TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION No. 3253295
IN THE NAME OF TINY REBEL BREWING COMPANY LIMITED

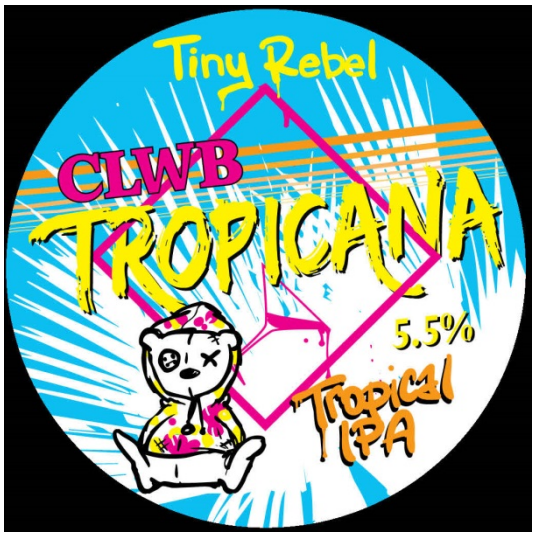
AND IN THE MATTER OF OPPOSITION No. 411025 THERETO
BY TROPICANA PRODUCTS INC.

AND IN THE MATTER OF AN APPEAL TO THE APPOINTED PERSON
BY THE APPLICANT
AGAINST A DECISION OF MR GW SALTHOUSE
DATED 31 JANUARY 2019

DECISION

Background

1. On 29 August 2017, Tiny Rebel Brewing Company Limited ("the Applicant") applied under number 3253295 to register the figurative designation represented below for use in the UK as a trade mark:



2. The goods in respect of which registration was sought were:

   Class 32
   Beers; shandy, de-alcoholised drinks, non-alcoholic beers

3. Following publication of the application in the Trade Marks Journal on 15 September 2017, Tropicana Products Inc. ("the Opponent") filed Notice of opposition and statement of grounds against the application on 13 December 2017.

4. The grounds of opposition were under Section 5(2)(b) (similar mark for identical/similar goods and likelihood of confusion), 5(3) (unfair advantage of/damage to similar earlier trade mark with reputation without due cause) and 5(4)(a) use in UK liable to be prevented by passing off).

5. For the purposes of Section 5(2)(b) and 5(3), the Opponent relied on four earlier trade marks within the meaning of Section 6(1)(a) in the Opponent's ownership:

Mark	**Number**	**Filing/Registration date**	**Goods, Class 32**
TROPICANA	EU 1184746	25.05.99/17.12.02	Non-alcoholic beverages, namely fruit drinks, fruit juices and fruit based-beverages
	EU 5678818	09.02.07/29.01.08	Fruit juices and fruit juice drinks
TROPICANA	EU 12828901	29.04.14/23.09.14	Non-alcoholic drinks, namely, fruit drinks, fruit juices and fruit-based drinks; fruit drinks and fruit juices; syrups and other preparations based on fruit for making beverages; fruit smoothies
TROPICANA	UK 890438	09.02.66/09.02.66	Non-alcoholic drinks and preparations for making such drinks, all included in Class 32

6. I pause here to note that the widest specification of Class 32 goods relied on by the Opponent was *prima facie* in the Opponent's UK Registration number 890438.

7. The Opponent provided evidence addressing *inter alia* the Applicant's demands in its Notice of defence and counterstatement filed on 20 February 2018 for proof of: (a) use of the Opponent's earlier trade marks EU 1184746, EU 5678818 and UK 890438[1]; (b) the Opponent's claimed reputation in UK 890438 for the purposes of Section 5(3); and (c) the Opponent's claimed goodwill in the UK in relation to the unregistered trade mark TROPICANA for the purposes of Section 5(4)(a). The

[1] All more than 5 years old at the application date of the mark in suit and so subject to the proof of use requirements in Section 6A of the Act.

Opponent also claimed that this evidence showed that the Opponent's TROPICANA marks were entitled to an enhanced level of distinctive character acquired through use.

8. The Applicant for its part filed evidence going to *inter alia* the history of the Applicant and the circumstances surrounding and the rationales for the Applicant's adoption of the mark in suit.

9. Neither party requested a hearing but both sides filed written submissions, and the Hearing Officer decided the opposition on the basis of the papers before him. Mr George W Salthouse, acting for the Registrar, issued his written decision under reference number BL O/068/19 on 31 January 2018.

The Hearing Officer's decision

10. The Hearing Officer did not decide the ground of opposition under Section 5(3).

11. Furthermore, he decided the objection under Section 5(2)(b) (in favour of the Opponent) on the basis of the Opponent's EU 12828901 only, which (unlike the Opponent's other earlier trade marks) was not subject to proof of use:

Mark	**Goods**
TROPICANA	Non-alcoholic drinks, namely, fruit drinks, fruit juices and fruit-based drinks; fruit drinks and fruit juices; syrups and other preparations based on fruit for making beverages; fruit smoothies

12. There his findings were in brief, first that the Applicant's: (a) *de-alcoholised drinks* and *non-alcoholic beers* were identical (or in the case of *de-alcoholised drinks* highly similar); and (b) *beers* and *shandy* were similar to a medium degree to the Opponent's *non-alcoholic drinks, namely, fruit drinks, fruit juices and fruit-based drinks*[2]. Second, the marks were similar to a low to medium degree. Third, the earlier trade mark was inherently distinctive at least to a medium degree and was entitled to an enhanced penumbra of protection by reason of distinctiveness acquired through use in the fruit juice market. Fourth, the average consumer was the general public who would pay an average degree of attention to the purchase act which would primarily be visual although aural considerations could play a part. Fifth, by reason of these interdependent factors and the principle of imperfect recollection, there was a risk of confusion globally assessed.

13. Under Section 5(4)(a), the Hearing Officer was satisfied that the Opponent had shown that it enjoyed considerable reputation and goodwill in the UK in the fruit juice and

[2] These findings were not clearly worded by the Hearing Officer (para. 24), but it appears that he may have missed the limitation "namely" in the Opponent's specification of EU 12828901. In the event this turned out to be immaterial to the appeal.

fruit juice based beverages market under and by reference to its mark TROPICANA and that use by the Applicant of the mark in suit in the UK in relation to the goods concerned would be liable to be prevented by the law of passing off.

14. The opposition therefore succeeded, and the Hearing Officer ordered the Applicant to pay to the Opponent costs in the sum of £1,800.

The appeal

15. On 28 February 2019, the Applicant filed Notice of appeal to the Appointed Person under Section 76 of the Act against the Hearing Officer's refusal of the application under Section 5(2)(b) and 5(4)(a) of the Act.

16. In the grounds of appeal it was alleged by the Applicant that the Hearing Officer was wrong as a matter of law or plainly wrong in finding that:

    1) the Applicant's goods (beers, shandy, de-alcoholised drinks, non-alcoholic beers) were similar to "the various non-alcoholic drinks in respect of which the earlier marks of the Opponent were registered";

    2) the marks were similar to a low to medium degree. Under this head the Applicant argued:

        (a) TROPICANA was of very low inherent distinctive character due to its ordinary meaning of "objects from the tropics, or things associated with or characteristic of tropical regions"), which the Hearing Officer failed to take into account;

        (b) The Hearing Officer erred in determining that TROPICANA was an independent and distinctive element in the Applicant's mark allegedly such that the relevant comparison was between the word TROPICANA and this element in the Applicant's mark;

        (c) The Hearing Officer's alternative comparison allegedly between CLWB TROPICANA in the Applicant's mark and the Opponent's earlier word marks for TROPICANA was also wrong;

        (d) The Hearing Officer wrongly excluded in his comparison: (i) the Applicant's Tiny Rebel name; and (ii) the various graphical elements in the Applicant's mark;

    3) there was a likelihood of confusion between the marks under Section 5(2)(b);

    4) by reason of the above errors, Section 5(4)(a) was made out.

17. There was no cross appeal and no Respondent's notice. Furthermore the Applicant's skeleton argument (confirmed at the oral hearing): (1) confined the Applicant's case to "beer" (i.e., the Applicant no longer pursued its appeal in relation to "shandy, de-alcoholised drinks, non-alcoholic beers" as listed in the Applicant's specification); and (2) proceeded on the basis that the relevant comparison was with the Opponent's

widest category of goods in Class 32, that is, "non-alcoholic drinks" in UK 890438 (despite the fact that the Hearing Officer's comparison under Section 5(2)(b) was on the basis of the more limited specification in EU 12828901).

18. I pause here additionally to note that there was no challenge by either party to: (a) the Hearing Officer's failure to decide the ground of objection under Section 5(3); and/or (b) the Hearing Officer's decision to determine the opposition under Section 5(2)(b) solely on the basis of the Opponent's EU 12828901[3].

Standard of review

19. It was accepted that the appeal is a review and that I should not interfere in the absence of error, which can include not only legal but also evaluative error in the application of a legal standard to the facts (*REEF Trade Mark* [2003] RPC 5, paras. 25 – 28, Robert Walker LJ, *Actavis Group PTC EHF v. ICOS Corporation* [2019] UKSC 15, paras. 78 – 81, Lord Hodge, *The Queen v. London Borough of Hackney* [2019] EWCA Civ 1099, paras. 63 – 67, Lewison LJ). Nevertheless,

> "It is not enough simply to demonstrate an error or flaw in reasoning. It must be such as to undermine the cogency of the conclusion. Accordingly, if there is no such error or flaw, the appeal court should not make its own assessment …" (*Hackney*, para. 66)

and

> "This evaluative process is often a matter of degree upon which different judges can legitimately differ and an appellate court ought not to interfere unless it is satisfied that the judge's conclusion is outside the bounds within which reasonable disagreement is possible …" (*Actavis*, para. 80).

Representation on appeal

20. The Applicant was represented by Mr Nick Zweck of Counsel instructed by Tennant IP. Mr Jeremy Pennant of D Young & Co LLP represented the Opponent.

Grounds of appeal

Comparison of goods

21. The first ground of appeal was that the Hearing Officer erred in his comparison of the goods.

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[3] I reminded the parties by reference to the observations of Mr Geoffrey Hobbs QC in *MUSLIM MATCH Trade Mark*, BL O/014/19, paragraph 21, that:

> "[A party] cannot expect or require this Tribunal to work through the papers and proceed as if it was working inquisitorially to decide the opposition *de novo* in relation to the [goods applied for]. The question for determination on this appeal is, in essence, whether it was open to the Hearing Officer, on the evidence and materials before [him], to conclude as [he] did for the reasons [he] gave that the [goods applied for] were … caught by the Opponent's objections to registration under ss. 5(2)(b) and [5(4)(a)] of the 1994 Act. The Grounds of Appeal define and limit the scope of the enquiry by identifying the particular matters which the Tribunal is called upon to consider in that connection".

22. As explained earlier, the Applicant chose only to pursue its appeal in relation to "beer".

23. Furthermore, the Applicant decided to contest the Hearing Officer's finding of a medium degree of similarity with the Applicant's beers on the basis of the Opponent's widest specification of goods relied on for "non-alcoholic drinks", which was in UK 890438. [On the other hand the Hearing Officer's comparison was between the Applicant's "beers" and the Opponent's "non-alcoholic drinks, namely, fruit drinks, fruit juices and fruit-based drinks; fruit drinks and fruit juices; syrups and other preparations based on fruit for making beverages; fruit smoothies" in EU 12828901, which was narrower due to the restrictive presence of the word "namely".]

24. On that case advanced by the Applicant before me, the Applicant's arguments were threefold:

    1) It was not the case that beer and non-alcoholic drinks shared the same purpose. Whilst both might be seen as thirst quenchers, the defining characteristic of beer was alcohol the function of which was to lower inhibitions. Beer and fruit juices were not substitutable items.

    2) Because of its alcoholic content, beer was heavily regulated. There were age restrictions and heavy taxes on its sale. That meant it was sold and consumed in a different way to non-alcoholic drinks and was significantly more expensive. It was not therefore "like for like".

    3) Although it was true that beers and non-alcoholic drinks were both sold in pubs, it was "obviously" not true that they were sold in the same way or were in competition.

25. My observations on the Applicant's arguments include the following (in no particular order):

    (1) the term "beers" in the Applicant's specification would include non-alcoholic beers, which meant that on the comparison case being put forward by the Applicant, identical goods were involved (Case T-133/05, *Gérard Meric v. EUIPO* [2006] ECR II-2737, para. 29);

    (2) it is established that in the context of beers and other mainly non-alcoholic drinks in Class 32, the presence or absence of alcohol is not a deciding factor. This is because of the availability of low alcohol and no alcohol beers and mixed beer drinks (Case T-99/01, *Mystery Drinks GmbH v. EUIPO* [2003] ECR II-0043 paras. 40 – 41, Case T-150/17, *Asolo LTD v. EUIPO*, EU:T:2018:641, paras. 14 and 61);

    (3) the Applicant appeared to accept that beer and non-alcoholic drinks had the same purpose of quenching thirst but added that they were different because beer was bought deliberately for its alcoholic effect of lowering inhibitions. That distinction, whilst it may true for some drinkers, falls away when low alcohol, low alcohol and mixed beer drinks in Class 32, which may be non-alcoholic, are considered;

(4) similar observations apply to the Applicant's arguments regarding regulation (*Mystery*, para. 41) but in any event, as the Opponent noted, the Applicant put forward no evidence as to the extent of any regulation and/or whether this might be a differentiating factor for the average consumer;

(5) the Applicant accepted that beers and non-alcoholic drinks were sold in common outlets, with the Applicant specifically mentioning pubs. The Applicant sought to draw a distinction on the basis that they were not sold together in the same way or are in competition with each other but failed to explain or explain convincingly why.

26. The Applicant further criticised the Hearing Officer for failing to give reasons for his finding of a medium degree of similarity to the Applicant's "beers". I accept that this part of the Hearing Officer's decision might have been better worded, Nevertheless, on my reading it seems to me clear that the Hearing Officer was applying the same reasoning that he had used in connection with the Applicant's "non-alcoholic beers", thus:

> "24. Whilst I note the comments of the Hearing Officer [in BL O/119/07 referred to the Hearing Officer by the Applicant] I am not bound by them. Nonetheless I note that he believes that non-alcoholic drinks must be considered to be identical to fruit juices; a view which I fully endorse. Equally to my mind, de-alcoholised drinks would also be identical or at least highly similar to non-alcoholic drinks, namely, fruit drinks, fruit juices and fruit-based drinks. The applicant contends that de-alcoholised drinks and non-alcoholic beers are sold in the same manner as beers and should be regarded as dissimilar to the opponent's goods. Whilst I accept that in a supermarket non-alcoholic beers are unlikely to be alongside fruit juices and fruit based drinks, this does not mean that the goods are not similar. Both are intended to slake one's thirst, both will be sold in pubs, clubs and restaurants as being ideal for a designated driver and so to my mind they are in direct competition with each other. It is not unusual, in my experience, [for] fruit based beverages to be sold in half pints and pints just as beer may be. Similar arguments can be made in relation to shandy and beer, other than these are not suitable for anyone considering driving. **In conclusion, in my opinion, "de-alcoholised drinks and non-alcoholic beers" are identical to the opponent's goods, whilst "Beers and shandy" are similar to the opponent's goods to a medium degree**."

27. Turning to the actual comparison before the Hearing Officer (beers/non-alcoholic drinks, namely, fruit drinks, fruit juices and fruit-based drinks) it seems to me that the Hearing Officer's observations were borne out by the evidence of both parties as to the modern prevalence of fruit beers, the evidence of the Opponent regarding the sale of beers and soft drinks including fruit juices in pubs/restaurants, and the Opponent's reliance on two decisions of the EUIPO Opposition Division[4] where beers on the one hand and fruit juices on the other hand were held to possess a certain degree of similarity. I would add that the Hearing Officer's reasoning was also supported by

[4] Decisions on Opposition B 1 429 390 and B 795 171 exhibited at TP13, 2nd Witness Statement of Janet Silverberg, 11 October 2018.

the CJEU decisions in *Mystery* and *Asolo*, WIPO guidance on Class 32[5], and EUIPO practice[6].

28. Although different minds might have arrived at differing *degrees* of similarity, I do not consider that the Hearing Officer's finding of a medium degree of similarity with the Applicant's "beers" was outside the bounds within which reasonable disagreement is possible, and indeed on the case advanced by the Applicant before me, applying the *Meric* principle, identicality would have been involved.

29. Whilst, therefore, it could have been better expressed, I do not accept that the Hearing Officer's comparison of goods was materially in error.

30. It is convenient at this point to mention that at the end of the hearing the Applicant offered to limit its specification of beers to exclude non-alcoholic beers. First, in my judgment, this offer of a fall-back position came at too late a stage in the proceedings. Second, in any event, I do think it would assist the Applicant since the certain degree of similarity found by the Hearing Officer to exist between beers and the Opponent's goods arose (backed by the evidence and authorities) irrespective of alcoholic content.

Comparison of marks

31. The second ground of appeal was that the Hearing Officer erred in his comparison of the marks and in his finding of a low to medium degree of similarity between them.

32. The Hearing Officer started by instructing himself on the importance of comparing the marks overall:

> "25) It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by them, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:
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> > ".....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion."
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> 26) It would be wrong, therefore, to artificially dissect the trade marks, although it is necessary to take into account their distinctive and dominant components and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by them …"

[5] https://www.wipo.int/classifications/nice/nclpub/en/fr/20170101/information_files/class/32/?lang=en
[6] http://euipo.europa.eu/sim/

33. He then went through the Applicant's arguments and concluded:

> "28) I do not agree that the word TROPICANA is of low distinctiveness, or that it has a true definition. The word does not appear in the Collins English dictionary and an online search also failed to find a dictionary reference. The applicant has not shown that its mark has been used extensively, it has not shown a UK market share for its goods under the mark in suit and the sales figures suggest that it is a relatively minor brand in a very large market. I also dismiss the idea that it is somehow part of a family of marks. The only similarity between the branding evidenced at exhibit BC3 is the figure of a bear in a coat and a "graffiti style". There is only evidence of use of one of these other marks, but again no market share. The applicant's mark is very "busy", with a blue and white "splash" background with gold lines across the top of the pink diamond, and a device of a pink cocktail glass tipping its contents. At the bottom is an image of a bear wearing a coat with a cross for its left eye and a form of patch for its right eye, in the style of an unloved teddy bear that has seen better days. At the top of the mark in small type in yellow are the words "Tiny Rebel", then underneath and in slightly larger font and in pink is the word "CLWB", then in much larger font is the word TROPICANA in yellow across the middle of the mark. Further down, in quite small print is the figure "5.5%" in yellow and the words "Tropical IPA" in gold in a font size similar to the words "Tiny Rebel".
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> 29) In my opinion, it is not clear how a consumer will view the word "CLWB", i.e. whether it will believe it is attached to the words "Tiny Rebel"- as in "Tiny Rebel CLWB"- or whether they will view each word separately. The "5.5%" will be seen for what it is, an indication of alcoholic strength, whilst the words "Tropical IPA" are descriptive of the product as IPA is a common abbreviation for India Pale Ale. It appears to me that there are several independent elements in the mark and the word TROPICANA is one of them. Given its size as the largest font, and its position across the middle of the mark, it is, to my mind, independent and distinctive of the other elements. Even if I were to accept that the average consumer would view the word "CLWB" as being its prefix, this simply means that the mark would be viewed as CLWB TROPICANA or TROPICANA CLUB if the Welsh word is recognised for what it is and the individual is aware that the Welsh language tends to alter the order of words so that "The Red House" becomes "Ty Coch" where "ty" is "house" and "coch" is "red". Whichever way it is seen the word TROPICANA is the dominant element. The applicant also contends that the mark will bring to mind a song from thirty five years ago, but I fail to see why the instant mark used on the goods in the application will bring about such an association, and the applicant has provided no evidence to show that the average consumer would view it as they contend. There are obvious visual, aural and conceptual similarities and differences. Taken overall, in my opinion, the marks have a low to medium degree of similarity."

34. The Applicant contended that the Hearing Officer was wrong to regard the word TROPICANA as playing an independent distinctive role within the Applicant's mark. Moreover, he was wrong to find that if, as argued by the Applicant, the Applicant's mark was viewed by the average consumer as CLWB TROPICANA or TROPICANA

CLUB then whichever way that was seen, TROPICANA would be the dominant element.

35. The Applicant's arguments in this regard appeared to have several strands.

36. First, it was argued that the Hearing Officer was wrong not to have found that the word TROPICANA was descriptive and non-distinctive. The Applicant had included in its written submissions a definition of "tropicana" from the Oxford dictionaries online as: "Things associated with or characteristic of tropical regions; objects of the tropics" (said to have originated in the 1930's). At the hearing before me the Applicant produced a hard copy of the same definition from the Shorter Oxford English Dictionary, 6th Edition, which the Opponent did not object to although introduced for the first time on appeal. The Hearing Officer said that he could find no such definition in the Collins English Dictionary or from his own online searches and did not therefore accept that the word had a true definition. Whatever the Hearing Officer meant by the latter I accept that the word "tropicana" has the definition as stated in the Oxford dictionaries. However, the fact that a word appears in a dictionary does not mean that it is non-distinctive for the goods in question. Whilst in my judgment TROPICANA may be allusive for the goods in question, I do not accept that this element would be viewed as descriptive in the Applicant's mark whether of geographical origin or otherwise.

37. Moreover, it seems to me that the Applicant's argument overlooked or ignored first, the finding by the Hearing Officer that TROPICANA was entitled to enhanced distinctiveness through use in relation to the Opponent's fruit juices and fruit drinks, which finding was not appealed. Second, it is trite law that weak distinctiveness does not necessarily prevent an element being regarded as dominant in a composite mark (see, e.g., recently Case C-705/17, *Patent- och registreringsverket v. Mats Hansson* EU:C:2019:481, paras. 41 – 55).

38. Second, the Applicant argued that the words CLWB and TROPICANA in the Applicant's mark needed to be viewed together (as I understood it, in the sense that CLWB qualified TROPICANA).

39. The Hearing Officer dealt with this but reasonably in my view still regarded the TROPICANA element (because of its size and position, see above) as dominant.

40. The Applicant argued that this created a conceptual difference which was sufficient to distinguish the marks. The conceptual difference was that the average consumer would understand the mark as a reference to the apparently well-known Wham! song – "Club Tropicana". The Hearing Officer did not accept that the average consumer would form this association in the context of the goods applied for with a song from over 30 years ago. Mr Zweck referred me to the Witness Statement of Bradley Cummings, founder and managing director of the Applicant, dated 28 August 2018, at Exhibit BC9, which included two third party comments on Facebook referring to a line in the Wham! song – "… drinks are free …". Mr Zweck also directed me to Exhibit BC10 that contained print outs from Twitter announcing the UK Craft Beer Name World Cup Winner – HOW DIPA'S YOUR LOVE? – which Mr Zweck said showed that craft beers were often named after songs.

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41. Whilst I am prepared to accept that some members of the average consumer for beers might associate CLWB TROPICANA with the Wham! song, there will undoubtedly in my judgment be some who do not (and the evidence of the Applicant did not persuade me otherwise). It is not necessary to show under Section 5(2)(b) that all members of the average consumer will be confused, a significant proportion suffices (*Gap (ITM) Inc. v. GAP 360 Ltd* [2019] EWHC 1161 (Ch), Henry Carr J, paras. 53 – 57).

42. Mr Zweck referred me to Case C-254/09 P, *Calvin Klein Trademark Trust v. OHIM* [2010] ECR I-7989 at paragraph 56[7] in support of his argument that it is not permissible to compare marks based only on a common component (dominant or otherwise) unless all the other elements of a complex mark are negligible. I accept the correctness of that proposition (see more recently, e.g., Case T-28/18, *Marriott Worldwide Corp. v. EUIPO* EU:T:2019:436, para. 29).

43. However, I do not accept that the Hearing Officer based his comparison of the marks solely on the TROPICANA or indeed CLWB TROPICANA elements. To the contrary, the Hearing Officer identified that the Applicant's mark was "very busy" comprising several independent elements – which he listed – including the word TROPICANA (Decision, para. 29, see para. 33 above). The Hearing Officer did not make any finding/suggestion of negligibility with regard to any element in the Applicant's mark. The crux of his finding was that TROPICANA played an independent and distinctive role within the mark (and/or if perceived with CLWB, a dominant role within that combination) along with the other elements in the mark. Following on from this, I do not accept, therefore, the Applicant's further argument that the Hearing Officer failed to take into account the "Tiny Rebel" or other elements in the Applicant's mark.

44. The Hearing Officer determined that there was a low to medium degree of similarity in the marks, the converse of which is that he took into account the different elements. He expressly said that there were obvious visual, aural and conceptual differences in the marks (Decision, para. 29, see para. 33 above) confirming in my view that he compared the marks overall.

45. There are criticisms that can be levelled at the Hearing Officer's decision like his apparent failure to accept the Oxford dictionary definition of "tropicana" and/or that any member of the relevant public would recognise the association of CLWB TROPICANA with Wham! but in my judgment these were immaterial to the outcome. The Hearing Officer's finding of a low to medium degree of similarity in

[7] "… the existence of a similarity between two marks does not presuppose that their common component forms the dominant element within the overall impression created by the mark applied for. According to established case-law, in order to assess the similarity of two marks, it is necessary to consider each of the marks as a whole, although that does not rule out the possibility that the overall impression created in the mind of the relevant public by a complex trade mark may, in certain circumstances, be dominated by one or more of its components. However, it is only if all the other components of the mark are negligible that the assessment of the similarity can be carried out solely on the basis of the dominant element (see *OHIM v Shaker*, paragraphs 41 and 42; the judgment of 20 September 2007 in Case C-193/06 P *Nestlé v OHIM*, paragraphs 42 and 43; and *Aceites del Sur-Coosur v Koipe*, paragraph 62). In that connection, it is sufficient for the common component not to be negligible."

the marks was in my view one that he was entitled in the circumstances reasonably to make.

46. Looking at it from a different perspective: if, as the Applicant argued, the Hearing Officer had compared only the TROPICANA elements in the marks then the resulting degree of similarity should have been high. The Applicant's explanation that the Hearing Officer's finding of a low to medium similarity between the marks constituted a strange part of the decision was unconvincing. It showed by contrast that the Hearing Officer properly viewed the marks overall and identified and took into account the differences in the marks in the perceptions of the average consumer.

Section 5(4)(a)

47. The Applicant did not dispute the Hearing Officer's conclusion that the Opponent enjoyed substantial reputation and goodwill in the UK for its TROPICANA fruit juices and fruit drinks. However, the Applicant challenged the Hearing Officer's findings in relation to misrepresentation and damage. Since those criticisms were said by the Applicant to be based on the same arguments that the Applicant had made in relation to the comparisons of goods and marks under Section 5(2)(b) that I have rejected, I can see nothing further to say on this ground which also fails.

Conclusion and costs

48. In the result the appeal has failed. The Hearing Officer ordered the Applicant to pay the Opponent costs in the sum of £1,800. I will order the Applicant to pay the Opponent a further sum of £1,000 as a contribution towards the Opponent's costs of this appeal; the total sum of £2,800 to be paid by the Applicant to the Opponent within 28 days of the date of this decision.

Professor Ruth Annand, 16 August 2019

Mr Nick Zweck of Counsel instructed by Tennant IP appeared for the Applicant/Appellant

Mr Jeremy Pennant of D Young & Co LLP appeared for the Opponent/Respondent