

O/561/20

**TRADE MARKS ACT 1994**

**IN THE MATTER OF  
INTERNATIONAL REGISTRATION NO. 1437651  
DESIGNATING THE UNITED KINGDOM  
IN THE NAME OF BEST FRUITS 17 EAD:**

**FLORINA**

**IN CLASSES 30 & 32**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER NO. 416650  
BY ETABLISSEMENTS GEYER FRERES**

## **BACKGROUND AND PLEADINGS**

1. On 17 July 2018, Best Fruits 17 EAD (“the holder”) registered the International Trade Mark displayed on the cover page of this decision, under number 1437651 (“the IR”). With effect from the same date, the holder designated the UK as a territory in which it seeks to protect the IR under the terms of the Protocol to the Madrid Agreement. The IR claims a priority date of 21 June 2018 from the Patent Office of Republic of Bulgaria, under filing number 151134.
2. The IR was accepted for protection in the UK and published in the Trade Marks Journal on 15 March 2019 in respect of the following goods:

Class 30: Flavourings of tea; herbal infusions; white tea; sage tea; ginger tea; non-medicated tea extracts; tea essences; tea substitutes; green tea; instant tea; citron tea; infusions, not medicinal; packaged tea [other than for medicinal use]; fruit teas; instant tea [other than for medicinal purposes]; iced tea; chai tea; flowers or leaves for use as tea substitutes; tea extracts; tea-based beverages; tea-based beverages with fruit flavouring; tea; tea leaves; tea bags; jasmine tea; ginseng tea; lime tea; rosemary tea; rooibos tea; earl grey tea; black tea [English tea]; Japanese green tea.

Class 32: Mineral and aerated waters and other non-alcoholic beverages; fruit juice beverages; syrups and other preparations for making beverages; aperitifs, non-alcoholic; flavoured mineral water; flavoured carbonated beverages; non-alcoholic punch; alcohol free wine; non-alcoholic grape juice beverages; non-alcoholic vegetable juice drinks; non-alcoholic malt drinks; non-alcoholic honey-based beverages; non-alcoholic beverages; non-alcoholic beverages flavoured with coffee; non-alcoholic beverages flavoured with tea; fruit flavored soft drinks; vitamin fortified non-alcoholic beverages; non-alcoholic beverages containing vegetable juices; non-alcoholic beverages containing fruit juices; non-alcoholic fruit extracts; non-alcoholic fruit juice beverages; bitter lemon; waters [beverages]; nutritionally fortified water; aerated water; carbonated mineral water; vitamin enriched sparkling water [beverages]; carbonated non-alcoholic drinks; vegetable smoothies; distilled drinking water; tomato juice

[beverage]; extracts for making beverages; hop extracts for use in the preparation of beverages; energy drinks; essences for making beverages; vegetable drinks; vegetable juices [beverages]; spring water; isotonic beverages; cocktails, non-alcoholic; concentrates for use in the preparation of soft drinks; concentrates for making fruit drinks; lemonades; lemon squash; lithia water; malt syrup for beverages; mineral water [beverages]; apple juice beverages; rice-based beverages, other than milk substitutes; soya-based beverages, other than milk substitutes; coconut-based beverages; fruit-based beverages; aloe vera drinks, non-alcoholic; pineapple juice beverages; grape juice beverages; smoothies; green vegetable juice beverages; guarana drinks; cola drinks; fruit-flavoured beverages; beverages containing vitamins; beverages consisting of a blend of fruit and vegetable juices; non-carbonated soft drinks; low-calorie soft drinks; mineral enriched water [beverages]; cordials; lime juice cordial; flavoured waters; orgeat; drinking water with vitamins; non-alcoholic sparkling fruit juice drinks; non-alcoholic fruit cocktails; fruit juice concentrates; fruit nectars, non-alcoholic; fruit squashes; orange juice drinks; powders for effervescent beverages; cider, non-alcoholic; sarsaparilla [non-alcoholic beverage]; dry ginger ale; syrups for lemonade; syrups for beverages; syrups for making non-alcoholic beverages; mixed fruit juice; soda water; grapefruit juice; grape juice; guava juice; watermelon juice; lime juice for use in the preparation of beverages; blackcurrant juice; lemon juice for use in the preparation of beverages; mango juice; pomegranate juice; melon juice; aloe vera juices; sorbets in the nature of beverages; sports drinks; protein-enriched sports beverages; iced fruit beverages; whey beverages; preparations for making beverages; pastilles for effervescent beverages; tonic water [non-medicated beverages]; table waters; nutritionally fortified beverages; sherbets [beverages].

3. On 17 June 2019, ETABLISSEMENTS GEYER FRERES ("the opponent") filed a notice of opposition. The partial opposition is brought under sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 ("the Act"). Originally, the designation was also opposed on the basis of section 3(6) of the Act. However, reliance on this particular ground was withdrawn in the opponent's written submissions of 3 September 2020 and, therefore, nothing further shall be said about it. The opposition is directed against

some of the goods in classes 30 and 32 of the IR<sup>1</sup>, which are shown in the table at paragraph 66 of this decision.

4. In respect of the section 5(2)(b) and 5(3) claims, the opponent relies upon its International Registration Designating the UK number 710929, **LORINA** ("the earlier mark"). The earlier mark was registered on 19 March 1999 and protection was granted in the UK on 26 November 1999 in respect of the following goods:

Class 32: Beer, mineral and sparkling water and other non-alcoholic beverages; fruit drinks and fruit juices; lemonades; syrups and other preparations for making beverages.

5. The earlier mark qualifies as an acceptable basis to oppose the designation, in accordance with section 6 of the Act. As it had been protected for more than five years at the priority filing date claimed by the IR, it is subject to the proof of use requirements as defined in section 6A of the Act.

6. For the purposes of its claim under section 5(2)(b) of the Act, the opponent relies upon some of the goods for which the earlier mark has protection, namely, '*non-alcoholic fruit flavoured carbonated beverages; non-alcoholic mojitos; fruit drinks; lemonades*'. In its notice of opposition, the opponent claimed that the earlier mark has been used in relation to these goods. The opponent essentially contends that the competing trade marks are similar and the respective goods are identical or similar, giving rise to a likelihood of confusion, including a likelihood of association. The opponent has provided detailed arguments as to why the marks and respective goods are similar, which I have read and shall bear in mind.

7. In relation to section 5(3), the opponent claims to have a substantial reputation in respect of '*non-alcoholic fruit flavoured carbonated beverages; fruit drinks; lemonades*'. The opponent argues that members of the public will mistakenly believe that the holder's goods are connected with the opponent. In this regard, the opponent

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<sup>1</sup> The opposition had originally been directed against all the goods of the IR. However, the opponent restricted the scope of the opposition by email on 29 July 2020.

submits that the holder will benefit from its investment in advertising and will, therefore, obtain an unfair commercial advantage. Further, the opponent contends that the holder will ride on its coat tails and benefit from the reputation of the earlier mark. Additionally, the opponent claims that use of the IR will be out of its control and that inferior quality goods will cause detriment to its business. According to the opponent, use of the IR will also dilute the distinctive character of its mark and reputation as the public would no longer exclusively associate the mark with the opponent.

8. Turning to the 5(4)(a) claim, the opponent relies upon its alleged earlier right in the sign **LORINA**. It claims that the sign has been used throughout the UK since 2002 in respect of '*non-alcoholic fruit flavoured carbonated beverages; fruit drinks; lemonades*'. The opponent claims to have acquired considerable goodwill under the sign and contends that use of the IR would, therefore, be a misrepresentation to the public. The opponent argues that this would result in damage to the aforementioned goodwill.

9. The holder filed a counterstatement denying the claims made. The holder also indicated that it would require the opponent to provide proof of use of its earlier mark.

10. Both sides have been professionally represented throughout these proceedings; the opponent by CSY London and the holder by Innovate Legal Services Limited. Both parties filed evidence in these proceedings, which will be summarised to the extent that it is considered necessary. Both parties were given the option of an oral hearing, though neither asked to be heard on this matter. Only the opponent elected to file written submissions in lieu of a hearing, though the holder filed written submissions during the evidence rounds. I do not intend to summarise these but will refer to them throughout this decision, as and where necessary. This decision is taken following a careful perusal of the papers before me, keeping all submissions in mind.

## **EVIDENCE**

### **Opponent's evidence in chief**

11. The opponent's evidence in chief consists of a witness statement dated 14 November 2019 of Johannes Savonije, together with Exhibits JS1 to JS28. Mr Savonije is the President of the Board of Directors of the opponent company, a position he has held since 12 July 2018.

12. Mr Savonije explains that the opponent was established in Munster, France in 1960. An extract dated 1 October 2019 from the Commercial and Companies Register of France is evidenced,<sup>2</sup> which confirms that the opponent was registered on 1 July 1960 as well as Mr Savonije's position within the company. Mr Savonije further explains that the company specialises in non-alcoholic beverages and that its flagship product is 'LORINA', a carbonated soft drink sold worldwide in both glass and plastic bottles. According to Mr Savonije, the product was created in 1895 by the founder of the company. Prints obtained on 10 May 2018 and 8 November 2019 of the Wikipedia entry for 'Lorina' <https://en.wikipedia.org/wiki/Lorina> are exhibited and state the same.<sup>3</sup> Mr Savonije says that 'LORINA' beverages consist of water from the Vosages mountains in Eastern France and a variety of fruit. Prints obtained from the internet archive 'Wayback Machine' of the Lorina website [www.lorina.com](http://www.lorina.com) from 11 April 2003 to 11 February 2018 are evidenced.<sup>4</sup> The prints show bottled beverages of sparkling lemonade bearing the following marks:



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<sup>2</sup> Exhibit JS1

<sup>3</sup> Exhibit JS3

<sup>4</sup> Exhibit JS2

13. ‘LORINA’ products, Mr Savonije states, have been sold in the UK since 2002 by the opponent with the mark appearing prominently on the front of the bottles. Images showing bottles of beverages which have been sold in the UK between 2014 and 2018 are exhibited.<sup>5</sup> These demonstrate that lemon, lemonade and raspberry beverages under the ‘LORINA’ mark have been sold in WH Smith, Tesco and Waitrose in London and Northampton. Although it is not clear from the images, Mr Savonije suggests that the evidence also demonstrates that the mark has been used on coconut and lime and blood orange flavoured beverages.<sup>6</sup>

14. Mr Savonije explains that the opponent has sold products bearing the ‘LORINA’ mark in the UK between 21 June 2013 and 21 July 2018 through a number of distributors. Information regarding one such distributor, Petty Wood, is exhibited,<sup>7</sup> as is an extract of a distribution agreement between the opponent and another, Euro Food Brands.<sup>8</sup> The latter is dated 20 October 2014 and confirms that the opponent entered into an agreement with Euro Food Brands in relation to the distribution of a number of different ‘Lorina’ beverages. Since this agreement ended in April 2019, Mr Savonije states that ‘LORINA’ products have been exclusively distributed in the UK by Supermalt (UK) Limited.

15. Mr Savonije explains that ‘LORINA’ products have been sold at all major supermarkets in the UK, including Ocado, Waitrose, Tesco, Sainsbury’s, Asda, as well as other retail chains – such as WH Smith – and local grocery stores. A copy of a PowerPoint presentation is evidenced which, according to Mr Savonije, was prepared by Joanna Sayers of the distributor Petty Wood for a review meeting with the opponent.<sup>9</sup> The presentation shows that in 2013 and 2014, customers of ‘LORINA’ products included, *inter alia*, Waitrose, WH Smith, The Cress Co, London Foodservice, Ocado, Patisserie Valerie, Auguste Noel and EH Booth. Information regarding some of the perhaps lesser renowned businesses are also evidenced, suggesting a UK-wide customer reach.<sup>10</sup> A second PowerPoint presentation is exhibited, which was used

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<sup>5</sup> Exhibit JS4

<sup>6</sup> Witness statement of Johannes Savonije, §11

<sup>7</sup> Exhibit JS5

<sup>8</sup> Exhibit JS6

<sup>9</sup> Exhibit JS7

<sup>10</sup> Exhibit JS7

during a business and strategy review meeting on 23 November 2016 with distributor Euro Food Brands.<sup>11</sup> ‘Lorina’ is listed as one of the distributor’s suppliers, while its customers include major retailers, wholesalers, department stores as well as smaller retailers, discounters, internet marketplaces and members of the food service industry. Performance of the ‘Lorina’ brand is a topic of the presentation, though many of the details have been redacted. A list of ‘LORINA’ customers at June 2018 is provided by Mr Savonije<sup>12</sup> and suggests that the products are sold to a range of outlets in the UK.

16. The opponent’s turnover figures between 2001 and 2017 in relation to the sale of ‘LORINA’ products in the UK are provided.<sup>13</sup> These are broken down by distributor and, in some cases, by particular beverages. The evidence shows sales in the UK of a number of different flavoured ‘LORINA’ beverages. The figures have been certified as compliant with the company’s accounts by a statutory auditor, Patrick Baumeyer. From the evidence, the sales figures appear to be as follows:

Year	Turnover (€)
2002	160,406
2003	171,521
2004	188,136
2005	263,549
2006	388,568
2007	436,300
2008	269,882
2009	355,116
2010	497,719
2011	535,204
2012	133,901
2013	463,674
2014	639,081
2015	659,059

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<sup>11</sup> Exhibit JS8

<sup>12</sup> Exhibit JS10

<sup>13</sup> Exhibit JS11

2016	429,754
2017	302,016
Total	5,893,886

17. In addition, using the company's accounting system, Mr Savonije estimates that between 15 September 2017 and 21 June 2018, the opponent sold approximately €77,000 of products bearing the 'LORINA' mark in the UK.<sup>14</sup> A spreadsheet originating from Euro Foods Brands showing the sales of 'LORINA' products in the UK via Ocado, Waitrose and Amazon from 4 January 2015 to 12 August 2018 has also been provided.<sup>15</sup> The spreadsheet demonstrates that "many thousands of LORINA products" were sold during this period.

18. Numerous invoices have been provided concerning the sale of 'LORINA' products in the UK in 2002 as well as between 2012 and 2018.<sup>16</sup> The invoices were sent from the opponent to Bespoke Foods, Petty Wood and Euro Food Brands, based in London, Hampshire and Northampton, respectively. The invoices clearly demonstrate sales of products under the 'LORINA' mark. Many of the invoices refer to the goods as being "sparkling" and include their flavour. Some items on the invoices are listed as "non-alcoholic cocktail mojito".

19. Mr Savonije explains that the soft drinks market in the UK is "huge". An online article from 'The Grocer' dated 4 May 2017 is exhibited,<sup>17</sup> which suggests that the total market for such goods in 2016 was over £4 billion; the article states that carbonated soft drinks and juices accounted for just over and just under £1.3 billion, respectively. In this connection, a spreadsheet originating from Euro Food Brands is evidenced,<sup>18</sup> which shows the performance of the 'LORINA' non-alcoholic mojito product compared with its competitors. Although it is undated, Mr Savonije states that the spreadsheet is from July 2016.<sup>19</sup> From the spreadsheet, I have extrapolated that the mojito product accounted for 2% of total included sales and 2% of included distribution in the alcohol

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<sup>14</sup> Savonije, §16

<sup>15</sup> Exhibit JS12

<sup>16</sup> Exhibit JS13

<sup>17</sup> Exhibit JS14

<sup>18</sup> Exhibit JS15

<sup>19</sup> Savonije, §19

replacement drinks market. Mr Savonije also provides extracts from a Euro Food Brands presentation on 14 September 2016.<sup>20</sup> The presentation analyses the performance of 'LORINA' products as alcohol replacement drinks. It demonstrates that 'Lorina' accounted for 20% of total value and volume of sales at Tesco in the "Alcohol Replacement Category". An image is included of the mojito product, which prominently displays the mark on the front of the bottle:



20. Mr Savonije evidences another presentation from Euro Food Brands, dated 13 July 2017,<sup>21</sup> which summarises the performance of 'LORINA' products in the UK in 2017. Comparisons with performance between 2016 and 2017 are provided, as are updates regarding outlet accounts including Ocado.

21. 'LORINA' soft drinks continue to be sold in the UK, according to Mr Savonije, and extracts from Waitrose and Amazon.co.uk are exhibited.<sup>22</sup> The extracts were obtained on 8 November 2019 and demonstrate that various sparkling beverages have been recently available from these outlets. Mr Savonije also provides sample invoices after 21 June 2018,<sup>23</sup> which "show the continuation of [the company's] activity under the LORINA mark in the United Kingdom". Indeed, the invoices demonstrate that "sparkling" goods bearing the 'LORINA' mark were sold to the distributor Euro Food Brands in Northampton between 16 August 2018 and 5 March 2019.

22. While no precise information regarding the total marketing spend on 'LORINA' products in the UK has been provided, Mr Savonije provides details of reimbursements

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<sup>20</sup> Exhibit JS16

<sup>21</sup> Exhibit JS17

<sup>22</sup> Exhibit JS18

<sup>23</sup> Exhibit JS19

from the opponent to Euro Food Brands for its promotional spend between 2014 and 2018.<sup>24</sup> The figures provided are as follows:

Year	Promotional Expenditure (€)
2014	34,527
2015	131,814
2016	85,951
2017	60,403
2018	11,666
Total	324,361

23. Moreover, a spreadsheet originating from Euro Food Brands is exhibited,<sup>25</sup> which lists the promotions the distributor ran for ‘LORINA’ products in the UK in 2015 and 2016. The spreadsheet confirms that the associated cost of the promotions was in excess of £30,000.

24. In addition, Mr Savonije provides extracts from articles in ‘The Grocer’ magazine, ‘Wholesaler’ magazine and the ‘Daily Mail’ from 2014, 2015, 2016 and 2017.<sup>26</sup> The articles all refer to the ‘LORINA’ brand and some indicate that the beverages are sold in Tesco, WH Smith, Costco, Amazon, Asda, Sainsbury’s, Morrisons, Ocado and Waitrose.

25. Finally, in his evidence, Mr Savonije comments upon the holder’s activities and attempts to show that there is no use of the contested mark in the UK by means of internet searches.<sup>27</sup> Mr Savonije also makes reference to previous disputes between the respective parties. More specifically, he refers to a decision issued by the European Union Intellectual Property Office (EUIPO) Opposition Division dated 1 September 2015 and decision O/202/19 of this Tribunal dated 12 April 2019. I shall return to this point later in this decision.

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<sup>24</sup> Savonije, §22

<sup>25</sup> Exhibit JS20

<sup>26</sup> Exhibits JS9, JS21 – JS23 & JS25

<sup>27</sup> Exhibits JS26 & JS27

## **Holder's evidence**

26. The holder's evidence consists of a witness statement dated 14 February 2020 of Dimo Plamenov Angelov, together with Exhibits DPA1 to DPA9. Mr Angelov is the CEO of the holder company.

27. Mr Angelov explains that the holder is the owner of a number of trade marks concerning the 'FLORINA' brand. The details of the same have been evidenced,<sup>28</sup> demonstrating that the holder owns International Registration Designating the UK number 1306625, European Union trade mark number 11097714, and Bulgarian trade marks 23278 and 31265. Mr Angelov further explains that the 'FLORINA' brand has been used "since at least 1993", though has "reason to believe that the mark FLORINA has been in existence since its first owner [...] was established in the 1930s". Mr Angelov, however, confirms that there is no documentation available to substantiate such a claim.<sup>29</sup> The holder, according to Mr Angelov, purchased the 'FLORINA' mark in 2018 and has used the mark ever since.

28. Mr Angelov expresses his surprise with this opposition, as he says both marks at issue in these proceedings have coexisted for a number of years without any issue of confusion. The opponent has been aware of this coexistence, according to Mr Angelov, and has previously acknowledged a lack of confusion. A 'Letter of Consent' dated 24 March 2003 provided by the holder to the opponent is exhibited.<sup>30</sup> The letter contains a declaration by "FLORINA A HONEOS S.A." that it had no objections to "Jean-Pierre BARJON" obtaining protection for the mark 'LORINA' for class 32 goods in Finland. Mr Angelov states that the letter was sent in the "spirit of coexistence". A response letter from Jean-Pierre Barjon dated 16 April 2003 is also evidenced,<sup>31</sup> though it appears in a non-English language and no translation has been provided.

29. Mr Angelov says that products under the 'FLORINA' brand include non-alcoholic drinks, juices and juice drinks. He explains that these products are sold in Bulgaria

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<sup>28</sup> Exhibit DPA1

<sup>29</sup> Witness statement of Dimo Plamenov Angelov, §3

<sup>30</sup> Exhibit DPA2

<sup>31</sup> Exhibit DPA2

through various retail outlets, as well as in China, Vietnam, Greece, Cyprus, Libya, Jordan, Moldova and Scandinavia. Undated images showing such goods on sale in unspecified retail establishments are provided:<sup>32</sup>



30. According to Mr Angelov, the holder offers a “wide range of traditional and exotic flavoured drinks” and tailors its products to the tastes and consumer preferences of the markets in which the goods are sold. A sample of products sold under the ‘FLORINA’ mark are exhibited.<sup>33</sup> Again, I note that the images are undated. However, various flavoured juice drinks are displayed, all bearing the ‘FLORINA’ mark prominently on their packaging:



31. Mr Angelov continues by discussing his views on the opposition; in short, he does not believe there is a likelihood of confusion between the competing marks. Moreover, he believes the respective goods are distinguishable and that the parties are not in

<sup>32</sup> Exhibit DPA3

<sup>33</sup> Exhibit DPA4

direct competition. Mr Angelov also refers to the parties' different "price points" and suggests that the manner in which the holder's goods are presented to consumers are representative of their price. Further undated samples of the holder's goods on display in retail outlets are evidenced,<sup>34</sup> and they mostly show such goods in standalone display units next to other beverages.

32. The holder, Mr Angelov says, has received brand recognition for its products due to publicity through media advertising as well as print advertising in magazines, newspapers and billboards. The advertising undertaken is "fun and relaxed", in an attempt to provide a "distinctive voice". Samples of advertising materials used to promote the 'FLORINA' brand are provided.<sup>35</sup> While the 'FLORINA' brand can clearly be seen in the exhibits, the vast majority are undated. However, Mr Angelov says that these materials were used between 2016 and 2019. Advertising of the brand has been done on the sides of buses, on billboards and at railway platforms and bus stops. Moreover, advertising has been done via YouTube and Facebook, as well as on websites such as 'VBOX7' and 'sportal.bg'. Merchandise, such as air cushions and glasses, bearing the 'FLORINA' mark has also been produced. Mr Angelov states that the holder has invested significantly in promoting the 'FLORINA' mark. Although no evidence has been provided to this effect, he outlines that the promotional spend has been as follows:

Year	Promotional Expenditure (£)
2016	166,739
2017	129,432
2018	165,442
2019	244,600
Total	706,213

33. Mr Angelov concludes by asserting that the opponent's claim of confusion is "totally farcical"<sup>36</sup> and that the 'FLORINA' mark "has its own reputation and goodwill through

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<sup>34</sup> Exhibit DPA5

<sup>35</sup> Exhibits DPA6 – DPA9

<sup>36</sup> Angelov, §17

the years in which the brand has existed".<sup>37</sup> He claims that a) the holder is not taking advantage of the opponent's reputation in 'LORINA', b) consumers will not believe there is any association between the parties, and c) there is no detriment to 'LORINA' by the use and registration of 'FLORINA'.

### **Opponent's evidence in reply**

34. The opponent's evidence in reply comprises a witness statement dated 26 July 2020 of Jan Ankersen, accompanied by Exhibits JA1 to JA9. Mr Ankersen is the Senior Vice President (Central Europe) at Royal Unibrew as well as Managing Director of the opponent company, positions he has held since 25 March 2019.

35. Mr Ankersen explains that Royal Unibrew is a regional beverage provider which predominantly operates in Northern Europe, Italy, France and Germany. Royal Unibrew acquired the opponent company in July 2018 and has since been responsible for the 'LORINA' brand. Since this acquisition, products sold under the 'LORINA' brand are distributed in the UK by Supermalt UK Limited, a subsidiary of Royal Unibrew. Prints from the Royal Unibrew website [www.royalunibrew.com](http://www.royalunibrew.com) are exhibited.<sup>38</sup> 'Lorina' can be seen within Royal Unibrew's brand portfolio. The prints are undated, though they do refer to "Developments in 2019" and "Outlook for 2020".

36. Mr Ankersen is not aware of any goods sold in the UK under the holder's 'FLORINA' mark and states that such use would lead to confusion with the 'LORINA' mark. On this basis, he does not understand the holder's contention that the marks have coexisted.

37. Turning to products sold under the 'LORINA' mark, Mr Ankersen says he is familiar with the brand; he also states that 'LORINA' branded "carbonated non-alcoholic drink[s]" have been sold in the UK for "many years". In support of this, Mr Ankersen provides a witness statement dated 22 April 2020 from a representative of EH Booth & Co. Ltd.<sup>39</sup> Andrew McDermott refers to himself as a "buyer" for EH Booth and

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<sup>37</sup> Angelov, §18

<sup>38</sup> Exhibit JA1

<sup>39</sup> Exhibit JA3

confirms that the business has stocked ‘LORINA’ beverages since at least January 2017. A print dated 20 July 2020 of the Wikipedia entry for EH Booth has also been evidenced,<sup>40</sup> which describes it as “a chain of high-end supermarkets” with “28 retail stores in Northern England”.

38. According to Mr Ankersen, it is not uncommon for ‘LORINA’ beverages – as well as other sparkling fruit beverages – to be displayed on shelves in retail outlets in close proximity to iced tea and fruit concentrate soft drinks. Various photographs to that effect are exhibited,<sup>41</sup> though I note that all postdate the date of designation of the IR.

### **PRELIMINARY ISSUE**

39. The opponent’s evidence and many of its submissions in these proceedings refer to previous decisions of the Tribunal, namely, O/646/19, O/376/19 and, most notably, O/202/19. In respect of the latter, the proceedings concerned a prior dispute between the opponent and the holder. The opponent has attributed a great deal of weight to the findings of the decision and has sought to substantiate many of its arguments in the present proceedings with the same. Moreover, the opponent has also referred to previous opposition proceedings between itself and the holder at EUIPO.

40. I must clarify at this early stage that, while I note the contents and findings of these decisions, it suffices to say that they will be of little import to the present proceedings. It is well established that previous decisions, whether that be of this Tribunal or the EUIPO, are not binding. Each case must be assessed on its own merits and, as such, I do not consider it appropriate to derive my findings or conclusions wholly from the decisions to which the opponent refers. For the avoidance of doubt, the determination of each of the opponent’s claims must take into account the relevant factors, following an assessment of the papers before me.

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<sup>40</sup> Exhibit JA2

<sup>41</sup> Exhibits JA4, JA5 & JA8

## **DECISION**

### **Proof of use**

41. I must firstly deal with the issue of whether, or to what extent, the opponent has shown genuine use of its earlier mark. The relevant statutory provisions are as follows:

“6A - (1) This section applies where

- (a) an application for registration of a trade mark has been published,
- (b) there is an earlier trade mark of a kind falling within section 6(1)(a),  
(b) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and
- (c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

(1A) In this section “the relevant period” means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

- (a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or
- (b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes -

(a) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5) In relation to a European Union trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

(5A) In relation to an international trade mark (EC) the reference in subsection (1)(c) to the completion of the registration procedure is to be construed as a reference to the publication by the European Union Intellectual Property Office of the matters referred to in Article 190(2) of the European Union Trade Mark Regulation.

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.”

42. The onus is on the opponent, as the proprietor of the earlier mark, to show use made of the mark because Section 100 of the Act states:

“If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

43. Pursuant to Section 6A of the Act, the relevant period for assessing whether there has been genuine use of the earlier mark is the five-year period ending with the priority filing date of the IR at issue, i.e. 22 June 2013 to 21 June 2018.

44. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J summarised the law relating to genuine use as follows:

"114.....The CJEU has considered what amounts to "genuine use" of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 Verein Radetsky-Order v *Bundervsvereinigung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases may be summarised as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* at [29].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or

services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14] and [22]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71]; *Reber* at [29].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or

just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72] and [76]-[77]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32]."

### **Form of the mark**

45. In *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12, which concerned the use of one mark with, or as part of, another mark, the Court of Justice of the European Union ("CJEU") found that:

"31. It is true that the 'use' through which a sign acquires a distinctive character under Article 7(3) of Regulation No 40/94 relates to the period before its registration as a trade mark, whereas 'genuine use', within the meaning of Article 15(1) of that regulation, relates to a five-year period following registration and, accordingly, 'use' within the meaning of Article 7(3) for the purpose of registration may not be relied on as such to establish 'use' within the meaning of Article 15(1) for the purpose of preserving the rights of the proprietor of the registered trade mark.

32. Nevertheless, as is apparent from paragraphs 27 to 30 of the judgment in *Nestlé*, the ‘use’ of a mark, in its literal sense, generally encompasses both its independent use and its use as part of another mark taken as a whole or in conjunction with that other mark.

33. As the German and United Kingdom Governments pointed out at the hearing before the Court, the criterion of use, which continues to be fundamental, cannot be assessed in the light of different considerations according to whether the issue to be decided is whether use is capable of giving rise to rights relating to a mark or of ensuring that such rights are preserved. If it is possible to acquire trade mark protection for a sign through a specific use made of the sign, that same form of use must also be capable of ensuring that such protection is preserved.

34. Therefore, the requirements that apply to verification of the genuine use of a mark, within the meaning of Article 15(1) of Regulation No 40/94, are analogous to those concerning the acquisition by a sign of distinctive character through use for the purpose of its registration, within the meaning of Article 7(3) of the regulation.

35. Nevertheless, as pointed out by the German Government, the United Kingdom Government and the European Commission, a registered trade mark that is used only as part of a composite mark or in conjunction with another mark must continue to be perceived as indicative of the origin of the product at issue for that use to be covered by the term ‘genuine use’ within the meaning of Article 15(1)". (emphasis added)

46. Although the case was decided before *Colloseum*, the guidance given by Mr Richard Arnold Q.C. (as he then was) as the Appointed Person in *Nirvana Trade Mark*, BL O/262/06, on assessing whether the use of a mark in a different form constitutes genuine use of a registered mark remains sound law:

"33. .... The first question [in a case of this kind] is what sign was presented as the trade mark on the goods and in the marketing materials during the relevant period..."

34. The second question is whether that sign differs from the registered trade mark in elements which do not alter the latter's distinctive character. As can be seen from the discussion above, this second question breaks down in the sub-questions, (a) what is the distinctive character of the registered trade mark, (b) what are the differences between the mark used and the registered trade mark and (c) do the differences identified in (b) alter the distinctive character identified in (a)? An affirmative answer to the second question does not depend upon the average consumer not registering the differences at all."

47. In *Dreamersclub Ltd v KTS Group Ltd*, BL O/091/19, Mr Philip Johnson, as the Appointed Person, found that the use of the mark  qualified as use of the registered word-only mark 'DREAMS'. This was because the stylisation of the word did not alter the distinctive character of the word mark. Rather, it constituted an expression of the registered word mark in normal and fair use.

48. I have no submissions from the holder to the effect that the form in which the mark has been used differs to what is registered, i.e. **LORINA**.

49. The word 'LORINA' appears in normal font on invoices and, when applied to the bottles of the beverages, the mark is presented as:



50. I note that the earlier mark is protected in word-only format and can be nominally used in any standard typeface. Moreover, the distinctive character of the mark lies in the word 'LORINA' itself. The evidenced marks are presented in a basic font. As can

be seen, the main difference is that the first and last letters – ‘L’ and ‘A’, respectively – are in a slightly larger font. In relation to the first evidenced mark, the word ‘LORINA’ is also slightly curved, while the second evidenced mark is presented with the smaller words ‘Victor Geyer’ and ‘1895’. I am of the view that the evidenced marks differ to the mark as protected in elements which do not alter the latter’s distinctive character. In other words, the differences are minimal and do not alter the distinctive character of the earlier mark. Moreover, the word ‘LORINA’ continues to be the indicator of the origin of the goods at issue, in line with *Colloseum*. Accordingly, I consider the evidenced marks to be acceptable variant uses of the mark as protected.

### **Sufficient use**

51. An assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself.<sup>42</sup>

52. As indicated in the case law cited above, use does not need to be quantitatively significant to be genuine. The assessment must take into account a number of factors in order to ascertain whether there has been real commercial exploitation of the mark which can be regarded as “warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark”.

53. The holder has filed lengthy submissions regarding the sufficiency of use of the earlier mark. While I have read these submissions and bear them in mind, it suffices to say that the holder disputes that the earlier mark has been used to a sufficient extent during the relevant period.

54. I believe the soft drinks industry to be remarkably large, numbering in the billions of pounds per annum. In fact, there is some evidence before me to that effect. Nevertheless, the opponent has evidenced uncontested UK turnover figures for the relevant period which are in excess of €2.5million. The evidence also includes a number of invoices dated within the relevant period for the sale of various beverages

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<sup>42</sup> *New Yorker SHK Jeans GmbH & Co KG v OHIM*, T-415/09

to distributors in the UK. There is evidence, too, that these distributors have a number of customers with retail outlets across the UK. There are photographs of the opponent's products on sale at Tesco and WH Smith stores in London and Northampton. Furthermore, there is evidence of 'LORINA' branded products being sold to, inter alia, Tesco, Waitrose, and Ocado, many of which are significant food and drinks retailers in the UK. While there is a lack of evidence in relation to marketing expenditure, the opponent has provided uncontested figures of reimbursements paid by the opponent to its distributors for promoting the 'LORINA' brand in the UK. The evidence is not without its deficiencies. For instance, there is little indication of the opponent's market share. However, it is clear to me that the opponent has attempted to create and maintain a market for its goods under the 'LORINA' mark. Taking the evidence as a whole into account, I do not hesitate to conclude that the opponent has demonstrated genuine use of its earlier mark within the relevant period.

### **Fair specification**

55. I must now consider whether, or the extent to which, the evidence shows use of the opponent's mark in relation to the goods relied upon. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law as being:

"In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned."

56. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors [2016] EWHC 3103 (Ch)*, Mr Justice Carr summed up the law relating to partial revocation as follows.

"iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the

specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria's Secret UK Ltd* [2014] EWHC 2631 (Ch) ("Thomas Pink") at [52].

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd* (Extreme Trade Mark) [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 ("Asos") at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them; *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46."

57. I begin by reminding myself that the goods for which the opponent must demonstrate genuine use are '*non-alcoholic fruit flavoured carbonated beverages; non-alcoholic mojitos; fruit drinks; lemonades*'. The holder has not commented upon the specific goods for which it believes the earlier mark has, or has not, been used. From the opponent's evidence, it is clear that the earlier mark has been used in relation to lemonades as well as a variety of fruit flavoured carbonated drinks. This is apparent from the invoices, spreadsheets and photographs. Furthermore, there are references to the opponent as a carbonated soft drinks company. While some of the evidence uses the word "sparkling", the beverages in question are referred to in this way as they have been carbonated. In my view, carbonated is a more clear and precise term. The opponent's evidence also demonstrates use of the mark in relation to non-alcoholic mojito drinks, as can be seen from the invoices, spreadsheets and brand performance assessments. In light of the above, I find that the opponent may rely upon its specification of '*non-alcoholic fruit flavoured carbonated beverages; non-alcoholic mojitos; fruit drinks; lemonades*'.

## **Section 5(2)(b)**

### **Legislation and case law**

58. Sections 5(2)(b) and 5A of the Act read 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."

“5A 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.”

59. 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 Klijzen 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:

(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**

60. In the judgment of the CJEU in *Canon Kabushiki Kaisha v Metro Goldwyn Mayer Inc*, 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”.

61. 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.

62. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* (OHIM), Case T-325/06, the General Court ("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".

63. The GC confirmed in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, that, even if goods 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 für 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”.

64. In *Separode Trade Mark*, BL O/399/10, Mr Geoffrey Hobbs Q.C. as the Appointed Person confirmed at paragraph 5 that:

“The determination must be made with reference to each of the different species of goods listed in the opposed application for registration; if and to the extent that the list includes goods which are sufficiently comparable to be assessable for registration in essentially the same way for essentially the same reasons, the decision taker may address them collectively in his or her decision.”

65. The opponent has argued that the holder’s goods are identical or similar to those for which the earlier mark is protected. In relation to the holder’s class 32 goods, the opponent largely rests its argument on a prior decision concerning the respective parties and has invited me to reach the same finding of similarity. In respect of the holder’s class 30 goods, the opponent has contended that ‘iced tea’ overlaps with its goods in terms of nature, purpose and trade channels. Moreover, the opponent has argued that ‘iced tea’ is in competition with its goods. Accordingly, the opponent has submitted that the goods are similar. For its part, the holder has disputed that any of the goods of the IR are similar to those protected by the IR.

66. The goods to be compared are as follows:

Opponent's goods	Holder's goods
Class 32: Non-alcoholic fruit flavoured carbonated beverages; non-alcoholic mojitos; fruit drinks; lemonades.	Class 30: Iced tea.  Class 32: Mineral and aerated waters and other non-alcoholic beverages; fruit juice beverages; syrups and other preparations for making beverages; aperitifs, non-alcoholic; flavoured mineral water; flavoured carbonated beverages; non-alcoholic punch; alcohol free wine; non-alcoholic grape juice beverages; non-alcoholic vegetable juice drinks; non-alcoholic malt drinks; non-alcoholic honey-based beverages; non-alcoholic beverages; non-alcoholic beverages flavoured with coffee; non-alcoholic beverages flavoured with tea; fruit flavoured soft drinks; vitamin fortified non-alcoholic beverages; non-alcoholic beverages containing vegetable juices; non-alcoholic beverages containing fruit juices; non-alcoholic fruit extracts; non-alcoholic fruit juice beverages; bitter lemon; waters [beverages]; nutritionally fortified water; aerated water; carbonated mineral water; vitamin enriched sparkling water [beverages]; carbonated non-alcoholic drinks; vegetable smoothies; distilled drinking water; tomato juice [beverage]; extracts for making beverages; hop extracts for use in the preparation of beverages; energy drinks; essences for making beverages; vegetable drinks; vegetable juices [beverages]; spring water; isotonic beverages; cocktails, non-alcoholic; concentrates for use in the preparation of soft drinks; concentrates for making fruit drinks; lemonades; lemon squash; lithia water; malt syrup for beverages; mineral water [beverages]; apple juice beverages; rice-based beverages, other than milk substitutes; soya-based beverages, other than milk substitutes; coconut-based beverages; fruit-based beverages; aloe vera drinks, non-alcoholic; pineapple juice beverages; grape juice beverages; smoothies; green vegetable juice beverages; guarana drinks; cola drinks; fruit-flavoured beverages; beverages containing vitamins; beverages consisting of a blend of fruit and vegetable juices; non-carbonated soft drinks; low-calorie soft drinks; mineral enriched water [beverages]; cordials; lime juice cordial; flavoured waters;

	drinking water with vitamins; non-alcoholic sparkling fruit juice drinks; non-alcoholic fruit cocktails; fruit juice concentrates; fruit nectars, non-alcoholic; fruit squashes; orange juice drinks; powders for effervescing beverages; cider, non-alcoholic; sarsaparilla [non-alcoholic beverage]; dry ginger ale; syrups for lemonade; syrups for beverages; syrups for making non-alcoholic beverages; mixed fruit juice; soda water; grapefruit juice; grape juice; guava juice; watermelon juice; lime juice for use in the preparation of beverages; blackcurrant juice; lemon juice for use in the preparation of beverages; mango juice; pomegranate juice; melon juice; aloe vera juices; sorbets in the nature of beverages; sports drinks; protein-enriched sports beverages; iced fruit beverages; whey beverages; preparations for making beverages; pastilles for effervescing beverages; tonic water [non-medicated beverages]; table waters; nutritionally fortified beverages; sherbets [beverages].
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### Class 30

67. '*Iced tea*' in the holder's specification refers to a form of cold tea which is a popular packaged drink, often flavoured with fruit or sweetened with sugar. Iced tea and the opponent's '*non-alcoholic fruit flavoured carbonated beverages*' are made from different raw materials. Nevertheless, there is an overlap in the nature of the respective goods insofar as they are both non-alcoholic beverages. Moreover, the intended purpose of the respective goods is the same as they are consumed to quench thirst or for a pleasurable taste. In this connection, the method of use will also be the same as the respective goods will be consumed by mouth. In addition, the respective goods have common end users, being those who are seeking refreshment from a beverage. Furthermore, there is an overlap in the trade channels through which the respective goods reach the market as they are both sold in supermarkets and other drinks retailers. In these circumstances, the goods will be self-selected by consumers from chilled cabinets or shelves. While I accept that it may not always be the case, it is not uncommon for iced tea to be displayed near non-alcoholic carbonated beverages in the same '*chilled drinks*' sections of supermarkets. The goods are not complementary in the sense outlined in case law. However, I consider there to be competitive relationship between the respective goods as a consumer seeking refreshment may

select an iced tea over a fruit flavoured carbonated beverage, and vice versa. In light of the above, I consider the respective goods to be similar to between a medium and high degree.

## Class 32

68. The term '*lemonades*' has a direct counterpart in the specification of the earlier mark. These goods are self-evidently identical.

69. Although the term '*non-alcoholic sparkling fruit juice drinks*' in the holder's specification is worded differently to the opponent's '*non-alcoholic fruit flavoured carbonated beverages*', the terms describe the same goods. Therefore, the goods are considered identical.

70. Similarly, while '*fruit-based beverages*' in the holder's specification may be worded differently to the term '*fruit drinks*' in the opponent's specification, the goods they describe are considered identical.

71. '*Bitter lemon*' in the holder's specification refers to a lemon flavoured soft drink. In my view, this would fall within the scope of the broader term '*non-alcoholic fruit flavoured carbonated beverages*' in the opponent's specification. Even in circumstances where the bitter lemon is not carbonated, it will be encompassed by the broader category of '*fruit drinks*' in the opponent's specification. In either case, the goods are identical under the principle outlined in *Meric*.

72. The terms '*fruit juice beverages; non-alcoholic grape juice beverages; non-alcoholic beverages containing fruit juices; non-alcoholic fruit juice beverages; tomato juice [beverage]; apple juice beverages; non-alcoholic fruit cocktails; orange juice drinks; mixed fruit juice; grapefruit juice; grape juice; guava juice; watermelon juice; blackcurrant juice; mango juice; pomegranate juice; melon juice; iced fruit beverages; pineapple juice beverages; grape juice beverages; guarana drinks*' in the holder's specification all describe various fruit drinks. As such, I consider that they are encompassed by the broader category '*fruit drinks*' in the opponent's specification. Applying the principle in *Meric*, I consider the goods to be identical.

73. To my mind, the term '*non-alcoholic fruit flavoured carbonated beverages*' in the opponent's specification would be encompassed by the broader categories of '*non-alcoholic beverages; flavoured carbonated beverages; carbonated non-alcoholic drinks; fruit flavoured soft drinks; fruit-flavoured beverages*' in the holder's specification. Accordingly, these goods are identical under the principle outlined in *Meric*.

74. Moreover, '*non-alcoholic mojitos*' in the opponent's specification describes a particular non-alcoholic cocktail. As such, the term would fall within the scope of the holder's '*cocktails, non-alcoholic*', rendering the goods identical under the principle outlined in *Meric*.

75. I turn now to the designated '*mineral and aerated waters; flavoured waters; flavoured mineral water; non-alcoholic punch; cider, non-alcoholic; alcohol free wine; aperitifs, non-alcoholic; sherbets [beverages]; non-alcoholic vegetable juice drinks; non-alcoholic malt drinks; non-alcoholic honey-based beverages; non-alcoholic beverages flavoured with coffee; non-alcoholic beverages flavoured with tea; vitamin fortified non-alcoholic beverages; non-alcoholic beverages containing vegetable juices; lithia water; waters [beverages]; nutritionally fortified water; aerated water; carbonated mineral water; vitamin enriched sparkling water [beverages]; vegetable smoothies; distilled drinking water; energy drinks; vegetable drinks; vegetable juices [beverages]; spring water; isotonic beverages; mineral water [beverages]; rice-based beverages, other than milk substitutes; soya-based beverages, other than milk substitutes; coconut-based beverages; aloe vera drinks, non-alcoholic; smoothies; green vegetable juice beverages; cola drinks; beverages containing vitamins; beverages consisting of a blend of fruit and vegetable juices; non-carbonated soft drinks; low-calorie soft drinks; mineral enriched water [beverages]; drinking water with vitamins; sarsaparilla [non-alcoholic beverage]; dry ginger ale; soda water; aloe vera juices; sorbets in the nature of beverages; sports drinks; protein-enriched sports beverages; whey beverages; tonic water [non-medicated beverages]; table waters; nutritionally fortified beverages*'. These goods in the holder's specification are all examples of non-alcoholic drinks. While the raw materials used for the production of the goods may vary, the nature of these goods and those of the earlier mark overlap

insofar as they are all non-alcoholic beverages. The respective goods are all consumed to quench thirst or for a pleasurable taste and, as such, they have the same purpose. Further, the method of use for the respective goods is the same, namely, that they will all be consumed by mouth. The respective goods will also share end users, being those who are seeking refreshment from a beverage. The trade channels through which the respective goods reach the market will also overlap as they are all sold in supermarkets and other retail outlets, whereby the goods will be self-selected by consumers. The holder's goods are likely to be located in the same section of those outlets as the opponent's goods, though I note that this is not without exception. The respective goods are neither important nor indispensable to the use of one another and, thus, are not complementary. However, given the respective goods are all non-alcoholic beverages and have the same intended purpose, I consider them to be in competition; for example, a consumer seeking refreshment may select flavoured mineral water over a carbonated fruit flavoured beverage, and vice versa. In light of the above, I consider the respective goods to be similar to between a medium and high degree.

76. Finally, the designated '*syrups and other preparations for making beverages; non-alcoholic fruit extracts; extracts for making beverages; hop extracts for use in the preparation of beverages; essences for making beverages; concentrates for use in the preparation of soft drinks; malt syrup for beverages; fruit nectars, non-alcoholic; powders for effervescing beverages; syrups for lemonade; syrups for beverages; syrups for making non-alcoholic beverages; preparations for making beverages; pastilles for effervescing beverages; lime juice for use in the preparation of beverages; lemon squash; cordials; lime juice cordial; fruit juice concentrates; fruit squashes; lemon juice for use in the preparation of beverages; concentrates for making fruit drinks*' are all preparations for making beverages. They are typically diluted to create either still or carbonated drinks. As they are not finished drink products, the nature of the goods differs from that of the opponent's goods. In this connection, the intended purpose of the respective goods is not entirely the same as the holder's goods are for making beverages, while the opponent's goods are to provide refreshment or a pleasurable taste. However, there is a degree of overlap when one considers the ultimate purpose of the holder's beverage-making preparations. The respective goods have a different method of use: the opponent's goods are finished products which will

be consumed by mouth, while some form of process is required before the holder's goods are consumed. There is likely to be an overlap in the trade channels through which the goods reach the market as they are all typically sold in supermarkets and other retail outlets. The goods will all be self-selected by consumers, though in practice they are not likely to be on the same shelves. However, beverage-making preparations may be found nearby. Although the holder's goods may be used to create beverages, the respective goods are not important or indispensable to one another in such a way that consumers would assume that they are from the same commercial undertaking. As such, they are not complementary. There is, however, a degree of competition between the goods as a consumer may select a finished product or purchase the holder's goods in order to make the drink themselves. Balancing the similarities against the differences, I consider that the goods are similar to between a low and medium degree.

### **The average consumer and the nature of the purchasing act**

77. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question (see *Lloyd Schuhfabrik Meyer*, Case C-342/97).

78. 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.”

79. The opponent has submitted that:

“[...] the average consumer for all of both parties' goods in class 32 is a member of the general public. These are moderately inexpensive everyday products which will be purchased with a low to average level of care.”

80. Conversely, the holder has argued that:

“The average consumer is likely to be a member of the general public or a business [...] The average consumer will pay, at least, a medium degree of attention when selecting the goods not least because the price difference of the goods is significant in their respective markets [...] the relevant consumer are sufficiently perceptive and careful when it comes to consumables such as drinks and beverages, the relevant consumer takes enough care and are well aware of the different brands which may have small differences between them.”

81. The goods at issue in these proceedings are all beverages or preparations therefor. I agree with the opponent that the average consumer of such goods will be members of the general public. The goods are likely to be purchased relatively frequently for the purposes of refreshment. The purchasing act will not require an overly considered thought process as, overall, they are relatively inexpensive everyday purchases; the purchasing of the goods is likely to be more casual than careful. The average consumer will, nevertheless, consider factors such as the cost, taste and nutritional content of the goods as they will wish to ensure that what they are purchasing to consume meets their individual requirements. Taking the above factors into account, I find that the level of attention of the general public in respect of these goods would be medium.

82. The goods are typically sold in supermarkets and convenience stores, where the goods are likely to be selected from shelves or chilled cabinets. In these circumstances, visual considerations would dominate. Beverages are also sold in restaurants and bars where there may be an oral component to the selection process, such as requests to bar and waiting staff. Even where the goods are ordered orally, the selection process would still be in the context of a visual inspection of a drinks list,

for example, prior to the order being placed. Considered overall, I am of the view that the purchasing process would be predominantly visual in nature, though aural considerations will play their part.<sup>43</sup>

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

83. 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).”

84. Registered trade marks possess varying degrees of inherent distinctive character. These range from the very low, such as those which are suggestive or allusive of the goods or services, to those with high inherent distinctive character, such as invented

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<sup>43</sup> *Simonds Farsons Cisk plc v Office for Harmonization in the Internal Market (OHIM)*, Case T-3/04

words. Dictionary words which do not allude to the goods or services will be somewhere in the middle. The degree of distinctiveness is an important factor as it directly relates to whether there is a likelihood of confusion; the more distinctive the earlier mark, the greater the likelihood of confusion. The distinctive character of a mark may be enhanced as a result of it having been used in the market.

85. The opponent has contended that 'LORINA', being an invented word, has a high degree of inherent distinctiveness. Moreover, the opponent has claimed that the earlier mark has also "acquired additional distinctiveness through use". I have no submissions from the holder regarding the distinctiveness of the earlier mark.

86. The earlier mark is in word-only format and consists of the word 'LORINA'. As the earlier mark is comprised of one plain word, its distinctiveness lies in the word itself. The mark will be perceived by consumers as an invented word with no descriptive or allusive qualities. Therefore, I find that the earlier mark has a high level of inherent distinctive character.

87. The evidence of use filed by the opponent has been summarised above and I am now required to assess whether, at the relevant date of 21 June 2018, the opponent has demonstrated that the earlier mark had an enhanced degree of distinctive character.

88. No specific details have been provided by the opponent to indicate its market share and there is no evidence before me to that effect. Moreover, the opponent has not provided any evidence relating to the extent of, or investment in, the promotion of its goods. The evidence demonstrates that the opponent's sales were in excess of €2.5 million during the relevant period for 'LORINA' branded products. Although sales in the millions of euros over a five-year period are respectable, there is evidence before me which confirmed my perception that the drinks industry in the UK is remarkably large. In this context, the opponent's turnover is modest. Notwithstanding the same, the opponent has been continuously and regularly using the earlier mark since 2002 and sells its goods in a number of major supermarkets and retailers with outlets across the UK. Moreover, the opponent has provided uncontested figures of reimbursements paid to its distributors for promoting the 'LORINA' brand in the UK, totalling in excess

of €300,000 in the relevant period. Further, there were references to the ‘LORINA’ brand in magazines and articles during the relevant period, some of which are aimed at the general public. In light of the above, I find that the distinctive character of the earlier mark has been marginally enhanced by virtue of the use made of it.

### **Comparison of trade marks**

89. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a 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 marks must be assessed by reference to the overall impressions created by the 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.”

90. Therefore, it would be wrong to artificially dissect the trade marks, though it is necessary to take into account the distinctive and dominant components of the marks. Due weight must be given to any other features which are not negligible and hence contribute to the overall impressions created by the marks.

91. The competing trade marks are as follows:

<b>Earlier trade mark</b>	<b>Holder's mark</b>
LORINA	<b>FLORINA</b>

### Overall impression

92. The earlier mark is in word-only format and consists of the invented word ‘LORINA’. As this is the only element of the mark, the overall impression is dominated by the word itself.

93. The IR is a figurative mark and consists of the word ‘FLORINA’. The word ‘FLORINA’ has no descriptive meaning relevant to the goods at issue, nor is it allusive. Rather, it will be perceived by consumers as an invented word. The word is presented in a bold and rounded font with a black border. Although the word is stylised, the font is, ultimately, unremarkable and I do not consider it to be particularly striking. As such, the word ‘FLORINA’ will dominate the overall impression conveyed by the IR, while the minimal degree of stylisation will provide a much smaller contribution.

### Visual comparison

94. The opponent has argued that there is an obvious visual similarity between the marks, highlighting that the earlier mark is “entirely reproduced” within the holder’s mark. The opponent has contended that the marks differ only in the additional letter ‘F’ at the beginning of the holder’s mark and that this should not be given additional weight as it is not a separate and standalone part of the mark. The opponent has also submitted that the stylisation of the latter is minimal, such that the word ‘FLORINA’ is clearly recognisable within the mark. For these reasons, the opponent has argued that there is a high level of visual similarity between the competing marks.

95. In contrast, while the holder has conceded that the earlier mark is wholly contained within its mark, it has argued that the letter ‘F’ at the beginning of the mark “changes the composition in its entirety”. On this basis, the holder has submitted that the competing marks are not visually similar.

96. Visually, the competing marks are similar because they share a common six-letter string ‘L-O-R-I-N-A’, in the same order. I do not consider the difference created by the stylisation of the word ‘FLORINA’ in the holder’s mark to be significant as this is

minimal and, in any event, notional and fair use allows word-only marks to be presented in any standard font. I agree with the holder that the marks differ insofar as its mark begins with a letter 'F'. However, bearing in mind my assessment of the overall impressions, I consider there to be a high degree of visual similarity between the marks.

### Aural comparison

97. The opponent has submitted that the letter 'F' at the beginning of the holder's mark is a "very soft sound" and is "very likely to be missed". On this basis, the opponent has argued that the marks are phonetically highly similar.

98. Conversely, it is the holder's contention that the beginning of its mark, i.e. 'FLOR', is aurally dominant. Based upon the letter 'F' at the beginning of its mark, the holder has submitted that the competing marks are aurally distinct.

99. Aurally, the holder's mark and the earlier mark both consist of three syllables, i.e. ("FLO-REE-NA") and ("LO-REE-NA"), respectively. Although the holder's mark begins with an 'F' sound and the earlier mark does not, the remainder of the competing marks are aurally indistinguishable. Taking into account the overall impressions, I consider that the competing marks are aurally similar to a high degree.

### Conceptual comparison

100. The holder has argued that:

"20. The Opponent has promoted its mark LORINA as being part of the French Region and its distinctiveness is derived from that region.

21. In comparison, the [holder] has not promoted its mark FLORINA as being from any particular region. In fact, the word FLORINA does not conjure up images of France or any region in France.

22. The mark FLORINA is not promoted with any particular meaning.

23. However, it is conceivable that the word FLORINA reminds the consumer of “Flora” or “Flowers” and therefore subtly reminding the consumers that fruits are formed from flowers.

24. Therefore we submit that [...] there is no conceptual similarity between FLORINA and LORINA.”

101. For its part, the opponent has submitted that, given that the competing marks are both invented terms, they are conceptually neutral.

102. Conceptually, I do not agree with the holder that the earlier mark would be understood as a reference to a region of France, or that its mark would be understood as referring to flora or flowers. No evidence has been adduced by the holder to demonstrate that the marks would be understood in the ways it has claimed. Furthermore, for a concept to be relevant, it must be capable of immediate grasp by the relevant consumer.<sup>44</sup> Given that neither mark has any clear and obvious meaning per se, I consider it more likely that the marks will be perceived by the average consumer as invented terms. As such, a conceptual comparison is not possible; the position is neutral.

### **Likelihood of confusion**

103. 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. One such factor 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 necessary for me to keep in mind the distinctive character of the earlier trade mark, 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

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<sup>44</sup> *The Picasso Estate v OHIM*, Case C-361/04 P

opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that they have retained in their mind.

104. 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 down to the responsible undertakings being the same or related.

105. Earlier in this decision I concluded that:

- The holder's class 30 goods are similar to the opponent's goods to between a medium and high degree;
- Some of the goods in class 32 of the IR are identical to the opponent's goods; of the holder's remaining class 32 goods, some are similar to between a medium and high degree while others are similar to between a low and medium degree;
- Average consumers of the goods at issue are likely to be members of the general public, who would demonstrate a medium level of attention during the purchasing act;
- The purchasing process for the goods would be predominantly visual in nature, though I have accepted that it will include an aural element in certain circumstances;
- The earlier mark possesses a high level of inherent distinctive character, which has been marginally enhanced through use;
- The overall impression of the earlier mark would be dominated by the word 'LORINA', being the only element of the mark;

- The overall impression of the IR would be dominated by the word ‘FLORINA’, while the minimum degree of stylisation would play a much lesser role;
- The competing marks are visually and aurally similar to a high degree, while the marks are conceptually neutral.

106. I acknowledge that the IR contains an additional letter at the beginning of the mark, a position which is generally considered to have more impact due to consumers in the UK reading marks from left to right.<sup>45</sup> I also appreciate that the IR is presented in a stylised font and that the earlier mark is registered in word-only format. Nevertheless, taking into account the overall similarity between the marks and the high level of distinctive character of the earlier mark, I am of the view that the differences between the competing marks are insufficient to distinguish the goods of the holder from those of the opponent. The earlier mark is reproduced in full within the IR and, although the latter begins with an additional letter, the words are otherwise identical. Furthermore, as both marks are invented terms, neither provide any conceptual ‘hook’ which will differentiate the marks from one another in the mind of the average consumer. Moreover, as I have already found, the stylisation of the word ‘FLORINA’ in the IR is minimal and does not create any material difference between the competing marks, not least because notional and fair use allows a word-only mark (such as the earlier mark) to be presented in any standard typeface. In light of the above and taking into account the imperfect recollection of the consumer, the average consumer may not recall the respective marks with sufficient accuracy to differentiate between them; consumers may misremember one for the other, assuming they are one and the same. Consequently, I consider there to be a likelihood of direct confusion, even for the goods which are not identical.

107. In his witness statement, Mr Angelov says:

“4. I was surprised the Application has come under attack by the Opponent. This is because, FLORINA has coexisted for a number of years with LORINA and there has been no issue of confusion.

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<sup>45</sup> *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

5. More importantly, the proprietors of LORINA have known of that coexistence with FLORINA and have acknowledged that there is no issue of confusion. The opponent has in the past requested letters of consent from the Applicant in other territories in the EU where our mark FLORINA has preceded their mark for LORINA.”

108. Although it has not been expressly pleaded, I consider this tantamount to an argument that the designation should be granted protection in the UK by virtue of a coexistence, or honest concurrent use, defence. In *Victoria Plumb Ltd v Victorian Plumbing Ltd* [2016] EWHC 2911 (Ch), Carr J considered the CJEU’s judgment in *Budejovicky Budvar NP v Anheuser-Busch Inc. (BUDWEISER)*, Case C482/09, and the Court of Appeal’s judgments in that case and in *IPC Media Ltd v Media 10 Ltd* [2014] EWCA Civ 1403, and stated that a defence of honest concurrence use could, in principle, defeat an otherwise justified claim of trade mark infringement where the two parties had been using the same or closely similar names honestly for a long time and the guarantee of origin of the claimant’s trade mark was not impaired by the defendant’s use.

109. The *BUDWEISER* case had demonstrated that honest concurrent use may be relevant in cancellation proceedings, and I can see no reason why it would not be relevant in opposition proceedings. Nevertheless, the CJEU noted that the circumstances of that particular case were exceptional. The Court’s answer to the third question put to it was as follows:

“In the light of the foregoing, the answer to the third question is that Article 4(1)(a) of Directive 89/104 must be interpreted as meaning that the proprietor of an earlier trade mark cannot obtain the cancellation of an identical later trade mark designating identical goods where there has been a long period of honest concurrent use of those two trade marks where, in circumstances such as those in the main proceedings, that use neither has nor is liable to have an adverse effect on the essential function of the trade mark which is to guarantee to consumers the origin of the goods or services.”

110. Whether the exceptional circumstances referred to by the CJEU in *BUDWEISER* apply in a particular case is, ultimately, a question of fact. The evidence adduced by the holder does not show that the businesses have coexisted for a long period. On the contrary, the holder's evidence fails to demonstrate any use of its 'FLORINA' mark in the UK. Indeed, Mr Angelov has, himself, omitted the UK from the list of territories in which 'FLORINA' products are sold.<sup>46</sup> No sales figures have been provided in connection with its mark. A number of photographs have been provided and I appreciate that 'FLORINA' branded fruit flavoured beverages can be seen on sale in retail establishments. However, no details as to the provenance or context of the photographs have been provided and there is no evidence before me which suggests that they were taken in the UK. The holder has demonstrated that it has promoted its 'FLORINA' mark, though there is no indication that any of its advertising has targeted UK consumers. Furthermore, the holder has referred to "letters of consent". The fact that the holder raised no objections to the opponent obtaining a registration in Finland for the 'LORINA' mark is simply not relevant; it is open to a party to oppose, or not oppose, other marks and to have different strategies in that regard depending on the particular jurisdiction or market. In light of all the foregoing, I find that the evidence falls a long way short of what would be required to mount a successful honest concurrent use defence.

111. The opposition based upon section 5(2)(b) succeeds in its entirety. I shall, however, go on to consider briefly the section 5(3) and 5(4)(a) grounds.

### **Section 5(3)**

#### **Legislation and case law**

112. Section 5(3) of the Act states:

"(3) A trade mark which-

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<sup>46</sup> Angelov, §9

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a European Union trade mark or international trade mark (EC), in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

113. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, Case 252/07, *Intel*, Case C-408/01, *Adidas-Salomon*, Case C-487/07, *L'Oréal v Bellure* and Case C-323/09, *Marks and Spencer v Interflora* and Case C383/12P, *Environmental Manufacturing LLP v OHIM*. The law appears to be as follows:

a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas-Salomon*, paragraph 29 and *Intel*, paragraph 63.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel*, paragraph 42.

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel*, paragraph

68; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel*, paragraph 79.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel*, paragraphs 76 and 77 and *Environmental Manufacturing*, paragraph 34.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel*, paragraph 74.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oréal v Bellure NV*, paragraph 40.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora*, paragraph 74 and the court's answer to question 1 in *L'Oréal v Bellure*).

114. The conditions of section 5(3) are cumulative. Firstly, the opponent must show that its earlier mark has achieved a level of knowledge, or reputation, amongst a significant part of the public. Secondly, the opponent must establish that the public will make a link between the marks, in the sense of the earlier mark being brought to mind by the later mark. Thirdly, assuming the first and second conditions have been met, section 5(3) requires that one or more of three types of damage claimed by the opponent will occur. It is unnecessary for the purposes of section 5(3) that the goods are similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks.

115. The relevant date for the assessment under section 5(3) is the priority date of the contested IR, namely, 21 June 2018.

## **Reputation**

116. In General Motors, Case C-375/97, the CJEU held that:

“25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.

28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation ‘in the Member State’. In the absence of any definition of the Community provision in this respect, a trade mark cannot

be required to have a reputation ‘throughout’ the territory of the Member State. It is sufficient for it to exist in a substantial part of it.”

117. The opponent has submitted that “proving a reputation is not especially onerous”. In this regard, opponent has claimed that it enjoys an “extensive reputation” by virtue of the “substantial use” it has made of the earlier mark in the UK. It is the opponent’s contention that the evidence it has filed in these proceedings “indubitably” proves that it has built up a reputation in the earlier mark in respect of ‘*non-alcoholic fruit flavoured carbonated beverages; fruit drinks; lemonades*’.

118. The holder does not accept that the opponent has a protectable reputation. The holder has submitted that the opponent has not established that its mark is known by a significant part of the relevant public in the UK.

119. I take the opponent’s submission that “proving a reputation is not especially onerous” to be a reference to the comments of Arnold J in *Enterprise Holdings Inc. v Europcar Group UK Ltd.*<sup>47</sup> It is important to note that the evidence before Arnold J in that case showed that the claimant was the market leading car hire company in the UK with a 30% share of the UK market. It was in that context that it was said that proving a reputation “is not a particularly onerous requirement”. Arnold J had no reason to turn his mind to situations where a claimant has only a small or unquantified share of the relevant market.

120. Professor Phillip Johnson, as the Appointed Person in the ‘SACURE’ appeal decision,<sup>48</sup> stated to the effect that it is not the case that a party relying on an earlier mark who has filed only weak, incomplete, or irrelevant evidence to establish a reputation should be given the benefit of the doubt at the expense of the other party. The reason it is not an onerous requirement is because collecting the evidence should be straightforward (even if time consuming) where a mark has the necessary reputation.

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<sup>47</sup> [2015] EWHC 17 (Ch)

<sup>48</sup> Case BL O/360/20

121. As outlined above, the CJEU in *General Motors* provided guidance on assessing the existence of a reputation. That judgement requires that I take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.

122. The opponent has not provided any specific details regarding its market share or filed any evidence in that respect. Furthermore, there is no evidence relating to the extent of, or investment in, the promotion of its goods. However, the evidence does indicate that the 'LORINA' brand has appeared in magazines and national publications prior to the relevant date. Moreover, there is evidence of media coverage, such as in 'Daily Mail' articles, which are aimed at the general public. The opponent has demonstrated that it reimbursed its distributors for promoting the 'LORINA' brand in the relevant period, totalling in excess of €300,000; these figures have not been contested by the holder. However, there is no precise evidence as to what this was actually spent on and I do not consider this a vast sum. From the evidence, it is clear that there has been continuous and regular use of the mark in the UK since 2002. Further, 'LORINA' branded products have been sold in major retailers and supermarkets which have customers across the UK. Turnover figures in excess of €2.5million over a five-year period are respectable, though, in the context of the drinks industry, I do not consider them striking for the purposes of supporting a claim to having a reputation. Taking the evidence as a whole into account, on balance I am prepared to accept that there is a modest reputation in '*non-alcoholic fruit flavoured carbonated beverages; fruit drinks; lemonades*'. In the absence of marketing materials and with limited, albeit respectable, sales figures, there is little basis to find anything stronger than a modest reputation.

## **Link**

123. As noted above, my assessment of whether the public will make the required mental 'link' between the marks must take into account of all relevant factors. The factors identified in *Intel* are:

*The degree of similarity between the conflicting marks*

I have found the marks to be visually and aurally similar to a high degree. I have found the marks to be conceptually neutral.

*The nature of the goods or services for which the conflicting marks are registered, or proposed to be registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public*

I have found the holder's goods in class 30 of the IR to be similar to the opponent's goods to between a medium and high degree. I have found some of the goods in class 32 of the IR to be identical to the opponent's goods. I have found that, of the remaining class 32 goods which are not identical, some are similar to between a medium and high degree while others are similar to between a low and medium degree.

*The strength of the earlier mark's reputation*

I have found that the earlier mark has a qualifying reputation, which I consider to be modest.

*The degree of the earlier mark's distinctive character, whether inherent or acquired through use*

I have found that the earlier mark, being an invented term, has a high level of inherent distinctive character. I have also found that this has been marginally enhanced by virtue of the use made of the mark.

*Whether there is a likelihood of confusion*

I have found there to be a likelihood of direct confusion.

124. The opponent has submitted that there is sufficient similarity between the marks to establish a link. Conversely, the holder has argued that its 'FLORINA' mark is distinguishable from the opponent's 'LORINA' mark, intimating that no such link would be made by the relevant public.

125. In my view, taking into account the overall similarities between the competing marks and the high level of distinctive character of the earlier mark, combined with my findings that the respective goods are identical or at least similar to between a low to medium degree, I consider that a significant part of the relevant public will make a link between the competing marks. I have already found that consumers are likely to mistake one mark for the other. Therefore, to my mind, it is highly likely that the relevant public are likely to make the requisite link between them.

### **Damage**

126. I must now assess whether any of the three pleaded types of damage will arise.

127. The opponent has claimed that use of the holder's mark would, without due cause, give the holder an unfair economic advantage because of an association with the opponent's well-established range of drinks.

128. In *Jack Wills Limited v House of Fraser (Stores) Limited* [2014] EWHC 110 (Ch) Arnold J. concluded that:

"80. The arguments in the present case give rise to two questions with regard to taking unfair advantage. The first concerns the relevance of the defendant's intention. It is clear both from the wording of Article 5(2) of the Directive and Article 9(1)(c) of the Regulation and from the case law of the Court of Justice interpreting these provisions that this aspect of the legislation is directed at a particular form of unfair competition. It is also clear from the case law both of the Court of Justice and of the Court of Appeal that the defendant's conduct is most likely to be regarded as unfair where he intends to benefit from the reputation and goodwill of the trade mark. In my judgment, however, there is nothing in the case law to preclude the court from concluding in an appropriate

case that the use of a sign the objective effect of which is to enable the defendant to benefit from the reputation and goodwill of the trade mark amounts to unfair advantage even if it is not proved that the defendant subjectively intended to exploit that reputation and goodwill.”

129. I have already found that there is a likelihood of direct confusion between the competing marks, whereby a consumer may select the holder’s goods in the mistaken belief that they are selecting the opponent’s goods. As such, even if there is no intention on the part of the holder, it is clearly foreseeable that the holder would secure an unfair commercial advantage, benefitting from the opponent’s reputation without paying financial compensation and diverting sales to the holder.

130. As the holder has not shown that it has due cause for using the contested mark, the opposition based upon section 5(3) succeeds in its entirety.

### **Section 5(4)(a)**

#### **Legislation and case law**

131. Section 5(4)(a) of the Act reads as follows:

“(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented-

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection (4A) is met,

(aa) [...]

(b) [...]

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an “earlier right” in relation to the trade mark.”

132. Subsection (4A) of Section 5 of the Act states:

“(4A) The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of application for registration of the trade mark or date of the priority claimed for that application.”

133. In *Discount Outlet v Feel Good UK*, [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

“55. The elements necessary to reach a finding of passing off are the ‘classical trinity’ of that tort as described by Lord Oliver in the Jif Lemon case (*Reckitt & Colman Product v Borden* [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56. In relation to deception, the court must assess whether “*a substantial number*” of the Claimants’ customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21).”

### **Relevant date**

134. In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O/410/11, Mr Daniel Alexander Q.C. as the Appointed Person endorsed the registrar’s assessment of the relevant date for the purposes of section 5(4)(a) of the Act, as follows:

“43. In SWORDERS TM O-212-06 Mr Alan James acting for the Registrar well summarised the position in s.5(4)(a) proceedings as follows:

'Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made.' "

135. The holder has claimed that 'FLORINA' has been used in relation to the contested goods since "at least 1995". Further, that it has "reason to believe" that the mark has been used – either by itself or its predecessors in title – since the establishment of the company in the 1930s. However, while the holder has filed evidence in these proceedings, none of it supports such a claim. Moreover, there is a distinct lack of evidence of any use of the mark in the UK. The ownership of a number of trade marks from various jurisdictions have been provided, though they do not, in isolation, demonstrate that the mark has been used. The holder has also evidenced a number of photographs and I accept that these show the 'FLORINA' mark applied to fruit flavoured beverages. Nevertheless, no details regarding when or where the photographs were taken have been provided by the holder. Finally, although the holder's evidence shows that the 'FLORINA' mark has been advertised, both traditionally and online, there is no indication that these adverts have been seen by consumers in the UK. Accordingly, the relevant date for assessment of the opponent's claim under section 5(4)(a) is the priority date claimed by the IR, namely, 21 June 2018.

### **Goodwill**

136. The first hurdle for the opponent is to show that it had the necessary goodwill in the sign 'LORINA' at the relevant date. Goodwill was described in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (HOL), in the following terms:

"What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start."

137. Goodwill arises as a result of trading activities. The sales figures provided demonstrate that the opponent had been continuously and regularly trading in the UK from 2002 up to the relevant date. This is supported by the invoices and accounting spreadsheets that have been exhibited. There is also evidence that drinks products bearing the 'LORINA' sign have been sold at major retailers and supermarkets with outlets across the UK. As the opponent had clearly been trading prior to the relevant date, I am satisfied that the opponent has a reasonable degree of goodwill in the UK in relation to '*non-alcoholic fruit flavoured carbonated beverages; fruit drinks; lemonades*'. I am also satisfied that the sign relied upon was distinctive of that goodwill at the relevant date.

### **Misrepresentation**

138. In *Neutrogena Corporation and Another v Golden Limited and Another* [1996] RPC 473, Morritt L.J. stated that:

"There is no dispute as to what the correct legal principle is. As stated by *Lord Oliver of Aylmerton in Reckitt & Colman Products Ltd. v. Borden Inc. [1990] R.P.C. 341* at page 407 the question on the issue of deception or confusion is

"is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the public will be misled into purchasing the defendants' [product] in the belief that it is the respondents'[product]"

The same proposition is stated in Halsbury's Laws of England 4th Edition Vol.48 para 148 . The necessity for a substantial number is brought out also in *Saville*

*Perfumery Ltd. v. June Perfect Ltd.* (1941) 58 R.P.C. 147 at page 175 ; and *Re Smith Hayden's Application* (1945) 63 R.P.C. 97 at page 101.”

139. Later in the same judgment, Morritt L.J. stated that:

“.... for my part, I think that references, in this context, to “more than *de minimis*” and “above a trivial level” are best avoided notwithstanding this court's reference to the former in *University of London v. American University of London* (unreported 12 November 1993) . It seems to me that such expressions are open to misinterpretation for they do not necessarily connote the opposite of substantial and their use may be thought to reverse the proper emphasis and concentrate on the quantitative to the exclusion of the qualitative aspect of confusion.”

140. I recognise that the test for misrepresentation is different from that for likelihood of confusion in that it entails *deception of a substantial number of members of the public* rather than *confusion of the average consumer*. However, as recognised by Lewison L.J. in *Marks and Spencer PLC v Interflora*, [2012] EWCA (Civ) 1501, it is doubtful whether the difference between the legal tests will produce different outcomes. Certainly, I believe that to be the case here. I consider that a substantial number of members of the relevant public would be misled into purchasing the holder's goods in the mistaken belief that they were the goods of the opponent.

### **Damage**

141. In *Harrods Limited v Harroddian School Limited* [1996] RPC 697, Millett L.J. described the requirements for damage in passing off cases in the following terms:

“In the classic case of passing off, where the defendant represents his goods or business as the goods or business of the plaintiff, there is an obvious risk of damage to the plaintiff's business by substitution. Customers and potential customers will be lost to the plaintiff if they transfer their custom to the defendant in the belief that they are dealing with the plaintiff. But this is not the only kind of damage which may be caused to the plaintiff's goodwill by the deception of

the public. Where the parties are not in competition with each other, the plaintiff's reputation and goodwill may be damaged without any corresponding gain to the defendant. In the *Lego* case, for example, a customer who was dissatisfied with the defendant's plastic irrigation equipment might be dissuaded from buying one of the plaintiff's plastic toy construction kits for his children if he believed that it was made by the defendant. The danger in such a case is that the plaintiff loses control over his own reputation."

142. In the present case, I consider that damage through diversion of sales is entirely foreseeable.

143. The opposition based upon section 5(4)(a) succeeds in its entirety.

## **CONCLUSION**

144. The partial opposition under sections 5(2)(b), 5(3) and 5(4)(a) of the Act has succeeded. Subject to any successful appeal against my decision, the IR will be refused in respect of the following goods:

Class 30: Iced tea.

Class 32: Mineral and aerated waters and other non-alcoholic beverages; fruit juice beverages; syrups and other preparations for making beverages; aperitifs, non-alcoholic; flavoured mineral water; flavoured carbonated beverages; non-alcoholic punch; alcohol free wine; non-alcoholic grape juice beverages; non-alcoholic vegetable juice drinks; non-alcoholic malt drinks; non-alcoholic honey-based beverages; non-alcoholic beverages; non-alcoholic beverages flavoured with coffee; non-alcoholic beverages flavoured with tea; fruit flavoured soft drinks; vitamin fortified non-alcoholic beverages; non-alcoholic beverages containing vegetable juices; non-alcoholic beverages containing fruit juices; non-alcoholic fruit extracts; non-alcoholic fruit juice beverages; bitter lemon; waters [beverages]; nutritionally fortified water; aerated water; carbonated mineral water; vitamin enriched sparkling water [beverages]; carbonated non-alcoholic drinks; vegetable smoothies; distilled drinking water; tomato juice

[beverage]; extracts for making beverages; hop extracts for use in the preparation of beverages; energy drinks; essences for making beverages; vegetable drinks; vegetable juices [beverages]; spring water; isotonic beverages; cocktails, non-alcoholic; concentrates for use in the preparation of soft drinks; concentrates for making fruit drinks; lemonades; lemon squash; lithia water; malt syrup for beverages; mineral water [beverages]; apple juice beverages; rice-based beverages, other than milk substitutes; soya-based beverages, other than milk substitutes; coconut-based beverages; fruit-based beverages; aloe vera drinks, non-alcoholic; pineapple juice beverages; grape juice beverages; smoothies; green vegetable juice beverages; guarana drinks; cola drinks; fruit-flavoured beverages; beverages containing vitamins; beverages consisting of a blend of fruit and vegetable juices; non-carbonated soft drinks; low-calorie soft drinks; mineral enriched water [beverages]; cordials; lime juice cordial; flavoured waters; drinking water with vitamins; non-alcoholic sparkling fruit juice drinks; non-alcoholic fruit cocktails; fruit juice concentrates; fruit nectars, non-alcoholic; fruit squashes; orange juice drinks; powders for effervescing beverages; cider, non-alcoholic; sarsaparilla [non-alcoholic beverage]; dry ginger ale; syrups for lemonade; syrups for beverages; syrups for making non-alcoholic beverages; mixed fruit juice; soda water; grapefruit juice; grape juice; guava juice; watermelon juice; lime juice for use in the preparation of beverages; blackcurrant juice; lemon juice for use in the preparation of beverages; mango juice; pomegranate juice; melon juice; aloe vera juices; sorbets in the nature of beverages; sports drinks; protein-enriched sports beverages; iced fruit beverages; whey beverages; preparations for making beverages; pastilles for effervescing beverages; tonic water [non-medicated beverages]; table waters; nutritionally fortified beverages; sherbets [beverages].

145. Protection will be granted in the UK in relation to the following goods which were not opposed:

Class 30: Flavourings of tea; herbal infusions; white tea; sage tea; ginger tea; non-medicated tea extracts; tea essences; tea substitutes; green tea; instant tea; citron tea; infusions, not medicinal; packaged tea [other than for medicinal

use]; fruit teas; instant tea [other than for medicinal purposes]; chai tea; flowers or leaves for use as tea substitutes; tea extracts; tea-based beverages; tea-based beverages with fruit flavouring; tea; tea leaves; tea bags; jasmine tea; ginseng tea; lime tea; rosemary tea; rooibos tea; earl grey tea; black tea [English tea]; Japanese green tea.

Class 32: Orgeat.

## **COSTS**

146. The opposition has been successful and, as such, the opponent is entitled to a contribution towards its costs. The opponent has, through its representatives, submitted that off-scale costs are appropriate. The opponent has claimed that the holder has acted unreasonably by pursuing the UK designation of the IR, despite the findings of a prior decision of the Tribunal. Decision number O/202/19 involved both parties to these proceedings and it is the opponent's contention that the respective disputes are nearly identical in circumstance. The opponent has argued that the sole purpose of the UK designation of the IR at issue in these proceedings was to disrupt the opponent's business and put it through unnecessary trouble and expense. The opponent has claimed that the filing of further applications to register minor variations of the 'FLORINA' mark in relation to soft drinks would amount to an abuse of process; therefore, it seeks an award of costs off the usual scale to deter the holder from filing such applications.

147. Rule 67 of the Trade Marks Rules 2008 provides:

"The registrar may, in any proceedings under the Act or these Rules, by order award to any party such costs as the registrar may consider reasonable, and direct how and what parties they are to be paid."

148. Tribunal Practice Notice ("TPN") 4/2007 indicates that the Tribunal has a wide discretion when it comes to the issue of costs, including making awards above or below the published scale where the circumstances warrant it. The TPN stipulates that costs off the scale are available "to deal proportionately with wider breaches of rules,

delaying tactics or other unreasonable behaviour". The opponent has not argued that the holder has breached any rules or utilised delaying tactics. The matter at issue is whether the UK designation of the IR by the holder should be considered unreasonable behaviour.

149. Having considered the conduct of proceedings, it is my view that off-scale costs are not appropriate in this instance. I acknowledge that the IR at issue in these proceedings is similar to the contested mark in decision number O/202/19 and the respective specifications of the holder's two international registrations cover similar goods. However, to my mind, it is not *prima facie* unreasonable for a party to file a fresh application for a variant mark and an amended specification if a prior attempt to obtain a registration has failed. The opponent has referred to one prior decision of the Tribunal, in which it was partially successful against the holder, and one other designation made by the holder. This does not strike me as representative of continual and repeated attempts. In the circumstances, the holder does not appear to be concerned with anything other than its own business in the UK designation of the IR. To my mind, none of the aforesaid is compelling evidence of an abuse of process or otherwise unreasonable behaviour. In any event, the filing date of the IR and the date of UK designation was 17 July 2018, while decision number O/202/19 was not issued until 12 April 2019. Therefore, the facts are plainly not consistent with the opponent's argument that the holder has acted unreasonably in disregarding the findings of the decision and proceeding to file a new application.

150. The relevant scale is contained in TPN 2/2016. This decision has been taken from the papers without an oral hearing. The opponent filed evidence in these proceedings as well as written submissions in lieu of a hearing. In the circumstances I award the opponent the sum of **£2,600** as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Preparing a statement and considering the holder's counterstatement	£400
Preparing evidence and considering the holder's evidence	£1,500
Preparing written submissions in lieu of hearing	£500
Official fees	£200
<b>Total</b>	<b>£2,600</b>

151. I therefore order Best Fruits 17 EAD to pay ETABLISSEMENTS GEYER FRERES the sum of **£2,600**. The above sum should be paid within twenty-one of the expiry of the appeal period or, if there is an unsuccessful appeal, within twenty-one days of the conclusion of the appeal proceedings.

**Dated this 11th day of November 2020**

**James Hopkins**  
**For the Registrar,**  
**The Comptroller General**