O-131-15

TRADE MARKS ACT 1994

SUPPLEMENTARY DECISION

IN THE MATTER OF APPLICATION NO 3024251
BY
MAXICORP LIMITED

Eisenberg

IN CLASSES 5 AND 32

AND

THE OPPOSITION THERETO
UNDER NO 600000075
BY
HALEWOOD INTERNATIONAL BRANDS LIMITED

1. On 26 September 2014 I issued a provisional decision in relation to this opposition, in which I stated the following:

> "74. 'Calorie controlled and calorie reduced beverages' in class 32, include some goods which will lead to a likelihood of confusion but some goods which will not. In the circumstances, in accordance with TPN 1/2012, paragraph 3.2.2, I invite the applicant to file a revised specification and accompanying submissions detailing any types of goods it wishes to register that:
>
> a) Fall within the ambit of "calorie controlled and calorie reduced beverages";
>
> b) Fall within the scope of this decision in that the goods so specified have no similarity to 'de-alcoholised wines';
>
> c) Do not fall foul of the guidance issued by the CJEU in the *Postkantoor*[1] decision;
>
> 75. The applicant's written submissions should explain why it considers the terms to be within the scope of my decision. A period of 14 days from the date of this decision is permitted for such action. Upon receipt of the above, the opponent will be allowed 14 days to comment on any proposed terms and I will then issue a supplementary decision in which I will decide whether any proposed terms are free from objection. If the applicant puts forward no revised terms then I will issue a supplementary decision confirming that the broad term 'calorie controlled and calorie reduced beverages' may include services which are the same or similar as those contained in the opponent's specification. Consequently, there will be a likelihood of confusion."

2. The applicant filed submissions on 10 October 2014 in which it stated the following:

> "In accordance with paragraph 74 of the interim decision, our client wishes to amend the goods "calorie controlled and calorie reduced beverages" in class 32 to "calorie controlled and calorie reduced beverages namely, food or meal replacement drinks, drinks containing protein, fibre, vitamins or minerals for sports and/or nutritional purposes, isotonic drinks for sports and/or nutritional purposes".
>
> We submit that such revised goods are akin to the goods "protein based drinks for sports nutrition" in class 5 and "protein based fruit drinks and energy drinks" in class 32 which were held by the Hearing Officer to be dissimilar to the Opponent's goods and that such revised goods should be decided on the same basis.

[1] *CJEU case C-363/99*

The revised goods are specific in nature as members of the public will have specific reason to purchase such goods, namely for sport and/or nutritional purposes, rather than as “a drink” in its own right as with the Opponent’s goods. Accordingly, the uses and the users of the parties’ goods are different. The packaging of the parties’ goods are also likely to be different as the Applicant’s goods are likely to be made available in packaging which will make them convenient to drink, whilst the Opponent’s goods are more likely to be sold in larger bottles to be poured into a glass or other drinking vessel.

The trade channels for the respective goods are also different. As the Hearing Officer acknowledged in her decision, the Opponent’s goods are likely to be sold in close proximity to their alcoholic counterparts. The Applicant’s revised goods on the other hand are clearly aimed at those members of the public with sports and/or nutrition in mind and so are likely to be sold in the pharmaceutical or health and fitness area of a supermarket.

The Applicant’s revised goods are neither in competition or complementary with the Opponent’s goods. They are put simply dissimilar goods.”

3. In a letter dated 30 October 2014 the Opponent responded in the following terms:

“Food or meal replacement drinks are proper to Class 30, rather than 32, and should not therefore be included in the specification. We disagree with the applicant's reasoning that the revised goods are aimed at members of the public with sports and/or nutrition in mind and so are likely to be sold in the pharmaceutical or health fitness area of a supermarket. We submit all members of the public shop with nutrition in mind; nutrition is a very broad and general term, and all beverage products, de-alcoholised wine included, have some elements of nutrition.

Furthermore, in most supermarkets and retail outlets, "sports" drinks such as energy and isotonic drinks are sold in soft drinks section not in the health and fitness area, if there is such a thing. In the soft drink section of the supermarkets there are numerous drinks which are purchased as alternatives to wine, perhaps by people who are drivinq, or non-drinkers at a dinner party, such as flavoured waters in wine-like bottles, Schloer and other such drinks. Although it may be correct that de-alcoholised wines are sold in the wine section of a supermarket, this fact alone is not enough to render these products entirely dissimilar with all other non-alcoholic drinks.

We disagree with the applicant's reasoning that packaging of the respective goods are likely to be different. Sports drinks are sold in a variety of different bottle types and sizes. If the applicant wishes to rely on this line of argument, they should specify the size and style of the bottle or packaging in their specification of goods. We also disagree with the contention that the revised goods are specific in nature as the public will

> purchase them for sports and/or nutritional purposes as rather than as a drink in its own right. This is clearly erroneous; even if a drink is bought in order to be drunk whilst participating in sport, it is still a drink, and the place where it is consumed, or the activity being done whilst it is consumed, does not make it a drink.
>
> Food or meal replacement drinks are not proper to class 32 but to classes 5 or 30. Consequently, they cannot be considered a subset of 'calorie controlled and calorie reduced beverages' in class 32.
>
> With regard to the specification proposed by the applicant's attorney, we submit that "food or meal replacement drinks" should not be allowed in Class 32, and also that the wording "for sports and/nutritional purposes" is too broad, and should be amended to "for sports nutritional purposes".

4. The first part of the suggested revised specification is 'calorie controlled and calorie reduced beverages, namely, food or meal replacement drinks'. Food or meal replacement drinks are proper to classes 30 or 5 and, accordingly, cannot be a subset of calorie controlled and calorie reduced beverages in class 32. Consequently, this is not an acceptable term suitable for inclusion in the applicant's revised specification.

5. The remaining term, 'calorie controlled and calorie reduced beverages, namely, drinks containing protein, fibre, vitamins or minerals for sports and/or nutritional purposes, isotonic drinks for sports and/or nutritional purposes', relates to goods which are proper to class 32 and are goods which can be considered to fall within the ambit of calorie controlled and calorie reduced beverages.

6. These drinks may be bought because they contain, inter alia, protein, vitamins or fibre, or are described as 'isotonic' rather than to be enjoyed as drinks in their own right. However, they may also be selected as soft drinks, consumed for taste or may be used as mixers with alcohol. Whilst I have considered the opponent's comments regarding particular sections of a supermarket, the trade channels for the respective goods are unlikely to coincide as de-alcoholised wines are specific products which offer an alternative to wine containing alcohol. They are unlikely to be displayed cheek by jowl with isotonic drinks or drinks with protein/fibre/vitamins. The goods are not in competition and are not complementary. Consequently, I find these to be dissimilar goods."

7. Having reached the above conclusions, I have not overlooked the parties' respective submissions regarding the packaging of goods in class 32. These submissions do not assist either side for the reasons outlined in *Devinlec Développement Innovation Leclerc SA v Office for Harmonization in the Internal Market (Trade Marks and Designs)(OHIM)* Case T- 147/03, in which the Court of First Instance (now the General Court) said:

> "104. Consideration of the objective circumstances in which the goods covered by the marks are marketed is fully justified. The examination of the likelihood of confusion which the OHIM authorities are called on to carry out is a prospective examination. Since the particular circumstances

> in which the goods covered by the marks are marketed may vary in time and depending on the wishes of the proprietors of the trade marks, the prospective analysis of the likelihood of confusion between two marks, which pursues an aim in the general interest, that is, the aim that the relevant public may not be exposed to the risk of being misled as to the commercial origin of the goods in question, cannot be dependent on the commercial intentions, whether carried out or not, and naturally subjective, of the trade mark proprietors."

Conclusion

8. At paragraph 73 of the interim decision I stated:

> **The opposition fails under section 5(2)(b) of the Act in respect of:**
>
> **Class 5 – Protein based drinks for sports nutrition**
>
> **Class 32 – Protein based fruit drinks and energy drinks**

9. Having considered the applicant's proposals to limit its specification I conclude that the application will proceed to registration for the following specification:

> **Class 5 – Protein based drinks for sports nutrition**
>
> **Class 32 – Protein based fruit drinks and energy drinks; calorie controlled and calorie reduced beverages namely, drinks containing protein, fibre, vitamins or minerals for sports and/or nutritional purposes, isotonic drinks for sports and/or nutritional purposes.**

COSTS

10. Both parties have achieved a measure of success and I consider both should bear its own costs.

Dated this 25th day of March 2014

Ms. Al Skilton
For the Registrar