

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 2150821 BY
FRUGOSA, S.A. DE C.V.
TO REGISTER A TRADE MARK IN CLASS 32**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER No. 49653
BY THE COCA-COLA COMPANY**

TRADE MARKS ACT 1994

**IN THE MATTER OF Application No. 2150821
by Frugosa, S.A. De C.V. to register a trade mark
in Class 32**

AND

**IN THE MATTER OF Opposition thereto under
No. 49653
by The Coca-Cola Company**

BACKGROUND

1. On 13 November 1997, Frugosa, S.A. De C.V. of Mexico applied to register the trade mark shown below in Class 32:



2. The application was examined and subsequently accepted and published for the following range of goods:

Juices; drinks made of fruit; soft drinks; non alcoholic drinks and beverages;
real fruit soda; juice fruits and nectars.

3. The application is opposed by The Coca-Cola Company of Georgia, United States of America. The opponent explains that they are the registered proprietor of four trade marks all registered in Class 32 and all of which contain the element FRUITOPIA either alone, or together with other words and/or devices. Full details of the trade marks on which the opponent relies in these proceedings can be found in the Annex to this Decision. Stemming from this, they frame their objections to the application in the following terms:

“The trade mark FRUTASTICA and device applied for under No. 2150821 (hereinafter referred to as the Trade Mark) is similar to the opponent’s marks FRUITOPIA, FIND YOUR OWN FRUITOPIA and FRUITOPIA and device registered under Nos. 1561654, 1562841, 2023606 and 2061482 such that there is a likelihood of confusion on the part of the public, which includes the likelihood of association with the registered trade marks of the opponents as set out above. Application No. 2150821 should therefore be refused under Section 5(2)(b) of the Trade Marks Act 1994.

2. The trade marks FRUITOPIA and FRUITOPIA in stylised form were used extensively by the opponents or with their consent in the United Kingdom before the date of filing of Application No. 2150821 on 13 November 1997. The opponents enjoyed a substantial reputation associated with the FRUITOPIA mark and product and use of the Trade Mark in the United Kingdom by the opponents in respect of the goods specified in Application No. 2150821 could have been prevented in November 1997 by virtue of rule of law, in particular, the law of passing off protecting an unregistered trade mark or other sign used in the course of trade. Application No. 2150821 should therefore be refused under Section 5(4)(a) of the Trade Marks Act 1994.”

4. The applicant filed a Counter-Statement which, in essence, consists of a denial of the various grounds of opposition.

5. Both sides filed evidence and both seek an award of costs. Following a review of the pleadings and evidence filed I advised the parties that I did not consider it necessary for an oral hearing to be held in order that I could make a decision in this case. The applicant however sought a hearing and the matter came before me on 20 June 2002. In the event, two days before the hearing, the applicant advised, through their Agents, Marks & Clerk, that they would not be attending the hearing but would be content for a decision to be taken from the papers. The hearing went ahead and the opponent was represented by Mr Christopher Morcom of Her Majesty’s Counsel instructed by Carpmaels & Ransford, Trade Mark Attorneys.

Opponent's evidence-in-chief

6. This consists of two statutory declarations. The first, dated 17 April 2000, is by Jandam Meriem Aliss’s who is a trade mark attorney in the employ of Carpmaels & Ransford who are the opponent’s professional representatives in these proceedings. I do not propose to summarise Ms Aliss’ declaration here; it consists entirely of submissions relating to the similarity of the trade mark the subject of the application in suit and the trade marks owned by the opponent.

7. The second statutory declaration dated 14 April 2000 is by Sheryl Ann Norman. Ms Norman explains that she is the Advertising Media and Message Manager of Coca-Cola Great Britain, who are themselves a wholly owned subsidiary of the Coca-Cola Company. Ms Norman states that she has held her current position for seven months adding that the information in her declaration comes from her own personal knowledge or from the books, records or accounts of her company to which she has full access.

8. The following points emerge from Ms Norman's declaration:

- that the opponent launched and began selling non-carbonated fruit drinks in the United Kingdom under the FRUITOPIA trade mark in May 1995. However, the trade marks were used and appeared on sales material and in advertising in the United Kingdom three months prior to the launch of the product, in February 1995;
- that drinks have been sold in 350ml and 500ml bottles in a range of flavours;
- that drinks have been sold under the FRUITOPIA trade mark throughout the United Kingdom and have been available from a variety of retail outlets, namely groceries, convenience and impulse channels. Exhibit SAN2 consists of a selection of bottle labels demonstrating how the FRUITOPIA trade mark is used on the goods;
- that the total sales value of drinks sold under the FRUITOPIA trade mark in the United Kingdom from May 1995 to presumably the date the statutory declaration was sworn (which is some two and a half years after the material date in these proceedings), amounted to £8.2m; the retail price of a 500ml bottle of the drink at launch was on average £0.69p;
- that the FRUITOPIA trade mark has been advertised and marketed in the United Kingdom. Advertising has taken the form of television and cinema advertisements, on ITV, Channel 4 and various satellite channels, billboards, bus and bus shelter posters. Marketing has included point of sale materials, labels and stickers and a sampling campaign via door-to-door drops, in selected company offices, city centres and shopping malls and at events such as a twenty venue sampling tour including the Edinburgh Festival in the summer of 1995. The total amount spent on advertising and marketing the FRUITOPIA product in the United Kingdom from launch to presumably the date the statutory declaration was sworn (which as mentioned above is some two and a half years after the material date in these proceedings) amounted to £5.1m. Exhibit SAN3 consists of examples of promotional material and literature and advertisements which appeared in various trade publications.

Applicant's evidence-in-chief

9. This consists of a witness statement dated 1 March 2001 by Joanna Clayre Lowther. Ms Lowther explains that she is a trainee trade mark attorney in the employ of Marks & Clerk who are the applicant's professional representatives in these proceedings. Ms Lowther confirms that she is authorised to make her witness statement on the applicant's behalf, adding that the information in it comes from her own knowledge or experience or from the files and records of her employer to which she has full access.

10. The following points emerge from Ms Lowther's witness statement:

- that a search of the United Kingdom trade marks register was conducted for trade marks containing the element FRUIT or FRUT for goods in Classes 29, 30, 31 and 32. A copy of the search results is provided as exhibit JCL1. Of this search, Ms Lowther says:

“7. The search has revealed at least 500 registrations, pending applications and lapsed registrations for marks containing FRUIT or FRUT, the majority of which cover grocery products or beverages containing fruit or fruit flavourings. The co-existence of these marks highlights that FRUIT or FRUT is non-distinctive for fruit related products and that no party is entitled to monopolise these elements in relation to such goods. Since FRUT/FRUIT is non-distinctive, it can be inferred that greater emphasis will be placed on the endings of both parties’ marks when establishing whether they are distinguishable. Even if the differences were slight, which I do not believe to be so, they are likely to be sufficient to enable the public to distinguish between the trade mark applied for and the FRUITOPIA marks.”

- that an investigation was carried out into the state of the market place. In this regard, a company name search and a common law search for company names, trade names and trade marks containing FRUIT-/FRUT- were undertaken. The company name search involved a search of the United Kingdom company names register, whilst for the common law search, major trade journals relating to the food and drink industry were reviewed. Copies of the searches are provided as exhibits JCL2 and JCL3. Of these searches, Ms Lowther says:

“10. As can be seen from exhibit JCL2, the company name search has disclosed a large number of registered companies with names contain (sic) the element FRUIT or FRUT. Other information contained in the company names themselves plus more detailed information provided about the activities of some of the companies, tends to suggest that a number of UK companies which incorporate FRUIT or FRUT co-exist in several fields related to fruit products, such as the supply of fruit drinks, the supply of food containing fruit or fruit flavourings and the importation of fruit etc. The result of the common law search also tends to suggest that there are numerous examples of similar products containing fruit , including drinks, provided under marks which consist of FRUIT or FRUT plus another element. The fact that these trade marks and trade names appear to co-exist for similar goods suggest to me that there is no reason why the applicant’s and opponent’s marks should not co-exist in the market place.”

- that in order to substantiate the evidence revealed by the common law and company name searches, Ms Lowther visited a number of retail outlets including supermarkets, high street stores, newsagents, grocers and greengrocers. Of these visits Ms Lowther says:

“During this visit to retail outlets, I saw a large number of products for sale under names consisting of or containing FRUIT or FRUT, and purchased representative samples for several categories of goods containing fruit. Photographs of the goods purchased or their packaging are now produced and shown to me marked exhibits JCL4 to JCL10. The type of products/packaging shown in each of these exhibits is as follows: JCL4 - drinks containing fruit or fruit flavourings, JCL5 - tinned fruit deserts, JCL6 - boxes for fruits, JCL7 -

fruit yogurts, JCL8 - cereals containing fruit, JCL9 - sweets containing flavouring and JCL10 - snack bars containing fruit or fruit flavouring.”

- commenting on the results of her various visits, Ms Lowther concludes her witness statement in the following terms:

“12. In summary, this evidence clearly confirms that marks consisting of or containing FRUIT co-exist in the market place without confusion for similar or identical foodstuffs and drinks containing fruit. This even appears to be the case for marks with a FRUIT-/FRUT- prefix, with slightly similar suffixes and with some similarity between the stylisation of the marks and the get-up of the packaging (for example FRUTINI and FRUITIME for tinned fruit desserts co-exist in the market place (see exhibit JCL5)) and were even displayed sold adjacent to each other on a Tesco’s supermarket shelf. Having regard to the fact that considerable evidence has been produced of the co-existence of marks containing the prefixes FRUIT- or FRUT-, for the same or similar fruit related products, it can be inferred that the trade mark applied for, FRUTASTICA and device, and the opponents’ FRUITOPIA marks are distinguishable and that there would be no likelihood of association, between both parties marks and their goods bearing the marks.”

Opponent's evidence-in-reply

11. This consists of a witness statement dated 21 September 2001 by the same Jandan Meriem Aliss mentioned above. Ms Aliss’s witness statement is, in essence, a critique of the searches conducted by Ms Lowther on behalf of the applicant for registration. I do not propose to summarise Ms Aliss’s witness statement here but will of course bear its contents in mind when reaching my decision.

DECISION

12. The first ground of opposition is based upon Section 5(2)(b) of the Act which states:

“(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.

13. An earlier trade mark is defined in Section 6 of the Act, the relevant part of which states:

“6.-(1) In this Act an "earlier trade mark" means -

- (a) a registered trade mark, international trade mark (UK) or Community trade mark which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,”

14. All of the trade marks upon which the opponent relies for this ground are earlier trade marks.

15. I go on to consider the matter under this head bearing in mind the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] E.T.M.R. 1, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] E.T.M.R. 1, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG* [2000] E.T.M.R. 723.

It is clear from these cases that:

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*, paragraph 22;
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v. Puma AG*, paragraph 23, 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; *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* paragraph 27;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v. Puma AG*, paragraph 23;
- (d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v. Puma AG*, paragraph 23;
- (e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17;
- (f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v. Puma AG*, paragraph 24;
- (g) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v. Puma AG*, paragraph 26;

- (h) further, 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; *Marca Mode CV v. Adidas AG*, paragraph 41;
- (i) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 29.

Similarity of the goods

16. Identical, or at least similar goods are involved here. Neither side have suggested otherwise. The applicant’s specification is within the scope of all of the opponent's earlier registrations.

Comparison of trade marks

17. It seems to me that the opponent’s best case is based upon registration number 2023606, for the series of trade marks. These and the applicant's trade mark are shown below.

Opponent’s Trade Marks



Applicant’s Trade Mark



First of all, the opponent claims that their trade mark has an enhanced distinctive character because of the use they have made of it. The applicant through their evidence seeks to demonstrate that the prefix ‘FRUIT’ in the word element of the opponent's trade marks, is very common in the trade, thus the trade marks have a low distinctive character. In my view neither claim is fully supported.

18. The opponent's evidence which they say goes to show an enhanced reputation is little more than evidence of use - sales figures and promotional expenditure. They have not sought to put this into context ie. to demonstrate that their market share is such as to clearly indicate that the trade marks have acquired an enhanced reputation.

19. Similarly, the applicant's evidence is a combination of state of the trade marks and company register evidence. As has been said before, such evidence does not actually point to why the trade marks or company names were registered or what is happening in the market place. And whilst I accept that the prefix of the opponent's trade marks may allude to the goods, or a characteristic of them, the evidence of Ms Lowther which seeks to show that the word FRUIT is used in names for products which are the same or similar as those covered by the registrations, skirts the fact that the opponent's trade marks do not just consist of the word FRUIT, it has other, significant, elements. In that connection I must have regard to both parties' trade marks as wholes in undertaking a comparison, as would the average consumer who will be reasonably well informed, reasonably circumspect and observant, but who will have to rely on imperfect recollection. I also bear in mind that the goods of the application and of the earlier registrations are likely to be (relatively) low cost items bought and purchased without a great deal of attention.

20. The applicant's trade mark consists of the word FRUTASTICA in a fanciful script contained within an unusually shaped border. The opponent's trade marks consist of the word FRUITOPIA, again in a fanciful script and an unusually shaped border, together with some added decorative material. In both cases it is the word which is the predominant element. Mr Morcom's skeleton argument summarised his view of the similarity of the trade marks as follows:

- “(a) *Visual similarity*: both marks begin with the letters ‘FRU’; both end with ‘A’; both have a similar number of letters;
- (b) *Phonetic similarity*; both marks have the same phonetic stress when spoken aloud; again, both have the same sounds at the beginning and end of the words;
- (c) *Conceptual similarity*; both marks are amalgams of the word or idea of ‘fruit’ with another word of superlative import; in the Applicant’s case, ‘fantastic’; in the Opponent’s case, ‘Utopia’. The ‘fruit’ part is at the beginning of each mark;
- (d) *Artistic similarity*; in addition to the above, the opposed mark creates a similar artistic impression to that of the Opponent’s device. Both use curly, free-form lettering; both feature an enlarged middle letter; both enclose the word within a roughly round border; both are intended, and succeed, in giving an ‘exotic’ or a ‘jungle’ feel to the marks. It should be taken into account that the normal use of the mark applied for will be on a label, where it will probably be flanked by extraneous illustration etc. making the similarity with the Opponent’s device even greater;
- (e) *Reduced importance of descriptiveness of the words*: The artistic form of the lettering in both device marks not only conveys a similar impression to the viewer, but it also serves to obscure, at a quick glance, any differences between the actual words contained in each of the marks, making confusion even more likely.”

21. The visual and aural similarity derives from the prefixes FRU and FRUIT, but as these may allude to the goods or a characteristic of them, I believe it is the suffixes which the viewer and listener will connect with in relation to the goods involved. Visually and aurally there are plainly significant differences between the two suffixes and therefore when considering these two means of comparisons, I believe that the respective trade marks are not similar, certainly or not similar enough to cause confusion.

22. Insofar as the conceptual similarity is concerned, I consider there is some merit in Mr Morcom's submissions. The two trade marks do make play on the words 'fantastica' and 'utopia' both of which have laudatory connotations in a combination with the illusory term FRUIT or FRU. Also, both words are represented in a fanciful script with the characteristics described by Mr Morcom.

23. Bearing in mind that these trade marks would appear on identical goods, which are likely to be low cost items the combination of very similar fanciful scripts coupled with conceptually similar trade marks means that the average consumer is likely to perceive that the two trade marks were similar, similar enough to cause confusion as to origin and therefore the ground of opposition under Section 5(2)(b) insofar as the above earlier trade marks are concerned is made out.

24. In relation to the opponent's other trade marks ie. those in plain block capitals, I do not consider that, on the basis of a global appreciation, the same factors exist in terms of the comparison. Absent the fanciful script and unusual border in the opponent's trade mark significantly changes the conceptual similarity and it means that the differences between the applicant's and the opponent's trade marks outweigh the similarities. The ground of opposition based on Section 5(2)(b) in respect of registration Nos 1561654, 1562841 and 2061482 is therefore not made out.

25. Mr Morcom, I think, accepted that the opponent was not likely to be better off under the ground based upon Section 5(4)(a) than that under Section 5(2)(b), where they have been successful in part. However, for completeness, and having regard to the criteria set out for the Registrar by Mr Geoffrey Hobbs QC acting as the Appointed Person in *WILD CHILD* [1998] RPC 455 I will record my view that the opponent's case is not made out. The evidence they provided does not, as indicated earlier, amount to evidence showing that they have a reputation and that the sign used will be accordingly recognised as theirs. In reaching that decision I also bear in mind the views of Mr Justice Pumfrey on evidence in passing off cases in *South Cone Inc. v Jack Bessant & Others* [2002] RPC 19. The ground of opposition under Section 5(4)(a) is not made out.

Costs

26. The opponent has been successful in these proceedings and is therefore entitled to an award of costs. As indicated at paragraph 5 above, at the conclusion of the statutory evidence rounds I reviewed these proceedings and indicated to the parties that in my view a decision could be reached without the need for oral submissions. I communicated this view to the parties in a letter dated 29 October 2001. The chronology of the correspondence from the parties and the Trade Marks Registry following my letter is as follows:

- letter dated 29 November 2001 from the applicant’s attorneys Marks & Clerk requesting an oral hearing;
- letter dated 21 December 2001 from the opponent’s attorneys Carpmaels & Ransford indicating that their clients would be represented at the oral hearing by Counsel;
- letter dated 29 January 2002 from Marks & Clerk indicating that it was also the applicant’s intention to be represented by Counsel at the oral hearing;
- letter dated 6 March 2002 from Carpmaels & Ransford indicating that Mr Morcom would be representing the opponent at the oral hearing;
- letter dated 24 April 2002 from the Trade Marks Registry giving notice that the oral hearing would be held at 10.30am on 20 June 2002;
- letter dated 3 May 2002 from Marks & Clerk indicating that it is their understanding that the applicant will be represented by Counsel (Mr Hamer) at the oral hearing;
- letter dated 18 June 2002 from Marks & Clerk in the following terms:

“Further to our letter dated 29 November 2001, in which we confirmed the applicant’s request for an oral hearing, we are now advised that the client is prepared to have a decision taken on the papers on file.

In the event that the Hearing Officer is not prepared to issue his decision on the papers on file, we are writing to confirm that the applicant will not be attending the hearing scheduled for 10.30am on 20 June 2002. Consequently, counsel, Mr George Hamer, will not be appearing.”

27. At the hearing, Mr Morcom made a number of submissions on costs. It is, I think, fair to say that his main criticism was in relation to the applicant’s belated notification (dated 18 June 2002 - only two days before the oral hearing) that they were now content for a decision to be taken from the papers on file and would not be attending the oral hearing which they themselves had requested. In this regard Mr Morcom said:

“...But in this particular type of situation, of course it is well known to trade mark attorneys throughout the land that skeleton arguments have to be prepared. Everybody has some basic idea of the amount of costs which are involved if counsel has to prepare skeleton arguments and prepare for a hearing. With that in mind, to come up with a suggestion at the time it came, a without prejudice letter and the letter to the office saying, “Please decide it on the papers contrary to what we originally asked” is much too late at a time when it must have been known that these costs would have been incurred.”

28. At the hearing I said:

“I am particularly concerned in this case that it was the applicant - if I recall events I wrote out to the parties saying that I had a look at this case and the evidence filed and

I thought that I could take a view on the papers filed. The applicant then said, no, they wanted a hearing. Which is of course their right. That was not a problem. The opponents, therefore, said that they would be appointing yourself. The date for the hearing was fixed and then days before they withdraw I am conscious, therefore, that the expense of coming along to a hearing might be properly said to be one that was incurred unnecessarily in all the circumstances and it might well be something that the other side have to make some, or a significant, contribution towards.”

29. At the conclusion of the hearing I asked for Mr Morcom’s instructing agent to compile details of the costs involved in relation to the hearing. In a letter dated 27 June 2002, Carpmaels & Ransford responded to my request in the following terms:

“As requested by Mr Knight, I set out herewith a schedule of the costs incurred by the opponent in relation to the preparation and attendance at the main hearing.

Counsels fees for preparation of skeleton arguments and representation at the hearing - £2,250

Instructing agents fees for preparation for and attendance at the hearing - £400.”

30. In a letter dated 28 August 2002 I wrote to Marks & Clerk enclosing the relevant portion of the transcript which related to costs and sought their views on Mr Morcom’s submissions in this regard. They responded in a letter dated 3 October 2002. The main points I take from this letter are as follows:

- that the applicant had instructed Marks & Clerk to request a hearing;
- that in subsequent correspondence the applicant had indicated that they might after all accept the Registrar’s original proposal to decide the matter on the papers;
- that it was not until 14 June 2002 that Marks & Clerk received final instructions from the applicant with regard to “without prejudice” proposals, that were put to the opponent on 18 June 2002;
- that Marks & Clerk recognised that it was probably too late to avoid the hearing taking place but that they wished to give the opponent the opportunity of making their own determination as to whether they should or should not attend the hearing.

31. The final two paragraphs of Marks & Clerk letter read as follows:

“Therefore, the situation we have is no more and no less than a failure on the part of the applicants to show up at the hearing. Had we appeared at the hearing, no question would have been raised as to the propriety of the actions of the applicant. It is therefore extraordinary to suggest that, because of their failure to attend the hearing, the applicants have somehow acted improperly and must be punished for their wrongdoing! In fact, because of the applicant’s failure to attend, the hearing should

have been conducted much quicker than it might otherwise have been and, at least in theory, the opponent's prospects of success must have improved although I very much doubt whether, in practice, it would have made any difference.

Costs, of course, follow the event and are awarded in favour of the successful party. We have no problem with this. However, it is quite unacceptable to suggest that costs should be awarded on an indemnity basis simply because one party has the honesty to advise that they have changed their mind and no longer wish to be represented at the hearing. I am not aware that failure to attend a hearing is a reason for one of the parties to be penalised. As mentioned above, the proposal that the opposition be determined from the papers was put forward simply to allow the opponents the opportunity of following that option if they wished to do so and I think our letter of 18 June 2002 recognised that the hearing would almost certainly take place.”

32. The Trade Marks Registry's practice of reviewing cases at the conclusion of the statutory evidence rounds and offering a view on how, in the Trade Marks Registry's view, the case should proceed ie. whether a decision can be taken from the papers on file or whether an oral hearing is considered more appropriate was put in place in an effort to assist both the parties and the Trade Marks Registry and whenever possible to reduce costs. In these proceedings I took the view that an oral hearing was not necessary. Of course the parties retained their right to be heard and Marks & Clerk on instructions from their client exercised this right in their letter of 29 November 2001; this was a perfectly proper response.

33. However, from the chronology above, one can see that the oral hearing in these proceedings was scheduled for 20 June 2002, the parties having been notified of this date in the Trade Marks Registry's letter of 24 April 2002. On 14 June 2002 Marks & Clerk were in receipt of their clients final instructions; they communicated these “without prejudice” proposals to the opponent on 18 June 2002; at the same time they advised the Trade Marks Registry that they were now content for a decision to be taken from the papers on file and were not going to attend the hearing. In my view, having themselves requested an oral hearing, this notification came too late. At the hearing Mr Morcom said:

“By deciding and inviting you to consider it on the papers at that later stage after I had done all the work and preparation they were depriving us of the option of saying, “All right, as we have not incurred any expense we will agree to it being considered on the papers”. It is far too late for that to be a viable course for us to take.”

34. Tribunal Practice Notice 5 of 2000 at paragraph (d) makes it clear that all parties professionally represented at substantive hearings before the Trade Marks Registry are required to submit a skeleton argument at least 24 hours in advance of the hearing. By the time the opponent was notified of the applicant's “without prejudice” offer and non-attendance at the hearing, the majority if not all of the preparatory work would have been completed. Had the offer come earlier, then as Mr Morcom suggests the opponent may have been in a position to take a different view; they were not and as a result they are in my view entitled to a contribution towards the costs they incurred in the preparation for, and attendance at, a hearing they may not otherwise have attended.

35. To conclude, I order the applicant to pay to the opponent the sum of £2600 as a contribution towards their costs in these proceedings; this sum reflects a contribution towards the costs incurred in connection with the preparation for and attendance at the hearing (in the amount of £2,000) and £600 in respect of the successful opposition to the application for registration. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 6th day of November 2002

**M KNIGHT
For the Registrar
The Comptroller- General**

ANNEX

(1) TM No. 1561654

App date: 08.02.1994

Status: Registered

Mark: FRUITOPIA

Goods: Non-alcoholic beverages; all containing fruit or being fruit flavoured; fruit juices and fruit drinks; all included in Class 32.

(2) TM No. 1562841

App date: 18.02.1994

Status: Registered

Mark: FRUITOPIA

Goods: All goods included in Class 32; all containing fruit or being fruit flavoured.

(3) TM No. 2023606

App date: 12.06.1995

Status: Registered

Mark:



Goods: Mineral and aerated waters, carbonated and non-carbonated soft drinks, syrups, concentrates and powders used for making beverages; all containing fruit or being fruit flavoured.

(4) TM No. 2061482

App date: 14.03.1996

Status: Registered

Mark: FIND YOUR OWN FRUITOPIA

Goods: Mineral and aerated waters and other non-alcoholic beverages, carbonated and non-carbonated soft drinks, fruit drinks, syrups, concentrates and powders used for making beverages.