TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 2201164
BY TROPICAL DELIGHT LIMITED TO REGISTER A MARK
IN CLASS 32

AND

IN THE MATTER OF OPPOSITION THERETO UNDER NO. 50315
BY SUNDOR BRANDS, INC

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BACKGROUND

1. On 24 June 1999 Tropical Delight Limited of London applied to register the mark **SUMMER DELIGHT** in Class 32.

2. Following examination the application was accepted and published for the following specification of goods:

> "Non-alcoholic drinks and preparations for making such drinks; fruit drinks; fruit juices".

3. On 21 October 1999 Sundor Brands, Inc of Cincinnati, Ohio, United States of America filed notice of opposition. The grounds of opposition are, in summary:

(a) under Section 5(2)(b) of the Act in that the mark for which registration is sought is confusingly similar to earlier trade marks owned by the opponents and is applied for in respect of goods which are identical or similar to those for which the opponents' earlier trade marks are either registered or pending. Full details of the marks on which the opponents rely can be found in the Annex to this decision

(b) under Section 5(4)(a) of the Act given the use the opponents have made of their SUNNY DELIGHT marks in the United Kingdom

(c) under Section 3(6) of the Act, the opponents contend that the applicants adopted the trade mark the subject of the application in suit deliberately and with the intention of appropriating the opponents' goodwill arising from their extensive use and reputation in their SUNNY DELIGHT range of beverages.

4. On 26 January 2000 the applicants filed a counterstatement in which the grounds of opposition were denied.

5. Both parties filed evidence in these proceedings and both sides ask for an award of costs. The matter came to be heard on 10 August 2001. The applicants were represented by Dr Mary Vitoria of Her Majesty's Counsel, instructed by Langer Parry; the opponents were represented by Mr James Graham of Counsel, instructed by D Young & Co.

OPPONENTS' EVIDENCE

6. This consists of a statutory declaration dated 25 April 2000 by Penelope Nicholls. Ms Nicholls explains that she is a registered trade mark attorney and a partner in the firm of D Young & Co who are the opponents' professional representatives in these proceedings. She confirms that she is authorised to make her declaration on the opponents' behalf. The purpose of her declaration is to exhibit a copy of the statutory declaration of Arthur John Bennett dated 10 March 2000 together with copies of its exhibits which were filed in other opposition proceedings (No 49853), between the parties.

7. In his declaration Mr Bennett explains that he is employed by Procter & Gamble UK as Marketing Director, Foods and Beverages UK, a position he has held since 1998. Mr Bennett adds that his company is a wholly owned subsidiary of the Procter & Gamble Company, as is Sundor Brands, Inc who are the opponents in these proceedings. The information in his declaration comes from both his personal knowledge and from information available to him from company records.

8. Having confirmed that the opponents are the registered proprietors of the trade marks shown in the Annex to this decision, the following points emerge from Mr Bennett's declaration:

- that the opponents' SUNNY DELIGHT trade mark has been in use in the United Kingdom in relation to a citrus flavoured fruit juice drink which has been enriched with vitamins A, B1, B6 and C, since 1 April 1998

- that SUNNY DELIGHT was initially marketed in two distinct styles. These were "Florida style" and "California Style" both of which have been continuously available in the United Kingdom since April 1998. Exhibit AJB1 is a copy of an undated in-store poster advertising the availability of SUNNY DELIGHT "Florida style" which Mr Bennett says appeared in supermarkets such as Tesco, J Sainsbury, Asda, Safeway and Somerfield

- that since its introduction in April 1998 the SUNNY DELIGHT product has been sold in a variety of bottle sizes making it suitable for use in packed lunches, in the home or as an impulse purchase

- that the SUNNY DELIGHT product has been extremely popular in the United Kingdom with approximate annual sales of £200m

- that the company spend on average £18m per year advertising the SUNNY DELIGHT product in the United Kingdom with an additional £10m spent on in-store promotions. Mr Bennett adds that in the period April 1998 to November 1998 the company spent a total of £4.1m promoting the trade mark on television in the United Kingdom. During this period, Mr Bennett says that it is estimated that 90% of all mothers of 6-18 year old children will have seen a SUNNY DELIGHT television commercial. Exhibit AJB2 consists of copies of story boards from the SUNNY DELIGHT television commercials all of which carry dates in 1998

- that the SUNNY DELIGHT product has been extensively advertised in children's magazines and in magazines aimed at the retail grocery trade. Exhibits AJB3 and AJB4 consist respectively of sample advertisements for the SUNNY DELIGHT product which appeared in Smash Hits (in June and September 1998), Bliss (date uncertain) the Dandy (SUNNY DELIGHT not actually shown) and Forecourt Trader (March 1998)

- that the mark SUNNY DELIGHT has also been promoted in the United Kingdom at various trade exhibitions including the Convenience Show and Food Expo (March 1998) and the Professional Retail Show (April 1998) and by means of direct mail advertising. Exhibit AJB5 consists of copies of direct mail advertising of the SUNNY DELIGHT product dated April, July and November 1998. Mr Bennett states that approximately 5 million households were targeted by these campaigns with the approximate cost of the campaigns amounting to some £5m

- that to the best of his knowledge there are no other brands using the DELIGHT element on fruit drinks of any kind in the United Kingdom, Mr Bennett concludes his declaration in the following terms:

  "I would also point out that the principal customers for the SUNNY DELIGHT product are children, young teenagers and their mothers and our products are largely sold through supermarkets and retail outlets such as newsagents. Purchasers of frequently bought low cost items, within a distracting environment such as a supermarket, are likely to pay less attention to the trade mark for those goods than will purchasers of higher value items.....".

APPLICANTS' EVIDENCE

9. This consists of a witness statement dated 19 October 2000 by Andrew Shupick. Mr Shupick explains that he is the Company Secretary of Tropical Delight Limited adding that he is authorised to make this statement on the applicants' behalf.

10. The following points emerge from Mr Shupick's statement:

- that the word DELIGHT when applied to drinks and foodstuffs is not in his view distinctive in isolation (given that it is a noun meaning extreme pleasure or something that causes extreme pleasure) and needs to be combined with another/other elements in
- order to be considered registrable

- that the United Kingdom and Community Trade Marks Registers contain many marks in Class 32 which feature the word DELIGHT and that these trade marks are in a range of different ownerships. Exhibit AS1 consists of copies of trade marks on both the United Kingdom and Community Trade Marks Registers in Class 32 and which feature the word DELIGHT. Of the various marks provided, Mr Shupick states that he is aware that the marks SOUTHERN DELIGHT and TROPICAL DELIGHT are in use, contrary to Mr Bennett's statement that there are no other DELIGHT trade marks being used for fruit drinks in the United Kingdom

- exhibit AS2 consists of copies of trade marks on the United Kingdom and Community Trade Marks Registers in Classes 29 and 30 which contain the word DELIGHT. From this evidence Mr Schupick concludes that the average consumer would be familiar with the use of the word DELIGHT on all sorts of goods and would as a result be readily able to discern the differences between such products from other distinctive elements within the respective marks.

OPPONENTS' EVIDENCE-IN-REPLY

11. This consists of a witness statement by Jane Harlow dated 25 January 2001. Ms Harlow explains that she is a trade mark attorney and associate in the firm of D Young & Co the opponents' professional representatives in these proceedings. She confirms that she is authorised to make her witness statement on the opponents' behalf.

12. I do not propose to summarise Ms Harlow's witness statement in any great detail. It is, in essence, a response to the applicants' "state of the Register" evidence provided in exhibits AS1, AS2 and AS3. Suffice to say that Ms Harlow submits that the existence of the various DELIGHT marks listed in the exhibits mentioned are irrelevant to the present proceedings. In reaching this conclusion, Ms Harlow comments that while the marks in exhibit AS1 each contain the word DELIGHT, in her view the remaining elements of the various marks are less similar than the words SUMMER and SUNNY which appear in the marks the subject of these proceedings. In addition Ms Harlow points out that the state of the United Kingdom and Community Trade Marks Registers is not necessarily representative of the situation in the market place.

13. Ms Harlow levels much the same criticisms at the marks contained in exhibits AS2 and in addition notes that the goods specified in these marks are in respect of foodstuffs which are not considered to be similar goods to non-alcoholic beverages. In so far as exhibit AS3 is concerned, Ms Harlow comments that there is no evidence that any of the marks mentioned are actually in use in the United Kingdom.

14. That concludes my review of the evidence in so far as I think it necessary.

DECISION

15. In her skeleton argument, Ms Vitoria drew attention to the fact that the opponents had not provided details of their earlier registrations. She asked me therefore to dismiss the opposition because the Registrar had insufficient material to undertake the comparison between the trade mark the subject of the application for registration and the earlier trade marks (see Andreas Giesen's Trade Mark application 'ORADENT' - BL 0/136/98).

16. For his part Mr Graham asked me to admit some additional evidence, a witness statement dated 9 August 2001 by Jane Harlow of the opponents' attorneys exhibiting copies of the Trade Marks Registry's database in respect of the trade marks the opponents relied upon.

17. I decided not to dismiss the opposition summarily and to admit the evidence. The opponents' point had been taken very late - and certainly years after the applicants' attorneys would have themselves considered the relevant details. Thus admitting the opponents evidence at this very late stage (under Rule 13(11) of the Trade Marks Rules 2000) did not, in my view, prejudice the applicants in this case. I go on to consider the substantive issues.

18. First of all, there is no evidence from the opponents to support their extremely serious allegation made under Section 3(6) of the Act that the applicants adopted the trade mark in suit in order to appropriate any goodwill the opponents might have had in their SUNNY DELIGHT trade mark. Thus the ground of opposition based upon Section 3(6) is dismissed without further deliberation.

19. Secondly, Mr Graham for the opponents agreed that his clients would be no better off under the ground of opposition based upon Section 5(4)(a) than they would be under that based upon Section 5(2)(b). Therefore I intend only to consider the latter.

20. I go on then to consider the matter under Section 5(2)(b) which states:

> "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."

An earlier right is defined in Section 6(1)(a) which states:

> "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."

21. Neither side suggested that there was any difference in the nature of the goods covered by the application for registration and the opponents' registrations. That is, I think, correct and I proceed therefore on the basis that identical or similar goods are involved.

22. In reaching a decision on this matter I take into account 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.

23. Mr Graham agreed that his client's best case was based upon trade mark No 1213373 which consists of the trade mark SUNNY DELIGHT in plain block capitals and is registered for 'Citrus beverages, mineral waters, aerated waters, non-alcoholic beverages, preparations for making beverages and syrups all included in Class 32'.

24. Mr Graham submitted that his client had an enhanced reputation in the trade mark shown as a result of the use they had made of it. In that connection he drew my attention to the evidence of Mr Bennett which he said showed that the product sold under the SUNNY DELIGHT trade mark had in a very short space of time, and as a result of significant sums spent on advertising, achieved "colossal sales". In my view, the evidence on which the claim is made is deficient in a number of ways. First of all, the sales and advertising figures are not put into context. The soft drinks industry must generate massive sales; are the figures given here "colossal"? Given that the trade mark in suit was applied for on 24 June 1999 by which time the opponents' trade mark had been in use for only 15 months, I am unable to establish whether the amount of money spent on advertising in that period, and the resultant turnover, are significant in the context of the soft drinks industry. There are assertions made that 90% of all mothers of 6-18 year old's would have seen a SUNNY DELIGHT television commercial but no details are given of where and when these television commercials appeared. Some promotional material is undated and in relation to the magazines in which advertisements appeared I am given no information as to their circulation figures or audiences. More particularly, the promotional and turnover figures do not correlate with the period in which I am required to assess the reputation of the opponents' trade mark ie from its launch in April 1998 to the date of application which was June 1999. Therefore, in my view, the evidence here is too vague and too full of assertions to enable me to accept that the opponents' trade mark had at the date of application for registration of the trade mark in suit a reputation that I should or could take into account in assessing the likelihood of confusion between the trade marks. The shorter the period in which a party is seeking to establish a reputation the more convincing (and therefore detailed) must be the evidence and facts upon which that can be assessed. In reaching that view I bear in mind the comments of Mr Geoffrey Hobbs QC acting as the Appointed Person in CORGI [1999] RPC 549 at page 560 where he said:

> "I appreciate that the Registrar is frequently required to act upon evidence that might be regarded as less than perfect when judged by the standards applied in High Court proceedings. Even so, it is necessary to remember that there is a distinction to be drawn between inference and conjecture. This was a point which figured in the speeches in the House of Lords in *Jones v. Great Western Railway Company* (1930) 144 L.T. 194. The question in that case was whether the plaintiff had adduced evidence from which it could reasonably be inferred that the death of her husband had been caused by negligence on the part of the defendant. Lord MacMillan (dissenting on the facts, but not as to the applicable principles of law) said at 202:
>
> > "The dividing line between conjecture and inference is often a very difficult one to draw. A conjecture may be plausible but it is of no legal value, for its essence is that it is a mere guess. An inference in the legal sense, on the other hand, is a deduction from the evidence, and if it is a reasonable deduction it may have the validity of legal proof."
>
> These are words of general application. Looking at the present case from that perspective I do not think it should be inferred from the slender evidence before me that use of the Respondent's CORGI trade mark would take unfair advantage of or be detrimental to the distinctive character or the repute of the applicant's CORGI trade mark."

25. I therefore go on to consider the matter on the basis of notional and fair use of the applicants' and the opponents' trade marks in respect of all the goods covered by the respective specifications (REACT Trade Mark [2000] RPC 285). For convenience I set out the two trade marks below:

Applicants' Trade Mark	**Opponents' Trade Mark**
SUMMER DELIGHT	SUNNY DELIGHT

26. The trade marks both contain the word DELIGHT as the second element. The applicants have put in evidence that there are other trade marks on the register in respect of the same or similar goods which consist of or contain that word. They therefore contend that the word DELIGHT has a low imaginative content and is lacking in distinctive character. In their view the public would not see it as being distinctive and would therefore distinguish the applicants' and the opponents' trade marks on the basis of the first elements, both of which are ordinary words of the English language.

27. Mr Graham, rightly in my view, pointed out that evidence of what was on the register was no indication of distinctiveness or of what the position was in the market place. Therefore, I am not prepared to assume that because others have registrations for and including the word DELIGHT that it is in consequence an element which lacks distinctiveness. In any event, I am directed by the Court of Justice, (*Sabel BV v Puma AG)* to consider the trade marks as wholes because that is the way the relevant public would view and perceive them. In that connection, I am prepared to accept that the relevant public in this case are most likely to be young children, teenagers and their mothers who predominately, but not exclusively, consume or purchase soft drinks.

28. As indicated above, the respective trade marks consist as a first element of ordinary words of the English language, SUMMER and SUNNY together with the word DELIGHT. The applicants are seeking to register the words SUMMER DELIGHT and the opponents have already registered the words SUNNY DELIGHT. In most cases the fact that the respective trade marks could be distinguished one from another because each had as its first element a separate and distinguishable word of the English language might be sufficient to suggest that there would be no confusion between them. However, it was submitted that the words SUMMER and SUNNY had conceptual similarities which, together with the fact each had the same second element (and given that identical goods are involved) was sufficient to produce the likelihood of confusion. I think there is force in that submission. It seems to me that though different words of the English language are involved here, both SUMMER and SUNNY conjure up very similar images. Thus there are conceptual similarities between the trade marks.

29. I also take into account the fact that phonetically there is some similarity between the first elements of each trade mark. Both consists of the letters SU followed by MM or NN thus pronunciation of the prefix will be very similar.

30. Taking account of all the factors, I consider that the nature and character of the respective trade marks are sufficiently similar such that anyone who does not have the chance to make a direct comparison between the trade marks, and instead will rely on imperfect recollection, is likely to be confused as to the origin of the goods sold under the trade marks. Therefore, I consider that the applicants' trade mark SUMMER DELIGHT, if placed on the register would result in the likelihood of confusion on the part of the public which includes the likelihood of association with the opponents' earlier trade marks. Therefore, the grounds of opposition based upon Section 5(2)(b) of the Act is made out and the application for registration must be refused.

31. As the opponents have been successful, they are entitled to an award of costs. I order the applicants to pay to the opponents the sum of **£800**. This sum 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.

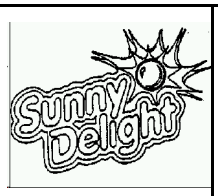
Dated this 9TH Day of November 2001

M KNIGHT
For the Registrar
The Comptroller-General

ANNEX

UNITED KINGDOM REGISTRATIONS

TM No:	App Date	Mark	Cl	Goods
1213373	23/2/84	SUNNY DELIGHT	32	Citrus beverages, mineral waters, aerated waters, non-alcoholic beverages, preparations for making beverages and syrups, all included in Class 32
1228524	18/10/84		32	Mineral waters, aerated waters, non-alcoholic drinks, syrups and preparations for making beverages, all included in Class 32
2040893	12/10/95	SUNNY DELIGHT CITRUS PUNCH	32	Beers; mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages; all containing, being flavoured with or having the flavour of citrus fruits
2040920	11/10/95	SUNNY DELIGHT SMOOTHIE	29	Fruit based dairy beverages

2160593	11/3/98		29, 32	**29** Meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies, jams; eggs, milk; fruit based dairy beverages; preserves **32** Beers; mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages

COMMUNITY REGISTRATIONS/APPLICATIONS

TM No	**App Date**	**Mark**	**Cl**	**Goods**
311092	24/7/96	SUNNY DELIGHT CHILLERS	32	Beers; mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages
766824	10/3/98		29 32	**29** Meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies, jams; fruit sauces, eggs, milk and milk products; edible oils and fats **32** Beers; mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages

1096825	5/3/99	SUNNY DELIGHT	32	Beers; mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages