster Supplements. Archive pages from waybackmachine dated August 2013 and June 2015 show the COCOTEIN product for

sale on its website and priced in pounds. Ms Sonnabend's statement confirms that the product was advertised and sold to customers in the UK.

67. Ms Sonnabend's breakdown of sales of COCOTEIN by Monster Supplements between August 2013 and June 2015 amounts to 1941 bottles. Whilst this cannot be said to be a high number of sales, I do not find it to be insignificant. The product sold under the sign COCOTEIN is a sports nutrition drink which contains whey protein. This is a fairly specialised product which is unlikely to be bought casually in place of any number of other drinks, but will be bought by those with a specific training/nutritional goal.

68. In its totality, the evidence provided by the opponent is sufficient to show it had a protectable goodwill at the relevant date, namely 10 July 2015.

69. I note that the applicant makes reference to the opponent's goodwill being localised in Hull. I do not find this to be the case as the evidence shows the opponent's product for sale at pro-performance in Torbay in 2013 and the opponent's stockist, Monster Supplements, sells online throughout the UK, so is unlikely only to have customers in the Hull area. In any case, even if the goodwill were localised in the way suggested by the applicant, this does not prevent the claim succeeding since the registration is a UK registration which, notionally, may be used in the same geographic area.

70. The sign COCOTEIN is used in plain black capital letters on the bottle, in the invoices and in descriptions of the product. Accordingly, the use shown is such that the goodwill is associated with the word, per se. The goodwill rests in nutritional supplements and drinks for sports, health, exercise and fitness.

### **Misrepresentation**

71. In *Neutrogena Corporation and Another v Golden Limited and Another*, [1996] RPC 473, Morritt L.J. stated that:

“There is no dispute as to what the correct legal principle is. As stated by Lord Oliver of Aylmerton in *Reckitt & Colman Products Ltd. v. Borden Inc.*

[1990] R.P.C. 341 at page 407 the question on the issue of deception or confusion is:

‘is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the public will be misled into purchasing the defendants' [product] in the belief that it is the respondents' [product]?’

The same proposition is stated in Halsbury's Laws of England 4th Edition Vol.48 para 148. The necessity for a substantial number is brought out also in *Saville Perfumery Ltd. v. June Perfect Ltd.* (1941) 58 R.P.C. 147 at page 175 ; and *Re Smith Hayden's Application* (1945) 63 R.P.C. 97 at page 101.”

72. And later in the same judgment:

“... for my part, I think that references, in this context, to ‘more than *de minimis*’ and ‘above a trivial level’ are best avoided notwithstanding this court's reference to the former in *University of London v. American University of London* (unreported 12 November 1993). It seems to me that such expressions are open to misinterpretation for they do not necessarily connote the opposite of substantial and their use may be thought to reverse the proper emphasis and concentrate on the quantitative to the exclusion of the qualitative aspect of confusion.”

73. I have found the applicant to have goodwill in respect of nutritional supplements and drinks for sports, health, exercise and fitness. The opponent makes its passing off claim in respect of the applicant's goods, ‘Nutrition supplements for sports, fitness, health and exercise’ and ‘Drinks for sports, health, exercise and fitness.’ These are identical goods.

74. The opponent's goodwill is associated with the sign COCOTEIN. The applicant's mark is ‘cocotein’. Fair and notional use of the applicant's mark would include use in upper case and I find these to be identical marks.

75. I come to the firm view that the use shown by the opponent is such that the word COCOTEIN will be seen as an indication of the commercial origin of the goods in relation to which it is used. The sign COCOTEIN is distinctive of the opponent.

76. Assuming use of the application in respect of identical goods, I find that a substantial number of the public would have been deceived at the relevant date. In conclusion, a normal and fair use of the applicant's mark at the relevant date would have constituted a misrepresentation to a substantial number of people.

## **Damage**

77. Having found that the goodwill and misrepresentation limbs of the test have been satisfied in respect of some of the goods and services, it follows that damage to the opponent's goodwill will arise, most obviously, by diverting trade from the opponent to the applicant.

78. Damage can also be wider than simply a loss of sales. In *Maslyukov v Diageo Distilling Ltd* Arnold J stated:

“85 Secondly, counsel submitted that the hearing officer had wrongly failed to recognise that damage resulting from Diegeo's loss of control over the marks, including erosion of distinctiveness of the marks, was sufficient damage to sustain a passing off action, as shown by the following passage from McAlpine at [20] which the hearing officer himself quoted at para.128 of the decision:

“When it comes to considering damage, the law is not so naïve as to confine the damage to directly provable losses of sales, or ‘direct sale for sale substitution’. The law recognises that damage from wrongful association can be wider than that. Thus in *Ewing v Buttercup Margarine Ltd* (1917) 34 R.P.C. 232 Warrington L.J. said:

‘To induce the belief that my business is a branch of another man's business may do that other man damage in all kinds of

ways. The quality of the goods I sell; the kind of business I do; the credit or otherwise which I might enjoy. All those things may immensely injure the other man, who is assumed wrongly to be associated with me.'

In so saying, he was not limiting the kinds of potential damage to those listed by him. Rather, he was indicating that the subtleties of the effect of passing off extend into effects that are more subtle than merely sales lost to a passing off competitor. In *Associated Newspapers Ltd v Express Newspapers* [2003] F.S.R. 909 at 929 Laddie J. cited this passage, referred to other cases and went on to say:

'In all these cases [that is to say, the Clock Ltd case referred to above and *Harrods v Harrodian School* [1996] R.P.C. 679], direct sale for sale substitution is unlikely or impossible. Nevertheless the damage to the claimant can be substantial and invidious since the defendant's activities may remove from the claimant his ability to control and develop as he wishes the reputation in his mark. Thus, for a long time, the common law has protected a trader from the risk of false association as it has against the risk of more conventional goods for goods confusion.'

The same judge expressed himself more picturesquely, but equally helpfully, in *Irvine v Talksport Ltd* [2002] 1 W.L.R. 2355 at 2366. Having pointed out the more familiar, and easier, case of a defendant selling inferior goods in substitution for the claimant's and the consequential damage, he went on to say:

'But goodwill will be protected even if there is no immediate damage in the above sense. For example, it has long been recognised that a defendant cannot avoid a finding of passing off by showing that his goods or services are of as good or better quality than the claimant's. In such a case, although the defendant may not damage the goodwill as such, what he does is damage the value of the goodwill to the

claimant because, instead of benefiting from exclusive rights to his property, the latter now finds that someone else is squatting on it. It is for the owner of goodwill to maintain, raise or lower the quality of his reputation or decide who, if anyone, can use it alongside him. The ability to do that is compromised if another can use the reputation or goodwill without his permission and as he likes. Thus Fortnum and Mason is no more entitled to use the name FW Woolworth than FW Woolworth is entitled to use the name Fortnum and Mason ...' 'The law will vindicate the claimant's exclusive right to the reputation or goodwill. It will not allow others so to use goodwill as to reduce, blur or diminish its exclusivity.' (at 2368)

In *Taittinger SA v Allbev Ltd* [1994] 4 All ER 75 at 88, Peter Gibson L.J. acknowledged that:

'Erosion of the distinctiveness of the name champagne in this country is a form of damage to the goodwill of the business of the champagne houses.' The same view was expressed by Sir Thomas Bingham MR at 93."

79. To illustrate the point further, I note that in *WS Foster & Son Limited v Brooks Brothers UK Limited*,<sup>25</sup> Mr Recorder Iain Purvis QC stated:

"Damage

55 Although proof of damage is an essential requirement of passing off cases, it will generally be presumed where a misrepresentation leading to a likelihood of deception has been established, since such deception will be likely to lead to loss of sales and/or more general damage to the exclusivity of the Claimant's unregistered mark. Mr Aikens accepted that if there was a misrepresentation in the present case, then he had no separate case on damage. I hold that damage is inevitable, at least in the sense

---

<sup>25</sup> [2013] EWPC 18

recognised in *Sir Robert McAlpine v Alfred McAlpine* [2004] RPC 36 at 49 (the ‘blurring, diminishing or erosion’ of the distinctiveness of the mark).”

80. I therefore find that use of the applicant’s mark at the relevant date was liable to be restrained under the law of passing off in respect of the goods I have identified above.

81. The opposition succeeds under section 5(4)(a) of the Act.

## **COSTS**

82. The opposition having succeeded, the opponent is entitled to a contribution towards its costs.

83. Three case management conferences (CMCs) were held during these proceedings. The first was to discuss an extension to the opponent’s deadline by which to file its evidence in chief. The second concerned a request by the opponent to file additional evidence, to which I have referred in detail earlier in this decision, and the third concerned a request for leave to appeal that decision. Having considered all of the relevant material, I find that the parties should bear their own costs with regard to the CMCs.

In respect of the substantive proceedings, I award costs on the following basis:

Official fee:	£200
Preparing a statement and considering the other side’s statement:	£200
Preparing evidence and submissions and considering submissions:	£900
Preparation for and attending a hearing:	£800
Total:	£2100

84. I order Bio-Synergy Limited to pay the The Isopure Company, LLC the sum of £2100. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 12<sup>th</sup> day of June 2018**

**Ms AI Skilton**

**For the Registrar,**

**The Comptroller-General**