O/0190/24

TRADE MARKS ACT 1994
CONSOLIDATED PROCEEDINGS

IN THE MATTER OF TRADE MARK APPLICATION NOS. 3621905 AND 3621884 IN THE NAME OF COPAL TREE BRANDS, INC. FOR THE TRADE MARKS

COPALLI

IN CLASS 33

AND

COPAL TREE

IN CLASSES 30, 33, 40 AND 43

AND THE OPPOSITIONS THERETO UNDER NOS. 426754 AND 426760 BY SUMOL + COMPAL MARCAS, S.A.

AND

IN THE MATTER OF TRADE MARK REGISTRATION NO. 810701103 AND INTERNATIONAL TRADE MARK REGISTRATION NO. 701103
IN THE NAME OF SUMOL + COMPAL MARCAS, S.A. , BOTH FOR THE TRADE MARK

COMPAL

IN CLASSES 29, 30 AND 32

AND THE APPLICATIONS FOR REVOCATION ON THE GROUNDS OF NON-USE UNDER NOS. 505064 AND 505065 BY COPAL TREE BRANDS, INC.

Background and pleadings

1. On 6 April 2021, Copal Tree Brands, Inc. ("Copal") filed applications for the trade marks COPALLI and COPAL TREE, numbers 3621905 and 3621884, respectively. COPALLI covers goods in class 33, and COPAL TREE covers goods and services in classes 30, 33, 40 and 43. The trade marks were filed pursuant to Article 59 of the Withdrawal Agreement between the UK and the EU, retaining their original EU filing dates of 13 September 2018 and claiming priority dates from the US of 26 June 2018. The trade marks were published for opposition purposes on 11 June 2021. COPALLI was opposed in full and COPAL TREE was opposed in classes 30, 33 and 43 by Sumol + Compal Marcas, S.A. ("Sumol"), under sections 5(2)(b) and 5(3) of the Trade Marks Act ("the Act").[1]

2. For the opposition against COPALLI, Sumol relies on the following two marks, for both grounds of opposition:

(i) 810701103

COMPAL

Relying on Class 29 *preserved, dried and cooked fruits and vegetables*, and Class 30 *non-alcoholic beverages; fruit drinks and fruit juices*.

Filing date: 23 July 2010; registration date 2 February 2012.

(ii) International registration 701103

COMPAL

[1] There is no opposition against the class 40 services, despite Copal's written submissions in lieu of a hearing having included arguments about the lack of similarity between its class 40 services and the goods relied upon by Sumol.

Relying on the same goods as for earlier mark (i).

International registration date and designation date in the UK: 16 October 1998, claiming priority from Portugal from 25 May 1998; date of protection in the UK: 16 March 2000.

3. Sumol claims that the parties' marks, goods and services are similar leading to a likelihood of confusion under section 5(2)(b). It also claims, under section 5(3), the following:

> "The Opponent has a substantial reputation in relation to the goods listed at Q1. in the Earlier Mark and has been using its trade mark in the EU/UK since 2013. The Opponent has customers all over the EU/UK. The Application is for a similar mark and has been filed for similar goods. In light of this, the average consumer is likely to think that the goods emanate from the Opponent or are provided with its consent. This will confer an unfair advantage on the Applicant. The Applicant's use of COPALLI [and COPAL TREE] will lessen the attractiveness and strength of the Opponent's Mark as an indicator of origin. Any use of COPALLI [and COPAL TREE] by the Applicant in relation to the goods listed in Q2. would risk significant confusion and would lower the distinctiveness of the COMPAL Mark for it has been acquired by the Opponent over a significant period of time and the Opponent has vigilantly protected its exclusivity in the COMPAL mark."

4. This was in answer to Q.3 of the section 5(3) pleadings on its forms TM7, which asks:

> "Is it claimed that the similarity between the reputed earlier trade mark and the later trade mark is such that the relevant public will believe that they are used by the same undertaking or think that there is an economic connection between the users of the trade marks?"

5. There are no pleadings under section 5(3) which are not predicated on confusion arising.

6. Copal filed defences and counterstatements on 29 December 2021, denying the grounds of opposition and putting Sumol to proof of use and reputation of its earlier marks. On 29 June 2022, Copal filed applications to revoke Sumol's earlier marks on the grounds that no genuine use of them had been made in relation to the registered goods during the following five-year periods:[2]

Earlier mark (i)

- 3 February 2012 to 2 February 2017, with an effective revocation date of 3 February 2017 under section 46(1)(a) of the Act;
- 29 June 2017 to 28 June 2022, with an effective revocation date of 29 June 2022 under section 46(1)(b);
- 3 February 2017 to 2 February 2022, with an effective revocation date of 3 February 2022 under section 46(1)(b).

Earlier mark (ii)

- 17 March 2000 to 16 March 2005, with an effective revocation date of 17 March 2005 under section 46(1)(a) of the Act;
- 29 June 2007 to 28 June 2012, with an effective revocation date of 29 June 2012 under section 46(1)(b);
- 29 June 2017 to 28 June 2022, with an effective revocation date of 29 June 2022.

7. The non-use claims are against all of Sumol's registered goods, which is a wider list than the goods relied upon for the oppositions. Sumol filed defences and counterstatements, denying the allegations and stating that the earlier marks had been put to genuine use in all the claimed periods of non-use for all goods. At this point, the proceedings were consolidated.

[2] The boxes on the forms for Copal to state when it notified Sumol that it would seek revocation have been left blank.

8. Sumol is represented by Withers & Rogers LLP and Copal by Stobbs. Both parties filed evidence. Neither party requested a hearing and both parties filed written submissions in lieu of a hearing. I make this decision after a careful consideration of all the papers on file, referring to the evidence and submissions as relevant and/or necessary. In particular, I note that Copal's submissions run to 37 pages and give a forensic analysis of all of Sumol's evidence. I have borne all of these submissions in mind.

Relevant dates for proof of use of the earlier registrations in the oppositions

9. I have already set out the dates for which genuine use must be shown in relation to the applications to revoke Sumol's earlier marks. In relation to the oppositions, the five year period for which genuine use must be shown of the earlier marks is 27 June 2013 to 26 June 2018.

The revocation applications

10. I will begin by assessing the applications for non-use in case the outcome has a direct impact upon the oppositions. The relevant parts of Section 46 of the Act state:

> "46. - (1) The registration of a trade mark may be revoked on any of the following grounds—
>
> (a) that within the period of five years following the date of completion of the registration procedure it has not been put to genuine use in the United Kingdom, by the proprietor or with his consent, in relation to the goods or services for which it is registered, and there are no proper reasons for non-use;
>
> (b) that such use has been suspended for an uninterrupted period of five years, and there are no proper reasons for non-use;
>
> (c) […]

(d) […]

(2) For the purpose of subsection (1) use of a trade mark includes use in a form (the "variant form") differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(3) The registration of a trade mark shall not be revoked on the ground mentioned in subsection (1)(a) or (b) if such use as is referred to in that paragraph is commenced or resumed after the expiry of the five year period and before the application for revocation is made:

Provided that, any such commencement or resumption of use after the expiry of the five year period but within the period of three months before the making of the application shall be disregarded unless preparations for the commencement or resumption began before the proprietor became aware that the application might be made.

(4) […]

(5) Where grounds for revocation exist in respect of only some of the goods or services for which the trade mark is registered, revocation shall relate to those goods or services only.

(6) Where the registration of a trade mark is revoked to any extent, the rights of the proprietor shall be deemed to have ceased to that extent as from—

(a) the date of the application for revocation, or

(b) if the registrar or court is satisfied that the grounds for revocation existing at an earlier date, that date".

11. Following the end of the transition period of the UK's withdrawal from the EU, all international (EU) trade mark designations registered before 1 January 2021 were recorded as comparable trade marks in the UK trade mark register (and as a consequence, have the same legal status as if they had been applied for and registered under UK law). A 'comparable trade mark (IR)' retains the same designation date (filing date), priority date (if applicable) and registration date of the international (EU) trade mark designation. Earlier mark (i) is a 'comparable mark'. Use made of this mark in the EU prior to and including 31 December 2020 is potentially relevant.[3]

12. In *easyGroup Ltd v Nuclei Ltd & Ors* [2023] EWCA Civ 1247, Arnold LJ summarised the law relating to genuine use as follows:

> "105. The principles applicable to determining whether there has been genuine use of a trade mark have been considered by the CJEU in a considerable number of cases, the principal decisions being Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159, Case C-416/04 P *Sunrider Corp* v *Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bundervsvereinigung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], Case C-141/13 *P Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089], Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434] and Joined Cases C–720/18 and C–721/18 *Ferrari SpA v DU* [EU:C:2020:854].

[3] The Trade Marks (Amendment etc.) (EU Exit) Regulations 2019; also see Tribunal Practice Notice 2/2020.

106. Ignoring issues which do not arise in the present case, such as use in relation to spare parts or second-hand goods and use in relation to a sub-category of goods or services, the principles may be summarised as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29]; *Ferrari* at [32].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29]; *Gözze* at [37], [40]; *Ferrari* at [32].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56]; *Ferrari* at [33].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32]."[4]

13. The specifications under attack for non-use are:

[4] The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

Class 29: Meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs, milk and milk products; edible oils and fats.

Class 30: Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery, edible ice; honey, treacle; yeast, baking powder; salt, mustard; vinegar, sauces (condiments); spices; ice for refreshment.

Class 32: Beer; non-alcoholic beverages; fruit drinks and fruit juices; syrups and other preparations for making beverages.

14. The international registration (earlier mark (ii)) is recorded on the register of the World Intellectual Property Organisation as being registered in standard characters, as a word mark. Where it is necessary to do so, I will differentiate between the earlier marks, otherwise I will refer to them in the singular because the marks themselves are the same.

15. Sumol bears the burden of proving that its registrations have been put to genuine use in both the revocation and the opposition proceedings because Section 100 of the Act states:

"If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it."

16. Sumol's evidence comes from Luis da Costa Magalhães, one of Sumol's board members.[5] Some of the evidence is the subject of a confidentiality order made by this Tribunal during the present proceedings. Mr Magalhães' first witness statement was filed in the opposition proceedings, prior to the revocation proceedings. That witness statement goes to the goods relied upon for the earlier registrations for the proof of

[5] First witness statement dated 11 April 2022 and exhibits; second witness statement dated 3 February 2023 and exhibits.

use period of 27 June 2013 to 26 June 2018 and adduces exhibits LFCM 1 to LFCM10. The second witness statement, adducing exhibits LFCM11 to 17, was filed to meet the revocation attacks and Mr Magalhães states that the evidence in his second statement primarily focuses on the period of June 2017 to June 2022. I note that, in paragraph 8 of the second statement, Mr Magalhães states:

> "I confirm that the Registered Mark has been used in the UK and EU in connection with the following ("the COMPAL Goods"):
>
> Class 29 Preserved and cooked fruits and vegetables
>
> Class 32 Non-alcoholic beverages; fruit drinks and fruit juices."

17. I note that there is no reference to dried fruits and vegetables, whereas there is in Mr Magalhães' first witness statement.

18. Mr Magalhães' statement above lists a narrower set of goods than that which is registered and attacked by Copal. Although the defences and counterstatements from Sumol defended all the registered goods of the earlier registrations, Mr Magalhães has made a clear statement in paragraph 8 of his second witness statement that the mark has been used only in relation to the goods identified in that paragraph. This means that the two earlier registrations are revoked for all other goods. In any event, I can see from the evidence that there is no use in relation to the other registered goods. Accordingly, earlier mark (i) is revoked from 3 February 2017 and earlier mark (ii) from 17 March 2005, both in respect of:

> Class 29: Meat, fish, poultry and game; meat extracts; jellies, jams, compotes; eggs, milk and milk products; edible oils and fats.
>
> Class 30: Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery, edible ice; honey, treacle; yeast, baking powder; salt, mustard; vinegar, sauces (condiments); spices; ice for refreshment.

Class 32: Beer; syrups and other preparations for making beverages.

19. Mr Magalhães states that the earlier mark (he uses the singular noun) has been used in relation to Sumol's range of fruit and nectar juices, preserved and cooked vegetables and tomato derivatives since 1952, with products exported to the UK since at least 1989. Exhibit LFCM02 comprises pages taken from a brochure dated 16 July 2018, duplicated in Exhibit LFCM12, showing a composite version of the mark on cartons of fruit juice, tomato puree and tinned vegetables, such as:

20. Mr Magalhães gives unit sales figures (in litres) and sales value figures for the opponent's sales in both Portugal and the UK from 2009 to 2022. These are subject to a confidentiality order, which means the next part of this paragraph is redacted from the public version of this decision. [Redacted]

21. Mr Magalhães states that Sumol sells its goods to UK-based companies which then act as distributors and/or retailers. A selection of invoices to UK-based companies is provided at Exhibits LFCM03 and LFCM13, with each invoice listing the items, which include COMPAL followed by the goods, such as 'Multi Fruits', "Polpa Tomate", "White Beans", "Red Beans" and "Black Beans". The invoices are in Portuguese and whilst I can see some obvious descriptions, there are some words with which I am unfamiliar, such as "Feijão and "Grão". However, these words are shown on the labels of cans in the 2018 brochures, which are beans and chickpeas (respectively). The invoices are dated 21 January 2016, 16 February 2017, 28 February 2017, 7 July 2017, 15 December 2017, 24 January 2018, 30 June 2018, 29 November 2018, 31 December 2018, 15 February 2019, 11 March 2019, 19 July 2019, 31 July 2019, 26 August 2019, 6 March 2020, 30 April 2020, 29 May 2020, 17 June 2020, 31 July 2020, 28 May 2021, 18 August 2021, 24 August 2021, 16 September 2021, 20 October 2021 and 28 October 2021.

22. Exhibit LFCM04 comprises twelve photographs which Mr Magalhães states are photographs of Sumol's products on display in the UK, for sale. I can see UK pricing but there are no dates for any of the photographs. The same photographs are shown in Exhibit LFCM14. Exhibit LFCM05 also contains undated material, duplicated in Exhibit LFCM15. These exhibits are said to comprise screen shots taken from UK websites on which Sumol's goods are advertised for sale. I can see that one of them (page 5) has a copyright date of 2019. On that page, all the wording is Portuguese, but the pricing of the carton of juice is in pounds sterling. The mark appears as follows:

23. I note that Sumol's company report at Exhibit LFMC01, duplicated at Exhibit LFCM11, says that the COMPAL brand was re-launched in 2019:

24. Another screen shot, on page 6 of Exhibit LFCM05, has a copyright date of 2022 and the wording and pricing is in English, for a bottle of "Pineapple Compal". The mark shown on the bottle label is the same as for page 5. A third example, on page 7, is from an English language website called PORTUGALIA, for "Compal 100% Orange 200ml", showing the re-launched composite mark on the bottle. The copyright date is too small to make out.

25. Mr Magalhães provides advertising expenditure figures for Portugal and the UK from 2013 to 2022, which are the subject of a confidentiality order. Hence, the next sentence is redacted from the public version of this decision. [Redacted] The explanation for the substantially lower figures for the UK compared to Portugal is that in the UK it is retailers and distributors who advertise the goods. Exhibit LFCM06 comprises photographs of advertising and point of sale locations, which all look to be non-UK. Only one is dated, from 16 October 2008, when the mark appears in the following forms:

26. These would seem to be earlier uses of the mark because the word and leafy device is what is used in the 2018 brochure and the website screenshots in Exhibit LFCM05, which also include the re-launched version.

27. Exhibit LFCM16 contains the same photographs, plus additional photographs not shown in Exhibit LFCM06. In the later exhibit, the photographs are grouped into those from Portugal and those from the UK. In Exhibit LFCM16, all the photographs in Exhibit LFCM06 are identified as being from Portugal but, apart from the photograph dated 16 October 2008, none are dated (in either exhibit). The UK photographs have dates and locations, e.g. showing fruit drinks in Atlantico Stores in 2015, Portugalia Wines Stores in 2016, a food show called Food Matters Live in 2017, 'other' UK stores in 2013, and in Morrisons in 2017 on a 'specials' display of Portuguese foods. Tins of beans are shown in Tesco in 2017 and 2020. The 2013 photographs ('other' UK stores) show the older mark with the oval border, whilst the photographs from named stores show it with the leafy device and the re-launched tree device version.

28. At Exhibit LFCM07, Mr Magalhães provides copies of pages from decisions by the Portuguese Supreme Court of Justice (from 2003) and the European Union Intellectual Property Office (from 2020), both of which state that the mark had acquired a reputation for fruit drinks and fruit juices.[6] I am not bound by either of these decisions

[6] The pages from the Portuguese Supreme Court of Justice are translated, Exhibit MWSS02 to the witness statement dated 6 May 2022 of Marta Weinstein Saluce de Sampaio, who is fluent in Portuguese and English and is a legal practitioner at a Portuguese law firm.

and they carry little weight as evidence because (i) they are from other jurisdictions, and (ii):

> "… the opinion of another tribunal on a factual issue is not admissible evidence to support a finding of fact or evaluative finding in these proceedings. This is by reason of the rule from *Hollington v Hewthorn* [1943] KB 587 (also see *BANDIT* (O/197/23), [13] to [18])."[7]

29. As of 5 April 2022, Sumol's dedicated COMPAL social media sites had had nearly half a million 'likes' on Facebook, over 35,000 followers on Instagram and over 29 million views on YouTube. Exhibit LFCM09 comprises details of three awards which Sumol has won for its goods sold under the earlier marks. The first of these dates from March 2007, being the 2007 Global Beverage Innovation Awards in Madrid, for fruit drinks. The second dates from 2010, when Compal Vital Blackberry Red-Tea won the non-alcoholic drinks category in the Masters of Distribution awards. It appears the award was either Spanish or Portuguese. The third award was in the UK, in 2021: the Degusta Box Awards.[8] The details show that subscribers to the Degusta box provided over 2.3 million ratings for the products received in their boxes. The second highest rating was:

2. Compal - Orange Algarve

In the Algarve we found the perfect balance between the hours of sunshine and the quality of the land for the sweetest and juiciest oranges. An unmistakable taste of the Algarve's Orange made only with freshly squeezed fruit. Compal, Expert in Fruitology.

30. In 2007, the Portuguese government recognised and certified COMPAL as a brand which had obtained international success and had enhanced the reputation of Portugal, although the territories in which COMPAL was sold are not identified.[9] Exhibit LFCM09 comprises material which Mr Magalhães states shows that the

[7] Paragraph 28 of *Ardutch BV v Ontel Products Corporation* BL O/0067/24, Phillip Jonson, sitting as the Appointed Person.
[8] Details of this award are duplicated at Exhibit LFCM17.
[9] Exhibit LFCM10.

COMPAL brand has been recognised as being well-known and holding a strong reputation via independent third party studies. For instance, in 2017 a Portuguese report said that, in Portugal, COMPAL was ranked as the fourth most popular brand; in 2019, another put it in the top 10 in Portugal (the composite version with the leafy device); in 2019, it was in the Portuguese top three alongside Nivea and Google.

40. The registered mark is COMPAL. It appears like this on the invoices. The other forms of use are:

(with the leafy device)

(with the tree-like device, re-launched in 2019)

(the oval device, pre-2015)

41. In the oval device form, and the two forms shown below it, Compal appears in a horizontal straight line. In the later versions, with the leafy device and the tree-like device, it appears in a horizontal, slightly arched form. In all versions, the word COMPAL is intact and has no extra or removed letters or stylisation. In the earlier forms of use, the use with a capital C and lower case 'ompal' is covered by registration of COMPAL in block capitals. The slightly arched form of COMPAL does not alter the distinctive character of COMPAL in word-only form. The colour of the word does not make a difference because registration in black in word-only form covers use in colour. The question is, therefore, does the additional matter present in all the forms of use mean that they are not acceptable variants of the registered form COMPAL? In *Colloseum Holdings AG v Levi Strauss & Co.,* Case C-12/12, which concerned the use of one mark with, or as part of, another mark, the Court of Justice of the European Union ("CJEU") found that (emphasis added):[10]

> "31. It is true that the 'use' through which a sign acquires a distinctive character under Article 7(3) of Regulation No 40/94 relates to the period before its registration as a trade mark, whereas 'genuine use', within the meaning of Article 15(1) of that regulation, relates to a five-year period following registration and, accordingly, 'use' within the meaning of Article 7(3) for the purpose of registration may not be relied on as such to establish 'use' within the meaning of Article 15(1) for the purpose of preserving the rights of the proprietor of the registered trade mark.
>
> 32. Nevertheless, as is apparent from paragraphs 27 to 30 of the judgment in *Nestlé*, the 'use' of a mark, in its literal sense, generally encompasses both its independent use and its use as part of another mark taken as a whole or in conjunction with that other mark.
>
> 33. As the German and United Kingdom Governments pointed out at the hearing before the Court, the criterion of use, which continues to be fundamental, cannot be assessed in the light of different considerations according to whether the issue to be decided is whether use is capable of giving rise to rights relating to a mark or of ensuring that such rights are preserved. If it is possible to acquire trade

[10] Case C-12/12

mark protection for a sign through a specific use made of the sign, that same form of use must also be capable of ensuring that such protection is preserved.

34. Therefore, the requirements that apply to verification of the genuine use of a mark, within the meaning of Article 15(1) of Regulation No 40/94, are analogous to those concerning the acquisition by a sign of distinctive character through use for the purpose of its registration, within the meaning of Article 7(3) of the regulation.

35 Nevertheless, as pointed out by the German Government, the United Kingdom Government and the European Commission, a registered trade mark that is used only as part of a composite mark or in conjunction with another mark must continue to be perceived as indicative of the origin of the product at issue for that use to be covered by the term 'genuine use' within the meaning of Article 15(1)." (emphasis added)

42. Apart from the slightly arched form of COMPAL, which does not alter its distinctive character, the word itself is unchanged in any of the variations in use. It is the distinctive part of all the variations and will continue to be perceived by consumers as indicative of the trade origin of the goods. If I am wrong about that, I approach the matter following the guidance set out *Lactalis McLelland Limited v Arla Foods AMBA* (emphasis added):[11]

"13. […] While the law has developed since *Nirvana* [BL O/262/06], the recent case law still requires a comparison of the marks to identify elements of the mark added (or subtracted) which have led to the alteration of the mark (that is, the differences) (see for instance, T-598/18 *Grupo Textil Brownie v EU*IPO*, EU:T:2020:22, [63 and 64]).

14. The courts, and particularly the General Court, have developed certain principles which apply to assess whether a mark is an acceptable variant and the following appear relevant to this case.

[11] BL O/265/22, Phillip Johnson, sitting as the Appointed Person.

15. First, when comparing the alterations between the mark as registered and used it is clear that the alteration or omission of a non-distinctive element does not alter the distinctive character of the mark as a whole: T-146/15 *Hypen v EUIPO*, EU:T:2016:469, [30]. Secondly, where a mark contains words and a figurative element the word element will usually be more distinctive: T-171/17 *M & K v EUIPO*, EU:T:2018:683, [41]. This suggests that changes in figurative elements are usually less likely to change the distinctive character than those related to the word elements.

16. Thirdly, where a trade mark comprises two (or more) distinctive elements (eg a house mark and a sub-brand) it is not sufficient to prove use of only one of those distinctive elements: T-297/20 *Fashioneast v AM.VI. Srl*, EU:T:2021:432, [40] (I note that this case is only persuasive, but I see no reason to disagree with it). Fourthly, the addition of descriptive or suggestive words (or it is suppose figurative elements) is unlikely to change the distinctive character of the mark: compare, T-258/13 *Artkis*, EU:T:2015:207, [27] (ARKTIS registered and use of ARKTIS LINE sufficient) and T-209/09 *Alder*, EU:T:2011:169, [58] (HALDER registered and use of HALDER I, HALDER II etc sufficient) with R 89/2000-1 CAPTAIN (23 April 2001) (CAPTAIN registered and use of CAPTAIN BIRDS EYE insufficient).

17. It is also worth highlighting the recent case of T-615/20 *Mood Media v EUIPO*, EU:T:2022:109 where the General Court was considering whether the use of various marks amounted to the use of the registered mark MOOD MEDIA. It took the view that the omission of the word “MEDIA” would affect the distinctive character of the mark (see [61 and 62]) because MOOD and MEDIA were in combination weakly distinctive, and the word MOOD alone was less distinctive still.”

43. Accordingly, I consider the use of COMPAL in all its forms to be acceptable variants under section 46(2) of the Act because:

(i) COMPAL is the standout distinctive element of the signs and is in a normal font covered by the registration; and

(ii) the ovals and leaves, and tree-like device are relatively low in distinctive character and the addition of such figurative elements does not detract from the perception that COMPAL is indicative of trade origin.

44. Copal's written submissions in lieu of a hearing analyse Sumol's evidence at a granular level. For instance, it submits that the photograph of the 'specials' display in Morrisons' supermarket in 2017 will only appeal to Portuguese consumers in the UK, and not the average UK consumer. I do not agree with this submission because UK consumers in a supermarket such as Morrisons will be interested in all sorts of goods from various countries. I remind myself that an assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole, not whether each piece of evidence shows use by itself.[12] It may be the case that exhibits support each other. In the present case, there are several years' worth of UK turnover figures provided and a large number of invoices to customers in the UK. I disagree with Copal that because only a selection of invoices has been provided that this means that the sales figures are uncorroborated. It would be surprising if parties before this Tribunal were required to submit invoices for each and every sale made, even if that ran to huge figures. Importantly, Copal is inviting me to disbelieve Sumol's evidence at the conclusion of the proceedings, without having raised the issue earlier during the evidence rounds, or requesting cross-examination of Mr Magalhães.[13]

45. This is also a feature of Copal's submissions about the invoices. Copal submits that Exhibit LFCM03 includes two invoices to addresses in Jersey, which is not part of the UK. The invoices have been redacted following a refusal to allow confidentiality for that exhibit in its complete form. The original exhibit was not admitted to the proceedings, but Copal had seen a copy of it, so I presume that is how Copal knows that two invoices were sent to addresses in Jersey. Copal submits that this undermines the credibility of the UK sales figures because they could include sales made to Jersey. Again, this should have been raised earlier, not by asking me to

[12] *New Yorker SHK Jeans GmbH & Co. KG v OHIM*, General Court of the European Union, Case T-415/09.
[13] See Tribunal Practice Notice 5/2007 "Procedure for parties to challenge evidence filed in inter partes trade mark disputes" and the comments of Ms Anna Carboni, sitting as the Appointed Person, in *G&D Restaurant Associates Limited v Pasticceria E Confetteria Sant Ambroeus S.R.L.* BL O/371/09.

disbelieve the evidence at the end of the proceedings. In any event, the point is not a good one. It is unreasonable to conclude that the UK sales figures are substantially diminished because they might include some sales made to Jersey. It is not likely that such a scale of figures is largely accounted for by sales made to Jersey.

46. Copal has filed evidence about the size of the UK market for fruit juice and nectar. Natalie O'Shea, an attorney at Copal's firm of representatives, adduces at Exhibit NO1 printouts taken from the AIJN Liquid Fruit Market Report with data from GlobalData, which she states is the leading independent beverage industry information specialist.[14] Ms O'Shea states that the printouts show that the total volume of fruit juice and nectars sold in the EU each year between 2014 and 2018 was in excess of 9 billion litres. The UK accounted for about a billion litres per year. Copal filed another witness statement along the same lines from Tanja Hofer, also a trade mark attorney with Copal's firm of representatives.[15] Exhibit TH1 comprises two extracts from statistica.com which Ms Hofer states is an online platform specialising in market and consumer data which offers statistics and reports. She states that the extracts give details of the value of the fruit juice market in the UK from 2013 to 2021 (in 2021, it was valued at over £1.8 billion) and the total consumption of juice and nectars in the UK from 2007 to 2021 (over 1 billion per year). Copal submits that Sumol's sales figures for the contested registrations are "very minimal" and that "there is a real doubt that the use of the Contested Registrations amount [sic] to more than just "token use", given the market in which the Opponent operates is a massive consumer market."

47. In assessing whether genuine use has been made of the earlier mark, I am not making a judgment about the commercial success of the mark in relation to the goods for which it is registered. It depends upon a variety of factors which includes the nature of the goods and the characteristic of the market, but also the consistency of sales over time and whether the use is warranted to create or maintain a share in that market.[16] Relatively low numbers of sales may still qualify as genuine in the market. I do not agree that yearly sales between 2009 and 2022 of [redacted] in the UK indicates token use, even in a large market such as this. There are many players in

[14] Witness statement dated 1 August 2022, and exhibits.
[15] Witness statement dated 19 May 2023 and exhibits.
[16] *MFE Marienfelde GmbH v OHIM*, GC, Case T-334/01.

the food and drink industry and they cannot all have a large share of it. Not having a large share does not mean that they are not creating or maintaining a share in that market.

48. Exhibit LFCM16 to Mr Magalhães' second witness statement is split into location photographs in Portugal and in the UK. The UK photographs are dated and show in which stores the goods were for sale, including Morrisons and Tesco. They range from 2013 to 2020, showing fruit juice for sale in 2013, 2015, 2016 and 2017, and tins of beans for sale in 2017 and 2020. Mr Magalhães has split the turnover figures for juice and preserved fruits and vegetables in the UK, which he states were sold in each of these years and for the amounts referred to earlier in this decision. There are invoices for 2016 to 2021 years to UK customers for goods falling within the description of fruit juices and nectars and preserved vegetables. I can see that fruit juices were for sale in pounds sterling on UK websites with copyright dates of 2019 and 2022. Marketing expenses of [redacted] in Portugal and [redacted] in the UK were spent consistently from 2009 to 2022. In 2021, UK subscribers to the Degusta box voted COMPAL orange juice as their second-favourite product. Copal submits that the Degusta evidence does not assist Sumol because there is no explanation as to what Degusta is and that, in fact, Degusta provides new products for its subscribers to try which means that the goods were not sold in the UK prior to 2021. I do not accept this submission. It is clear from the exhibit that Degusta is the name of a box to which customers subscribe. Copal has given evidence in its submissions about Degusta boxes containing new products. It is not permitted to give evidence for the first time in submissions in lieu of a hearing (or in submissions at all): this should have been filed as evidence in reply earlier in the proceedings. In any event, it could simply mean that the particular product (Algarve orange juice) was sold as a new COMPAL product, not that this was the first time COMPAL products were sold by Degusta or anyone else in the UK. I have discounted what Copal says about the contents of Degusta boxes and will take the exhibit at face value: it shows that, in 2021, this particular COMPAL juice was very popular with subscribers to a UK food box scheme called Degusta.

49. Standing back and viewing the evidence in the round, I find that there was genuine use of the contested mark in Portugal and in the UK from 2009. This means that genuine use has been shown in all the relevant periods, including the relevant period

in the oppositions, except for the first period for earlier registration (ii) (17 March 2000 to 16 March 2005). That does not affect the finding of genuine use because earlier registration (ii) benefits from the provisions of section 46(3) of the Act.

50. I am required to determine in relation to which goods the mark has been used and, if that use is not on everything relied upon, or a reasonable range of goods within the terms in the specifications of the earlier registrations, to decide upon reduced, fair specifications represented by the use. In so doing, I am guided by *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors*, in which Mr Justice Carr summed up the law relating to partial revocation as follows:[17]

> "iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria's Secret UK Ltd* [2014] EWHC 2631 (Ch) ("Thomas Pink") at [52].
>
> iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].
>
> v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd* (Extreme Trade Mark) [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].
>
> vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably

[17] [2016] EWHC 3103 (Ch).

be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Pl*c [2015] EWCA Civ 220 ("Asos") at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them; *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46."

51. The evidence does not support a finding of genuine use across all the goods relied upon. In his second witness statement, which supported the defence against the revocations, Mr Magalhães said that Sumol had made genuine use of the earlier mark in relation to "Preserved and cooked fruits and vegetables" (class 29) and "Non-alcoholic beverages; fruit drinks and fruit juices" (class 32). He did not refer to dried fruits and vegetables, which are relied upon in the oppositions. I have not seen any examples of evidence regarding dried fruits and vegetables, so this term cannot form part of a fair specification. The evidence is in relation to fruit juices and nectars, tinned vegetables and tomato puree and juices. Although tomatoes are technically fruits, I believe that the natural way in which tomato puree and tomato juice, or passata, are perceived by consumers is as vegetables, for use in cooking and producing savoury dishes. None of the evidence shows cooked goods or fruit-based goods other than drinks. Consequently, a fair specification for the class 29 specifications for both the earlier registrations, and for reliance upon in the oppositions, is "preserved vegetables".

52. In relation to the class 32 goods, 'non-alcoholic drinks' is a broad term encompassing a wide variety of drinks, such as non-alcoholic beer, soda, fruit-based drinks like squash, smoothies and energy drinks. I do not consider that Sumol can

retain (or rely upon) this broad term on the basis of its evidence. I also disagree with Copal that it cannot retain or rely upon fruit drinks because any use is only on fruit juices. This would be pernickety: fruit juices are fruit drinks, and may be pure or diluted. They are goods which consumers would consider to belong to the same group and which are not in substance different. A fair specification for the class 32 specifications of both earlier registrations, and for reliance upon in the oppositions, is "fruit drinks and fruit juices".

Revocation outcomes

53. Under section 46(6)(b) of the Act, registration 810701103 is revoked from 3 February 2017 in respect of:

> Class 29: Meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits; dried and cooked vegetables; jellies, jams, compotes; eggs, milk and milk products; edible oils and fats.
>
> Class 30: Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery, edible ice; honey, treacle; yeast, baking powder; salt, mustard; vinegar, sauces (condiments); spices; ice for refreshment.
>
> Class 32: Beer; non-alcoholic beverages; syrups and other preparations for making beverages.

54. Registration 810701103 remains registered for:

> Class 29: Preserved vegetables.
>
> Class 32: Fruit drinks and fruit juices.

55. Under section 46(6)(b) of the Act, international registration 701103 is revoked from 17 March 2005 in respect of:

Class 29: Meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits; dried and cooked vegetables; jellies, jams, compotes; eggs, milk and milk products; edible oils and fats.

Class 30: Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery, edible ice; honey, treacle; yeast, baking powder; salt, mustard; vinegar, sauces (condiments); spices; ice for refreshment.

Class 32: Beer; non-alcoholic beverages; syrups and other preparations for making beverages.

56. International registration 701103 remains registered for:

Class 29: Preserved vegetables.

Class 32: Fruit drinks and fruit juices.

<u>The oppositions</u>

57. The above approach, made in the context of revocation proceedings, is also applicable to genuine use under section 6A of the Act. Following the above analysis of Sumol's use and the conclusions I reached, I reiterate here that Sumol has met the proof of use requirements for both its earlier marks in respect of:

Class 29: Preserved vegetables.

Class 32: Fruit drinks and fruit juices.

Section 5(2)(b) of the Act

58. Section 5(2)(b) states:

"5. (2) A trade mark shall not be registered if because –

(a) …

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark."

59. Section 5A states:

"Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only."[18]

60. The following principles for determining whether there is a likelihood of confusion under section 5(2)(b) of the Act are taken from the decisions of the CJEU in *Sabel BV v Puma AG,* Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc,* Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV,* Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH,* Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM,* Case C-334/05P and *Bimbo SA v OHIM,* Case C-591/12P.

The principles

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

[18] This section also applies to the ground raised under section 5(3) of the Act.

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods and services

61. In comparing the respective specifications, all relevant factors should be considered, as per *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.* where the CJEU 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."

62. Additionally, the criteria identified in *British Sugar Plc v James Robertson & Sons Limited ("Treat")* [1996] R.P.C. 281 for assessing similarity between goods and services also include an assessment of the channels of trade of the respective goods or services.

63. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, the GC stated that complementary means:[19]

> "82 … there is a close connection between [the goods], in the sense that one is indispensable or important for the use of the other in such a way that

[19] Case T-325/06, the General Court of the European Union.

customers may think that the responsibility for those goods lies with the same undertaking…".[20]

64. The parties' respective goods and services to be compared in accordance with the above caselaw are:

Sumol	**Copal**
Class 29: *Preserved vegetables.* Class 32: *Fruit drinks and fruit juices.*	<u>COPALLI</u> Class 33: *Alcoholic beverages (except beers); distilled spirits; absinthe; alcoholic aperitifs; alcoholic bitters; alcoholic cocktail mixes; alcoholic cordials; alcoholic energy drinks; alcoholic essences; alcoholic extracts; alcoholic beverages of fruit; alcoholic fruit beverages; alcoholic fruit cocktail drinks; alcoholic jellies; alcoholic tea-based beverage; alcopops; anisette; aperitifs; arak; bitters; blended whisky; bourbon whiskey; brandy; ciders; cooking brandy; cooking wine; distilled beverages; fermented spirit; flavoured tonic liquors; fortified wines; fruit wine; gin; grape wine; liqueurs; preparations for making alcoholic beverages; pre-mixed alcoholic beverages; sake; sparkling wines; spirits and liquors; vodka; vermouth; whiskey; wine.*

[20] In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is capable of being the sole basis for the existence of similarity between goods and services.

	COPAL TREE Class 30: *Coffee, tea, cocoa and artificial coffee; rice; tapioca and sago; flour and preparations made from cereals; bread, pastries and confectionery; edible ices; sugar, honey, treacle; yeast, baking-powder; salt; mustard; vinegar, sauces (condiments); spices; ice (frozen water); candy; candy bars; chocolate; chocolate bars; chocolate cakes; chocolate candies; chocolate chips; chocolate confections; chocolate covered cocoa nibs; chocolate covered fruit; chocolate covered nuts; chocolate covered roasted coffee beans; chocolate for confectionery and bread; chocolate for toppings; chocolate mousse; chocolate mousses; chocolate pastes; chocolate powder; chocolate sauce; chocolate syrup; chocolate topping; chocolate truffles; chocolate-based spreads; chocolates and chocolate based ready to eat candies and snacks; cocoa; cocoa mixes; cocoa powder; cocoa spreads; milk chocolate; candy with cocoa; confectionery, namely, candy and chocolate; frozen confections; white chocolate chips; chocolate fondue; chocolate syrups; chocolate sauces; chocolate coating; chocolate spread;*

	chocolate spreads; chocolate extracts; aerated chocolate; chocolate marzipan; chocolate creams; chocolate sweets; chocolate eggs; chocolate flavourings; chocolate confectionery; chocolate fudge; chocolate pastries; chocolate desserts; chocolate brownies; chocolate biscuits; chocolate beverages; chocolate flavoured confectionery; chocolate based products; milk chocolate teacakes; chocolate drink preparations; chocolate confectionery products; chocolate covered biscuits; chocolate covered cakes; chocolate based drinks; chocolate candy with fillings; chocolate beverages with milk; biscuits containing chocolate flavoured ingredients; ice creams flavoured with chocolate; chocolate spreads for use on bread; chocolate-based fillings for cakes and pies; chocolate essences for the preparation of beverages; chocolate extracts for the preparation of beverages; non-medicated flour confectionery coated with imitation chocolate; confectionery bars; confectionery ices; sugar confectionery; confectionery chocolate products; nonmedicated flour confectionery coated with chocolate. Class 33: *Alcoholic beverages (except beers); distilled spirits; absinthe;*

	alcoholic aperitifs; alcoholic bitters; alcoholic cocktail mixes; alcoholic cordials; alcoholic energy drinks; alcoholic essences; alcoholic extracts; alcoholic beverages of fruit; alcoholic fruit beverages; alcoholic fruit cocktail drinks; alcoholic jellies; alcoholic tea-based beverage; alcopops; anisette; aperitifs; arak; bitters; blended whisky; bourbon whiskey; brandy; ciders; cooking brandy; cooking wine; distilled beverages; fermented spirit; flavoured tonic liquors; fortified wines; fruit wine; gin; grape wine; liqueurs; preparations for making alcoholic beverages; pre-mixed alcoholic beverages; sake; sparkling wines; spirits and liquors; vodka; vermouth; whiskey; wine. Class 43: *Services for providing food and drink; temporary accommodation; hotel services; hotel reservations; hotel information; appraisal of hotel accommodation; arranging of hotel accommodation; hotels, hostels and boarding houses, holiday and tourist accommodation; accommodation reservations; temporary accommodation reservation services; arranging and providing temporary accommodation; holiday lodgings; providing travel lodging information services and travel lodging booking agency services for*

	travellers; mobile catering; outside catering; hotel catering services; food and drink catering; catering of food and drink; information, advisory and consultancy services relating to all the aforesaid services.

65. Sumol's written submissions are very light and non-specific in terms of addressing the comparison of goods and services. It submits:

> "31. As to the nature of the goods and services, are [sic] at the very least complementary as they are all produced for consumer consumption or consumption of these products is anticipated/expected to be provided by the services.
>
> 32. As to their end users, these are the same given they are consumers who wish to consumer [sic] the products or engage with the services in order to consumer the products.
>
> 33. Overall, the goods and services applied for under the Applications are, at the very least, complementary to those registered under the Registrations."

66. Copal submits that the goods in its class 30 specification do not share the same nature or intended purpose, and that confectionery goods are unlikely to be offered by the same undertaking as Sumol's goods. They will be found in different sections of the supermarket, target different consumers, are unlikely to compete which each other and are not complementary.

67. Copal's class 30 specification covers *coffee, tea, cocoa, artificial coffee, cocoa, cocoa mixes, cocoa powder, chocolate beverages, chocolate drink preparations, chocolate based drinks, chocolate beverages with milk, chocolate essences for the preparation of beverages* and *chocolate extracts for the preparation of beverages*. I agree with Copal that the goods are not complementary. I do not agree with Copal

that these goods do not share nature and method of use with Sumol's fruit drinks and fruit juices. At least some of Copal's goods are liquid in nature and are drunk: *chocolate beverages, chocolate based drinks* and *chocolate beverages with milk*. The purpose of the other goods is that they are made up into beverages to be drunk. There may be a choice as to whether a chocolate-based drink is bought or a fruit drink (drink or juice). Chocolate drinks, especially those containing milk, are frequently found alongside fruit juices and fruit drinks in the refrigerated aisles of supermarkets. There is at least a medium degree of similarity between Sumol's fruit drinks and fruit juices and Copal's *chocolate beverages, chocolate based drinks* and *chocolate beverages with milk*. There is a low degree of similarity between Sumol's fruit drinks and fruit juices and Copal's *coffee, tea, cocoa, artificial coffee, cocoa, cocoa mixes, cocoa powder, chocolate drink preparations, chocolate essences for the preparation of beverages* and *chocolate extracts for the preparation of beverages*.

68. I cannot see any meaningful similarity between Sumol's goods upon which it may rely and the remainder of the class 30 goods of the COPAL TREE application. Whilst the class 30 specification contains *chocolate covered fruit*, this is a confectionery item and is not similar in nature, purpose or method of use to Sumol's goods. The goods are not complementary or in competition. They would not be found nearby to each other in retail outlets because preserved vegetables, fruit drinks and fruit juices are in different sections to confectionery. They are not similar.

69. Copal's class 33 specifications are the same for both its contested applications. I do not see any similarity between Sumol's preserved vegetables and Copal's class 33 goods. Turning to a comparison with Sumol's fruit drinks and fruit juices, the parties' goods share the same liquid nature. The goods are liquid because they are all for consumption by the same method, that of drinking them, apart from Copal's alcoholic jellies. However, there will be a marked difference in the quantities consumed for some of Copal's goods, with Sumol's drinks being longer than, e.g. whisky or wine. Those of Copal's goods which have a relatively high alcoholic content are not drunk in quantities which are conducive to quenching thirst, whilst those lower in alcohol are longer and may partly be drunk to quench thirst, such as a cold cider on a hot day. Fruit drinks and fruit juices are drunk to quench thirst and for nutritional purposes. Alcoholic drinks are consumed for the effects of alcohol as well as for taste,

even if some are also drunk partly to quench thirst or for sociable reasons. Some of Copal's goods are fruit-flavoured and so their nature, as far as flavour is concerned, will have similarities with Sumol's class 32 goods, e.g. *alcoholic beverages of fruit; alcoholic fruit beverages* and *alcoholic fruit cocktail drinks*, *cider* and broader terms which cover these goods (such as *alcoholic beverages (except beers)*).

70. The parties' goods are not generally found in close proximity in supermarkets, but both are sold in pubs. There may be an element of competition as one may decide to drink, e.g. an apple juice drink instead of a pint of cider; but there are other goods for which there is no discernable element of competition, such as fruit juice instead of a measure of whisky or a liqueur. Although some of Copal's goods may require or frequently be drunk with a mixer, which could be e.g. orange juice, the goods are not complementary in the sense described in *Boston*. There is no evidence before me that the same undertakings are recognised by consumers as producing alcoholic goods and fruit juice as a mixer. Taking all this into account, I find the following levels of similarity between Sumol's fruit drinks and fruit juice and Copal's class 33 goods:

- low to medium similarity: *Alcoholic beverages (except beers); alcoholic cocktail mixes; alcoholic cordials; alcoholic energy drinks; alcoholic beverages of fruit; alcoholic fruit beverages; alcoholic fruit cocktail drinks; alcopops; ciders; fruit wine; pre-mixed alcoholic beverages*. These goods are, or include, longer drinks and are, or include, drinks which are fruit-based or fruit flavoured;

- no similarity: *distilled spirits; absinthe; alcoholic aperitifs; alcoholic bitters; alcoholic essences; alcoholic extracts; alcoholic jellies; alcoholic tea-based beverage; anisette; aperitifs; arak; bitters; blended whisky; bourbon whiskey; brandy; cooking brandy; cooking wine; distilled beverages; fermented spirit; flavoured tonic liquors; fortified wines; gin; grape wine; liqueurs; preparations for making alcoholic beverages; sake; sparkling wines; spirits and liquors; vodka; vermouth; whiskey; wine.* Although, for example, wine and brandy are produced from fruit, they are not fruit-flavoured. These are all goods which are high in alcoholic content, or are not drinks *per se* (such as preparations for making alcoholic beverages), or are jellies and not drinks, or are ingredients in

cocktails such as bitters. They are not similar to Sumol's goods within the parameters of the case law cited above.

71. I cannot see any similarities between Sumol's goods and the following contested services in class 43:

> *temporary accommodation; hotel services; hotel reservations; hotel information; appraisal of hotel accommodation; arranging of hotel accommodation; hotels, hostels and boarding houses, holiday and tourist accommodation; accommodation reservations; temporary accommodation reservation services; arranging and providing temporary accommodation; holiday lodgings; providing travel lodging information services and travel lodging booking agency services for travellers; information, advisory and consultancy services relating to all the aforesaid services.*

72. These services are not similar to Sumol's goods. The remaining services are:

> *Services for providing food and drink; mobile catering; outside catering; hotel catering services; food and drink catering; catering of food and drink; information, advisory and consultancy services relating to all the aforesaid services.*

73. The nature of the parties' goods and services are clearly not similar. There is some similarity of purpose in that one might seek the service of drink provision in order to quench a thirst, and for that reason there is also some similarity of trade channels. I do not see any other elements of similarity, other than users which is on too general a level to be meaningful. I also do not think there is any meaningful similarity at all with *hotel catering services*. Unlike mobile catering and other forms of casual food and drink services, which may provide their own drinks and juices e.g. from the catering van, hotel catering is arranged for functions. There is a very low degree of similarity between Sumol's goods and Copal's *Services for providing food and drink; mobile catering; outside catering; food and drink catering; catering of food and drink*. There is no similarity with Copal's *hotel catering services; information, advisory and consultancy services relating to services for providing food and drink; mobile catering;*

outside catering; hotel catering services; food and drink catering; catering of food and drink, as these services are too far removed from fruit drinks and fruit juices.

The average consumer and the purchasing process

74. As the caselaw cited above indicates, it is necessary to decide who the average consumer is for the parties' goods and services and how they purchase them. "Average consumer" in the context of trade mark law means the "typical consumer."[21] The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*.

75. The average consumer for the parties' goods (for which there is any similarity) is a member of the general public (over the age of 18 for Copal's goods in class 33). They are everyday foods and drinks, purchased regularly, where the main focus of attention will be use and flavour. Although some attention may be paid to allergy information, a low to medium degree of attention will generally be paid during purchase. The goods will be purchased primarily visually, selected from shelves or online outlets. There may be an aural element; for example, if a purchase is being made from a street trader or kiosk. A medium degree of attention will be paid to the selection of Copal's services (those which I have found to be similar to Sumol's goods). Again, this will primarily be a visual selection process, although there may be more potential for aural use owing to recommendations of food and drink or catering services.

[21] Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited, [2014] EWHC 439 (Ch).

Comparison of marks

76. The marks to be compared are:

Earlier mark	Contested marks
COMPAL	COPALLI COPAL TREE

77. *Sabel BV v. Puma AG* explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, 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:

> ".....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."

78. It is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

COPALLI

79. Both parties' marks comprise single elements in which the overall impression of each mark lies. The earlier mark contains six letters and the later mark seven. The first two letters of the marks are identical, and they both contain the sequence PAL.

However, only the later mark has a double L and an I, and only the earlier mark contains a letter M. Overall, there is a low degree of visual similarity.

80. There is a very low degree of aural similarity. The earlier mark comprises two syllables and the contested mark three. There is no M sound in the later mark. The later mark will be pronounced according to the UK average consumer's normal understanding of language conventions, which means it will be said as co-pall-ee, with a short 'o' and a long third syllable. In contrast, there is no long 'ee' sound in the earlier mark.

81. The earlier mark, COMPAL, is an invented word with no meaning. For Copal, Ms O'Shea gives evidence about the definition of COPAL in Exhibit NO2. She states that the dictionary definitions contained in the exhibit show that 'copal' is a dictionary-defined term in the English language, "referring to a resin from a tropical tree use [sic] to make varnishes and lacquers and originating from the 16 century Spanish, from Nahuatl *copalli* resin or incense."[22] It is said to be used in sacred communal ceremonies by the indigenous peoples of Belize. Ms Hofer, also for Copal, has given the same evidence in Exhibit TH3 to her witness statement, with an additional definition for 'copal tree' in *Merriam-Webster*, which is a US dictionary. That dictionary defines a copal tree as any of several trees which have fragrant resins. Copal submits that *copalli* is the linguistic root for 'copal' and that COPALLI has a conceptual meaning because it evokes or is suggestive of a form of ritual that brings people together.

82. This argument is far-fetched. It is highly unlikely that the average consumer in the UK for the parties' goods and services knows of the practices of indigenous people in Belize. Furthermore, simply because a word appears in a UK English language dictionary, it does not automatically follow that its meaning will be apparent to the average UK consumer for the goods and services. In *Chorkee Ltd v Cherokee Inc.,* Ms Anna Carboni, sitting as the Appointed Person, found that although the Hearing Officer was entitled to take judicial knowledge of the fact that CHEROKEE was the name of a tribe of native Americans, he was not entitled to attribute this knowledge to

[22] The dictionaries accessed include Oxford and Collins.

the average UK consumer of clothing.[23] No doubt, 'cherokee' appeared in the dictionary (although no evidence was led): the Appointed Person said that the meaning could easily be established from looking in an encyclopaedia or online reference sources. The point was that unless the meaning is so notorious, evidence must show that a term has the relevant meaning to the average UK consumer for the goods (or services). Simply showing that a word appears in a dictionary is not determinative *per se*. In *Creative Nail Design v Maroc Organics Limited*, Mr Iain Purvis QC (now KC), sitting as the Appointed Person, said that there are plenty of technical words which are entirely unknown to the average consumer: the word in that case was 'shellac', meaning a thin hard varnish used on wood.[24] It seems to me that 'copal' falls into that category: it is in the dictionary, but is relatively obscure and technical. Mr Purvis said:

> "25. The Hearing Officer consulted two dictionaries, set out the definitions given in those dictionaries and concluded that the word was therefore not distinctive for goods '*such as polish or coating which may either be made from shellac or provide a shellac-like result.'* Her analysis therefore missed out the step which was vital to a finding that the term was not a distinctive element within either mark, namely whether it would be recognised in its descriptive sense by the average consumer. If it would not, then the mere fact that it appeared in dictionaries was entirely irrelevant.
>
> […]
>
> 31. […]
>
> (c) The presence of a word in a dictionary does not mean that the word would be known or recognised by the average consumer. A large number of words in dictionaries are completely unknown save to a tiny number of specialists or to Scrabble experts. Similarly, where a word has a number of definitions, it cannot be assumed that all such definitions are equally well-known."

[23] Case BL O/048/08.
[24] Case BL O/500/14.

83. I find that both parties' marks will be seen as invented words with no known concept. They are conceptually neutral.

COPAL TREE

84. As before, the earlier mark comprises a single element in which the overall impression of the mark resides. The later mark comprises two elements, neither of which is especially dominant in the overall impression, although I acknowledge that COPAL will be seen or heard first as the mark will be read from left to right.

85. COMPAL and COPAL differ only in one letter: the M which is in the middle of the earlier mark. This makes the common elements visually highly similar. There is no counterpart to TREE in the earlier mark. Overall, the marks are visually similar to a medium degree.

86. The common elements of both marks comprise two syllables which begin with a C sound and end in a PAL sound. I consider that the O in COMPAL will be a short O (as in 'company') and the O in COPAL will, according to normal UK pronunciation convention, be a long O (as in 'total'). TREE will have its ordinary pronunciation. Overall, the marks have a low to medium degree of aural similarity.

87. The earlier mark, COMPAL, is an invented word with no meaning. I have addressed, above, the significance of COPAL appearing in the dictionary. It will be seen as an invented word by the average UK consumer for the goods and services. TREE has its obvious meaning and is absent in the earlier mark. COPAL, in combination with TREE, with TREE as the second element of the mark, could give rise to a perception that COPAL is the name of some sort of tree. The parties' marks are conceptually dissimilar.

Distinctive character of COMPAL

88. The assessment as to whether there is a likelihood of confusion includes considering whether the distinctive character of the earlier mark has been enhanced

(i.e. more distinctiveness has been acquired) through the use made of it. If a mark has an inherently high, or an enhanced, level of distinctiveness, the likelihood of confusion is increased. The inherent distinctiveness of COMPAL is high because it is invented. Invented words are generally held to have a higher degree of inherent distinctive character because they do not directly describe or allude to goods or services or to their characteristics.

89. Distinctive character is a measure of how strongly the earlier mark identifies the goods or services for which it is registered, determined, according to *Lloyd Schuhfabrik Meyer & Co.*, partly by assessing the proportion of the relevant public which, because of the mark, identify the goods or services as originating from a particular undertaking. At paragraph 23, of its judgment, the CJEU stated:

> "In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).

90. The assessment can only take into account use in the UK because the likelihood of confusion is assessed from the perspective of the UK average consumer. The evidence falls short of what is required for a finding of enhanced distinctive character (beyond the already high inherent level) for fruit drinks and fruit juices in what is a huge UK market. The turnover and advertising is modest in the UK market context. The distinctiveness of the earlier mark had not been enhanced by its UK use at the relevant date.

Likelihood of confusion

91. Deciding whether there is a likelihood of confusion is not scientific; it is a matter of considering all the factors, weighing them and looking at their combined effect, in accordance with the authorities set out earlier in this decision. One of those principles states that a lesser degree of similarity between goods and services may be offset by a greater degree of similarity between the trade marks, and vice versa. In this case, there are some similar goods and services and some which are dissimilar. Where there is no similarity, there can be no likelihood of confusion. The section 5(2) opposition, therefore, fails in relation to the following:

> Class 30: rice; tapioca and sago; flour and preparations made from cereals; bread, pastries and confectionery; edible ices; sugar, honey, treacle; yeast, baking-powder; salt; mustard; vinegar, sauces (condiments); spices; ice (frozen water); candy; candy bars; chocolate; chocolate bars; chocolate cakes; chocolate candies; chocolate chips; chocolate confections; chocolate covered cocoa nibs; chocolate covered fruit; chocolate covered nuts; chocolate covered roasted coffee beans; chocolate for confectionery and bread; chocolate for toppings; chocolate mousse; chocolate mousses; chocolate pastes; chocolate powder; chocolate sauce; chocolate syrup; chocolate topping; chocolate truffles; chocolate-based spreads; chocolates and chocolate based ready to eat candies and snacks; cocoa spreads; milk chocolate; candy with cocoa; confectionery, namely, candy and chocolate; frozen confections; white chocolate chips; chocolate fondue; chocolate syrups; chocolate sauces; chocolate coating; chocolate spread; chocolate spreads; chocolate extracts; aerated chocolate; chocolate marzipan; chocolate creams; chocolate sweets; chocolate eggs; chocolate flavourings; chocolate confectionery; chocolate fudge; chocolate pastries; chocolate desserts; chocolate brownies; chocolate biscuits; chocolate flavoured confectionery; chocolate based products; milk chocolate teacakes; chocolate confectionery products; chocolate covered biscuits; chocolate covered cakes; chocolate candy with fillings; biscuits containing chocolate flavoured ingredients; ice creams flavoured with chocolate; chocolate spreads for use on bread; chocolate-based fillings for cakes and pies; non-medicated flour confectionery coated with imitation

chocolate; confectionery bars; confectionery ices; sugar confectionery; confectionery chocolate products; nonmedicated flour confectionery coated with chocolate.

Class 33: distilled spirits; absinthe; alcoholic aperitifs; alcoholic bitters; alcoholic essences; alcoholic extracts; alcoholic jellies; alcoholic tea-based beverage; anisette; aperitifs; arak; bitters; blended whisky; bourbon whiskey; brandy; cooking brandy; cooking wine; distilled beverages; fermented spirit; flavoured tonic liquors; fortified wines; gin; grape wine; liqueurs; preparations for making alcoholic beverages; sake; sparkling wines; spirits and liquors; vodka; vermouth; whiskey; wine.

Class 43: temporary accommodation; hotel services; hotel reservations; hotel information; appraisal of hotel accommodation; arranging of hotel accommodation; hotels, hostels and boarding houses, holiday and tourist accommodation; accommodation reservations; temporary accommodation reservation services; arranging and providing temporary accommodation; holiday lodgings; providing travel lodging information services and travel lodging booking agency services for travellers; hotel catering services; information, advisory and consultancy services relating to all the aforesaid services.

92. Direct confusion occurs where marks are mistaken for one another, flowing from the principle that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them which has been retained in the mind. Indirect confusion occurs when the consumer recognises that the marks are different, but puts the similarities between them down to the undertakings being the same or economically linked, as explained in *Back Beat Inc v L.A. Sugar (UK) Limited*, by Mr Iain Purvis QC, sitting as the Appointed Person:[25]

[25] BL O/375/10.

"16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: *"The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark"*.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

> (a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right ("26 RED TESCO" would no doubt be such a case).
>
> (b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as "LITE", "EXPRESS", "WORLDWIDE", "MINI" etc.).
>
> (c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension ("FAT FACE" to "BRAT FACE" for example)."

COPALLI

93. There is no likelihood of confusion, either directly or indirectly. The marks are too different to be imperfectly recalled to such an extent that they will be confused. The average consumer will not pay so little attention in looking at the goods bearing the marks, or asking for them, that they will make the sort of mistake which leads to direct confusion. There is also nothing about the marks which would lead consumers to recognise the differences but decide that the marks are brand variants. They will simply be seen as two different invented words with nothing substantive in common. Indirect confusion is not a consolation prize for an opponent which has not succeeded in a finding of direct confusion. Differences between marks which are the reason why there is no likelihood of direct confusion might also be the reason why there is no indirect confusion.[26] I have not forgotten that the Court of Appeal confirmed that the three categories in *L.A. Sugar* are non-exhaustive.[27] Nevertheless, the parties' marks have no obvious connection to each other. There is therefore no reason for anyone to conclude that either is a sub-brand or offshoot of the other, or some type of collaboration. For the avoidance of doubt, I would have found no likelihood of confusion of either type even if Sumol had proven use for all the goods relied upon and even if I had found an enhanced level of distinctive character for the earlier mark.

COPAL TREE

94. There is no likelihood of direct confusion. The additional word TREE means that the marks are too different to be imperfectly recalled to such an extent that they will be confused.

95. The common element between the marks is highly similar visually. The high degree of visual similarity between COMPAL and COPAL is prone to being imperfectly recalled. I bear in mind that indirect confusion can occur when the common element

[26] See the comments of Mr James Mellor QC (as he then was), sitting as the Appointed Person in *Cheeky Italian Limited v Ashish Sutaria*, BL O/219/16.
[27] *Liverpool Gin Distillery and others v Sazerac Brands, LLC and others* [2021] EWCA Civ 1207.

is identical but also when it is only similar, owing to imperfect recollection of the common element.[28]

96. I said earlier in this decision that, notwithstanding COPAL by itself has no meaning to the average UK consumer for the goods and services, in conjunction with TREE, it may be perceived as 'a copal tree', even though average consumers may not be familiar with the name. Some fruit grows on trees. It could be the case that consumers imperfectly recall the common elements, both of which appear to be invented words, and assume that the additional TREE element denotes a brand variation in relation to goods derived from or flavoured like tree-grown fruit. There could be confusion if consumers assume that the first element is a house brand, imperfectly recalled, and the TREE element a brand extension or variant reflecting tree-grown fruit-flavoured COMPAL/COPAL goods. I find that there is a likelihood of indirect confusion for goods which are fruit-flavoured or are terms which cover goods which are fruit-flavoured:

> Alcoholic beverages (except beers); alcoholic cocktail mixes; alcoholic cordials; alcoholic energy drinks; alcoholic beverages of fruit; alcoholic fruit beverages; alcoholic fruit cocktail drinks; alcopops; ciders; fruit wine; pre-mixed alcoholic beverages.

97. I do not think this would be the case for the remainder of Copal's goods and services which I have found to be similar because there is too tenuous a link: the distance between the marks overall and goods and services which are not fruit tree-related will avoid a likelihood of confusion. For such goods and services, TREE is not a natural brand variant and there is no likelihood of confusion.

98. As before, for the other goods and services I would have found no likelihood of confusion of either type even if Sumol had proven use for all the goods relied upon and even if I had found an enhanced level of distinctive character for the earlier mark. I also mention here that I have not been influenced by Sumol's use of COMPAL with

[28] *Aveda Corporation v Dabur India Limited* [2013] EWHC 589 (Ch and *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271.

a leafy or tree device. I have made the assessment solely on the basis of the parties' marks as they appear on the register.

Section 5(2)(b) outcome

99. The opposition against COPALLI fails under section 5(2)(b).

100. The opposition against COPAL TREE succeeds under section 5(2)(b) against:

> Alcoholic beverages (except beers); alcoholic cocktail mixes; alcoholic cordials; alcoholic energy drinks; alcoholic beverages of fruit; alcoholic fruit beverages; alcoholic fruit cocktail drinks; alcopops; ciders; fruit wine; pre-mixed alcoholic beverages.

101. The opposition under section 5(2)(b) fails against all other goods and services.

Section 5(3) of the Act

102. Section 5(3) states:

> "(3) A trade mark which-
>
> is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark".
>
> (3A) Subsection (3) applies irrespective of whether the goods and services for which the trade mark is to be registered are identical with, similar to or not similar to those for which the earlier trade mark is protected."

103. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors,* Case 252/07, *Intel,* Case C-408/01, *Adidas-*

Salomon, Case C-487/07, *L'Oreal v Bellure* and Case C-323/09, *Marks and Spencer v Interflora* and Case C-383/12 P, *Environmental Manufacturing LLP v OHIM.* The law appears to be as follows.

(a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; G*eneral Motors*, paragraph 26.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman*, paragraph 29 and *Intel*, paragraph 63.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel*, paragraph 42.

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel*, paragraph 68*;* whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel*, paragraph 79.

(f) the more immediately and strongly the earlier mark is brought to mind by the later mark, the greater the likelihood that use of the latter will take unfair advantage of, or will be detrimental to, the distinctive character or the repute of the earlier mark; *L'Oreal v Bellure NV*, paragraph 44.

(g) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is

weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel,* paragraphs 76 and 77 and *Environmental Manufacturing*, paragraph 34.

(h) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel*, paragraph 74.

(i) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV,* paragraph 40. The stronger the reputation of the earlier mark, the easier it will be to prove that detriment has been caused to it; *L'Oreal v Bellure NV*, paragraph 44.

(j) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora*, paragraph 74 and the court's answer to question 1 in *L'Oreal v Bellure).*

104. For a successful claim under section 5(3), cumulative conditions must be satisfied by Sumol: similarity between the marks; a qualifying reputation in the earlier mark; a link between the marks (the earlier mark will be brought to mind on seeing the

later marks); and one (or more) of the claimed types of damage. It is not necessary that the goods and services be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the relevant public will make a link between the marks.

105. The first condition of some similarity between the marks is satisfied, as found earlier in this decision.

106. The next condition is reputation. Reliance upon this ground requires evidence of a reputation amongst a significant part of the relevant public, as stated in *General Motors*:

> "25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.
>
> 26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.
>
> 27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.
>
> 28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation 'in the Member State'. In the absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation 'throughout' the territory of the Member State. It is sufficient for it to exist in a substantial part of it."

107. Sumol is entitled to rely upon use in the EU prior to 31 December 2020 to establish a reputation under this ground. I consider that the substantial level of turnover and the evidence pointing to the popularity of COMPAL for fruit juices and

fruit drinks (not preserved vegetables) in Portugal meets the reputation requirement for earlier registration (i).[29] However, the use is not on a sufficient scale in the UK that earlier registration (ii) meets the requirement. This means that, despite earlier registration (i) meeting the reputation requirement in Portugal, it was insufficiently known in the UK at the relevant date for UK consumers to have made a link between the earlier mark and either of the later marks.

108. In any event, even if there was a link, this ground does not take Sumol any further forward than its section 5(2)(b) ground, because its section 5(3) ground was pleaded only on the basis of confusion between the parties' marks. For completeness, I would not find a link with COPALLI because of the differences in the marks, even though the similarity for a link to be found can be less than that for a likelihood of confusion.[30] As there is no link there can be no consequential damage. **The section 5(3) ground fails against both contested marks.**

Overall outcome

109. The opposition against COPALLI (number 3621905) fails and the application may proceed to registration.

110. The opposition against COPAL TREE (number 3621884) partially succeeds under section 5(2)(b) against:

> Class 33: Alcoholic beverages (except beers); alcoholic cocktail mixes; alcoholic cordials; alcoholic energy drinks; alcoholic beverages of fruit; alcoholic fruit beverages; alcoholic fruit cocktail drinks; alcopops; ciders; fruit wine; pre-mixed alcoholic beverages;

111. The application is refused for the above goods but may proceed to registration for all other goods and services in the application:

[29] See *Pago International GmbH v Tirolmilch registrierte GmbH*, Case C-301/07, CJEU, and *Burgerista Operations GmbH v Burgista Bros Limited* [2018] EWHC 35 (IPEC).
[30] *Intra-Presse SAS v OHIM,* Joined cases C-581/13P & C-582/13P, CJEU.

Class 30: Coffee, tea, cocoa and artificial coffee; rice; tapioca and sago; flour and preparations made from cereals; bread, pastries and confectionery; edible ices; sugar, honey, treacle; yeast, baking-powder; salt; mustard; vinegar, sauces (condiments); spices; ice (frozen water); candy; candy bars; chocolate; chocolate bars; chocolate cakes; chocolate candies; chocolate chips; chocolate confections; chocolate covered cocoa nibs; chocolate covered fruit; chocolate covered nuts; chocolate covered roasted coffee beans; chocolate for confectionery and bread; chocolate for toppings; chocolate mousse; chocolate mousses; chocolate pastes; chocolate powder; chocolate sauce; chocolate syrup; chocolate topping; chocolate truffles; chocolate-based spreads; chocolates and chocolate based ready to eat candies and snacks; cocoa; cocoa mixes; cocoa powder; cocoa spreads; milk chocolate; candy with cocoa; confectionery, namely, candy and chocolate; frozen confections; white chocolate chips; chocolate fondue; chocolate syrups; chocolate sauces; chocolate coating; chocolate spread; chocolate spreads; chocolate extracts; aerated chocolate; chocolate marzipan; chocolate creams; chocolate sweets; chocolate eggs; chocolate flavourings; chocolate confectionery; chocolate fudge; chocolate pastries; chocolate desserts; chocolate brownies; chocolate biscuits; chocolate beverages; chocolate flavoured confectionery; chocolate based products; milk chocolate teacakes; chocolate drink preparations; chocolate confectionery products; chocolate covered biscuits; chocolate covered cakes; chocolate based drinks; chocolate candy with fillings; chocolate beverages with milk; biscuits containing chocolate flavoured ingredients; ice creams flavoured with chocolate; chocolate spreads for use on bread; chocolate-based fillings for cakes and pies; chocolate essences for the preparation of beverages; chocolate extracts for the preparation of beverages; non-medicated flour confectionery coated with imitation chocolate; confectionery bars; confectionery ices; sugar confectionery; confectionery chocolate products; nonmedicated flour confectionery coated with chocolate.

Class 33: Distilled spirits; absinthe; alcoholic aperitifs; alcoholic bitters; alcoholic essences; alcoholic extracts; alcoholic jellies; alcoholic tea-based beverage; anisette; aperitifs; arak; bitters; blended whisky; bourbon whiskey; brandy; cooking brandy; cooking wine; distilled beverages; fermented spirit;

flavoured tonic liquors; fortified wines; gin; grape wine; liqueurs; preparations for making alcoholic beverages; sake; sparkling wines; spirits and liquors; vodka; vermouth; whiskey; wine.

Class 40: Alcohol distillery services; spirits distillery services; preservation of drink; food and drink preservation; rental of machines and apparatus for processing beverages; pasteurization services for food and beverages; wine-making for others; production of wine for others; distilling of spirits for others; food and beverage treatment; brewing of beer; brewing services; cider-making for others; information, advisory and consultancy services relating to all the aforesaid services.

Class 43: Services for providing food and drink; temporary accommodation; hotel services; hotel reservations; hotel information; appraisal of hotel accommodation; arranging of hotel accommodation; hotels, hostels and boarding houses, holiday and tourist accommodation; accommodation reservations; temporary accommodation reservation services; arranging and providing temporary accommodation; holiday lodgings; providing travel lodging information services and travel lodging booking agency services for travellers; mobile catering; outside catering; hotel catering services; food and drink catering; catering of food and drink; information, advisory and consultancy services relating to all the aforesaid services.

112. Under section 46(6)(b) of the Act, registration 810701103 is revoked from 3 February 2017 in respect of:

Class 29: Meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits; dried and cooked vegetables; jellies, jams, compotes; eggs, milk and milk products; edible oils and fats.

Class 30: Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery, edible ice; honey, treacle; yeast, baking powder; salt, mustard; vinegar, sauces (condiments); spices; ice for refreshment.

Class 32: Beer; non-alcoholic beverages; syrups and other preparations for making beverages.

113. Registration 810701103 remains registered for:

Class 29: Preserved vegetables.

Class 32: Fruit drinks and fruit juices.

114. Under section 46(6)(b) of the Act, international registration 701103 is revoked from 17 March 2005 in respect of:

Class 29: Meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits; dried and cooked vegetables; jellies, jams, compotes; eggs, milk and milk products; edible oils and fats.

Class 30: Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery, edible ice; honey, treacle; yeast, baking powder; salt, mustard; vinegar, sauces (condiments); spices; ice for refreshment.

Class 32: Beer; non-alcoholic beverages; syrups and other preparations for making beverages.

115. International registration 701103 remains registered for:

Class 29: Preserved vegetables.

Class 32: Fruit drinks and fruit juices.

Costs

116. Copal has been considerably more successful than Sumol across the four sets of proceedings, achieving revocation of a substantial part of Sumol's registrations and successfully defending its COPALLI application. Copal was also largely successful in defending its COPAL TREE application save for about half of its goods in class 33. Copal is entitled to a contribution towards its costs which are assessed according to the scale published in Tribunal Practice Notice 2/2016, reduced to take into account the goods for which Sumol successfully defended its registrations and those for which it successfully opposed COPAL TREE.

117. I note that there have been two case management conferences ("CMCs") in the consolidated proceedings. The first took place when only the oppositions were running, to deal with the registrar's refusal of an extension of time request from Sumol. The Hearing Officer allowed Sumol's request and reserved the issue of costs until the final determination of the proceedings. I note that Copal attended the hearing and argued against the extension of time being allowed. In the circumstances, an offset is appropriate in favour of Sumol. The second CMC took place before the same Hearing Officer in relation to the registrar's refusal of Sumol's request for confidentiality in respect of the turnover and marketing figures in Mr Magalhães' first witness statement. Copal did not object to the request and took no part in the CMC. There will be no offset in favour of Sumol for this CMC.

118. I make a small award for Copal's evidence because it was of no assistance in relation to the conceptual comparison of the marks. I also consider that Copal's written submissions in lieu of a hearing were overly granular and lengthy and do not merit an award commensurate with their length.

119. I award costs to Copal as follows, taking into account the repetitious nature of both parties' evidence and the economies of consolidation:

Fee for revocation applications x 2	£400
Preparing the revocation applications	

and considering the TM8(N) x 2	£400
Considering the notices of opposition and preparing the defences and counterstatements	£400
Preparing evidence and considering Sumol's evidence	£1000
Preparation of written submissions in lieu of a hearing	£400
Sub-total	£2600
Minus offset for CMC	£200
Minus offset for Sumol's partial success in the revocations and one of the oppositions	£260
Total	**£2140**

120. I order Sumol + Compal Marcas, S.A. to pay Copal Tree Brands, Inc. the sum of **£2140**. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of these proceedings if any appeal against this decision is unsuccessful.

Dated this 6th day of March 2024

Judi Pike
For the Registrar