

**O-053-17**

**TRADE MARKS ACT 1994  
IN THE MATTER OF  
TRADE MARK APPLICATION NO 3100349  
BY GEETA SIDHU-ROBB  
TO REGISTER  
NOSH  
AS A TRADEMARK  
IN CLASSES 30, 32, 43 & 44  
AND OPPOSITION THERETO (UNDER NO.406296)  
BY  
NOSH BEVERAGES LIMITED**

## **Background and pleadings**

1. Geeta Sidhu-Robb ('the applicant') applied to register the trade mark **Nosh** on 20 March 2015. It was accepted and published in the Trade Marks Journal on 18 December 2015 in respect of a number of goods and services in classes 30, 32, 43 and 44. For the purpose of this decision it is only necessary to set out the goods in classes 30 and 32 as only these are subject to opposition. They are:

**Class 30:** *Coffee, tea, artificial coffee; beverages based on tea; beverages with tea base; black tea; darjeeling tea; earl grey tea; fruit teas; ginger tea; ginseng tea; green tea; herb tea [infusions]; herbal flavourings for making beverages; herbal infusions; herbal tea [infusions]; instant tea; jasmine tea; lime tea; oolong tea; orange flavoured tea; red ginseng tea; rosemary tea; sage tea; tea leaves; tea mixtures; tea substitutes.*

**Class 32:** *Aerated juices; aerated mineral waters; aerated water; aloe vera juices; aperitifs, non-alcoholic; beverages consisting principally of fruit juices; apple juice beverages; beverages consisting principally of fruit juices; beverages containing vitamins; beverages enriched with added minerals; beverages enriched with added trace elements; beverages enriched with added vitamins; cocktails, non-alcoholic; concentrated fruit juice; concentrates for making fruit juices; cordials; drinking water; energy drinks; flavoured waters; fruit beverages; fruit beverages and fruit juices; fruit juice; fruit juice for use as a beverages; fruit-based beverages; fruit-flavoured beverages; fruit nectars; fruit squashes; grape juice; honey-based beverages (non-alcoholic -); juice (fruit -); juices; low-calorie soft drinks; milk of almonds [beverage]; mixed fruit juice; non-dairy milk; preparations for making beverages; smoothies; soft drinks; soya-based beverages, other than milk substitutes; sorbets in the nature of beverages; syrups for making beverages; syrups for beverages; vegetable juice.*

2. Nosh Beverages Limited ('the opponent') opposed the trade mark under Section 5(1) and 5(2)(a) of the Trade Marks Act 1994 (the Act). This is on the basis of its earlier UK Trade Mark set out below:

UKTM Details	Goods relied on
<p data-bbox="204 577 488 613">UKTM no. 3029528</p> <p data-bbox="204 689 316 734"><b>Nosh</b></p> <p data-bbox="204 817 517 853">Filing date: 6/11/2013</p> <p data-bbox="204 873 612 909">Registration date: 25/4/2014</p>	<p data-bbox="809 577 1329 667">Class 29: Non-alcoholic yogurt drink with fruit and cereals.</p>

3. The opponent argues that the respective goods are identical or similar and that the marks are identical.

4. The opponent's trade mark is an earlier mark, in accordance with section 6 of the Act and, as it had not been registered for five years or more before the publication date of the applicant's mark, it is not subject to the proof of use requirements, as per section 6A of the Act.

5. The applicant filed a counterstatement accepting that the trade marks were identical but denying the goods were identical or similar.

6. Neither party filed evidence. Only the opponent filed written submissions which will not be summarised but will be borne in mind. No hearing was requested and so this decision is taken following a careful perusal of the papers.

## **DECISION**

### **Section 5(1)**

7. This section of the Act provides:

“5. – (1) a trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trademark is applied for are identical with the goods or services for which the earlier trade mark is protected.”

8. In *S.A. Société LTJ Diffusion v. Sadas Vertbaudet SA*, Case C-291/00, the Court of Justice of the European Union held that:

“54... a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer.”

Both parties' marks consist of the word 'Nosh'. They are clearly identical.

9. The opponent claims that the respective goods are also identical. In terms of the applicant's class 30 goods which are, broadly speaking, tea, coffee or herbal drinks, these are clearly not identical to the opponent's goods which are essentially yoghurt drinks. As to the applicant's class 32, goods such as waters and fruit juices are obviously not identical to the opponent's yoghurt drinks. Whilst it is true that some of the applicant's goods such as 'smoothies' may have yoghurt as an ingredient, they are not a yoghurt drink *per se*. I find that none of the respective goods are identical. Without identity between the respective goods, the ground under section 5(1) must fail.

### **Section 5(2)(a)**

10. This section of the Act provides:

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

(a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the 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”.

11. The leading authorities which guide me are from the Court of Justice of the European Union ('CJEU'): *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

### **The principles**

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

(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 will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

I bear in mind, of course, that, as I have already found that the marks are identical, not all of the factors listed above are relevant to the case before me.

## Comparison of goods

12. The goods to be compared are:

Opponent's goods	Applicant's goods
<p><b>Class 29:</b> Non-alcoholic yogurt drink with fruit and cereals</p>	<p><b>Class 30:</b> Coffee, tea, artificial coffee; beverages based on tea; beverages with tea base; black tea; darjeeling tea; earl grey tea; fruit teas; ginger tea; ginseng tea; green tea; herb tea [infusions]; herbal flavourings for making beverages; herbal infusions; herbal tea [infusions]; instant tea; jasmine tea; lime tea; oolong tea; orange flavoured tea; red ginseng tea; rosemary tea; sage tea; tea leaves; tea mixtures; tea substitutes.</p> <p><b>Class 32:</b> Aerated juices; aerated mineral waters; aerated water; aloe vera juices; aperitifs, non-alcoholic; beverages consisting principally of fruit juices; apple juice beverages; beverages consisting principally of fruit juices; beverages containing vitamins; beverages enriched with added minerals; beverages enriched with added trace elements; beverages enriched with added vitamins; cocktails, non-alcoholic; concentrated fruit juice; concentrates for making fruit juices; cordials; drinking water; energy drinks;</p>

	<p>flavoured waters; fruit beverages; fruit beverages and fruit juices; fruit juice; fruit juice for use as a beverages; fruit-based beverages; fruit-flavoured beverages; fruit nectars; fruit squashes; grape juice; honey-based beverages (non-alcoholic -); juice (fruit -); juices; low-calorie soft drinks; milk of almonds [beverage]; mixed fruit juice; non-dairy milk; preparations for making beverages; smoothies; soft drinks; soya-based beverages, other than milk substitutes; sorbets in the nature of beverages; syrups for making beverages; syrups for beverages; vegetable juice.</p>
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13. In the judgment of the Court of Justice of the European Union 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”.

14. 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 services
- 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.

15. In *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

"... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."

16. In *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another*, [2000] F.S.R. 267, Neuberger J. (as he then was) stated that:

"I should add that I see no reason to give the word "cosmetics" and "toilet preparations"... anything other than their natural meaning, subject, of course,

to the normal and necessary principle that the words must be construed by reference to their context.”

17. I will address each of the applicant’s classes in turn and, where appropriate, will group terms together.<sup>1</sup>

### **Class 30**

Coffee, tea, artificial coffee; beverages based on tea; beverages with tea base; black tea; darjeeling tea; earl grey tea; fruit teas; ginger tea; ginseng tea; green tea; herb tea [infusions]; herbal flavourings for making beverages; herbal infusions; herbal tea [infusions]; instant tea; jasmine tea; lime tea; oolong tea; orange flavoured tea; red ginseng tea; rosemary tea; sage tea; tea leaves; tea mixtures; tea substitutes.

18. Both parties’ goods are likely to be found in retailers such as supermarkets. The opponent’s *non-alcoholic yoghurt drink with fruit and cereals* will come ready-made and will be stocked in the refrigerated section. The applicant’s goods are, generally speaking, coffee, tea and herbal drinks. Whilst some of these may possibly be found in ready-made bottles in a refrigerator, they are generally more likely to come in dried form as leaves and/or granules to be made up into a hot beverage by the consumer at home. The respective flavours are likely to be quite distinct and I would expect the extent of any competitive relationship to be limited. Overall, I consider there to be a very low degree of similarity with the opponent’s goods.

### **Class 32**

Aerated mineral waters; aerated water; drinking water; flavoured waters

19. The exact nature of these goods is not the same as the opponent’s goods for obvious reasons. However, like the opponent’s goods, they are ready made, non-alcoholic beverages that will be sold through supermarkets and suchlike to the

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<sup>1</sup> *Separode Trade Mark* BL O-399-10

general public. They may often be found in the refrigerated section of a retail outlet close to the opponent's goods and there may be an element of competition between them. There is a medium degree of similarity with the opponent's goods.

Aerated juices; aloe vera juices; beverages consisting principally of fruit juices; apple juice beverages; concentrated fruit juice; concentrates for making fruit juices; fruit beverages; fruit beverages and fruit juices; fruit juice; fruit juice for use as a beverages; fruit-based beverages; fruit-flavoured beverages; fruit nectars; fruit squashes; grape juice; juice (fruit -); juices; mixed fruit juice; sorbets in the nature of beverages; vegetable juice; cordials.

20. These goods are non-alcoholic beverages with presumably varying amounts of fruit juice/flavouring, concentrate or pulp. Although they are likely to consist principally of those ingredients rather than yoghurt, like the opponent's goods, they are likely to be sold in supermarkets in the refrigerated section and there may be an element of competition between the goods in the sense of the consumer choosing between buying a fruit based beverage, for example, or a yoghurt based drink containing fruit. There is a medium degree of similarity with the opponent's goods.

beverages containing vitamins; beverages enriched with added minerals; beverages enriched with added trace elements; beverages enriched with added vitamins.

21. These goods are non-alcoholic beverages of a non-specific nature but with added 'extras' in the form of vitamins or minerals. Depending on their perishable constituents, they could also be found in the refrigerated section of a retail outlet alongside the opponent's goods and may have similar ingredients. There is a high degree of similarity with the opponent's goods.

preparations for making beverages; syrups for making beverages; syrups for beverages

22. These goods are for making into beverages. They are unlikely to be in direct competition with the opponent's goods but their ingredients may be similar. There is a low degree of similarity with the goods of the opponent.

aperitifs, non-alcoholic; cocktails, non-alcoholic.

23. These goods are ready-made non-alcoholic beverages. As they are an alternative to a cocktail or aperitif, they are likely to be found in the alcohol aisle of a supermarket rather than the refrigerator section with the opponent's goods. However, their flavour and/or texture may be similar to the opponent's goods. There is a low degree of similarity with the opponent's goods.

energy drinks; low-calorie soft drinks; soft drinks

24. These goods are non-alcoholic beverages which may or may not be carbonated and usually contain sweet flavourings. Although the opponent's goods are yoghurt based and are therefore unlikely to ever be carbonated, they may all be stocked in close proximity to each other and there is likely to be competition between them. There is a high degree of similarity with the goods of the opponent.

honey-based beverages (non-alcoholic -).

25. These goods are non-alcoholic beverages based on honey rather than yoghurt. However, they may also contain yoghurt or other similar ingredients, be stocked in close proximity to the opponent's goods and be in competition with them. There is a high degree of similarity with the goods of the opponent.

milk of almonds [beverage]; non-dairy milk; smoothies; soya-based beverages, other than milk substitutes.

26. These goods are non-alcoholic beverages based on milk and/or dairy alternatives. Depending on their perishable constituents, they could also be found in the refrigerated section of a retail outlet alongside the opponent's goods. These goods are considered to be closest in terms of taste, texture and consistency to the goods of the opponent. There is a high degree of similarity with the opponent's goods.

**Average Consumer**

27. 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*.

28. 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.”

29. The average consumer of the goods in this case is the general public who are likely to make their selection from a shelf/refrigerator in a retail outlet such as a supermarket. The goods in question here are generally low cost items and are likely to be purchased reasonably frequently. As such the degree of care and attention paid to the purchase is likely to be low.

### **Distinctive character of the earlier mark**

30. The distinctive character of the earlier mark must be considered. 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 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).”

31. As no evidence has been filed in this case, I can only consider the trade mark’s inherent distinctiveness.

32. The word **nosh** is a well-known dictionary defined word in common parlance. It is likely to be perceived by the average consumer as an informal way of referring to food, eating or sustenance in general. Although not descriptive in relation to the opponent’s goods, the word clearly has allusive qualities. I would say that the trade mark is below average but not at the lowest level in terms of distinctiveness.

### **Likelihood of confusion**

33. I must now draw together my earlier findings into the global assessment of the likelihood of confusion, keeping in mind the following factors:

- a) The interdependency principle, whereby a lesser degree of similarity between the goods may be offset by a greater similarity between the marks, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Meyer Inc*).
- b) The principle that the more distinctive the earlier mark is, the greater the likelihood of confusion (*Sabel BV v Puma AG*).

- c) The factor of imperfect recollection i.e. that consumers rarely have the opportunity to compare marks side by side but must rather rely on the imperfect picture that they have kept in their mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*).

34. Having weighed all these relevant factors, and, bearing in mind, in particular that the marks are identical, and that a low degree of attention is likely to be paid during the purchase, I have reached the conclusion that, despite the below average degree of distinctiveness of the earlier mark, there is a likelihood of confusion in respect of goods for which there is, at least, a low degree of similarity i.e. all of the goods in class 32. The average consumer is likely to believe that the respective goods are produced by the same or economically linked undertaking. However, insofar as the applicant's goods in class 30 are concerned, I consider that the very low degree of similarity between the respective goods coupled with the below average distinctiveness of the earlier mark is insufficient, even bearing in mind the identity between the marks and the low degree of attention, to result in a likelihood of confusion.

### **Summary**

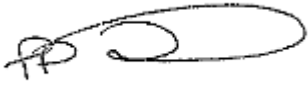
35. The application is to be refused for all goods in class 32.

36. The application will proceed to registration for the goods in class 30 and services in classes 43 and 44.

### **Costs**

37. As the parties have had a roughly equal measure of success, I do not consider it appropriate to favour either party with an award of costs.

**Dated this 10<sup>th</sup> day of February 2017**

A handwritten signature in black ink, appearing to be 'JR' followed by a large, stylized loop.

**June Ralph**

**For the Registrar**

**For the Comptroller General**