

O/258/20

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS
IN THE MATTER OF APPLICATIONS NO. UK00003358037
AND NO. UK00003358042 BY
HUNTAPAC PRODUCE LTD
TO REGISTER:

ROOTS

and



AS TRADE MARKS IN CLASSES 29, 30, 31 AND 32

AND

IN THE MATTER OF OPPOSITIONS THERETO
UNDER NO. 415564 AND NO. 416852 BY
KETTLE PRODUCE LIMITED

BACKGROUND AND PLEADINGS

1. On 3 December 2018, Huntapac Produce Ltd (“the applicant”) applied to register the following trade marks in the UK:

ROOTS

(“the applicant’s first mark”)

which was published for opposition purposes on 10 May 2019; and



(“the applicant’s second mark”)

which was published for opposition purposes on 28 December 2018.

2. The applicant’s first mark and second mark (collectively “the applicant’s marks”) share identical specifications. The applicant seeks registration for the following goods:

Class 29: Processed vegetables; peeled vegetables; chopped vegetables; cut vegetables; mixed vegetables; frozen vegetables; dried vegetables; pre-cut vegetables; cooked vegetables; Vegetables Cooked; Vegetable fats for cooking; Vegetables, tinned [canned (Am.)] [to the extent these comprise cooked vegetables];Vegetable, preserves[to the extent these comprise cooked vegetables];Vegetables, preserved [to the extent these comprise cooked vegetables];Vegetables preserved in oil [to the extent these comprise cooked vegetables]; Vegetable stock; Vegetable mousses; Vegetable juices for cooking; Vegetable jellies; Vegetable-based meat substitutes; Vegetable-based snack foods; Vegetable-based entrees; Vegetable-based spreads; Vegetable fats for food; Vegetable puree; Vegetable

purees; Vegetable marrow paste; Vegetable powders; Vegetable chips; Vegetable spreads; Vegetable burgers; Vegetable pastes; Vegetable oils for food; Crisps; Crisps (Potato -); Vegetable Crisps, Vegetables pickled; Vegetable soup preparations; Vegetable sausages; Vegetable flakes; Vegetable jams; Vegetable Chutneys; Vegetable compotes; Fruit based snack foods; fruit chips; fruit crisps; Snack bars containing principally, fruit, nuts and seed.

Class 30: Vegetable concentrates used for seasoning; Vegetable pulps [sauces - food] [to the extent these comprise prepared meals containing [principally] rice or pasta]; Vegetable flour; Vegetable purees [sauces] [to the extent these comprise prepared meals containing [principally] rice or pasta]; Vegetable-based seasonings for pasta; Vegetable pastes [sauces][to the extent these comprise prepared meals containing [principally] rice or pasta]; Vegetable flavoured corn chips; Vegetable thickeners; Vegetable based coffee substitutes; Crisps made of cereals; Cereal based snack foods; Tapioca based snack foods; Fruit flours, Fruit purees; Cereal based snack foods incorporating vegetables; Cereal based snack foods incorporating fruit; Snack bars containing principally, cereal, grains and nuts.

Class 31: Fresh vegetables; fresh salad vegetables; organic fresh vegetables; Vegetables Fresh; Vegetable seeds; Vegetable marrows, fresh; carrots.

Class 32: Fruit drinks and juices; Vegetable juices [beverages]; Vegetable juice; Vegetable drinks; Vegetable based beverages; Vegetable smoothies; Carrot juice; Carrot juice drinks and beverages; water.

3. The applicant's first mark was opposed on 4 July 2019. The applicant's second mark was opposed on 25 February 2019. Both applicant's marks were opposed by Kettle Produce Ltd ("the opponent"). The opposition is based on section 5(2)(b) of

the Trade Marks Act 1994 (“the Act”). The opponent relies on the following series of trade marks:

roots collective

Roots Collective

ROOTS COLLECTIVE

UK registration no. 3091074

Filing date 26 January 2015; registration date 17 April 2015

Relying on all goods namely:

Class 30: Prepared meals contained [principally] rice; prepared meals containing [principally] pasta.

Class 32: Non-alcoholic drinks, except carrot juice drinks.

Class 33: Alcoholic beverages, except beer.

(“the earlier registration”)

4. The opposition is directed against the following goods within the applicant’s marks’ specifications only:

Class 29: Vegetable soup preparations.

Class 30: Vegetable pulps [sauces - food] [to the extent these comprise prepared meals containing [principally] rice or pasta]; Vegetable purees [sauces] [to the extent these comprise prepared meals containing [principally] rice or pasta]; Vegetable pastes [sauces] [to the extent these comprise prepared meals containing [principally] rice or pasta].

Class 32: Fruit drinks and juices¹; Vegetable juices [beverages]; Vegetable juice; Vegetable drinks; Vegetable based beverages; Vegetable smoothies; Carrot juice; Carrot juice drinks and beverages; water.

5. The opponent submits that there exists a likelihood of confusion between the parties' respective marks due to the high degree of similarity between them and the identity and similarity between the goods.
6. The applicant filed counterstatements stating that the oppositions should fail for all goods opposed except "water and non-alcoholic drinks".
7. By letter dated 9 September 2019, the Registry confirmed to the parties that the proceedings were to be consolidated pursuant to Rule 62(g) of the Trade Marks Rules 2008.
8. The applicant is represented by Wilson Gunn and the opponent is represented by CMS Cameron McKenna Nabarro Olswang LLP. Only the opponent has filed evidence. No hearing was requested and only the opponent has filed written submissions in lieu of a hearing. Throughout their pleadings and submissions, the parties have referred to the previous proceedings between them that were dealt with by this Office on 2 May 2018 by way of decision number O-269-18 ("the previous proceedings"). I have taken the evidence, the written submissions and the previous proceedings into consideration and will refer to them below where necessary. This decision is taken following a careful perusal of the papers.

EVIDENCE

9. The opponent has submitted evidence in the form of the witness statement of Susan Jane McIntyre dated 8 November 2019, being the opponent's managing

¹ The opponent initially directed its opposition against the goods "non-alcoholic drinks". On 8 August 2019, the applicant amended its specifications to replace "non-alcoholic drinks" with "fruit drinks and juices". In its written submissions, the opponent maintains its opposition against the amended goods.

director. The evidence focuses on the comparison between the parties' goods, specifically, "non-alcoholic drinks, except carrot juice drinks" contained within the earlier registration's specification and the applicant's goods, specifically:

"Fruit drinks and juices; Vegetable juices [beverages]; Vegetable juice; Vegetable drinks; Vegetable based beverages; Vegetable smoothies; Carrot juice; Carrot juice drinks and beverages; water"

10. The opponent's evidence consists of screenshots of various vegetable juice products that can be obtained from online retailers such as Ocado, Google Shopping, biovea.net, pure-oils.co.uk, thefoodmarket.com, James White and 1juice.co.uk². The opponent states that the main ingredient of these products is vegetables and that they are either made from 100% pure vegetable juice or vegetable juice with fruit juice added as a sweetener or with other additives. Further, the opponent provides an article from the website Healthline.com entitled "The Best 12 Vegetables to Juice"³ and an Amazon.co.uk list of best sellers in the 'Juices & Smoothies' category⁴.

11. The opponent also submits that in the marketplace, vegetable drinks and juices are included within the general non-alcoholic category of goods. To demonstrate its point, the opponent has included screenshots of various online supermarket websites such as Tesco, Ocado, ASDA and Waitrose⁵. These screenshots show various fruit and vegetable juice products listed together online. For example, organic carrot juice is shown alongside orange and mango juice, vegetable juice is shown alongside cloudy lemonade and multipack cans of coca-cola are shown alongside a ginger shot. The screenshots are dated either 29 October 2019 or 5 November 2019 and as a result, are dated after the relevant date.

² Exhibit SJM-1

³ Exhibit SJM-2

⁴ Exhibit SJM-3

⁵ Exhibit SJM-4

DECISION

Section 5(2)(b): legislation and case law

12. Section 5(2)(b) of the Act reads as follows:

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

(a) ...

(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 or association with the earlier trade mark.”

13. Section 5A of the Act states as follows:

“Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

14. 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.”

15. Given its filing date, the earlier registration qualifies as an earlier trade mark under the above provisions. As the earlier registration had not completed its registration process more than 5 years before the date of the application in issue, it is not subject to proof of use pursuant to section 6A of the Act. The opponent can, therefore, rely upon all of the goods for which the marks are registered.

16. 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 Office for Harmonization in the Internal Market (Trade Marks and Designs) (“OHIM”)*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

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

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

- (d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;
- (e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;
- (f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;
- (g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;
- (h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;
- (i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;
- (j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;
- (k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods

17. The specifications of the applicant's marks (set out in paragraph 2 above) are identical. The same goods comparison with the earlier registration can therefore be applied to both of the applicant's marks.

18. The competing goods are set out as follows:

The earlier registration's goods	The applicant's marks' goods
<p><u>Class 30</u> Prepared meals contained [principally] rice; prepared meals containing [principally] pasta.</p> <p><u>Class 32</u> Non-alcoholic drinks, except carrot juice drinks.</p> <p><u>Class 33</u> Alcoholic beverages, except beer.</p>	<p><u>Class 29</u> Vegetable soup preparations.</p> <p><u>Class 30</u> Vegetable pulps [sauces - food] [to the extent these comprise prepared meals containing [principally] rice or pasta]; Vegetable purees [sauces] [to the extent these comprise prepared meals containing [principally] rice or pasta]; Vegetable pastes [sauces] [to the extent these comprise prepared meals containing [principally] rice or pasta].</p> <p><u>Class 32</u> Fruit drinks and juices; Vegetable juices [beverages]; Vegetable juice; Vegetable drinks; Vegetable based beverages; Vegetable smoothies; Carrot juice; Carrot juice drinks and beverages; water.</p>

19. When making the comparison, all relevant factors relating to the goods in the specifications should be taken into account. 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 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”.

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

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

21. The General Court (“GC”) confirmed in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, that, even if goods or services are not worded identically, they can still be considered identical if one term falls within the scope of another or (vice versa):

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

22. The opponent has provided detailed submissions regarding the comparison of the goods which I do not propose to reproduce in full, however, I will refer to them where necessary below.

Class 29 goods

23. The class 29 goods contained within the applicant’s marks’ specifications that are opposed by the opponent are “Vegetable soup preparations”.

24. The opponent has submitted that:

“the vegetable soup preparations of the ‘037 and ‘042 marks are similar to the prepared meals of Kettle’s Earlier Mark. Whilst they do not contain (principally) rice or pasta, soup preparations are nonetheless prepared meals which require only minimal further input – typically heating – from the consumer before they are ready to eat.”

25. The opponent also goes on to refer to the decision under the previous proceedings wherein the Hearing Officer in those proceedings found that these goods were similar to between low and medium degree.

26. “Vegetable soup preparations” within the applicant’s marks’ specifications describes pre-made vegetable soups. These goods do not have a direct counterpart within the earlier registration’s specification. While the applicant’s goods will not be made up principally of rice or pasta, I am of the view that a significant proportion of average consumers will consider “vegetable soup preparations” to be a pre-made meal. I, therefore, consider them to be similar to both “prepared meals contained [principally] rice” and “prepared meals containing [principally] pasta” contained in the earlier registration’s specification. These goods may overlap in use and user because they can both be used by the general public as an alternative to preparing and cooking their own meals. Further, there may be overlap in trade channels because the same undertakings may produce both ready-made soups and other ready-made meals. These goods may also have a competitive relationship in that the average consumer for these goods may wish to either purchase a pre-made soup or a pre-made rice/pasta meal. I therefore consider these goods to be similar to a medium degree.

Class 30 goods

27. The class 30 goods contained within the applicant’s marks’ specifications that are opposed by the opponent are “Vegetable pulps [sauces - food] [to the extent these comprise prepared meals containing [principally] rice or pasta]”, “Vegetable purees [sauces] [to the extent these comprise prepared meals containing [principally] rice or pasta]” and “Vegetable pastes [sauces] [to the extent these comprise prepared meals containing [principally] rice or pasta]”.

28. In its counterstatement, the applicant stated as follows:

“UKIPO Decision O-269-18 at paragraph 72 confirms that the opposition by Kettle Produce Limited (as the Opponent in the current proceedings) failed in respect of the goods in Class 30 “Vegetable pulps [sauces-food], purees [sauces] and pastes [sauces], [to the extent that these comprise prepared meals containing [principally] rice or pasta]”. Therefore, as this current opposition is on the same grounds it must also fail for the above goods.”

29. In response to this, the opponent submits that the applicant's position is "based on a misunderstanding of Decision O-269-18." The opponent further submits that,

"18. In the current proceedings, Huntapac appear to suggest in their counterstatements that in the previous proceedings the Hearing Officer allowed their opposed mark to be registered for the above goods 'to the extent these comprise prepared meals containing [principally] rice or pasta'. They have, for this reason, applied to register the '037 and '042 marks using this additional text and assert that, in light of the previous proceedings, the current opposition should fail. This, in Kettle's submission, is manifestly not the case.

19. First, the additional text was not part of Huntapac's specification: it showed the extent of Kettle's opposition if it were held that the pulps, purees and pastes of Huntapac's specification covered the prepared meals of Kettle's specification.

20. Second, the opposition failed in respect of these goods precisely because the Hearing Officer held the scope of pulps, purees and pastes not to include 'prepared meals containing [principally] rice or pasta'. [...]

22. [...] the previous proceedings involved determination of whether 'Vegetable pulps [sauces-food]', 'Vegetable purees [sauces]' and 'Vegetable pastes [sauces]' included 'prepared meals containing [principally] rice or pasta'. The Hearing Officer found they did not. The identity/similarity (or lack of) between the 'prepared meals containing [principally] rice or pasta' of the Earlier Mark and the pulps, purees and pastes of the '037 and '042 Marks 'to the extent these comprise prepared meals containing [principally] rice or pasta' is not a matter on which the Hearing Officer in the previous proceedings made a finding; *this* is the issue for determination in these proceedings. [...]

23. [...] Huntapac now seek to register a mark for which the specified goods *do include* certain types of prepared meals. It is readily apparent that, given Huntapac are now including prepared meals, there is overlap with the prepared

meals of Kettle's specification; there is identity 'to the extent these comprise prepared meals [principally] rice or pasta.'

30. For reasons that I will now explain, I agree with the opponent that the Hearing Officer in the previous proceedings did not make a finding in respect of the identity/similarity between the goods contained within the earlier registration's specification and the goods as now applied for by the applicant.

31. The Hearing Officer set out a comparison of the goods at paragraph 60 of the decision in the previous proceedings. At paragraph 60, the Hearing Officer stated that "Kettle's opposition is limited to the goods highlighted in bold. Further, in its submissions, Kettle specifies the limit of the opposition with the word to *"the extent that"* which are reproduced in brackets and italics."

32. In respect of these goods, the Hearing Officer added the words '*to the extent these comprise prepared meals containing [principally] rice or pasta*' to the comparison because it was to this extent that the opponent was attacking the applicant's goods. For the avoidance of doubt, the comparison in the previous proceedings was between "vegetable pulps [sauces – food]", "vegetable purees [sauces]" and "vegetable pastes [sauces]" within the applicant's previous specification and the categories "prepared meals contained [principally] rice" and "prepared meals containing [principally] pasta" contained within the earlier registration's specification.

33. The Hearing Officer made the following finding (at paragraph 65):

"Huntapac's vegetable pulps [sauces – food], vegetable purees [sauces] and vegetable pastes [sauces] are all ready-made sources made from vegetables. They are attacked by Kettle to the extent that they comprise prepared meals containing [principally] rice or pasta. However, the goods would only comprise sources used to make pasta or rice dishes, e.g. tomato sauce, pesto, and would not include prepared meals containing [principally] rice or pasta. The opposition against these goods must therefore fail to the extent that the conflict identified by Kettle is not reflected in the specification."

34. I agree with the Hearing Officer that the applicant's goods in the previous proceedings were not identical or similar to the opponent's goods. However, the same comparison does not apply to these proceedings. The additional wording contained within the applicant's marks' specifications materially changes the type of goods for which protection is now sought for the applicant's marks. It is now necessary to consider what the applied-for goods describe and apply the necessary comparisons.

35. In the absence of any submissions to the contrary, I find that "vegetable pulps [sauces - food] [to the extent these comprise prepared meals containing [principally] rice or pasta]" as contained within the applicant's marks' specification describes ready-made meals that contain rice or pasta as their principal ingredient and will include a sauce that is made from vegetable pulps. Therefore, these goods fall within the broader categories "prepared meals contained [principally] rice" and "prepared meals containing [principally] pasta" as contained in the earlier registration's specification. These goods are therefore identical under the principle outlined in *Meric*.

36. In the absence of any submissions to the contrary, I find that "vegetable purees [sauces] [to the extent these comprise prepared meals containing [principally] rice or pasta]" as contained within the applicant's marks' specification describes ready-made meals that contain rice or pasta as their principal ingredient and will include a sauce that is made from vegetable purees. Therefore, these goods fall within the broader categories "prepared meals contained [principally] rice" and "prepared meals containing [principally] pasta" as contained in the earlier registration's specification. These goods are therefore identical under the principle outlined in *Meric*.

37. In the absence of any submissions to the contrary, I find that "vegetable pastes [sauces] [to the extent these comprise prepared meals containing [principally] rice or pasta]" as contained within the applicant's marks' specification describes ready-made meals that contain rice or pasta as their principal ingredient and will include

a sauce that is made from vegetable pastes. Therefore, these goods fall within the broader categories “prepared meals contained [principally] rice” and “prepared meals containing [principally] pasta” as contained in the earlier registration’s specification. These goods are therefore identical under the principle outlined in *Meric*.

Class 32 goods

38. The class 32 goods contained within the applicant’s marks’ specifications that are opposed by the opponent are “Fruit drinks and juices”, “Vegetable juices [beverages]”, “Vegetable juice”, “Vegetable drinks”, “Vegetable based beverages”, “Vegetable smoothies”, “Carrot juice”, “Carrot juice drinks and beverages” and “water”.

39. I have no submissions from the applicant as to its position in respect of “fruit drinks and juices”. However, in its counterstatements, the applicant stated:

“in consideration of the fact that the Opponents goods are ‘non-alcoholic drinks, except carrot juice’ in Class 32, the Applicant denies that these goods are similar to the Applicant’s goods ‘vegetable juices [beverages], vegetable juice, vegetable drinks, vegetable based beverages, vegetable smoothies, carrot juice, and carrot juice drinks and beverages’. Such goods are excluded from the Opponent’s class 32 protection.”

40. In respect of the applicant’s class 32 goods, the opponent submits that:

“29. [...] whilst ‘carrot juice drinks’ are excluded from the class 32 specification of Kettle’s Earlier Marks, meaning Kettle cannot rely on identity of goods within the Earlier Mark’s specification with carrot juice drinks within the specification of the ‘037 and ‘042 Marks, Kettle can rely on similarity between the ‘non-alcoholic drinks except carrot juice’ of Kettle’s Earlier Mark and Huntapac’s ‘carrot juice, carrot juice drinks and beverages’ (and, to the extent they amount to carrot juice and carrot juice drinks, ‘Vegetable juices [beverages]; Vegetable juice, Vegetable drinks; Vegetable based beverages; Vegetable smoothies’).

30. It is submitted that it is self-evident that there is a high level of similarity between these goods.”

41. “Fruit drinks and juices”, “Vegetable juices [beverages]”, “Vegetable juice”, “Vegetable drinks”, “Vegetable based beverages” and “Vegetable smoothies” contained within the applicant’s marks’ specification are all forms of non-alcoholic beverages. While these goods may still include ‘carrot juice’, which is excluded from the earlier registration’s specification, they would include drinks made from other vegetables and would therefore fall within the broader category of “non-alcoholic drinks, except carrot juice drinks” in the earlier registration’s specification. These goods can therefore be considered identical on the principle outlined in *Meric*.

42. Carrot juice is expressly excluded from the earlier registration’s specification. I agree with the opponent’s submission that “Carrot juice” and “Carrot juice drinks and beverages” contained within the applicant’s marks’ specification cannot be considered identical to “non-alcoholic drinks, except carrot juice drinks” on the principle outlined in *Meric*. In my view, and in the absence of any submissions to the contrary, I consider carrot juice and carrot juice drinks to be non-alcoholic vegetable beverages. “Non-alcoholic drinks, except carrot juice drinks” contained within the earlier registration’s specification is a broad term and can encompass a wide range of drinks, including many types of non-alcoholic vegetable drinks and/or juices (except carrot drinks). These drinks/juices will be highly similar to carrot juice and they are likely to overlap in use, user and nature. Further, there may be overlap in trade channels because the same undertakings are likely to produce both carrot juice and other type of vegetable or fruit juices. The goods will likely be found on the same shelves of a supermarket. While the opponent’s evidence shows carrot juice alongside other types of fruit and vegetable juices on online supermarket websites⁶, the evidence does not reflect the position of the market at the relevant date. Notwithstanding this, I am of the view that, in any event, these goods are likely to be sold in the same aisles of supermarkets and the same sections of online

⁶ Exhibit SJM-4

retailers. These goods are also likely to have a competitive relationship. I, therefore, agree with the opponent's submission that there is a high level of similarity between these goods.

43. In its counterstatements, the applicant stated that "water" as contained within its marks' specifications is similar to "non-alcoholic drinks, except carrot juice drinks" in the earlier registration's specification. In my view, and in the absence of any submissions to the contrary, I consider "water" in the applicant's mark's specifications to be drinking water and, therefore, a non-alcoholic drink. Whilst I note that the applicant accepted that these goods are similar, they are in my view identical on the principle outlined in *Meric*.

The average consumer and the nature of the purchasing act

44. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods. I must then decide 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."

45. The opponent submits that the "the relevant consumer includes shoppers frequenting shops, including supermarkets and their online shopping pages". I have no submissions from the applicant on this point. I consider that the average consumer for the goods will be a member of the general public.

46. The goods are most likely to be sold through a range of retail shops, such as supermarkets and their online equivalents. Some of the goods may also be sold in cafes, restaurants, bars and public houses. In retail premises, the goods at issue will be displayed on shelves, where they will be viewed and self-selected by the consumer. A similar process will apply to websites, where the consumer will select the goods having viewed an image displayed on a webpage. In outlets such as cafes, bars, restaurants and public houses, the goods are likely to be on display, for example, behind the counter at bars or on drinks menus. While I do not discount there may be an aural component in the selection and ordering of the goods in eating and drinking establishments, this is likely to take place after a visual inspection of the goods or a menu (see *Simonds Farsons Cisk PLC v OHIM*, Case T-3/04 (GB)). The selection of the goods at issue will, therefore, be primarily visual, although I do not discount that aural considerations may play a part.

47. The goods at issue are every day food and beverage products that are likely to be relatively inexpensive. The purchase of the goods at issue are likely to be fairly frequent. When selecting the goods, the average consumer is likely to consider such things as dietary requirements, flavour, use by/best before dates and/or nutritional information. The average consumer is, therefore, likely to pay a medium degree of attention during the selection process. However, I recognise that some of the goods will be more casual purchases (such as bottled water), and for those goods I find that the average consumer is likely to pay a lower degree of attention.

Distinctive character of the earlier registration

48. 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).”

49. Registered trade marks possess various degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use made of it.

50. Neither party has made any submissions regarding the distinctive character of the earlier registration. I have, therefore, only the inherent position to consider.

51. I must assess the inherent distinctiveness of the earlier registration as a whole. The word ‘ROOTS’ is plural of the word ‘root’, which has multiple meanings. It is, therefore, necessary to consider the meaning of the word in relation to the earlier registration’s goods. For any vegetable, fruit or other plant-based good, I find that a significant proportion of average consumers would link the word ‘roots’ to the root of a vegetable and/or fruit plant from which the product is sourced. It may also be seen as a reference to a particular type of vegetable i.e. root vegetables. In this context, the word ‘roots’ would be allusive to the goods. For the goods with no

obvious link to fruits, vegetables or other plant-based products, I find that a significant proportion of average consumers would link the word 'roots' to the source of the product, whatever that may be. In both contexts, I find that, ultimately, the word 'roots' on the earlier registration is a reference to the source of the goods at issue. Given that the word 'ROOTS' may be used on plant-based products, I find that it may be allusive to some of the goods for which the mark is registered, but not all. It will therefore have between a low and medium degree of inherent distinctiveness.

52. The earlier registration also contains the word COLLECTIVE, which has multiple meanings. It can be used as a general term for two or more types of things or a business which is run, and often owned, by a group of people who take an equal share of any profits⁷. When viewed on the earlier registration's goods, I consider that a significant proportion of average consumers would view the word COLLECTIVE to be a reference to the company (or collection of companies) that provides the goods. The word COLLECTIVE would, therefore, contribute little to the distinctiveness of the earlier registration. Overall, I consider the earlier registration to have between a low and medium degree of inherent distinctive character.

Comparison of marks

53. It is clear from *Sabel 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.


54. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

⁷ <https://www.collinsdictionary.com/dictionary/english/collective>

“... 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.”

55. It would be wrong, therefore, to artificially dissect the trade marks, although it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

56. The respective trade marks are shown below:

Opponent’s trade marks (series of 3)	Applicant’s trade marks
<p style="text-align: center;">roots collective Roots Collective ROOTS COLLECTIVE</p>	<p style="text-align: center;">ROOTS (the applicant’s first mark)</p> <div style="text-align: center;">  </div> <p style="text-align: center;">(the applicant’s second mark)</p>

57. In its counterstatements, the applicant “admits that the respective trade marks are similar”. This concession means that I accept the marks are similar for the purpose of assessing likelihood of confusion under section 5(2)(b) of the Act. However, I will still need to carry out my own assessment to determine the overall impression the marks convey and their level of similarity.

58. I have lengthy submissions from the opponent regarding the similarity of the marks. Whilst I do not propose to reproduce these in full here, I will refer to them below where necessary.

Overall Impression

The applicant's first mark

59. The applicant's first mark consists of the word ROOTS. There are no other elements to contribute to the overall impression, which lies in the word itself.

The applicant's second mark

60. The applicant's second mark consists of the same word as the applicant's first mark but it is presented in a stylised font. The letter R is stylised to incorporate a carrot device. While the figurative elements are noticeable, the overall impression of the applicant's mark lies in the word ROOTS, with the device, stylisation and underline playing a lesser role.

The earlier registration

61. The earlier registration consists of a series of three marks each consisting of the words roots collective and presented as 'roots collective', 'Roots Collective' and 'ROOTS COLLECTIVE'. There are no other elements to contribute to the overall impression, which lies in the words themselves. I have found above that the word COLLECTIVE does not contribute significantly to the earlier registration's distinctiveness. Given the fact that a significant proportion of average consumers will view the word COLLECTIVE as a reference to the company providing the goods, it will play a lesser role in the overall impression of the earlier registration. While the word ROOTS may be considered allusive to some of the goods protected under the mark, I find that it still plays the greater role in the overall impression of the mark.

Visual Comparison

62. The opponent has submitted that “at the visual level, there is a medium degree of similarity between the Earlier Mark and the ‘042 Mark, and a high degree of similarity between the Earlier Mark and the ‘037 Mark. Whilst the Earlier Mark includes an additional word (‘COLLECTIVE’), absent from the ‘042 and ‘037 Marks, this lies to the right of ‘ROOTS’, the first of the two words, and so is of lower dominance. The ‘042 Mark features a stylised R, taking the form of a carrot, though the degree of stylisation is relatively low, with the effect that the dominant and distinctive element of the mark is the word ROOTS. For the ‘037 Mark, there is no such stylisation; this mark has a higher level of similarity with the Earlier Mark.”

The applicant’s first mark and the earlier registration

63. Visually, the marks coincide in that they share the word ROOTS. The marks differ in the word COLLECTIVE, that is present in the earlier registration but absent in the applicant’s first mark. Both marks are word only marks. While I have found the word COLLECTIVE plays a lesser role in the overall impression of the earlier registration, it still constitutes a visual difference between the marks. Additionally, it is established case law that the beginnings of marks tend to have more impact than the ends (see *El Corte Inglés, SA v OHIM* Cases T-183/02 and T-184/02). I, therefore, find that the marks are similar to a high degree.

The applicant’s second mark and the earlier registration

64. The visual similarities and differences set out above in my comparison of the applicant’s first mark and the earlier registration also apply to the comparison between the applicant’s second mark and the earlier registration. However, there are additional differences in that the word ROOTS in the applicant’s second mark is presented in a slightly stylised font that incorporates a carrot in the letter R. I note that the earlier registration is a word only mark and can be used in any standard typeface. Overall, while there are stylistic differences in the presentation of the applicant’s second mark, I have found that the word ROOTS still plays the greater role in the overall impression of the applicant’s second mark. The opponent

has submitted that the applicant's first mark shares a higher similarity than the applicant's second mark due to the presence of the stylisation acting as a point of additional visual difference between them. I agree with these submissions and therefore find that the marks are similar to a higher than medium degree.

Aural Comparison

65. The opponent has submitted that "at the aural level, there is no difference between the '037 and '042 Marks. As to the comparison with the Earlier Mark, again, whilst the latter includes the additional word 'COLLECTIVE', it is the first word, 'ROOTS', which is the dominant component. It is submitted that the Earlier Mark is aurally similar to the 037 and '042 Marks to a medium degree."

66. Given that the stylistic and device elements of the applicant's marks will not be pronounced they are aurally identical, and the below comparison will apply to both of the applicant's marks.

67. Aurally, the applicant's marks consist of one syllable that will be pronounced ROOTS. The earlier registration consists of four syllables, being ROOTS-COLL-ECK-TIV. The similarities include the entirety of the aural element of the applicant's marks. The marks differ aurally with the inclusion of the last three syllables of the earlier registration, being COLL-ECK-TIV. As noted above, I have found that the word COLLECTIVE plays a lesser role in the earlier registration. I conclude that if the word COLLECTIVE in the earlier registration is not pronounced (because it is simply viewed as the type of organisation) then the marks will be aurally identical. If the word COLLECTIVE is pronounced, then they will be aurally similar to a high degree.

Conceptual Comparison

68. The opponent has submitted that, "at the conceptual level, 'COLLECTIVE' adds little to the 'ROOTS' component of the Earlier Mark; if anything, it is suggestive of a brand extension. Given the shared meaning of the Earlier Marks and the 037 and '042 Marks, it is submitted there is a high degree of conceptual similarity."

The first applicant's mark and the earlier registration

69. In assessing the distinctive character of the earlier registration and the overall impression of the marks, I have found that a significant proportion of average consumer would connect the word ROOTS on both marks to a reference to the source of the goods at issue, whether they are plant-based products or not. The word ROOTS on both marks is, therefore, conceptually identical. I have also found that the word COLLECTIVE on the earlier registration refers to the company producing the goods. It, therefore, bears little trade mark significance and does not contribute much to the conceptual meaning conveyed by the earlier registration. Given that the word COLLECTIVE is the only conceptual difference between the marks and its contribution is minimal, I find that the marks are conceptually similar to a high degree.

The applicant's second mark and the earlier registration

70. The conceptual similarities and differences set out above in my comparison of the applicant's first mark and the earlier registration also apply to the comparison between the applicant's second mark and the earlier registration. The font stylisation used does not alter the conceptual meaning of the word ROOTS in the applicant's second mark. However, I note that the applicant's second mark also includes a carrot device which is not present in the applicant's first mark. A carrot is a vegetable and its incorporation into the word ROOTS provides a further connection to my finding above, being the roots of the plant and the source of the carrot itself. I, therefore, find that the marks are conceptually similar to a high degree.

Likelihood of confusion

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

undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier registration, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

72. I have found the goods to vary from being identical to similar to a medium degree. I have found the average consumer to be a member of the general public who will purchase the goods primarily by visual means, although I do not discount an aural component. I have concluded that a medium degree of attention is likely to be paid in the purchasing process although I recognised that for some of the goods, a lower degree of attention may be paid. I have taken these factors into account in my assessment of the likelihood of confusion between the marks.

Direct confusion

The applicant's first mark and the earlier registration

73. I have found the applicant's first mark and the earlier registration to be visually similar to a high degree, aurally identical or highly similar (depending on whether the word COLLECTIVE is pronounced) and conceptually similar to a high degree. The earlier registration is inherently distinctive to between a low and medium degree. However, the fact that the earlier registration has a relatively weak distinctive character does not preclude a likelihood of confusion.⁸

⁸ *L'Oréal SA v OHIM*, Case C-235/05 P

74. Taking all of these factors into account, I am satisfied that the average consumer would likely mistake one mark for the other. This is particularly the case given that I have found that the word 'COLLECTIVE' has little significance in the earlier registration. It is, therefore, likely to be overlooked or forgotten by the average consumer. As a result, the average consumer is likely to only consider the word 'ROOTS' in the earlier registration. Given that 'ROOTS' forms the entirety of the visual, aural and conceptual component of the applicant's first mark, I consider there to be a likelihood of direct confusion between the marks for all goods against which the opposition was directed.

The applicant's second mark and the earlier registration

75. I have found the applicant's second mark and the earlier registration to be visually similar to a higher than medium degree, aurally identical or highly similar (again, depending on whether the word COLLECTIVE is pronounced) and conceptually similar to a high degree. The earlier registration is inherently distinctive to between a low and medium degree.

76. The earlier registration is a word only mark and can be used in any standard typeface. It can, therefore, be displayed in the same font as the applicant's second mark. While the carrot device contained within the applicant's second mark is identifiable, I have found that the overall impression of the applicant's second mark lies in the word 'ROOTS'. I have also found that the word 'COLLECTIVE' in the earlier registration is likely to be overlooked or forgotten by the average consumer. As a result, I consider that there will be a likelihood of direct confusion between the marks for all goods against which the opposition was directed.

77. In the event that I am incorrect in my findings of direct confusion, I will proceed to consider the likelihood of indirect confusion.

Indirect confusion

78. Indirect confusion was described in the following terms by Iain Purvis Q.C., sitting as the Appointed Person in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10.

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.”

79. I must now consider the possibility of indirect confusion and whether average consumers would believe that there is an economic connection between the marks or that they are variant marks from the same undertaking as a result of the shared common elements of the marks. In my view, even if I am wrong in my finding that the word COLLECTIVE is likely to be forgotten or overlooked by the average consumer, it is likely to be seen as an indication of the type of business being operated under the mark and will be attributed little trade mark significance. Further, the addition of the stylisation in the applicant’s second mark will just be seen as an alternative mark being used by the same or economically linked undertakings. Taking all of the above factors into account, the presence of the word ROOTS in each of the marks will lead the average consumer to view them as alternative marks used by the same or economically linked undertakings. I therefore consider there to be a likelihood of indirect confusion for all goods against which the opposition was directed.

CONCLUSION

80. The opposition succeeds in its entirety and the applications are refused in respect of the following goods:

Class 29: Vegetable soup preparations.

Class 30: Vegetable pulps [sauces - food] [to the extent these comprise prepared meals containing [principally] rice or pasta]; Vegetable purees [sauces] [to the extent these comprise prepared meals containing [principally] rice or pasta]; Vegetable pastes [sauces][to the extent these comprise prepared meals containing [principally] rice or pasta].

Class 32: Fruit drinks and juices; Vegetable juices [beverages]; Vegetable juice; Vegetable drinks; Vegetable based beverages; Vegetable smoothies; Carrot juice; Carrot juice drinks and beverages; water.

81. The opposition was not directed against the following goods, for which the applications can proceed to registration:

Class 29: Processed vegetables; peeled vegetables; chopped vegetables; cut vegetables; mixed vegetables; frozen vegetables; dried vegetables; pre-cut vegetables; cooked vegetables; Vegetables Cooked; Vegetable fats for cooking; Vegetables, tinned [canned (Am.)] [to the extent these comprise cooked vegetables];Vegetable, preserves[to the extent these comprise cooked vegetables];Vegetables, preserved [to the extent these comprise cooked vegetables];Vegetables preserved in oil [to the extent these comprise cooked vegetables]; Vegetable stock; Vegetable mousses; Vegetable juices for cooking; Vegetable jellies; Vegetable-based meat substitutes; Vegetable-based snack foods; Vegetable-based entrees; Vegetable-based spreads; Vegetable fats for food; Vegetable puree; Vegetable

purees; Vegetable marrow paste; Vegetable powders; Vegetable chips; Vegetable spreads; Vegetable burgers; Vegetable pastes; Vegetable oils for food; Crisps; Crisps (Potato -); Vegetable Crisps, Vegetables pickled; Vegetable sausages; Vegetable flakes; Vegetable jams; Vegetable Chutneys; Vegetable compotes; Fruit based snack foods; fruit chips; fruit crisps; Snack bars containing principally, fruit, nuts and seed.

Class 30: Vegetable concentrates used for seasoning; Vegetable flour; Vegetable-based seasonings for pasta; Vegetable flavoured corn chips; Vegetable thickeners; Vegetable based coffee substitutes; Crisps made of cereals; Cereal based snack foods; Tapioca based snack foods; Fruit flours, Fruit purees; Cereal based snack foods incorporating vegetables; Cereal based snack foods incorporating fruit; Snack bars containing principally, cereal, grains and nuts.

Class 31: Fresh vegetables; fresh salad vegetables; organic fresh vegetables; Vegetables Fresh; Vegetable seeds; Vegetable marrows, fresh; carrots.

COSTS

82.As the opponent has been successful, it is entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 2/2016. The evidence provided by the opponent is dated after the relevant date and did not assist in the decision I have made. I have, therefore, not made an award of costs in respect of the evidence filed. In the circumstances, I award the opponent the sum of **£800** as a contribution towards its costs. The sum is calculated as follows:

Preparing statements and considering the applicant's statements:	£300
Preparing written submissions in lieu:	£300

Official fee x2: £200

Total: £800

83. I therefore order Huntapac Produce Ltd to pay Kettle Produce Ltd the sum of £800.

This should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 24th day of April 2020

A COOPER

For the Registrar