

O/0129/23

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003597078

BY BERRYWORLD LIMITED

TO REGISTER THE TRADE MARK:

POPPIN' POMS

IN CLASSES 29 AND 31

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 427164 BY

THE WONDERFUL COMPANY LLC

BACKGROUND AND PLEADINGS

1. On 18 February 2021, BerryWorld Limited (“the applicant”) applied to register the trade mark shown on the cover page of this decision in the UK. The application was published for opposition purposes on 25 June 2021 and registration is sought for the following goods:

Class 29 Prepared fruits; Snack food (Fruit-based -); Processed fruits, fungi and vegetables (including nuts and pulses).

Class 31 Fresh fruits; Mixed fruits [fresh]; Berries, fresh fruits.

2. On 27 September 2021, The Wonderful Company LLC (“the opponent”) opposed the application based upon sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). Under sections 5(2)(b) and 5(3), the opponent relies upon the following trade marks:

POM

UKTM no. 913092143

Filing date 17 July 2014; registration date 18 September 2018

(“the First Earlier Mark”)

The logo consists of the letters 'POM' in a bold, sans-serif font. The letter 'O' is replaced by a solid black heart shape.

UKTM no. 3213446

Filing date 17 February 2017; registration date 7 July 2017

(“the Second Earlier Mark”)

POM

UKTM no. 3213444

Filing date 17 February 2017; registration date 7 July 2017

(“the Third Earlier Mark”)



UKTM no. 913092309

Filing date 17 July 2014; registration date 18 January 2017

("the Fourth Earlier Mark")

(together "the earlier marks")

3. The opponent relies upon all goods for which the earlier marks are registered as set out in the Annex to this decision.
4. Under section 5(2)(b), the opponent claims that there is a likelihood of confusion because the marks are similar and the goods are identical or similar.
5. Under section 5(3), the opponent claims to have a reputation for all of the goods for which the earlier marks are registered and claims that use of the applicant's mark would, without due cause, take unfair advantage of, or be detrimental to, the distinctive character and/or reputation of the earlier marks.
6. Under section 5(4)(a), the opponent relies upon the signs **POM** and **POM POMS** which it claims to have used throughout the UK since 2008 in relation to "pomegranate, pomegranate arils, pomegranate juice".
7. The applicant filed a counterstatement denying the claims made.
8. The opponent is represented by Bird & Bird LLP and the applicant is unrepresented.

9. Only the opponent filed evidence. Neither party requested a hearing and only the opponent filed written submissions in lieu. This decision is taken following a careful perusal of the papers.

EVIDENCE AND SUBMISSIONS

10. The opponent filed evidence in the form of the Affidavit of Craig B. Cooper dated 4 December 2022. Mr Cooper is the Executive Vice President, General Counsel and Secretary of the opponent. His evidence is accompanied by 22 exhibits.

11. The opponent filed written submissions in lieu of a hearing dated 17 November 2022.

12. I have taken the evidence and submissions into account in reaching this decision.

RELEVANCE OF EU LAW

13. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied upon in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts.

DECISION

Section 5(2)(b)

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

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

(a)...

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

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

15. Section 5A of the Act is as follows:

“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.”

16. By virtue of their earlier filing dates, the trade marks upon which the opponent relies qualify as earlier trade marks pursuant to section 6 of the Act. As the earlier marks had not completed their registration process more than 5 years before the application date of the mark in issue, they are not subject to proof of use pursuant to section 6A of the Act. The opponent can, therefore, rely upon all of the goods identified.

17. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:

(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 greater 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 to mind the earlier mark, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of trade marks



18. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“... it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

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

20. The respective trade marks are shown below:

Opponent's trade marks	Applicant's trade mark
POM (the First Earlier Mark)	POPPIN' POMS

 <p>(the Second Earlier Mark)</p> <p>POM</p> <p>(the Third Earlier Mark)</p>  <p>(the Fourth Earlier Mark)</p>	
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Overall Impression

21. The First and Third Earlier Marks consist of the word POM. There are no other elements to contribute to the overall impression which lies in the word itself.

22. The Second and Fourth Earlier Marks consist of the letters P and M separated by a heart device. The overall impression of the mark lies in the combination of these elements.

23. The applicant's mark consists of the word POPPIN' followed by the word POMS. The word POPPIN' qualifies the word POMS, with the overall impression lying in the combination of these words.

Visual Comparison

24. The First and Third Earlier Marks overlap with the applicant's mark to the extent that they all contain the three letters, POM. However, these three letters are the only

element of the First and Third Earlier Marks, whereas in the applicant's mark they are preceded by the word POPPIN' and followed by the letter S. Overall, I consider there to be between a low and medium degree of visual similarity.

25. The Second and Fourth Earlier Marks cannot be said to contain the word POM. As noted above, they contain the letters P and M, separated by a heart device. There is some visual similarity between this sequence and the letters POM in the applicant's mark. However, the same differences apply as noted above i.e. the additional word POPPIN' and the letter S in the applicant's mark. Taking all of this into account, I consider there to be a low degree of visual similarity.

Aural Comparison

26. The point of aural overlap between the First and Third Earlier Marks and the applicant's mark will be in the pronunciation of the letters POM, which will be the same in all three. The additional word POPPIN' and the letter S in the applicant's mark will act as points of aural difference. Taking all of this into account, I consider there to be between a low and medium degree of aural similarity.

27. The way in which the Second and Fourth Earlier Marks will be pronounced is, in my view, far more arguable. I accept that there may be some people who, in wanting to form a pronounceable word, will substitute an 'O' in place of the heart device. For those consumers, there will be between a low and medium degree of aural similarity for the same reasons as set out above. However, there will also, in my view, be consumers who view the heart device as simply a device, and the only pronounceable parts of the mark being the letters P and M. For those consumers, the marks will be aurally dissimilar.

Conceptual Comparison

28. With regard to the conceptual comparison, the opponent submits:

"23. Conceptually, the element POM and POMS, which are the dominant and distinctive elements of the respective marks, are visually identical as POMS is

the plural of POM, and if any conceptual meaning is interpreted, it will be identical as between the two words. The additional element POPPIN' within the Opposed Mark does not play a dominant role within the mark. The element POPPIN' will be seen by the relevant public as referring to the word "popping". It is a well-known colloquialism in the English language known as "g-dropping" where the -ing ending is pronounced with an alveolar nasal [n]. It is shown in the conventional orthography by the use of an apostrophe in place of the "g", as in stoppin' and nothin' – and in this case, poppin'.

24. The relevant public will understand the element POPPIN' to mean the same as "popping" and when used before the element POMS, the interpretation will be that the POMS (whatever they are) are "popping".

25. In addition, there will be a portion of the relevant public that might allocate a meaning to the word POM(S), for example it may be understood as referring to the nickname that Australians give to British people, or it may be understood to have no meaning at all. Regardless of whether or not a meaning is ascribed to the element POM(S), the public will understand that POMS is the plural of POM, whatever POM means, and that the element POPPIN' included before POMS is merely an adjective describing the element POMS."

29. I agree with the opponent that the word "POPPIN'" in the applicant's mark is likely to be seen as a reference to the word "popping". However, it is not clear to me that any meaning will be conveyed by the word POM. I note the opponent's argument that the word POM may be seen as a reference to the Australian slang term for British people, but I am mindful that any conceptual meaning must be clear and obvious. In my view, there is no such clear and obvious meaning in this case. It is most likely that the word POM/POMS will simply be viewed as invented, with no particular meaning. Consequently, the only part of either mark which conveys a meaning is the word POPPIN' in the applicant's mark, which results in conceptual dissimilarity overall.

30. The same will also apply in respect of those average consumers who view the Second and Fourth Earlier Marks as the word POM. For those that view those marks

as the letters P and M, separated by a heart device, there will equally be no conceptual message conveyed and the position will be dissimilar.

31. The First and Third Earlier Marks are identical to each other, as are the Second and Fourth Earlier Marks. As the Third and Fourth Earlier Marks have the specifications that are most favourable to the opponent, I will continue my assessment on the basis of those marks only as they represent the opponent’s best case.

Comparison of goods

32. The full specifications upon which the opponent relies can be found in the Annex to this decision. However, for the purposes of my comparison, I have included only those terms I consider to be most relevant in the table below:

Opponent’s goods	Applicant’s goods
<p><u>The Third Earlier Mark</u></p> <p><u>Class 31</u> Fresh fruit</p> <p><u>The Fourth Earlier Mark</u></p> <p><u>Class 29</u> Preserved, frozen, dried and cooked fruits; preserved, frozen, dried and cooked vegetables; snack mixes containing processed nuts; snack mixes containing preserved, frozen, fried and cooked fruits; fruit-based snack products.</p> <p><u>Class 31</u> Fresh fruits.</p>	<p><u>Class 29</u> Prepared fruits; Snack food (Fruit-based -); Processed fruits, fungi and vegetables (including nuts and pulses).</p> <p><u>Class 31</u> Fresh fruits; Mixed fruits [fresh]; Berries, fresh fruits.</p>

33. When making the comparison, all relevant factors relating to the goods in the specifications should be taken into account. In the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon*, Case C-39/97, the court stated at paragraph 23 that:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary.”

34. Guidance on this issue has also come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

(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.

35. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court (“GC”) stated that:

“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 for 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.”

Class 29

Prepared fruits; Snack food (Fruit-based -); Processed fruits, fungi and vegetables (including nuts and pulses).

36. These terms overlap in user, purpose and method of use with the term “fresh fruit” in the specification of the Third Earlier Mark. Clearly, where the prepared foods in the applicant’s specification are fruit-based, then there will be some overlap in nature, albeit differences will be created by the fact that the applicant’s goods have been prepared or processed. The goods are likely to be in competition as a user may choose either fresh fruit products or processed alternatives. In the absence of any evidence on the point, I consider it unlikely that the same businesses will be responsible for both the fresh and processed goods, although I recognise that they are both likely to be available to purchase through the same retailers such as supermarkets and other food retail outlets. I do not consider the goods to be complementary. Consequently, I consider there to be at least a medium degree of similarity between the goods.

37. These terms in the applicant’s specification are self-evidently or *Merici* identical to the terms “preserved, frozen, fried and cooked fruits”, “preserved, frozen, dried and cooked vegetables”, “snack mixes containing processed nuts”, “snack mixes containing preserved, frozen, fried and cooked fruits” and “fruit-based snack products” in the specification of the Fourth Earlier Mark.

Class 31

Fresh fruits; Mixed fruits [fresh]; Berries, fresh fruits.

38. These terms are all either self-evidently or *Meric* identical to “fresh fruit” in the specifications of the Third and Fourth Earlier Marks.

Comparison with “fruit juices”

39. For the avoidance of doubt and for reasons that will become apparent later in this decision, I will consider the similarity of the applicant’s specification with the term “fruit juices”. I do not consider the goods to overlap significantly in nature, with the opponent’s goods being drinkable liquids and the applicant’s goods being fresh or processed food products. They only overlap in purpose and method of use to the extent that they can both be consumed; however, the applicant’s goods will be consumed to combat hunger whereas the opponent’s goods will be consumed to combat thirst. Clearly, the user will be the same as both goods can be used by members of the general public. In the absence of any evidence to the contrary, I do not consider it likely that there will be any meaningful overlap in the businesses that produce these goods, although I recognise that they will all be available from general retailers (such as supermarkets). I do not consider there to be any competition or complementarity. Taking all of this into account, I do not consider the goods to be similar to any meaningful degree.

The average consumer and the nature of the purchasing act

40. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties’ goods. I must then determine the manner in which the goods are likely to be selected by the average consumer. 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.”

41. The opponent submits as follows:

“36. In the present case, the goods of both the Application and the Earlier Marks are directed at the public at large and the level of attention of the public for these types of goods is average.”

I agree.

42. The goods are likely to be selected from the shelves of a retail outlet or their online equivalents. Consequently, I consider it likely that the purchasing process for the goods will be predominantly visual. However, given that advice may be sought from sales assistants, I do not discount that aural considerations may also play a part.

Distinctive character of the earlier trade marks

43. 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-2779, 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).”

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

45. I have reviewed Mr Cooper’s evidence and note that the opponent’s evidence of use overwhelmingly relates to fruit juices. As explained above, I do not consider these goods to share any similarity with the applicant’s goods. Similarity of goods is essential for a likelihood of confusion and, consequently, any enhanced distinctiveness in relation to dissimilar goods will not assist the opponent. Consequently, I need only consider the inherent position.

46. In relation to the inherent position, the opponent submits as follows:

“29. Clearly, the Earlier Marks are entirely arbitrary when applied to the relevant goods and, as a result, enjoy a normal level of inherent distinctiveness.

30. Furthermore, it has been recognised that where there is no clear link between a mark and the goods to which it relates the earlier registered trade mark can acquire a high level of distinctiveness (*Environmental Manufacturing LLP v OHIM*). The Opponent submits that there is no clear link between the

Earlier Marks and the goods for which they are registered and therefore the Earlier Marks enjoy a higher level of distinctiveness.”

47. The Third Earlier Mark consists of the word POM. In my view, this is most likely to be viewed as an invented word. Consequently, it will be reasonably high in distinctive character. The Fourth Earlier Mark may either be viewed as the letters P and M separated by a heart device, or as a stylised representation of the letters POM, where the letter O is represented by a heart device. It will have at least a medium degree of distinctive character.

Likelihood of confusion

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

49. I have found as follows:

- a) The Third Earlier Mark and the applicant’s mark are visually and aurally similar to between a low and medium degree.

- b) The Fourth Earlier Mark and the applicant's mark are visually similar to a low degree and aurally similar to between a low and medium degree or aurally dissimilar.
- c) The Third and Fourth Earlier Marks and the applicant's mark are conceptually dissimilar as the application will convey at least some meaning (by virtue of the word POPPIN') whereas the Third and Fourth Earlier Marks will convey no clear conceptual meaning.
- d) The Third Earlier Mark is inherently distinctive to a reasonably high degree, and the Fourth Earlier Mark is inherently distinctive to at least a medium degree.
- e) The goods are similar to at least a medium degree or identical.
- f) The average consumer is a member of the general public who will pay a medium (or average) degree of attention during the purchasing process.
- g) The purchasing process will be predominantly visual, although I do not discount an aural component.

50. Given the relatively modest degree of visual and aural similarity between the marks, I do not consider it likely that the Third and Fourth Earlier Marks will be mistaken for the applicant's mark. In my view, it is unlikely that the average consumer will overlook the additional word POPPIN' in the application, even when used on identical goods. Consequently, I do not consider there to be a likelihood of direct confusion.

51. With regard to indirect confusion, I remind myself that a finding of indirect confusion should not be made merely because two marks share a common element.¹ In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, identified three categories into which instances of indirect confusion are likely to fall:

¹ *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17

“(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (‘26 RED TESCO’ would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as ‘LITE’, ‘EXPRESS’, ‘WORLDWIDE’, ‘MINI’ etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (‘FAT FACE’ to ‘BRAT FACE’ for example).”

I bear in mind that this list is not exhaustive.

52. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ referred to the comments of James Mellor QC (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at [16] that “a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion”. Arnold LJ agreed, pointing out that there must be a “proper basis” for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

53. I recognise that the Third Earlier Mark is inherently distinctive to a reasonably high degree and that the Fourth Earlier Mark is inherently distinctive to at least a medium degree. However, I do not consider the letters POM to be so strikingly distinctive that no-one else could be using them in a trade mark at all. I do not consider this to be a case where the later mark simply adds a non-distinctive element to the earlier mark (I consider the word POPPIN’ to be distinctive for the goods in issue), nor is one mark entirely logical and consistent with a brand extension of the other. I can see no other basis upon which indirect confusion may arise in relation to these marks and it does not seem to me that the opponent has put forward any (or any convincing) explanation.

54. Consequently, taking all of the above factors into account, I am not satisfied that there is a likelihood of indirect confusion.

55. For the avoidance of doubt, my finding would have been the same even if I had found there to be some similarity between “fruit juices” in the opponent’s specification and the applicant’s goods. Any level of similarity would be low and this distance between the goods would offset any benefit that the opponent could have gained by virtue of any enhanced distinctive character.

56. The opposition based upon section 5(2)(b) is dismissed.

Section 5(3)

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

“5(3) A trade mark which -

(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 and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier trade mark.”

58. Section 5(3A) of the Act states:

“Subsection (3) applies irrespective of whether the goods and services for which the trade mark is to be registered are identical with, similar to or not similar to those for which the earlier trade mark is protected.”

59. As two of the earlier trade marks are comparable marks, paragraph 10 of Part 1, Schedule 2A of the Act is relevant. It reads:

“10.— (1) Sections 5 and 10 apply in relation to a comparable trade mark (EU), subject to the modifications set out below.

(2) Where the reputation of a comparable trade mark (EU) falls to be considered in respect of any time before IP completion day, references in sections 5(3) and 10(3) to—

(a) the reputation of the mark are to be treated as references to the reputation of the corresponding EUTM; and

(b) the United Kingdom include the European Union”.

60. 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’Oreal 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 Saloman, 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'Oreal 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'Oreal v Bellure*).

61. The conditions of section 5(3) are cumulative. Firstly, the opponent must show that the earlier marks and the applicant's mark are similar. Secondly, the opponent must show that the earlier marks have achieved a knowledge/reputation amongst a significant part of the public. Thirdly, it must be established that the level of reputation and the similarities between the marks will cause the public to make a link between them, in the sense of the earlier marks being brought to mind by the later mark. Finally, assuming that the first, second and third conditions have been met, section 5(3) requires that one or more of the types of damage will occur. It is unnecessary for the purposes of section 5(3) that the goods be 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.

62. Mr Cooper gives evidence that the opponent first started using the "POM" brand in the US in 2002. Mr Cooper gives evidence that the opponent first expanded into Europe in 2003, beginning with the export of fresh pomegranates to Belgium and thereafter throughout the EU and the UK. In relation to use in the EU, I note the following points from Mr Cooper's evidence:

- a) The following amounts have been spent on promotional expenditure in Europe (including the UK):²

Year	Figure
2012	1,601,537
2013	4,537,953
2014	824,272
2015	1,832,857
2016	637,886
2017	383,341
2018	1,982,074
2019	1,486,603

² Exhibit CBC-4

However, I note that further on in the same exhibit, there are tables which breakdown these numbers for 2018 and 2019 into three categories – “Pistachios”, “Almonds” and “POM”. No explanation is provided as to what the figures allocated to “Pistachios” and “Almonds” are or how they relate to the POM brand. The figures which appear under the “POM” heading are as follows:

2018	£504,167.48
2019	£296,971.00

These are significantly lower than the numbers provided in the above table.

- b) The following sales figures (USD) have been provided for “fruit juices” in various EU countries (not including the UK):³

2012	\$4,787,016.02
2013	\$3,366,785.21
2014	\$2,399,506.22
2015	\$2,009,366.39
2016	\$1,258,015.15
2017	\$935,205.54
2018	\$219,774.91

63. In relation to use in the UK, I note the following points from Mr Cooper’s evidence:

- a) The opponent registered a UK-based website in March 2004, which has been operational since 2008. The domain name is “pomwonderful” and it displays the following image:



³ Exhibit CBC-22

- b) In the period 2009 to 2011, over £4,300,000 was spent on advertising and consumer promotion in the UK;
- c) Television commercials were shown in the UK between 2013 and 2015;
- d) There have been various collaborations with social media influencers between 2016 and 2018 which have reached between 13,000 and 536,000 viewers;⁴
- e) Sampling campaigns were run in London in 2015, 2017 and 2018 and in Sainsbury's supermarkets across the UK in February 2016;⁵
- f) 'POM wonderful' has been referenced in magazines (or their online equivalents) such as *BBC Good Food* (December 2014 – circulation 4,333,161), *Female First* (July 2015 – circulation 2,800,000), *Take a Break* (July 2015, circulation 244,100), *That's Life* (July 2015 – circulation 44,500), *On Magazine* (August 2014 – circulation 30,000), *Bella* (July 2015 – circulation 27,100), *Love It* (April 2015 – circulation 35,800), *TV Choice* (July 2015 – circulation 106,000), *Eat In* (July 2015 – circulation 22,000), *Loughborough Echo* (February 2015 – circulation 14,424), *Win Summer* (July 2015 – circulation 1,700,000), *Closer* (April 2014 – 337,190), *Natural Health* (June 2015 – 60,000), *Daily Mail* (December 2014 – circulation 1,660,339), *Food Bev* (May 2015 – circulation 57,423).⁶
- g) The following gross figures for UK "fruit juice" sales have been provided:

⁴ Exhibits CBC-6 and CBC-7

⁵ Exhibits CBC-8, CBC-9, CBC-10, CBC-11 and CBC-12

⁶ Exhibit CBC-18

Year	Figure (USD\$)
2012	3,990,254
2013	4,015,475
2014	3,945,277
2015	3,796,769
2016	3,605,613
2017	3,625,062
2018	4,004,776
2019	4,124,492

64. The Second Earlier Mark and the Third Earlier Mark are UKTMs and, consequently, the opponent must show a reputation in the UK. The First Earlier Mark and the Fourth Earlier Mark are comparable marks and so use outside of the UK (but within the EU) prior to 31 December 2020 will be taken into account in my assessment.

65. I recognise that there has been a reasonable amount of advertising expenditure and publicity activity within the UK market over a number of years. However, the sales figures provided by the opponent for the UK market, whilst not insignificant, represent a relatively low share of what will undoubtedly be an extensive market. Television advertising has been sporadic and several years prior to the relevant date. The magazine advertising is also focused several years prior to the relevant date. I note that sales of goods in the EU has been relatively modest (again, given the scale of the market) and, further, has reduced in more recent years. I also note that advertising expenditure for the EU market is relatively modest and, as noted above, it is not clear to me that all of the expenditure identified related to promotion of the marks in issue. Taking all of this into account, I am not satisfied that the opponent has demonstrated the necessary reputation in the relevant market.

66. For the avoidance of doubt, even if I am wrong in that finding, and the opponent does have a reputation, it will be at a modest level and only in relation to fruit juices. I

will, for the sake of completeness, go on and consider whether there would be a link if I am wrong in the finding that the opponent does not have a reputation.

Link

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

The degree of similarity between the conflicting marks

The First and Third Earlier Marks and the applicant's mark are visually and aurally similar to between a low and medium degree.

The Second and Fourth Earlier Marks and the applicant's mark are visually similar to a low degree and aurally similar to between a low and medium degree or aurally dissimilar.

The earlier marks and the applicant's mark are conceptually dissimilar as the application will convey at least some meaning (by virtue of the word POPPIN') whereas the earlier marks will convey no clear conceptual meaning.

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 "fruit juices" to be dissimilar to the opponent's goods.

I have found the average consumer to be a member of the general public who will pay a medium degree of attention during the purchasing process (which will be predominantly visual, although aural considerations will also play a part).

The strength of the earlier mark's reputation

Any reputation would be at a relatively modest level.

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

The First and Third Earlier Marks are inherently distinctive to a reasonably high degree, and the Second and Fourth Earlier Marks are inherently distinctive to at least a medium degree.

Whether there is a likelihood of confusion

As the goods are dissimilar, there would be no likelihood of confusion.

68. In my view, the above factors, particularly the distance between the goods, when combined with the differences between the marks, will mean that no link will be made in the mind of the relevant public. If any link were made, then it would be fleeting and would not result in any damage. For the avoidance of doubt, my finding would be the same even if the goods were similar to a low degree.

69. The opposition based upon section 5(3) of the Act is dismissed.

Section 5(4)(a)

70. Section 5(4)(a) of the Act states as follows:

“5(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”.

71. 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.”

72. I can deal with this ground relatively swiftly. The opponent claims goodwill in relation to “pomegranate, pomegranate arils, pomegranate juice”. I am satisfied that the opponent’s evidence is sufficient to demonstrate a modest (but protectable) degree of goodwill for “pomegranate juice” in the UK. However, given the distance between those goods and the goods covered by the application, as well as the differences between the marks, I can see no reason why a substantial number of members of the relevant public would be misled into purchasing the applicant’s goods in the mistaken belief that they are the goods of the opponent. Consequently, I am not satisfied that either a misrepresentation or damage would occur.

73. The opposition based upon section 5(4)(a) of the Act is dismissed.

CONCLUSION

74. The opposition is unsuccessful, and the application may proceed to registration.

COSTS

75. The applicant has been successful and would ordinarily be entitled to a contribution towards its costs. However, as the applicant is unrepresented, the Tribunal wrote to

the applicant on 20 October 2022, inviting it to file a costs proforma if it wished to claim costs. The letter stated:

“If the pro-forma is not completed and returned, costs, other than official fees arising from the action (excluding extensions of time), may not be awarded. [...]”

76. No costs proforma was filed. Consequently, I make no order as to costs.

Dated this 6th day of February 2023

S WILSON

For the Registrar

ANNEX

The First Earlier Mark

Class 32

Fruit drinks; fruit juices; syrups and other preparation for making beverages; fruit juice for use as an ingredient for food; non-alcoholic fruit extracts; non-alcoholic fruit concentrate; non-alcoholic fruit extracts used in the preparation of beverages; preparations for making fruit drinks; fruit flavoured beverages (excluding soft drinks and carbonated water); non-alcoholic beverages containing fruit juices; non-alcoholic beverages containing fruit extracts; smoothies; non-alcoholic beverages with tea flavour; low calorie fruit juice drinks; low calorie tea flavoured beverages; fruit juice concentrate; concentrates for making fruit drinks; fruit juice mixes; fruit flavored drinking water (excluding carbonated drinking water); fruit and vegetable juice beverages; fruit and vegetable drinks; fruit and vegetable juice.

The Second Earlier Mark

Class 5

Dietary supplements.

Class 30

Iced tea and tea-based beverages with fruit flavouring.

Class 31

Fresh fruit.

Class 32

Fruit juice; fruit juice concentrate; soda; soft drinks; fruit flavored beverages; non-alcoholic beverages containing fruit juices; non-alcoholic beverages containing fruit extracts.

The Third Earlier Mark

Class 5

Dietary supplements.

Class 30

Iced tea and tea-based beverages with fruit flavoring.

Class 31

Fresh fruit.

Class 32

Fruit juice; fruit juice concentrate; soda; soft drinks; fruit-flavored beverages; non-alcoholic beverages containing fruit juices; non-alcoholic beverages containing fruit extracts.

The Fourth Earlier Mark

Class 29

Preserved, frozen, dried and cooked fruits; preserved, frozen, dried and cooked vegetables; frozen pomegranates; frozen pomegranate arils; dried pomegranates; dried pomegranate arils; jellies, jams, compotes; milk products; processed nuts; snack mixes containing processed nuts; snack mixes containing preserved, frozen, dried and cooked fruits; trail mixes; fruit-based food products; fruit-based snack products; snack bars, trail bars and health bars; snack bars, trail bars and health bars containing pomegranates, pomegranate by-products, and/or pomegranate flavouring; but not including potato snacks or extruded potato products for use in food.

Class 30

Coffee, tea, cocoa; honey; sauces (condiments); cereal-based snack products; snack bars, trail bars and health bars; snack bars, trail bars and health bars containing pomegranates, pomegranate by-products, and/or pomegranate flavouring; nonmedicated confectionery; topping syrup; iced tea and tea-based beverages with fruit flavouring; salad dressing; but not including crackers, extruded savory food products made of cereals, nachos, tortilla chips, extruded food products made of potatoes, or snack products made from potato flour.

Class 31

Fresh fruits; fruit for use as an ingredient in foods; fruit extract for use as an ingredient in foods; seeds; natural plants and flowers; nuts; pomegranates; pomegranate arils; pomegranate extract.

Class 32

Non-alcoholic beverages; fruit drinks; fruit juices; syrups and other preparation for making beverages; fruit juice for use as an ingredient for food; non-alcoholic fruit extracts; non-alcoholic fruit concentrate; non-alcoholic fruit extracts used in the preparation of beverages; preparations for making fruit drinks; fruit flavoured beverages; non-alcoholic beverages containing fruit juices; non-alcoholic beverages containing fruit extracts; smoothies; non-alcoholic beverages with tea flavour; low calorie fruit flavoured beverages; low calorie fruit juice drinks; low calorie tea flavoured beverages; soda; soft drinks; non-carbonated soft drinks; carbonated soft drinks; fruitflavoured soft drinks; fruit juice concentrate; concentrates for making fruit drinks; fruit juice mixes; fruit flavored drinking water; isotonic beverage; other carbonated drinks (refreshing beverages); carbonated drink mixes; fruit and vegetable juice beverages; fruit and vegetable drinks; fruit and vegetable juice.