

O-422-18

TRADE MARKS ACT 1994

IN THE MATTER OF INTERNATIONAL REGISTRATION NO 1351639 AND THE  
REQUEST BY GOGU MARIN TO PROTECT IN THE UK THE TRADE MARK



AND

IN THE MATTER OF OPPOSITION THERETO UNDER NO 410444  
BY ENERGY BEVERAGES LLC

## Background

1. On 17 March 2017, Gogu Marin (“the holder”) requested protection in the UK of International Trade Mark number 1351639 for the mark shown on the front page of this decision. A priority date of 3 March 2017 is claimed from a Moldovan trade mark.

2. The mark was accepted and published in the Trade Marks Journal on 7 July 2017 in respect of the following goods:

Class 34

Cigarettes, cigarette filters, cigarettes containing tobacco substitutes not for medical purposes, cigarette paper, tobacco.

3. The application is opposed by Energy Beverages LLC (“the opponent”) under the provisions of section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opposition is directed at all goods in the application. The opponent relies on five European Union Trade Marks (“EUTM”) as follows:

Mark and No	Dates	Goods relied upon
EUTM 3501244 BURN	Filing date: 31 October 2003  Date of entry in register: 12 April 2005  Seniority date: 3 January 2001	Goods in class 32
EUTM 10259687 	Filing date: 13 September 2011  Date of entry in register: 24 January 2012	Goods in class 32

<p>EUTM 11575289</p> 	<p>Filing date: 14 February 2013</p> <p>Date of entry in register: 25 June 2013</p>	<p>Goods in class 32</p>
<p>EUTM 11870516</p> 	<p>Filing date: 4 June 2013 Date of entry in register: 15 October 2013</p>	<p>Goods in class 32</p>
<p>EUTM 15816151</p> 	<p>Filing date: 12 September 2016 Date of entry in register: 28 December 2016</p>	<p>Goods in class 32</p>

4. Given their dates of filing, the opponent's marks qualify as "earlier marks" in accordance with section 6 of the Act. In respect of EUTMs 3501244 and 10259687, the opponent states in its notice of opposition that these marks have been used in relation to all the goods as relied upon. It says this because each of these marks are subject to the proof of use provisions set out in section 6A of the Act. The opponent claims that because each of the respective marks share a high degree of visual and

aural similarity coupled with the high similarity of the respective goods, confusion between them is inevitable.

5. The holder filed a counterstatement denying the grounds of opposition and putting the opponent to proof of use of its EUTMs 3501244 and 10259687. It also denies there is any possibility of confusion or association on the basis that the respective goods are “entirely different in nature and use”.

6. Only the opponent filed evidence which I do not summarise but will refer to as necessary in this decision. Both parties filed written submissions. Neither party sought to be heard and I therefore give this decision from the papers before me.

**Decision**

7. Two of the five earlier marks relied upon are subject to proof of their use. Whilst the opponent filed evidence which the holder submits does not show use in respect of all goods, I intend to proceed on the basis that the marks have been used in respect of each of the goods for which they have been registered.

**Comparison of goods**

8. The goods to be compared are as follows:

Opponent’s specification	Holder’s specification
EUTM 3501244 Class 32 Beverages, namely drinking waters, flavored waters, mineral and aerated waters: and other non-alcoholic beverages, namely, soft drinks, energy drinks and sports drinks; fruit drinks and juices; syrups, concentrates and powders for making beverages, namely flavored waters, mineral and aerated waters, soft drinks, energy drinks, sports drinks, fruit juices and juices	Class 34 Cigarettes, cigarette filters, cigarettes containing tobacco substitutes not for medical purposes, cigarette paper, tobacco
EUTM10259687 Class 32 Beers; Mineral and aerated waters and other non-alcoholic drinks; Fruit drinks and fruit juices; Syrups and other preparations for making beverages	

EUTM 11575289

Class 32

Beers; Mineral and aerated waters and other non-alcoholic beverages; Fruit beverages and fruit juices; Syrups and other preparations for making beverages; Aerated water; Aloe vera drinks, non-alcoholic; Aperitifs, non-alcoholic; Beer; Beer wort; Cider, non-alcoholic; Cocktails, non-alcoholic; Essences for making beverages; Extracts of hops for making beer; Fruit juice; Fruit nectars, non-alcoholic; Ginger ale; Grape must, unfermented; Isotonic beverages; Kvass [non-alcoholic beverage]; Lemonades; Lithia water; Malt beer; Malt wort; Milk of almonds [beverage]; Mineral water [beverages]; Must; Non-alcoholic beverages; Non-alcoholic fruit extracts; Non-alcoholic fruit juice beverages; Non-alcoholic honey-based beverages; Orgeat; Pastilles for effervescing beverages; Peanut milk [non-alcoholic beverage]; Powders for effervescing beverages; Preparations for making aerated water; Preparations for making beverages; Preparations for making liqueurs; Preparations for making mineral water; Sarsaparilla [non-alcoholic beverage]; Seltzer water; Smoothies; Soda water; Sorbets [beverages]; Syrups for beverages; Syrups for lemonade; Table waters; Tomato juice [beverage]; Vegetable juices [beverages]; Waters [beverages]; Whey beverages.

EUTM 11870516

Class 32

Beers; mineral and aerated waters and other non-alcoholic beverages; fruit beverages and fruit juices; syrups and other preparations for making beverages; aerated water; aloe vera drinks, non-alcoholic; aperitifs, non-alcoholic; beer; beer wort; cider, non-alcoholic; cocktails, non-alcoholic; essences for making beverages; extracts of hops for making beer; fruit juice; fruit

nectars, non-alcoholic; ginger ale; grape must, unfermented; isotonic beverages; kvass [non-alcoholic beverage]; lemonades; lithia water; malt beer; malt wort; milk of almonds [beverage]; mineral water [beverages]; must; non-alcoholic beverages; non-alcoholic fruit extracts; non-alcoholic fruit juice beverages; non-alcoholic honey-based beverages; orgeat; pastilles for effervescing beverages; peanut milk [non-alcoholic beverage]; powders for effervescing beverages; preparations for making aerated water; preparations for making beverages; preparations for making liqueurs; preparations for making mineral water; sarsaparilla [non-alcoholic beverage]; seltzer water; smoothies; soda water; sorbets [beverages]; syrups for beverages; syrups for lemonade; table waters; tomato juice [beverage]; vegetable juices [beverages]; waters [beverages]; whey beverages; energy drinks.	
EUTM 15816151 Class 32 Non-alcoholic beverages; beer.	

9. In the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment:

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

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

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

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

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

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

12. In *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another*, [2000] F.S.R. 267 (HC), Neuberger J. (as he then was) stated that:

“I should add that I see no reason to give the word “cosmetics” and “toilet preparations”... anything other than their natural meaning, subject, of course, to the normal and necessary principle that the words must be construed by reference to their context.”

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

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

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

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

Whilst on the other hand:

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

15. In response to a direction from the registrar to provide a specific explanation of why it considered the respective goods to be similar, the opponent claims the respective goods share a “reasonably high degree” of similarity and submits:

“It is clear from an application of the Canon factors that the [holder’s] cigarettes and smoking related goods share a relatively high degree of similarity with the Opponent’s beer and non-alcoholic beverages:

a: alcoholic and non-alcoholic beverages and cigarettes, respectively, are all consumable products and therefore share a similar nature;

b: beverages, in particular beer, and cigarettes are consumed for the same intended purpose, namely to enhance the enjoyment and relaxation of the consumer; and

c: beverages, in particular beer, and cigarettes are often consumed at the same time, for example in beer gardens in pubs; it is therefore clear that these goods are complementary. Indeed, the complementarity of alcoholic beverages and cigarettes is so well-established that the famous UK band Oasis released a song in 1994 called “Cigarettes and Alcohol””

Referring to the criteria set out in *Treat*, it goes on to claim:

“a: there is a significant overlap in the respective users of beverages, in particular beer, and cigarettes as both are consumed in the UK by adults over the age of 18: and

b: the trade channels of beverages, in particular beer, and cigarettes share some similarities as both are available for purchase in the same places, namely in off-licences, newsagents, supermarkets, duty-free shops in airports, as well as in pubs in the UK.”

16. I agree with the opponent that, insofar as alcoholic beverages, cigarettes and tobacco are concerned, their sale is restricted in the UK to those over the age of 18. Soft drinks may be bought by those of any age. To the extent that some people who buy beverages will also be smokers, there is some potential overlap in the users of the goods.

17. Beverages, whether alcoholic or otherwise, are in liquid form and bought, primarily, to drink so as to quench a thirst though I accept, in the case of alcoholic or energy drinks, that for some, the particular content and after-effects of consuming the same is a factor in the purchasing process. The holder's goods are not liquids but are goods for smoking. Whilst the smoker is likely to take various things into his/her body as a result of lighting and smoking cigarettes or tobacco, these goods are not “consumed” in the sense that they themselves are taken into the body. Whilst some of the respective goods may provide a “hit” of some sort to the consumer or aid relaxation, their uses and physical natures differ markedly.

18. I accept that the respective goods may be sold in the same premises but their methods of production differ and there is no evidence they reach the market through the same channels. In e.g. a supermarket or off licence, beverages, whether alcoholic or otherwise, are bought from the shelves by self-selection whereas cigarettes and tobacco will be kept in a different part of the store and, as they are subject to legal restrictions that they are stored out of view behind screens of some sort, they are not visible to potential consumers or available for self-selection but must be asked for and then supplied by a member of staff. I accept that in e.g. pubs and clubs the respective goods may both be available from behind the same bar, however the same restrictions apply so cigarettes and tobacco (if sold at all) will not be visible to a potential purchaser whereas beverages will be, whether on a shelf, in a fridge or displayed on a dispenser of some description.

19. Despite the fact that beverages on the one hand and tobacco products on the other may each be purchased from the same pubs and drunk/smoked in the beer garden, I do not consider that this means the respective goods are complementary. Indeed the processes, materials and skills required to produce and market tobacco products on one hand and beverages on the other are so different that consumers are very unlikely to believe that they are marketed by the same or related undertakings. I have no hesitation in finding the respective goods are dissimilar.

20. In *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, Lady Justice Arden stated:

“49..... I do not find any threshold condition in the jurisprudence of the Court of Justice cited to us. Moreover I consider that no useful purpose is served by holding that there is some minimum threshold level of similarity that has to be shown. If there is no similarity at all, there is no likelihood of confusion to be considered. If there is some similarity, then the likelihood of confusion has to be considered but it is unnecessary to interpose a need to find a minimum level of similarity.

21. As I have found the respective goods to be dissimilar there is no likelihood of confusion.

### **Summary**

22. The opposition under section 5(2)(b) of the Act fails in its totality.

### **Costs**

23. The opposition having failed, the holder is entitled to an award of costs in its favour. I make no award in respect of the holder reviewing the opponent's evidence. I do so on the basis that requiring the opponent to provide proof of use was not necessary given that three of the earlier marks relied on (some of which were closely similar marks and included the same goods) did not trigger the proof of use requirements and the holder's very clear view that the respective goods were not similar in any event. I make the award, therefore, on the following basis:

Preparing a counterstatement and considering the notice of opposition: £300

Written submissions: £100

**Total: £400**

24. I order Energy Beverages LLC to pay Gogu Marin the sum of £400. This sum is to be paid within fourteen days of the end of the period allowed for appeal or, if an appeal is filed, within fourteen days of the conclusion of that appeal (subject to any order made by that appellate tribunal).

**Dated this 16th day of July 2018**

**Ann Corbett**

**For the Registrar**