

O-059-17

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3170369 BY
DANIEL THOMSON**

TO REGISTER:

supernatural
juice & smoothie bar

AS A TRADE MARK

IN CLASSES 5, 29, 30, 32 & 43

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 60000488 BY
J SAINSBURY PLC**

BACKGROUND & PLEADINGS

1. On 19 June 2016, Daniel Thomson (“the applicant”) applied to register the trade mark shown on the cover page of this decision for the goods and services shown in paragraph 15 below.

The application was published for opposition purposes on 15 July 2016.

2. On 28 September 2016, the application was opposed in full by J Sainsbury plc (“the opponent”) under the fast track opposition procedure. The opposition is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”) .The opponent relies upon United Kingdom registration no. 3123235 for a series of two trade marks i.e. **SUPER NATURAL** and **SUPERNATURAL** which have an application date of 20 August 2015, a registration date of 20 November 2015 and which stand registered for the goods shown in paragraph 15 below.

3. The applicant filed a counterstatement in which the basis of the opposition is denied.

4. In these proceedings, the opponent is represented by Addleshaw Goddard LLP; the applicant, Mr Thomson, has represented himself.

5. Rule 6 of the Trade Marks (Fast Track Opposition)(Amendment) Rules 2013, S.I. 2013 2235, disapplies paragraphs 1-3 of Rule 20 of the Trade Mark Rules 2008, but provides that Rule 20(4) shall continue to apply. Rule 20(4) states that:

“(4) The registrar may, at any time, give leave to either party to file evidence upon such terms as the registrar thinks fit.”

6. The net effect of these changes is to require parties to seek leave in order to file evidence in fast track oppositions. No leave was sought in respect of these proceedings.

7. Rule 62(5) (as amended) states that arguments in fast track proceedings shall be heard orally only if (i) the Office requests it or (ii) either party to the proceedings requests it and the registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost; otherwise, written arguments will be taken. A hearing was neither requested nor considered necessary; neither party filed written submissions beyond those contained in the Notice of opposition and counterstatement.

DECISION

8. The opposition is based upon section 5(2)(b) of the Act, which reads 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.”

9. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

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

(a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) 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,

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if

registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

10. The trade mark upon which the opponent relies qualifies as an earlier trade mark under the above provisions. As this earlier trade mark is not subject to proof of use, the opponent is entitled to rely upon all of the goods it has identified.

Section 5(2)(b) – case law

11. 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.

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.

The correct approach to the comparison

12. In his counterstatement, Mr Thomson states:

“I’ve never heard or seen of Sainsbury’s “Supernatural” range, nor is there any trace of such a range on the Internet. I have conducted a video survey of 100 regular customers of Sainsbury’s and 10 members of staff on the 20th October 2016, all of whom have also never heard of any products under this title. So I would argue that their sign is neither established nor distinctive.

Our sign, however, is well established and distinctive. We have 7 locations across London, and in the last 18 months have also had another 6 pop-up locations across the city, and appeared at over 50 events, festivals, and trade shows under this sign. Two of these locations in particular are Oxford Circus Underground Station, and Canary Wharf Underground Station, each of which have over 120,000 people pass through them every single day, right past our stores. We also serve over 360,000 customers every year, all of whom would recognise our sign without any confusion and not confuse it with any brand owned by J Sainsbury’s.

Our signs have considerable and noticeable differences, not only in the sign itself but also by the way it is presented on our packaging...

Finally, we hold an existing trade mark for SuperNatural under class 43.

A consumer cannot be confused about the origin of goods if they have not heard of the original trade mark. As mentioned earlier by our survey, even the reasonably well-informed, observant consumer has not heard of Sainsbury’s Supernatural.

If the opponent’s trade mark has not been put to genuine use in the UK, their trade mark should be revoked (Section 46(1)(a) Trade Marks Act 1994) for non-use.”

13. Mr Thomson’s comments are based upon a number of misconceptions. Insofar as the opponent’s earlier trade mark is concerned, this was entered in the register on 20 November 2015. The opponent has five years from this date to begin using its trade mark before the revocation provisions contained in section 46(1)(a) of the Act

come into play. Thus although the “video survey” mentioned by Mr Thomson is not in evidence in these proceedings, even if it was, for the reasons mentioned it would not have assisted him. As to the use Mr Thomson states has been made of his trade mark, as no leave has been sought by him to file any evidence in these proceedings, it is not strictly necessary for me to comment upon it any further. However, to assist Mr Thomson’s understanding as to why both any use he may have made of his earlier trade mark and the existence of his trade mark registration which has an earlier filing date than that of the opponent’s trade mark does not assist him, I draw his attention to the guidance provided in Tribunal Practice Notice (“TPN”) 4 of 2009 which explains the position:

“Defences including a claim that the applicant for registration/registered proprietor has a registered trade mark that predates the trade mark upon which the attacker relies for grounds under sections 5(1) and 5(2) of the Act.

1. A number of counterstatements in opposition and invalidation actions have sought to introduce as a defence that the applicant for registration/registered proprietor has a registered trade mark (or trade mark application) for the same or a highly similar trade mark to that which is the subject of the proceedings that predates the earlier mark upon which the attacker relies.

2. Sections 5(1) and 5(2) of the Act turn upon whether the attacker has an earlier trade mark compared to the mark under attack, as defined by section 6 of the Act. Whether the applicant for registration/registered proprietor has another registered trade mark (or trade mark application) that predates the earlier mark upon which the attacker relies cannot affect the outcome of the case in relation to these grounds.

3. The position was explained by the Court of First Instance in *PepsiCo, Inc v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) T-269/02*:

"24 Nor did the applicant claim, and even less prove, that it had used its earlier German mark to obtain cancellation of the intervener's mark before the competent national authorities, or even that it had commenced proceedings for that purpose.

25 In those circumstances, the Court notes that, quite irrespective of the question whether the applicant had adduced evidence of the existence of its earlier German mark before OHIM, the existence of that mark alone would not in any event have been sufficient reason for rejecting the opposition. The applicant would still have had to prove that it had been successful in having the intervener's mark cancelled by the competent national authorities.

26 The validity of a national trade mark, in this case the intervener's, may not be called in question in proceedings for registration of a Community trade mark, but only in cancellation proceedings brought in the Member State concerned (Case T 6/01 Matratzen Concord v OHIM - Hukla Germany (MATRATZEN) [2002] ECR II 4335, paragraph 55). Moreover, although it is for OHIM to ascertain, on the basis of evidence which it is up to the opponent to produce, the existence of the national mark relied on in support of the opposition, it is not for it to rule on a conflict between that mark and another mark at national level, such a conflict falling within the competence of the national authorities."

The position with regard to defences based on use of the trade mark under attack which precedes the date of use or registration of the attacker's mark

4. The viability of such a defence was considered by Ms Anna Carboni, sitting as the appointed person, in *Ion Associates Ltd v Philip Stainton and Another*, BL O-211-09. Ms Carboni rejected the defence as being wrong in law.

5. Users of the Intellectual Property Office are therefore reminded that defences to section 5(1) or (2) grounds based on the applicant for registration/registered proprietor owning another mark which is earlier still compared to the attacker's mark, or having used the trade mark before the

attacker used or registered its mark are wrong in law. If the owner of the mark under attack has an earlier mark or right which could be used to oppose or invalidate the trade mark relied upon by the attacker, and the applicant for registration/registered proprietor wishes to invoke that earlier mark/right, the proper course is to oppose or apply to invalidate the attacker's mark."

14. Finally, in relation to Mr Thomson's comments regarding, inter alia, the differences between the opponent's trade mark and the manner in which his trade mark appears on his packaging, once again, this is not relevant. What I am required to do in these proceedings, is to compare the opponent's trade mark (in the form in which it is registered) and for the goods for which it is registered with Mr Thomson's trade mark as it appeared on the application form and in relation to the goods and services for which he seeks registration.

Comparison of goods and services

15. The competing goods and services are as follows:

The opponent's goods	The applicant's goods and services
<p>Class 5 - Non-ethical pharmaceutical substances and sanitary substances; infant's and invalids' foods; medical and surgical plasters; material prepared for bandaging; tampons and sanitary towels; disinfectants; pharmaceutical, veterinary and sanitary preparations; dietetic substances adapted for medicinal use; medicinal herbs; herbal teas for medicinal purposes; fish oils; vitamin and mineral preparations and supplements; food for babies; dental wax; disinfectants; preparations for destroying vermin; fungicides, herbicides; air freshening</p>	<p>Class 5 - Powdered nutritional supplement drink mix.</p> <p>Class 29 - Algae prepared for human foods; Almond butter; Aloe vera prepared for human consumption; Beans; Beverages consisting principally of milk; Beverages made from or containing milk; Bottled fruits; Bottled sliced fruits; Bottled vegetables; Candied fruits; Candied nuts; Cashew nut butter; Cocoa butter; Coconut; Coconut butter; Coconut, desiccated; Coconut milk powder; Coconut oil; Dates; Dried edible algae;</p>

preparations; air purifying preparations; plasters, bandages; filled first aid boxes; eye wash; incontinence pads; incontinence products; fly destroying preparations; medicated bathing preparations.

Class 29 - Meat, fish, poultry and game; meat extracts; prepared, preserved, dried or cooked fruits and vegetables; jellies, jams, fruit sauces; eggs, milk and milk products; dairy products; edible oils and fats; seafood and seafood products; prepared, jellies, preserves, jams, compotes, fruit sauces; salads, eggs; milk and milk products; edible oils and fats, cooking oils; pickles; dried herbs; meat extracts and meat products; poultry products; soups; vegetable juices; snack foods in Class 29; dips in Class 29; soups; spreads in Class 29; prepared meals in Class 29; constituents for meals in Class 29; desserts in Class 29.

Class 30 - Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery, ices, honey, treacle; yeast, baking powder; salt, mustard; vinegar, sauces (condiments); spices; ice; coffee, tea, cocoa, chocolate and tea based beverages; pasta, popcorn; cereal,

Drinking yogurts; Frozen fruits; Fruit jams; Fruit pulp; Fruit puree; Fruit rinds; Fruit-based snack food; Hummus; Hummus [chickpea paste]; Mango; Milk and milk products; Milk based beverages [milk predominating]; Milk based drinks [milk predominating]; Milk beverages; Milk-based beverages containing coffee; Milk-based beverages containing fruit juice; Milk-based beverages flavored with chocolate; Organic milk; Organic nut and seed-based snack bars; Peanut butter; Peanut spread; Salads (Fruit -); Salads (Vegetable -).

Class 30 - Cereal bars; Cereal based energy bars; Cereal based food bars; Cereal based foodstuffs for human consumption; Cereal based prepared snack foods; Cereal based snack food; Cereal flour; Cereal powders; Cereal snacks; Chai (tea); Edible essences for foodstuffs [other than etheric substances and essential oils]; Edible flour; Edible fruit ices; Hot chocolate.

Class 32 - Smoothies [non-alcoholic fruit beverages]; Smoothies; Guarana drinks.

Class 43 - Cafés; Juice bars.

muesli; rice, tapioca, sago; sugar, artificial coffee; flour and preparations made from cereals; bread, pastry confectionery, pies, frozen confectionery, sorbets, ices, ice; honey, treacle; yeast, baking-powder; salt, mustard; mayonnaise, vinegar, sauces (condiments); spices, pasta, noodles, couscous, tortillas, barley, bean meal, spring rolls, waffles; farinaceous foods and food pastes; crackers, rice cakes, biscuits, snack-foods; cakes, decorations for cakes, marzipan, pralines, popcorn, custard; meat gravies; pies, quiches, pizza; pizza bases, pizza toppings included in Class 30; flavourings for beverages; essences for foodstuffs; glucose, gluten, chewing gum; dips in Class 30; spreads in Class 30; prepared meals in Class 30; constituents for meals in Class 30; salad dressings; sandwiches; desserts in Class 30.

Class 31 - Agricultural, horticultural and forestry products and grains not included in other classes; live animals; fresh fruits, vegetables and nuts; seeds, natural plants and flowers; foodstuffs for animals, malt; vegetables; seeds, natural plants and flowers; foodstuffs for animals; malt; fresh garden herbs, seeds, malt, agricultural, horticultural and forestry products and grains not included

in other classes, natural plants and flowers, malts, foodstuffs for animals; animal litter.	
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16. In its Notice of Opposition, the opponent states:

“1...[the applicant’s trade mark] is to be registered for [the goods and services applied for] which are identical with, or similar to, the goods for which the opponent’s mark is protected.”

17. The opponent has not, however, provided any further submissions to support these claims. In the judgment of the Court of Justice of the European Union (“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”.

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 users of the respective goods or services;
- b) The physical nature of the goods or acts of services;
- c) The respective trade channels through which the goods or services reach the market;
- d) 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;
- e) 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.

In *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another*, [2000] F.S.R. 267 (HC), 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.”

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.”

In *Gérard Meric v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* case T-133/05, the General Court (“GC”) stated:

“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 the trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301,

paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 Oberhauser v OHIM – Petit Liberto (Fifties) [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 Vedral v OHIM – France Distribution (HUBERT) [2002] ECR II-5275, paragraphs 43 and 44; and Case T- 10/03 Koubi v OHIM – Flabesa (CONFORFLEX) [2004] ECR II-719, paragraphs 41 and 42).”

In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the GC stated that “complementary” means:

“...there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking”.

In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* (BL-0-255-13):

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes.”

Whilst on the other hand:

“.....it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.”

18. Although in his counterstatement the applicant did not deny the opponent's claims, I will, none the less, conduct a full comparison of the competing goods and services. In doing so, I have, for economy of procedure, identified what I consider to be the most obvious points of overlap; the applicant's goods may, however, also be considered to be identical (either literally or on the *Meric* principle) to a number of other goods within the opponent's specifications.

Class 5

19. As the term “powdered nutritional supplement drink mix” in the application would be included in the more general phrase “dietetic substances adapted for medicinal use” in the opponent's specification in this class, the competing goods are to be regarded as identical on the *Meric* principle.

Class 29

20. The opponent's specification in this class includes the term “milk and milk products”. This term is identical to “milk and milk products” in the application and is broad enough to also include the following goods in the application which are, as a consequence, to be regarded as identical on the *Meric* principle:

“Beverages consisting principally of milk; Beverages made from or containing milk; Drinking yogurts; Milk based beverages [milk predominating]; Milk based drinks [milk predominating]; Milk beverages; Milk-based beverages containing coffee; Milk-based beverages containing fruit juice; Milk-based beverages flavored with chocolate; Organic milk”.

21. The earlier trade mark includes the term “preserved, dried or cooked fruits and vegetables” which is broad enough to also include the following goods in the

application which are, as a consequence, to be regarded as identical on the *Meric* principle:

“Algae prepared for human foods”, “Aloe vera prepared for human consumption”, “Beans”, “Bottled fruits”, “Bottled sliced fruits”, “Bottled vegetables”, “Candied fruits”, “Candied nuts”, “Coconut”, “Coconut, desiccated”, “Coconut milk powder”, “Coconut oil”, “Dates”, “Dried edible algae”, “Frozen fruits”, “Fruit pulp”, “Fruit puree”, “Fruit rinds”, “Mango”, “Salads (Fruit -)” and “Salads (Vegetable -)”.

22. “Fruit jams”, “Fruit-based snack food”, “Organic nut and seed-based snack bars” and “Hummus” and “Hummus [chickpea paste]” in the application are included within the term “jams”, “snack foods” “and “dips in class 29” respectively which appear in the earlier trade mark’s specification and are identical on the *Meric* principle.

23. “Almond butter”, “Cashew nut butter”, “Cocoa butter”, “Coconut butter”, “Peanut butter” and “Peanut spread” in the application are included within the term “spreads in class 29” which appears in the opponent’s specification and are identical on the *Meric* principle.

Class 30

24. The opponent’s specification in this class includes: “flour and preparations made from cereals” and “snack foods” which are broad enough to include the following goods in the application:

“Cereal bars; Cereal based energy bars; Cereal based food bars; Cereal based foodstuffs for human consumption; Cereal based prepared snack foods; Cereal based snack food; Cereal flour; Cereal powders; Cereal snacks; Edible flour”.

These goods are identical on the *Meric* principle.

25. “Edible essences for foodstuffs [other than etheric substances and essential oils]” in the application is identical to “essences for foodstuffs” in the opponent’s specification. As the terms “Chai (tea)”, “Edible fruit ices” and “Hot chocolate” in the application are included within the terms “tea”, “ices” and “chocolate and tea based beverages” respectively in the opponent’s specification the goods are once again identical on the *Meric* principle.

Class 32

26. The applicant seeks registration in respect of “Smoothies [non-alcoholic fruit beverages]”, “Smoothies” and “Guarana drinks”. Having reviewed the opponent’s specifications and in the absence of any submissions from the opponent to assist me, it appears to me that the high point of the opponent’s case rests with its “dietetic substances adapted for medicinal use” in class 5, which would include dietetic drinks. Such goods may have the same physical nature and method of use as the applicant’s goods. While one may argue that the intended purpose of the competing goods differs, as the applicant points out, it operates in what it considers to be the “health industry”. The value of healthy smoothies as, for example, meal replacements and/or to assist in achieving one’s recommended daily allowance of fruits and vegetables would, by the date of the application, have been well known to the average consumer. There may, in addition, be a degree of both competition and complementarity between the competing goods in the sense that, for example, one may be chosen instead of the other, or both may be used as part of an individual’s health regime. Considered overall, I think there is at least a low degree of similarity between the goods at issue.

Class 43

27. The applicant seeks registration for “Café” and “Juice bar services”. Having applied the case law mentioned above, I can see no meaningful degree of similarity between any of the opponent’s goods and the provision of the services mentioned in this class. In the absence of any submissions from the opponent in this regard, I find there is no similarity between the services in this class and any of the

opponent's goods. In *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, Lady Justice Arden stated that:

“49..... I do not find any threshold condition in the jurisprudence of the Court of Justice cited to us. Moreover I consider that no useful purpose is served by holding that there is some minimum threshold level of similarity that has to be shown. If there is no similarity at all, there is no likelihood of confusion to be considered. If there is some similarity, then the likelihood of confusion has to be considered but it is unnecessary to interpose a need to find a minimum level of similarity.”

28. Having concluded that there is no similarity between any of the opponent's goods and the applicant's services in class 43, there can be no likelihood of confusion and the opposition to the services fails and is dismissed accordingly.

The average consumer and the nature of the purchasing act

29. As the case law above indicates, it is necessary for me to determine who the average consumer is for the goods at issue; I must then determine the manner in which these goods are likely to be selected by the average consumer in the course of trade. 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.”

30. In his counterstatement, Mr Thomson states:

“Furthermore in the health industry the customers of these products are typically more conscious and observant than the average individual...”

31. With the exception of the opponent’s “dietetic substances adapted for medicinal use” and the applicant’s goods in class 5 (the average consumer for which will also include professional users such as dieticians), the average consumer of all the goods which I have found to be identical or similar is a member of the general public. Such goods will, in my experience, most likely be self-selected from the shelves of a bricks and mortar retail outlet or from the equivalent pages of a website. Although the goods I have identified in class 5 may, in particular, also be the subject of, for example, enquiries to sales staff in a bricks and mortar retail setting (where aural considerations will also play their part), in my view, visual considerations are likely to dominate the selection process for all the goods at issue. I have no evidence as to how a professional user such as a dietician would select the goods in class 5, but a review of trade-specific documentation (in both printed and electronic form) and face-to-face discussions with those representing undertakings trading in such goods would seem likely and point to a mixture of visual and aural considerations being involved.


32. As to the degree of care the average consumer will display when selecting the goods, as the goods in classes 29, 30 and 32 are inexpensive and will be selected on a fairly regular basis, I would expect a fairly low degree of attention to be paid to their selection. As to the goods in class 5, once again such goods are likely to be purchased on a fairly regular basis and are unlikely to be terribly expensive. However, as such goods are likely to be selected to cater for specific dietary needs, I am led to conclude that both sets of average consumers are likely to pay a fairly high degree of attention to their selection.

Comparison of trade marks

33. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade 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 trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components. The CJEU 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.”

34. It would be wrong, therefore, artificially to dissect the trade marks, although it is necessary to take into account their distinctive and dominant components and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions they create. The trade marks to be compared are as follows:

The opponent's trade marks	The applicant's trade mark
SUPER NATURAL SUPERNATURAL	

35. In its Notice of Opposition, the opponent states:

“2. The applicant’s mark is similar to the opponent’s mark...The addition of the descriptive words “juice and smoothie bar” in the applicant’s mark are not sufficient to distinguish the marks apart.”

36. In his counterstatement, Mr Thomson states:

“Our mark states “Supernatural Juice and Smoothie Bar” – not just “Supernatural...[The opponent] is arguing that the addition of “Juice and Smoothie Bar” does not distinguish the marks. The addition of “Juice and Smoothie Bar” indicates that this is a separate entity (its own bar) which directly connects the products to the established business and pre-established trade mark. [The opponent] argues that the addition of these words is irrelevant however to the reasonable well informed, observant and circumspect person the words “Juice and Smoothie Bar” are read along with the word “supernatural”...”

37. In these proceedings, the opponent relies upon a series of two trade marks. Both are presented in block capital letters and differ only to the extent that one is presented as two words i.e. “SUPER NATURAL” and the other as a conjoined word i.e. “SUPERNATURAL”. Regardless of their presentation, as the word “SUPERNATURAL” and its meaning will be very well known to the average consumer, it matters not which version I chose upon which to conduct the comparison. The overall impressions created by both trade marks and their distinctiveness lies in their totalities. For the sake of convenience, I will refer to the conjoined version of the opponent’s trade mark i.e. “SUPERNATURAL”.

38. The applicant’s trade mark consists of two components. The first, is the word “supernatural” presented in an unremarkable font in lower case letters and in which the word “super” is presented in a bolder font than the word “natural” which accompanies it. Regardless of its presentation, this component will be understood by the average consumer as the word “supernatural”. The second component consists of the words and symbol “juice & smoothie bar” presented, once again, in an

unremarkable font in lower case letters; these words are much smaller and appear below and within the confines of the word “supernatural” which appears above them. Although these words contribute to the overall impression the trade mark conveys, when considered in relation to the goods which I have found to be identical or similar, they have obvious descriptive/non-distinctive credentials; as a consequence, any distinctiveness they may possess and any contribution they may make to the overall impression conveyed will be very low. Rather, it is the larger and distinctive word “supernatural” appearing at the top of the trade mark which is likely to make by far the more significant contribution to the overall impression the applicant’s trade mark conveys.

39. The competing trade marks consist either exclusively of the word “SUPERNATURAL” or consist of a trade mark in which the word “supernatural” makes by far the more significant contribution to the overall impression conveyed. Notwithstanding the other component present in the applicant’s trade mark (which I have concluded will make a very low contribution to the overall impression conveyed), there remains a high degree of visual similarity between the competing trade marks.

40. As a word well-known to the average consumer, the pronunciation of the opponent’s trade mark is entirely predictable. If, as I think most likely, the average consumer will refer to the applicant’s trade mark by the word “supernatural” alone, the competing trade marks are aurally identical. However, even if I am wrong in that regard and the applicant’s trade mark is referred to as “supernatural juice and smoothie bar”, the fact that the word “supernatural” would be articulated first still results in at least a medium degree of aural similarity between the trade marks at issue.

41. Finally, the conceptual comparison. As mentioned earlier, the word “SUPERNATURAL” and its meaning i.e. “creatures, forces, and events are believed by some people to exist or happen, although they are impossible according to scientific laws” (collinsdictionary.com refers) will be well-known to the average consumer. That is the meaning the opponent’s trade mark will convey; although the words and symbol “juice & smoothie bar” introduce a concept which is alien to the

opponent's trade mark, as they do nothing to modify the meaning of the word "supernatural" in the applicant's trade mark, the competing trade marks are, in my view, conceptually similar to a high degree.

Distinctive character of the earlier trade mark

42. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods for which it has been registered as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

43. These are fast track opposition proceedings in which it was not necessary for the opponent to provide evidence of the use it may have made of its earlier trade mark. As a consequence, I have only the inherent characteristics of its earlier trade mark to consider. In his counterstatement, Mr Thompson states:

"The opponent's existing trade mark has no distinctive character, and in its existing form may even be considered descriptive."

44. I disagree. Although an ordinary dictionary word, it has no obvious descriptive connotations in relation to the goods for which it is registered nor is it non-distinctive. Absent use, it is, in my view, a trade mark possessed of a normal degree of inherent distinctive character.

Likelihood of confusion

45. In determining whether there is a likelihood of confusion, 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 vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the opponent's trade mark as the more distinctive this trade mark is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods, the nature of the purchasing process and 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 he has retained in his mind. Earlier in this decision I concluded that:

- the applicant's goods in classes 5, 29 and 30 are identical to the opponent's goods in the corresponding classes;
- the applicant's goods in class 32 are similar to the named goods in the opponent's specification in class 5 to at least a low degree;
- the average consumer of the parties' goods in class 5 is a member of the general public or a specialist user such as a dietician;
- the average consumer of the parties' goods in classes 29, 30 and 32 is a member of the general public;
- the average consumer will select all of the goods by predominately visual means paying a fairly high degree of attention to the selection of the goods in class 5 and a low degree of attention to the selection of the goods in classes 29, 30 and 32;
- the overall impression conveyed by the opponent's trade mark and its distinctiveness lies in its totality;
- the distinctive word "supernatural" will make by far the most significant contribution to the overall impression the applicant's trade mark conveys;
- the competing trade marks are visually and conceptually similar to a high degree and aurally similar to at least a medium degree;

- the earlier trade mark is possessed of a normal degree of inherent distinctive character.

46. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one trade mark for the other, while indirect confusion is where the average consumer realises the trade marks are not the same but puts the similarity that exists between the trade marks/goods down to the responsible undertakings being the same or related.

47. I am satisfied that even in relation to the goods in class 5 where the average consumer will pay a fairly high degree of attention during the selection process (making them less susceptible to the effects of imperfect recollection), the identity in the goods combined with the normal degree of distinctive character the earlier trade mark possesses and the high degree of overall similarity between the competing trade marks, will lead to a likelihood of direct confusion. It follows that the same conclusion applies, albeit with even greater force, in relation to the goods in classes 29 and 30 where only a low degree of attention will be displayed during the selection process (making imperfect recollection a more relevant factor). I should make it clear that given, in particular, the identity in the goods and the high degree of overall similarity in the competing trade marks, I would have reached the same conclusion even if I had characterised the degree of attention paid to the selection of the goods in classes 29 and 30 as medium or even high.

48. That leaves the applicant's goods in class 32 to consider, goods which I have concluded are similar to the opponent's "dietetic substances adapted for medicinal use" in class 5 to at least a low degree. Bearing in mind, inter alia, the interdependency principle i.e. a greater degree of similarity between the respective trade marks may be offset by a lesser degree of similarity between the respective goods and vice versa, I am, once again, satisfied that the high degree of overall similarity in the competing trade marks is sufficient to lead to a likelihood of direct confusion in relation to the applicant's goods in this class.

Overall conclusion

49. The opposition has succeeded in relation to all of the applicant's goods in classes 5, 29, 30 and 32 but has failed in relation to "Cafés" and "Juice bars" in class 43.

Costs

50. As the opponent has been overwhelmingly successful, it is entitled to a contribution towards its costs (an award I do not intend to reduce given the very limited nature of the applicant's success). Awards of costs in fast track opposition proceedings filed after 1 October 2015 are governed by TPN 2 of 2015. Using that TPN as a guide, I award costs to opponent on the following basis:

Official fee:	£100
Preparing a statement and considering the applicant's statement:	£100
Total:	£200

51. I order Daniel Thomson to pay to J Sainsbury plc the sum of £200. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 14th day of February 2017



C J BOWEN
For the Registrar