

O-202-19

TRADE MARKS ACT 1994

IN THE MATTER OF INTERNATIONAL REGISTRATION NO. 1306625 AND THE
REQUEST BY BEST FRUITS 17 EAD TO PROTECT, IN THE UK, THE
FOLLOWING TRADE MARK:



IN CLASSES 16, 32, 35 AND 39

AND IN THE MATTER OF OPPOSITION THERETO UNDER NO. 411059 BY
ETABLISSEMENTS GEYER FRERES

Background and pleadings

1) Best Fruits 17 EAD ('the holder') applied to protect the following International Trade Mark in the UK ('the designation') on 8 May 2015 under no. 1306625. The holder claims a priority date of 16 January 2015 based on its Bulgarian trade mark no. 135380.



2) The designation includes the following colour claim "The mark contains the colours blue, dark green and white". It was accepted and published in the UK Trade Marks Journal on 15 September 2017. Following a limitation to the goods and services the designation now covers the following goods and services:

Class 16: Sheets of paper or plastic for food packaging; retsiklirana sheets of cellulose for wrapping; packaging materials [sealing, filling] of paper or cardboard; packaging materials made of paper or cardboard; packaging for bottles of cardboard or paper; bags for bottles of cardboard or paper; mats for beer glasses.

Class 32: Preparations for making aerated water; aerated water; aloe vera drinks, non-alcoholic; aperitifs, non-alcoholic; beer; beer wort; beer-based cocktails; preparations for making beverages; non-alcoholic beverages; cider, non-alcoholic; cocktails, non-alcoholic; essences for making beverages; extracts of hops for making beer; non-alcoholic fruit extracts; non-alcoholic fruit juice; beverages; fruit juices/fruit juice; fruit nectars, non-alcoholic; ginger beer/ginger ale; grape must, unfermented; non-alcoholic honey-based beverages; isotonic beverages; kvass [non-alcoholic beverage]; lemonades;

preparations for making liqueurs; lithia water; malt beer; malt wort; milk of almonds [beverage]; mineral water [beverages]; preparations for making mineral water; must; orgeat; pastilles for effervescing beverages; peanut milk [non-alcoholic beverage]; powders for effervescing beverages; sarsaparilla [non-alcoholic beverage]; seltzer water; sherbets [beverages]/sorbets [beverages]; smoothies; soda water; soya-based beverages, other than milk substitutes; syrups for beverages; syrups for lemonade; table waters; tomato juice [beverage]; vegetable juices [beverages]; waters [beverages]; whey beverages.

Class 35: Presentation of retail goods for sale through the communication means.

Class 39: Bottling services; delivery of goods; delivery of goods by mail order; packaging of goods; parcel delivery; wrapping of goods.

3) Etablissements Geyer Freres ('the opponent') partially oppose the designation on the basis of sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 ('the Act'). The designation was also opposed on the basis of section 3(6) but this ground of attack was withdrawn at the hearing and so nothing further shall be said about it.

4) In respect of the section 5(2)(b) and 5(3) claims they are both based on the opponent's earlier International Trade Mark designating the UK ("the earlier mark"). Pertinent details of the earlier mark are as follows:

Number: IR 710929

Mark: **LORINA**

Goods relied upon: Class 32: *Non-alcoholic beverages; fruit drinks; lemonades*

Date of protection of the international registration in UK: 26 November 1999

Date of publication: 25 August 1999

5) The opponent essentially argues that the respective goods/services are identical or similar and that the marks are similar. The statement of case includes further arguments relating to why the marks are similar which I have read and shall bear in mind.

6) With regard to section 5(3) the opponent claims to have a reputation in respect of '*non-alcoholic beverages; fruit drinks; lemonades*'. At this initial stage, it argued that all of the applied for goods and services listed at paragraph 1 should be refused registration. In particular the opponent argues that the holder will benefit from its investment in advertising, leading to advantage. Further that the holder will ride on its coat tails and will benefit from the power of attraction, reputation and prestige of the earlier mark. The opponent also claims that the later use will be out of its control and that poor quality or offensive goods will cause detriment to its valuable reputation and business. It claims that use of the later mark will dilute the distinctive character and reputation of its marks.

7) Turning to the section 5(4)(a) claim the opponent argues to have an alleged earlier right in the sign LORINA. It claims to have been selling '*non-alcoholic beverages; fruit drinks; lemonades*' under this sign since January 2002 and has acquired goodwill under the sign. Therefore, use of the trade mark applied for would therefore be a misrepresentation to the public and result in damage to the aforementioned goodwill.

8) The holder filed a counterstatement denying the claims made. It also requested that the opponent provides proof of use of its earlier trade mark relied upon.

9) Both sides filed evidence in these proceedings. This will be summarised to the extent that it is considered necessary.

10) A hearing took place via video-link on 22 January 2019, with the opponent represented by Ms Hobbs of Cleveland Scott York. The holder filed written submissions in lieu of attendance. These shall not be summarised but shall be referred to where necessary and borne in mind throughout.

Preliminary issue

11) On 10 January 2019, the opponent wrote to the Registry in the following terms:

“The Opponent hereby withdraws its Opposition no.411059 insofar as it is directed at the following goods and services covered by the contested Application no. 1306625:

Class 16: Sheets of paper or plastic for food packaging; retsiklirana sheets of cellulose for wrapping; packaging materials [sealing, filling] of paper or cardboard; packaging materials made of paper or cardboard.

Class 35: Presentation of retail goods for sale through the communication means, in relation to goods other than beverages or preparations for making beverages.

Class 39: Delivery of goods, other than the delivery of drinks; delivery of goods by mail order, other than the delivery of drinks by mail order; packaging of goods, other than the packaging of drinks; parcel delivery, other than the delivery of parcels containing drinks; wrapping of goods, other than wrapping of drinks.

For the avoidance of doubt, the opposition is maintained in relation to the following goods and services covered by Application no. 1306625:

Class 16: Packaging for bottles of cardboard or paper; bags for bottles of cardboard or paper; mats for beer glasses.

Class 32: Preparations for making aerated water; aerated water; aloe vera drinks, non-alcoholic; aperitifs, non-alcoholic; beer; beer wort; beer-based cocktails; preparations for making beverages; non-alcoholic beverages; cider, non-alcoholic; cocktails, non-alcoholic; essences for making beverages; extracts of hops for making beer; non-alcoholic fruit extracts; non-alcoholic

fruit juice; beverages; fruit juices/fruit juice; fruit nectars, non-alcoholic; ginger beer/ginger ale; grape must, unfermented; non-alcoholic honey-based beverages; isotonic beverages; kvass [non-alcoholic beverage]; lemonades; preparations for making liqueurs; lithia water; malt beer; malt wort; milk of almonds [beverage]; mineral water [beverages]; preparations for making mineral water; must; orgeat; pastilles for effervescing beverages; peanut milk [non-alcoholic beverage]; powders for effervescing beverages; sarsaparilla [non-alcoholic beverage]; seltzer water; sherbets [beverages]/sorbets [beverages]; smoothies; soda water; soya-based beverages, other than milk substitutes; syrups for beverages; syrups for lemonade; table waters; tomato juice [beverage]; vegetable juices [beverages]; waters [beverages]; whey beverages.

Class 35: Presentation of retail goods for sale through the communication means, namely preparations for making aerated water, aerated water, aloe vera drinks, non-alcoholic, aperitifs, non-alcoholic, beer, beer wort, beer-based cocktails, preparations for making beverages, non-alcoholic beverages, cider, non-alcoholic, cocktails, non-alcoholic, essences for making beverages, extracts of hops for making beer, non-alcoholic fruit extracts, non-alcoholic fruit juice, beverages, fruit juices/fruit juice, fruit nectars, non-alcoholic, ginger beer/ginger ale, grape must, unfermented, non-alcoholic honey-based beverages, isotonic beverages, kvass [non-alcoholic beverage], lemonades, preparations for making liqueurs, lithia water, malt beer, malt wort, milk of almonds [beverage], mineral water [beverages], preparations for making mineral water, must, orgeat, pastilles for effervescing beverages, peanut milk [non-alcoholic beverage], powders for effervescing beverages, sarsaparilla [non-alcoholic beverage], seltzer water, sherbets [beverages]/sorbets [beverages], smoothies, soda water, soya-based beverages, other than milk substitutes, syrups for beverages, syrups for lemonade, table waters, tomato juice [beverage], vegetable juices [beverages], waters [beverages], whey beverages.

Class 39: Bottling services; delivery of goods namely the delivery of drinks; delivery of goods by mail order, namely the delivery of drinks by mail order;

packaging of goods, namely the packaging of drinks; parcel delivery, namely the delivery of parcels containing drinks; wrapping of goods, namely wrapping of drinks.”

12) During the hearing I queried the intention and purpose of the limitation with Ms Hobbs. She advised that it was to assist me by showing that they are opposing, for example, the “retail” or “delivery” insofar that they relate to drinks. In other words, it was intended to focus my attention on the services which could be used for drinks.

13) In view of the limitation to the opposition, I shall proceed with the opposition being based against the goods and services listed above.

The earlier mark and proof of use requirements

14) The earlier mark qualifies as the acceptable basis to oppose the designation as defined in section 6 of the Act. Since the earlier mark is over 5 years old from the date of publication of the application, and the holder has requested proof of use as set out in section 6A of the Act which states:

“Raising of relative grounds in opposition proceedings in case of non-use

6A. - (1) This section applies where -

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if -

(a) within the period of five years ending with the date of publication of the application the earlier trade mark has 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, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes -

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and

(b) 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.

(5) In relation to a European Union trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Union.

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.”

Relevant period

15) The relevant period for proof of use is the five-year period ending on the date of publication of the designation in the UK, namely 16 September 2012 to 15 September 2017. Under section 100 of the Act the onus is on the opponent to show genuine use of its mark during this period in respect of the goods relied upon.

EVIDENCE

16) The opponent's evidence consists of a witness statement and supporting exhibits from Jean-Pierre Barjon. Mr Barjon is the President of the Board of Directors of the opponent, a position he has held since 1995.

17) Mr Barjon states that the opponent was established in Munster, France in 1960. He states that the opponent's flagship product is LORINA which is "a carbonated soft drink sold in glass bottles with a flip top opener and a rubber seal as well as in more conventional plastic bottles with screw caps", and that the LORINA product has been sold in the UK since 2002.

18) Exhibit JPB3 is an extract from Wikipedia headed "Lorina". It states that Lorina is a French carbonated soft drink created in 1895 and that it comes in 8 flavours: Traditional lemonade, traditional orangeade, French Lemonade, French Berry Lemonade, Pink Lemonade, Blood Orange, Blueberry Pomegranate and Blueberry Lemonade.

19) In terms of turnover for the relevant period, Mr Barjon states that total net turnover for sales of LORINA drinks to the UK amounts to €2,627,485. The turnover figures indicate that the sales are made to the distributors Pettywood and Euro Foods. They include the following product descriptions; lemonade, blood orange, classic lemon, cocolime, sugar free drinks plus strawberry, pomegranate, pomegranate lemon and pear flavoured drinks. These are sold in 1 litre, 75cl, 42cl and 33cl bottles.

20) Mr Barjon states that during the relevant period the opponent’s distributor was initially Petty Wood and subsequently Euro Food Brands Limited. Exhibit JPB6 is a copy of the distribution agreement between the opponent and Euro Foods Brands Limited. The agreement is dated 20 October 2014 and refers to the opponent as a producer of “Sparkling Beverages products”. To support this, Mr Barjon has submitted numerous invoices¹ dated within the relevant period from the opponent to the distributors Petty Wood and Euro Foods. Many of the invoices refer to the goods as “Sparkling”, include the flavour and some are listed as “Non Alcoholic Cocktail Mojito”. Mr Barjon states that goods sold to the current and prior distributors were subsequently sold to the general public via Ocado, Waitrose and Amazon.

21) Exhibit JPB4 consists of various photographs of bottles of Lorina drinks which are sold in various stores via its distributor Euro Food Brands². The drinks were of various flavours including Sicilian lemonade, lemon, pink lemonade and pink citrus lemonade. Below is a table of where and when the photographs took place:

Date	Location	Shop
01/09/2014, 01/10/2014 and 12/11/2014	London	WH Smith
14/09/2016	Northampton	Tesco
15/09/2016	Unknown	Tesco
23/01/2016	London	Tesco

¹ Exhibit JPB11

² Exhibit JPB6 is a copy of the distribution agreement between the opponent and Euro Foods Limited



22) In addition to the shops listed above, Mr Barjon states that the opponent sells its products via “major supermarkets”³ in the UK including Ocadao, Tesco and Waitrose. Exhibit JPB10 consists of a spreadsheet originating from Euro Foods Brands showing the sales of LORINA products sold via Ocadao, Waitrose and Amazon from the beginning of 2015 to September 2017. The spreadsheet demonstrates that “many thousands of LORINA products” were sold in the relevant period to Ocado, Waitrose and Amazon.

23) Mr Barjon has not provided any figures relating to how much the opponent spends on advertising and promotion. He does, however, refer to an extract from “The Grocer” magazine dated 23 April 2016. The article lists LORINA as “6th in the top 20 soft drinks online, based on the websites of Amazon, Asda, Morrisons, Ocado, Sainsbury’s, Tesco and Waitrose in the first two weeks of March 2016”. Mr Barjon explains that the “overall score for each brand depends on image optimisation and content, the availability and depth of range, product rating, reviews and search performance”.

24) Mr Barjon also makes reference to previous disputes between the respective parties. More specifically, he refers to a decision issued by the EU Intellectual Property Office Opposition Division dated 1 September 2015. The opposition was

³ Paragraph 13 of the witness statement



successful against an application for **FLORINA** based on the opponent's earlier French trade mark registration for the mark LORINA. I shall return to this decision later. That concludes my summary of the opponent's evidence.

Applicant's evidence

25) The applicant's evidence consists of a witness statement from Mr Tom Albertini and accompanying exhibits. Mr Albertini is a partner and trade mark attorney at J A Kemp, a position he has held since April 2012.

26) Exhibit TA2 to the witness statement comprises of an extract from "The Grocer" which is a leading industry publication of market research information and data relating to the FMCG (Fast Moving Consumer Goods), and particularly the food and drink, sectors in the UK. The extract, dated 4 May 2017, contains data relating to the size and segmentation of the take home soft drinks market in the UK. It shows in 2017 the total UK market value for such goods was £4.2billion, of which around £1.3billion were sales of carbonated drinks, such as cola, lemonade and fizzy drinks. A further £1.2billion were sales of juice and juice drinks.

27) A further extract⁴ indicates that between 2015 and 2016 the take home flavoured carbonates market was worth in the region of £354million, "with the lemonade market, a separate category, being worth £102.1 million in total."

28) Exhibit TA4 to the witness statement is a copy of the British Soft Drinks Association annual report 2017. Mr Albertini states that according to the British Soft Drinks Association it "is the national trade association representing the interests of producers and manufacturers of soft drinks including carbonated drinks, still and dilatable drinks, fruit juices and bottled waters". Mr Albertini states that the size of the overall soft drinks market is naturally larger than the take home sales market only. He specifically refers to the report which states that between 2011 and 2016 the

⁴ Exhibit TA3

sales value is in the region of £12.6 and £13.8 billion per annum. He also refers to the report which states that for the same period the value of the carbonates market ranges from around £5.6 to £5.9 billion per annum.

DECISION

Proof of use case-law

29) In *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*, [2016] EWHC 52, Arnold J. summarised the case law on genuine use of trade marks. He said:

“217. *The law with respect to genuine use.* In *Stichting BDO v BDO Unibank Inc* [2013] EWHC 418 (Ch), [2013] FSR 35 I set out at [51] a helpful summary by Anna Carboni sitting as the Appointed Person in *SANT AMBROEUS Trade Mark* [2010] RPC 28 at [42] of the jurisprudence of the CJEU in Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439 , Case C-259/02 *La Mer Technology Inc v Laboratoires Goemar SA* [2004] ECR I-1159 and Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759 (to which I added references to Case C-416/04 *P Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237). I also referred at [52] to the judgment of the CJEU in Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16 on the question of the territorial extent of the use. Since then the CJEU has issued a reasoned Order in 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] and that Order has been persuasively analysed by Professor Ruth Annand sitting as the Appointed Person in *SdS InvestCorp AG v Memory Opticians Ltd* (O/528/15).

218. An important preliminary point to which Prof Annand draws attention in her decision is that, whereas the English versions of Articles 10(1) and 12(1) of the Directive and Articles 15(1) and 51(1)(a) of the Regulation use the word “genuine”, other language versions use words which convey a somewhat different connotation: for example, “ernsthaf” (German), “efectivo” (Spanish),

“sérieux” (French), “effettivo” (Italian), “normaal” (Dutch) and “sério/séria” (Portuguese). As the Court of Justice noted in *Ansul* at [35], there is a similar difference in language in what is now recital (9) of the Directive.

219. I would now summarise the principles for the assessment of whether there has been genuine use of a trade mark established by the case law of the Court of Justice, which also includes Case C-442/07 *Verein Radetzky-Orden v Bundesvereinigung Kameradschaft 'Feldmarschall Radetzky'* [2008] ECR I-9223 and Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR 7, 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].

(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].

(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].

(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].”

30) In *Awareness Limited v Plymouth City Council* Case BL O/236/13 Mr Daniel Alexander Q.C. as the Appointed Person stated that:

“22. The burden lies on the registered proprietor to prove use...However, it is not strictly necessary to exhibit any particular kind of documentation, but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public...”

“28. ...I can understand the rationale for the evidence being as it was but suggest that, for the future, if a broad class, such as “tuition services”, is sought to be defended on the basis of narrow use within the category (such as for classes of a particular kind) the evidence should not state that the mark has been used in relation to “tuition services” even by compendious reference to the trade mark specification. The evidence should make it clear, with precision, what specific use there has been and explain why, if the use has only been narrow, why a broader category is nonetheless appropriate for the specification. Broad statements purporting to verify use over a wide range by reference to the wording of a trade mark specification when supportable only in respect of a much narrower range should be critically considered in any draft evidence proposed to be submitted.”

I begin by reminding myself that the relevant period is between 16 September 2012 and 15 September 2017. Further, the goods which the opponent must demonstrate genuine use are “*Non-alcoholic beverages; fruit drinks; lemonades*”.

Sufficient use

31) Proven use of a mark which fails to establish *that “the commercial exploitation of the mark is real”* because the use would not be “viewed as warranted in the economic sector concerned to maintain or create a share in the [European Union] market for the goods or services protected by the mark” is therefore not genuine use.

32) An assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself.⁵

33) The holder has not provided any comment or arguments relating to the sufficiency of use of the earlier mark during the relevant period, save for whether the use has been for all of the relied upon goods. I shall address this later.

34) The opponent’s evidence includes uncontested UK turnover figures for the relevant period which are in excess of €2.6m. The evidence also includes numerous invoices, dated within the relevant period, for the sale of various drinks to UK distributors. Further, the evidence also includes photographs of the goods on sale at various WH Smith and Tesco stores in London and Northampton. There are also spreadsheets which detail sales of LORINA drinks to Ocado, Tesco and Waitrose (all of which are large UK foods and drink retailers).

35) The evidence is not without its deficiencies. For example, it does not include what it spends on advertising and marketing the goods, nor does it provide any indication of market share. However, I have no reservation in concluding that the mark has been used during the relevant period.

Form of use

36) The holder has not provided any arguments that the form in which the mark has been used differs to what is registered, i.e. **LORINA**.

⁵ *New Yorker SHK Jeans GmbH & Co KG v OHIM T-415/09*

37) The word LORINA appears in normal font on invoices. In relation to the bottles the mark is presented as follows:



38) As can be seen, the only difference is that the first and last letters (“L” and “A” respectively) are in slightly larger font. It is my view that the sign used differs in elements to the mark as registered which do not alter the latter’s distinctive character. In other words, the differences between the mark used and the designation are minimal and do not alter the distinctive character of the designation⁶. It is an acceptable variant.

Fair specification

39) I must now consider whether, or the extent to which, the evidence shows use for all or only some of the relied upon goods. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law as being:

“In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”

40) In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), Mr Justice Carr summed up the law relating to partial revocation as follows.

⁶ Guidance provided in *Nirvana Trade Mark*, BL O/262/06 at paragraphs 33 and 34.

“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 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 Plc* [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.”

41) The earlier mark covers the following specification “non-alcoholic beverages; fruit drinks; lemonades”. The holder argues that the evidence does not show any use for the earlier mark relied upon “*non-alcoholic beverages; fruit drinks*”. It goes on to state that “At best, use is shown in relation to ‘carbonated soft drinks containing fruit; lemonades’, which is something the Opponent itself appears to admit at paragraph 3 of the Witness Statement of Jean-Pierre Barjon dated 18 May 2018.” The paragraph referred to describes LORINA as “a carbonated soft drink” and that “it is a premium soft drink made of water...mixed with fruit”. The holder also argues that the evidence demonstrates that “sugary carbonated beverages (which the public may know as “fizzy drinks”) form an independent sub-category of drinks”.

42) During the hearing Ms Hobbs helpfully conceded that “non-alcoholic beverages” is too broad a category to reflect the goods for which the earlier mark has been used. She then went on to refer me to the distribution agreement between the opponent and Euro Foods Brands Limited which states that the opponent “produces *Sparkling Beverages* products”⁷.

43) There is no doubt that the opponent has used its mark for lemonades. The evidence also shows that the mark has been used for various carbonated fruit flavoured drinks. This is demonstrated with the invoices referring to the goods as sparkling and references to the opponent as a carbonated soft drinks company⁸. For the avoidance of doubt, I consider the drinks in question to be referred to as sparkling since they have been carbonated and I consider carbonated to be a more clear and precise term than sparkling. The evidence also includes evidence of use of the mark in respect of non-alcoholic mojitos which are not carbonated.

44) Taking all of the above into account I find that a suitable specification to be “*Non-alcoholic fruit flavoured carbonated beverages; non-alcoholic mojitos; fruit drinks; lemonades*”.

⁷ Exhibit

⁸ Exhibit JPB3 wikipedia entry and the distribution agreement at exhibit JPB6

Section 5(2)(b)

45) Section 5(2)(b) of the Act is as follows:

“5(2) A trade mark shall not be registered if because-

(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”.

Case law

46) The following principles are gleaned from the decisions of the EU courts 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:

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

(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

47) Following my proof of use assessment, the respective goods and services are:

Holder's goods	Earlier goods
<p>Class 16: Packaging for bottles of cardboard or paper; bags for bottles of cardboard or paper; mats for beer glasses.</p> <p>Class 32: Preparations for making aerated water; aerated water; aloe vera drinks, non-alcoholic; aperitifs, non-alcoholic; beer; beer wort; beer-based cocktails; preparations for making beverages; non-alcoholic beverages; cider, non-alcoholic; cocktails, non-alcoholic; essences for making beverages; extracts of hops for making beer; non-alcoholic fruit extracts; non-alcoholic fruit juice; beverages; fruit juices/fruit juice; fruit nectars, non-alcoholic; ginger beer/ginger ale; grape must, unfermented; non-alcoholic honey-based beverages; isotonic beverages; kvass [non-alcoholic beverage]; lemonades; preparations for making liqueurs; lithia water; malt beer; malt wort; milk of almonds [beverage]; mineral water [beverages]; preparations for making mineral water; must; orgeat; pastilles for effervescing beverages; peanut milk [non-alcoholic beverage]; powders for effervescing beverages; sarsaparilla [non-alcoholic beverage]; seltzer water; sherbets [beverages]/sorbets [beverages]; smoothies; soda water; soya-based beverages, other than milk substitutes; syrups for beverages; syrups for lemonade; table waters; tomato juice [beverage]; vegetable juices [beverages]; waters [beverages]; whey beverages.</p> <p>Class 35: Presentation of retail goods for sale through the communication means, namely the presentation of preparations for making aerated water, aerated water, aloe vera drinks, non-alcoholic, aperitifs, non-alcoholic, beer, beer wort, beer-based</p>	<p>Class 32: Non-alcoholic fruit flavoured carbonated beverages; non-alcoholic mojitos; fruit drinks; lemonades.</p>

cocktails, preparations for making beverages, non-alcoholic beverages, cider, non-alcoholic, cocktails, non-alcoholic, essences for making beverages, extracts of hops for making beer, non-alcoholic fruit extracts, non-alcoholic fruit juice, beverages, fruit juices/fruit juice, fruit nectars, non-alcoholic, ginger beer/ginger ale, grape must, unfermented, non-alcoholic honey-based beverages, isotonic beverages, kvass [non-alcoholic beverage], lemonades, preparations for making liqueurs, lithia water, malt beer, malt wort, milk of almonds [beverage], mineral water [beverages], preparations for making mineral water, must, orgeat, pastilles for effervescing beverages, peanut milk [non-alcoholic beverage], powders for effervescing beverages, sarsaparilla [non-alcoholic beverage], seltzer water, sherbets [beverages]/sorbets [beverages], smoothies, soda water, soya-based beverages, other than milk substitutes, syrups for beverages, syrups for lemonade, table waters, tomato juice [beverage], vegetable juices [beverages], waters [beverages], whey beverages.

Class 39: Bottling services; delivery of goods namely the delivery of drinks; delivery of goods by mail order, namely the delivery of drinks by mail order; packaging of goods, namely the packaging of drinks; parcel delivery, namely the delivery of parcels containing drinks; wrapping of goods, namely wrapping of drinks.

48) In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, the General Court stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM- Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or

where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

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

“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”.

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

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

Class 16

51) The opponent argues that the evidence shows that its goods are sold in flip top glass bottles and therefore the applied for bags and packaging for such bottles

“cannot fail to be associated with the product itself”⁹. It argues the same in relation to the applied for *mats for beer glasses*. I disagree. I do not see any degree of similarity between the earlier goods and those applied for under class 16. They would not usually be produced by the actual producers of the drink but would be produced for them bearing the mark. Further, they clearly differ in nature and purpose. They are not similar.

Class 32

52) The earlier and applied for mark include the identical term *lemonades*.

53) Applying the principle set in *Merix*, I consider the applied for *non-alcoholic beverages; non-alcoholic fruit juice; beverages; fruit juices/fruit juice*; to be identical to the earlier *non-alcoholic fruit flavoured carbonated beverages; fruit drinks*.

54) I also consider the applied for *cocktails, non-alcoholic* to be sufficiently broad to include, and therefore be identical to, the earlier *non-alcoholic mojitos*.

55) All of the following goods are non-alcoholic drinks. Therefore, they have the same nature insofar that they are for consuming to quench thirst, in social surroundings or purely for a pleasurable taste. They are likely to be produced by the same undertakings and sold in close proximity to one another. They are in competition and therefore I consider them to be highly similar to the opponent's earlier goods:

Aerated water; aloe vera drinks, non-alcoholic; aperitifs, non-alcoholic; lithia water; milk of almonds [beverage]; Isotonic beverages; kvass [non-alcoholic beverage]; mineral water [beverages]; peanut milk [non-alcoholic beverage]; seltzer water; soda water; table waters; waters [beverages]; cider, non-alcoholic; ginger beer/ginger ale; non-alcoholic honey-based beverages; sarsaparilla [non-alcoholic beverage]; smoothies; soya-based beverages,

⁹ Paragraph 27 of the opponent's skeleton argument.

other than milk substitutes; tomato juice [beverage]; vegetable juices [beverages]; whey beverages

56) I now turn to the applied for goods which contain alcohol, namely *beer; beer-based cocktails; malt beer*. During the hearing Ms Hobbs referred me to the UKIPO decisions involving the marks BUZZ¹⁰ and SOSYO¹¹ whereby 'beer' was found to include non-alcoholic beer and it was stated that, "as well as ginger beer, root beer etc. Such goods are carbonated drinks and therefore identical to the goods covered by the prior right relied upon". Following the proof of use assessment, the earlier relied upon goods no longer include the broad non-alcoholic beverages term and they are further limited to being fruit flavoured and carbonated. Whilst the applied for 'alcohol' based drinks may be carbonated they are not fruit flavoured and are therefore not identical. However, since the applied for goods would cover non-alcoholic equivalents they share the same nature, purpose, would be sold in close proximity and are in competition with one another. They are similar to at least a medium degree.

57) I now turn to the applied for: *Preparations for making aerated water; preparations for making mineral water; preparations for making beverages; non-alcoholic fruit extracts; essences for making beverages; pastilles for effervescing beverages; powders for effervescing beverages; sherbets [beverages]/sorbets [beverages]; syrups for beverages; syrups for lemonade; grape must, unfermented; fruit nectars, non-alcoholic*. These goods are all preparations are goods which, when diluted, create still or carbonated drinks. The nature of the goods differs because the applied for goods are not the finished drink product. There is a degree of competition between the goods since one may buy the finished product or purchase the applied for goods and make the drink themselves. Further, the respective goods may be found nearby in supermarkets. I find that they are similar to a medium degree.

58) With regard to the applied for *beer wort; extracts of hops for making beer; must; orgeat; preparations for making liqueurs; malt wort*, these are specialist goods. They are a product used in the creation of the beverages, some of which are listed in the

¹⁰ O-391-17 Khatijah Shah v Boost Juice Holdings Pty Ltd

¹¹ O-514-14

holder's specification. Such goods are likely to be available from different trade channels and will be available through specialist stores rather than general consumer retail outlets. They will have different uses, with one being for consumption and the other to produce the end product for which it is intended.

59) Further, they are not goods which are simply added to water to produce a different type of drink and so they have different methods of use. They are not in competition. They are dissimilar.

Class 35

60) There was some debate at the hearing as to the meaning of the term of "presentation of goods for sale through communications means, namely the presentation...". Ms Hobbs interprets the term to effectively cover on-line retail services. My understanding of the applied for services are the presentation of the goods rather than the retail thereof. They are more akin to the advertising, marketing and promotional services rather than the sale of the goods themselves. They are services which are likely to be provided by companies to promote and sell their client's goods. Therefore, these services are typically provided by more specialist companies rather than retailers or manufacturers of drinks, i.e. the opponent. Therefore, I find that all of the applied for services to be dissimilar to the earlier relied upon goods.

Class 39

61) During the hearing Ms Hobbs highlighted that the evidence demonstrates that the goods are produced in large flip top bottles which are part of the marketing of the product. Therefore, she argues that since the bottles are integral then there is some form of link to bottling services. The earlier relied upon goods are for drinks rather than for bottles themselves and I must take a notional view of similarity between the earlier drinks and the applied for services. Applying the criteria set out above, they differ in nature, purpose, methods of use and end users. Therefore, there is no similarity between the opponent's goods and the holder's class 39 services. The same applies for all of the remaining class 39 applied for services.


Comparison of marks

62) It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union 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.”

63) It would be wrong, therefore, to artificially dissect the trade marks, although, 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.

64) The respective trade marks are shown below:

The designation	The earlier mark
	LORINA

65) The earlier mark consists of the 6-letter invented word LORINA, presented in upper non-stylised font. There are no other elements to contribute to the overall impression of the mark, which is contained in the word itself.

66) The designation consists of the same word (FLORINA) presented one above another of equal length and font size. The top “FLORINA” has a blue border and the one below an identical border but is coloured green. The word FLORINA has no dictionary defined meaning, nor is it allusive to some other meaning. Whilst the words are stylised, I do not consider it to be particularly striking and therefore I find that the dominant and distinctive elements of the mark are the words FLORINA and FLORINA.

67) Aurally, the designation consists of FLORINA repeated twice. I accept that the average consumer is unlikely to say FLORINA twice when referring to the goods in question. The opponent also argues that the letter ‘F’ at the beginning of the word is very soft in comparison with the ‘OR’ and ‘INA’ elements. In the holder’s submissions it argues that “the letter ‘F’ obviously creates a different sound. It also submits that the ‘FLOR’ element will be pronounced as a long syllable, like ‘FLOOR’ (as in “flora”), whereas the ‘LOR’ element of LORINA will be a shorter less emphasised syllable, more like the ‘loh’, as in ‘lorry’.” The holder argues, therefore, that there is only a minor degree of similarity (at most).

68) In my view, the holder’s mark would be pronounced as “FLORE-EEN-A” and the earlier mark as “LORE-EEN-A”. Therefore, they differ with the ‘FL’ sound at the beginning of the mark. Ms Hobbs argues that the ‘LAW’ sound is “very strong”. Whilst I am not persuaded by this particular argument, I find that the respective marks aurally similar to an above medium degree.

69) In respect of the visual assessment, the opponent argues as follows:

“Visually, the overall impression of the mark is FLORINA, a seven letter mark where letters 2-7 are identical to the mark LORINA. Although Best Fruits argues that the first letter F is likely to be given additional weight, Geyer

disputes that contention precisely because it is not a separate and standalone part of the FLORINA mark. We would also point out that, because of the round shape of bottles, the letter F could easily be hidden from view when FLORINA bottles are placed on shelves. There is therefore visual similarity between the marks.”

70) The holder argues that the repetition of FLORINA in the designation cannot be dismissed. Further, it warned against artificially dissecting the F from LORINA.

71) The marks do coincide with the 2nd to 7th letters within the words FLORINA and LORINA respectively. However, they differ insofar that the designation contains two words rather than one, are partly in colour and mildly stylised. Taking all these factors into account, I am of the view that the number of letters being the same and in the same order results in the marks being visually similar to a medium degree.

72) Conceptually, the holder’s mark includes repetition of an invented word and the opponent’s mark consists of an invented word, neither of which has any obvious meaning and therefore a conceptual comparison is not possible, and the position is neutral.

Average consumer and the purchasing act

73) 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*, Case C-342/97.

74) In *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), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably

well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

75) The opponent states that the “average consumer for all of both parties’ goods in class 32 is a member of the general public”. I agree. The opponent argues that since the Class 32 goods are “moderately inexpensive everyday products” they will “be purchased with a low level to average level of care”¹². Whilst I agree that most foods and drink are moderately inexpensive, consumers will nevertheless wish to ensure that what they purchase to consume meets their individual requirements. This may be based on taste or quality of the goods. Therefore, I find that the average consumer is likely to pay a medium degree of attention when selecting the goods or services.

76) The purchasing process for drink is largely a visual process, but I do not ignore the potential for aural use of the mark¹³.

Distinctive character of the earlier trade mark

77) In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in *Joined*

¹² Paragraph 29 of the opponent’s skeleton argument

¹³ General Court (“GC”) in *Simonds Farsons Cisk plc v Office for Harmonization in the Internal Market* (OHIM) Case T-3/04

Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. 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).”

78) The level of distinctive character of a trade mark can vary, depending on the particular goods at issue: a mark may be more distinctive for some goods than it is for others. Distinctiveness can also be enhanced through use of the mark. There has been no explicit claim of enhanced distinctiveness but evidence of use has been filed in support of its section 5(3) of the Act claim. I shall take this as a claim to having an enhanced distinctive character.

79) The evidence has been summarised above and I am required to assess whether, at the relevant date of 16 January 2015, the opponent has demonstrated that it has an enhanced degree of distinctive character.

80) In support of the proof of use claim the opponent states that its sales are in excess of €2.6m over the relevant five-year period. Whilst sales in the millions of euros over five years are *prima facie* respectable, the opponent has not provided any evidence relating to the extent or money spent on promoting its goods. Further, the holder has provided evidence illustrating the very large scale of the soft drinks industry and places in this contest, the opponent’s turnover is very small. However, the opponent has been continually using its mark since 2002 and sells its goods in some of the major UK supermarkets. From the perspective of inherent distinctive character, the earlier mark is the invented word LORINA. It is not allusive to any

characteristic of the goods and, as stated, has no meaning. Therefore, I find that it is has a high degree of inherent distinctive character. If the distinctive character was not already high then it would have been marginally enhanced by virtue of the use made of it.

GLOBAL ASSESSMENT AND OTHER ARGUMENTS

Other arguments

81) The opponent seeks to rely upon a decision from the Opposition Division of the EUIPO dated 1 September 2015 whereby the opponent successfully opposed an



application for the mark **FLORINA** based on its earlier French LORINA registration. I have read and acknowledge the points made in the aforementioned decision and it is always desirable to adopt a uniform approach¹⁴. However, as discussed at the hearing I pointed out that since the earlier mark is a French trade mark registration, the relevant public for that decision would be France. This is expressly stated in the decision at section b. Therefore, considering a likelihood of confusion based on France being the relevant public clearly distinguishes that case from me having to decide the position from the UK perspective. Notwithstanding this, Ms Hobbs maintains that certain elements of the decision are immediately applicable to this opposition and I shall bear these in mind.

82) During the hearing Ms Hobbs argued that since the bottles are placed in a fridge and could be positioned in such a way that the goods could be seen as LORINA rather than FLORINA, confusion may arise. I am not permitted to take this approach. I must assess the marks on a notional basis which may include use with different types of packaging such as cartons or bottles with distinct edges where marks are not likely to be partially obscured but not by the potential positioning within a fridge.

83) 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

¹⁴ See Mr James Mellor QC comments, sitting as the Appointed Person in BREXIT dated 27 April 2018 (BL O-262-18)

accordance with the authorities set out earlier in this decision. It is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the opponent's trade marks, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be alive to the fact 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 that he has retained in his mind.

84) Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other. Indirect confusion is where the consumer notices the differences between the marks but concludes that the later mark is another brand of the owner of the earlier mark or a related undertaking.

85) To determine whether there is a likelihood of direct or indirect confusion I now draw together my earlier findings into the global assessment of the likelihood of confusion, keeping in mind the factors I have set out above.

86) All of the opposed services and some of the goods were found to be dissimilar. Since similarity between goods and services is essential for finding a likelihood of confusion, where no similarity is found the section 5(2)(b) claim fails. Of the remaining goods, some are identical and the rest are similar to varying degrees.

87) I have found that the respective marks are aurally similar to an above medium degree and visually similar to a medium degree. Since neither mark has any meaning a conceptual comparison is not possible, so the position is neutral. I have also found that since the earlier mark is an invented word, it has a high degree of inherent distinctive character which has not been enhanced through use. I concluded that the goods will be purchased following a visual inspection of the goods whereby an average degree of attention will be paid. Taking all of the above factors into account I find that there is a likelihood of direct confusion. Whilst I acknowledge and fully take into account that there are two words in the application rather than one, I find that the

overall similarity between the marks and the high degree of distinctive character of the earlier mark all lead me to conclude that confusion is likely to arise. I find that the risk of confusion is also likely for the goods which are not identical.

88) Since the section 5(2)(b) claim has only succeeded in part I shall consider the section 5(3) and 5(4)(a) claims against the remaining goods and services.

SECTION 5(3)

89) Section 5(3) states:

“(3) A trade mark which-

(a) 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 (or, in the case of a European Union trade mark or international trade mark (EC), in the European Union) 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.”

Case law

90) 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, *Addidas-Salomon*, Case C-487/07, *L’Oreal v Bellure* and Case C-323/09, *Marks and Spencer v Interflora*. 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; *General 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) 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*.

(g) 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*.

(h) 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*.

(i) 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*).

91) The conditions of section 5(3) are cumulative. Firstly, the applicant must show that its earlier marks have achieved a level of knowledge/reputation amongst a significant part of the public. Secondly, the applicant must establish that the public will make a link between the marks, in the sense of the earlier marks being brought to mind by the later marks. Thirdly, assuming that the first and second conditions have been met, section 5(3) requires that one or more of three types of damage claimed by the opponent will occur. It is unnecessary for the purposes of section 5(3) 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 public will make a link between the marks.

92) The relevant date for the assessment under section 5(3) is the priority date of the contested designation, namely 16 January 2015.

Reputation

93) The first hurdle that the applicant must overcome is that it has the requisite reputation. The relevant case law can be found in *General Motors*, Case C-375/97, whereby the CJEU held that:

“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.”

94) The opponent is claiming to have a reputation for the mark **LORINA** in respect of ‘*non-alcoholic beverages; fruit drinks; lemonades*’. However, following the proof of use assessment it must follow that its claim to reputation cannot logically exceed the goods which I have found use for, namely: “Class 32: *Non-alcoholic fruit flavoured carbonated beverages; non-alcoholic mojitos; fruit drinks; lemonades*”.

95) The opponent argues that “proving a reputation is not especially onerous”¹⁵. It also argues that it has the requisite reputation since it has been used in the UK since 2002 and sold in supermarkets such as Tesco, Waitrose and Asda. Further, it has its own Wikipedia page¹⁶. It also specifically refers to the applicant’s evidence which

¹⁵ Paragraph 34 of the opponent’s skeleton argument

¹⁶ Exhibit JPB3

aims at demonstrating the size of the market and what share of the market the opponent enjoys. The opponent estimates this to be in the region of one half of a percent which it claims to be significant in a crowded market.

96) The opponent has not submitted any advertising and promotional spend. The only evidence relating to advertising is an article from The Grocer which places Lorina as 6th in the top 20 soft drinks but this is based on “overall score for each brand depends on image optimisation and content, the availability and depth of range, product rating, reviews and search performance”. I find it hard to accept the basis of Lorina being placed 6th as a contribution to the opponent having a reputation.

97) The evidence does indicate that there have been continuous sales of the goods for 13 years prior to the relevant date (2002 – 2015). The unchallenged witness statement of the opponent also states that the sales have been to some of the major supermarkets. However, whilst sales in the region of €2.6m over a five-year period are respectable, they are not striking for the purposes of supporting a claim to having a reputation.

98) Taking all of the evidence into account, I accept that there is a modest (at best) reputation in “*Non-alcoholic fruit flavoured carbonated beverages; fruit drinks; lemonades*” but not “*non-alcoholic mojitos*”. This is because in the absence of marketing and advertising material and money spent, sales figures which I do not consider to be striking and no real indication of the extent of use, there is little basis to find anything stronger than a modest reputation. Further, it is for the opponent to demonstrate that it has reputation in order to rely upon it and in the circumstances, I am unable to conclude that the evidence sufficiently demonstrates a reputation.

Link

99) As I have noted above, my assessment of whether the public will make the required mental ‘link’ between the marks must take into account all of the relevant factors. The factors identified in *Intel* are:

The degree of similarity between the conflicting marks

100) I earlier found that the marks have an above medium degree of aural similarity, a medium degree of visual similarity and that they are conceptually neutral.

The nature of the goods or services for which the conflicting marks are registered, or proposed to be registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public

101) For the goods and services that the section 5(2)(b) fails, I have found them all to be dissimilar. For the class 32 goods I have found to be dissimilar they are all goods used in the production of beer products. They would be sought by businesses looking to produce beer and they are specialist services. Therefore, was clear dissimilarity. With regard to the services and the class 16 goods they are more likely to be sought by businesses looking to distribute their products, bottle them, or provide materials for them to be transported or packed. Once again there is disparity between these and the earlier goods.

The strength of the earlier mark's reputation

102) I have found that the earlier mark has a qualifying reputation which I consider to be modest (at best).

The degree of the earlier mark's distinctive character, whether inherent or acquired through use

103) The earlier mark has a high degree of inherent distinctive character. I have found that this has not been further enhanced by virtue of the use of the mark for the reasons already expressed.

Whether there is a likelihood of confusion

104) There is no likelihood of confusion.

105) Taking all of these factors into account, I am not satisfied that there is a link between the earlier goods and those which the opposition has not already succeeded. A member of the relevant public encountering the holder's mark will not bring the earlier mark to mind, for dissimilar goods and services, in any more than the most fleeting manner. Any potential link would be far too weak to cause any damage to the earlier mark's modest (at best) and distinctive character which would lead to any damage.

106) The section 5(3) ground fails.

SECTION 5(4)(a)

107) I shall now assess the opponent's section 5(4)(a) claim against the goods and services which the section 5(2)(b) and 5(3) claims failed.

108) Section 5(4)(a) of the Act states:

"A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented –

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

(b) [.....]

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of "an earlier right" in relation to the trade mark."

Case law

109) In *Discount Outlet v Feel Good UK*, [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

“55. The elements necessary to reach a finding of passing off are the ‘classical trinity’ of that tort as described by Lord Oliver in the Jif Lemon case (Reckitt & Colman Product v Borden [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56. In relation to deception, the court must assess whether “*a substantial number*” of the Claimants' customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21).”

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

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

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

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

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

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

(a) the nature and extent of the reputation relied upon;

(b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;

(c) the similarity of the mark, name etc. used by the defendant to that of the plaintiff;

(d) the manner in which the defendant makes use of the name, mark etc. complained of and collateral factors; and

(e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.”

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

Relevant date

111) Since the opponent has not filed any evidence to support that it has used its mark, the date at which I must assess the section 5(4)(a) claim is the date of the UK designation¹⁷ or, as is the case here, the claimed priority date, i.e. 16 January 2015.

¹⁷ *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-410-11, Mr Daniel Alexander QC as the Appointed Person

Goodwill

112) In *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 the House of Lords defined goodwill as:

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start.”

113) I am satisfied for the reasons given above when assessing reputation under section 5(3) that the opponent had a protectable goodwill in respect of “*Non-alcoholic fruit flavoured carbonated beverages; fruit drinks; lemonades*”. I am also satisfied that the sign was distinctive of the opponent’s business at that date.

Misrepresentation

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

“There is no dispute as to what the correct legal principle is. As stated by *Lord Oliver of Aylmerton in Reckitt & Colman Products Ltd. v. Borden Inc.* [1990] R.P.C. 341 at page 407 the question on the issue of deception or confusion is

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

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

And later in the same judgment:

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

115) In *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation* [2016] EWCA Civ 41, Kitchin LJ considered the role of the average consumer in the assessment of a likelihood of confusion. Kitchen L.J. concluded:

“... if, having regard to the perceptions and expectations of the average consumer, the court concludes that a significant proportion of the relevant public is likely to be confused such as to warrant the intervention of the court then it may properly find infringement.”

116) Although this was an infringement case, the principles apply equally under 5(2): see *Soulcycle Inc v Matalan Ltd*, [2017] EWHC 496 (Ch). In *Marks and Spencer PLC v Interflora*, [2012] EWCA (Civ) 1501, Lewinson L.J. had previously cast doubt on whether the test for misrepresentation for passing off purposes came to the same thing as the test for a likelihood of confusion under trade mark law. He pointed out that it is sufficient for passing off purposes that “*a substantial number*” of the relevant public are deceived, which might not mean that the average consumer is confused. However, in the light of the Court of Appeal’s later judgment in *Comic Enterprises*, it seems doubtful whether the difference between the legal tests will (all other factors being equal) produce different outcomes. This is because they are both normative tests intended to exclude the particularly careless or careful, rather than quantitative assessments.

117) Whilst I am satisfied that the opponent had a protectable goodwill I am not satisfied that “a substantial number” of the opponent’s customers or potential customers will be deceived. In other words, I do not see how the opponent could be in any better position to argue that there would be misrepresentation (or likelihood thereof) if there is no confusion, as concluded above. The legal tests differ, but the outcome would be the same. Therefore, the section 5(4)(a) ground of opposition fails.

OVERALL CONCLUSION

118) The opposition has succeeded against the following goods and services. Therefore, subject to appeal, they shall be refused registration:

Class 32: Preparations for making aerated water; aerated water; aloe vera drinks, non-alcoholic; aperitifs, non-alcoholic; beer; beer-based cocktails; preparations for making beverages; non-alcoholic beverages; cider, non-alcoholic; cocktails, non-alcoholic; essences for making beverages; non-alcoholic fruit extracts; non-alcoholic fruit juice; beverages; fruit juices/fruit juice; fruit nectars, non-alcoholic; ginger beer/ginger ale; grape must, unfermented; non-alcoholic honey-based beverages; isotonic beverages; kvass [non-alcoholic beverage]; lemonades; lithia water; malt beer; milk of almonds [beverage]; mineral water [beverages]; preparations for making mineral water; pastilles for effervescing beverages; peanut milk [non-alcoholic beverage]; powders for effervescing beverages; sarsaparilla [non-alcoholic beverage]; seltzer water; sherbets [beverages]/sorbets [beverages]; smoothies; soda water; soya-based beverages, other than milk substitutes; syrups for beverages; syrups for lemonade; table waters; tomato juice [beverage]; vegetable juices [beverages]; waters [beverages]; whey beverages.

119) The opposition has failed in respect of the following goods and services. Therefore, subject to appeal, they will be registered:

Class 16: Sheets of paper or plastic for food packaging; retsiklirana sheets of cellulose for wrapping; packaging materials [sealing, filling] of paper or cardboard; packaging materials made of paper or cardboard; packaging for bottles of cardboard or paper; bags for bottles of cardboard or paper; mats for beer glasses.

Class 32: Beer wort; extracts of hops for making beer; must; orgeat; preparations for making liqueurs; malt wort.

Class 35: Presentation of retail goods for sale through the communication means.

Class 39: Bottling services; delivery of goods; delivery of goods by mail order; packaging of goods; parcel delivery; wrapping of goods.

COSTS

120) The opponent has succeeded against the majority of the class 32 goods but failed in respect of classes 16, some of 32 and all of 35 and 39. Therefore, the applicant has been largely successful and is entitled to a contribution towards its costs which reflects the extent of its success. In the circumstances I award the applicant the sum of £900. calculated as follows:

Considering the other side's statement and preparing a counterstatement	£200
Preparing evidence and considering and commenting on the other side's evidence	£500
Written submissions	£200
Total	£900

121) I therefore order Etablissements Geyer Freres to pay Best Fruits 17 EAD the sum of £900. The above sum should be paid within fourteen days of the expiry of the appeal period or within 14 days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated 12 April 2019

Mark King

For the Registrar,

The Comptroller-General