

O-438-21

TRADE MARKS ACT 1994

IN THE MATTER OF UK APPLICATION NO 3459423  
BY THE FIZZBANG BEVERAGE COMPANY LTD:



AND

THE OPPOSITION THERETO UNDER NO 600001393 BY  
SUN MARK LTD

## Background and pleadings

1. On 20 January 2020, The Fizzbang Beverage Company Ltd (the applicant) applied to register the above trade mark in class 32 for fruit squashes.<sup>1</sup>
2. The applicant's mark was published on 24 January 2020, following which it was opposed under the fast track opposition procedure by Sun Mark Ltd (the opponent).
3. The opponent bases its case on section 5(2)(b) of the Trade Marks Act 1994 (the Act). It relies upon the following Trade Marks:

Mark details and relevant dates	Goods relied upon
<p>UKTM: 3257519</p> <p><b>REJOICE</b></p> <p>Filed: 18 September 2017</p> <p>Registered: 15 December 2017</p>	<p><b>Class 32</b></p> <p>Aerated fruit juices; Aerated juices; Alcohol free wine; Beverages consisting principally of fruit juices; Beverages (Non-alcoholic -); Carbonated non-alcoholic drinks; Concentrated fruit juice; Flavoured carbonated beverages; Fruit beverages; Fruit drinks; Fruit flavored drinks; Fruit flavored soft drinks; Fruit flavoured carbonated drinks; Fruit flavoured drinks; Fruit juice beverages; Fruit juice concentrates; Fruit-based beverages; Fruit-flavoured beverages; Grape juice; Grape juice beverages; Juice (Fruit -); Mixed fruit juice; Non-alcoholic beverages; Non-alcoholic beverages containing fruit juices; Non-alcoholic carbonated beverages; Non-alcoholic flavored carbonated beverages; Non-alcoholic fruit juice beverages; Non-alcoholic grape juice beverages; Non-alcoholic sparkling fruit juice drinks; Non-alcoholic wine; Non-carbonated soft drinks; Soft drinks.</p>

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<sup>1</sup> *International Classification of Goods and Services for the Purposes of the Registration of Marks under the Nice Agreement (15 June 1957, as revised and amended).*

<p><b>UKTM:</b> 3360290</p> <p><b>REJOICE</b></p> <p><b>Filed:</b> 12 December 2018 <b>Registered:</b> 8 March 2019</p>	<p><b>Class 32</b></p> <p>Non-alcoholic beverages; Flavoured carbonated beverages; Alcohol free wine; Soft drinks; Non-carbonated soft drinks; Non-alcoholic malt free beverages (other than for medical use); Carbonated non-alcoholic drinks; Non-alcoholic flavoured carbonated beverages; all the aforementioned goods without predominant fruit content; Non-alcoholic sparkling beverages from fruit concentrate.</p>
<p><b>EUTM:</b> 17488586<sup>2</sup></p> <p><b>rejoice</b></p> <p><b>Filed:</b> 16 November 2017 <b>Registered:</b> 8 January 2019</p>	<p><b>Class 32</b></p> <p>Non-alcoholic beverages; Alcohol free wine; Soft drinks; Non-carbonated soft drinks; Non-alcoholic malt free beverages [other than for medical use]; Carbonated non-alcoholic drinks; Non-alcoholic flavoured carbonated beverages; all aforementioned goods without a predominant fruit content.</p>

4. The applicant filed a counterstatement in which it denied the ground raised by the opponent.

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

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

6. The net effect of these changes is to require the parties to seek leave in order to file evidence in fast track oppositions. Neither side made such a request.

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<sup>2</sup> Following the UK exit from the EU on 31 December 2020, a UK trade mark was created from this EU trade mark. However, at the time of filing the opposition, the opponent relied on its EU trade mark.

7. Rule 62(5) (as amended) states that arguments in fast track proceedings shall be heard orally only if (i) the Office requests it or (ii) either party to the proceedings requests it and the registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost; otherwise, written arguments will be taken.

8. Neither party requested to be heard, nor did they file submissions. I make this decision based on careful consideration of the papers before me.

### **Preliminary issue**

9. I note that in an email sent to this tribunal on 13 July 2020, the applicant included images purporting to show how its goods and the opponent's goods are presently marketed. As I have confirmed above, no request was made to file this as evidence and I do not intend to consider it.

10. For the sake of clarity, it is worth noting that even if this material had been filed as evidence, it is not relevant to the matter to be decided. Before I continue with the merits of the opposition, I will explain why this is so.

11. Until a trade mark has been registered for five years (when the proof of use requirements set out in s.6A of the Act take effect), it is entitled to protection in relation to all the goods/services for which it is registered. Consequently, the opponent's earlier marks must be protected for the goods for which they are registered in class 32, without the opponent needing to prove any use of its mark in relation to those goods. In other words, a trade mark is protected for the first five years for all goods and services for which it is registered, regardless of use. The opponent's earlier mark is therefore entitled to protection against a likelihood of confusion with the applicant's mark based on the 'notional' use of the earlier mark for all the goods listed in the register. This concept of notional use was explained by Laddie J. in *Compass Publishing BV v Compass Logistics Ltd*<sup>3</sup> as follows:

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<sup>3</sup> [2004] RPC 41

"22. ...It must be borne in mind that the provisions in the legislation relating to infringement are not simply reflective of what is happening in the market. It is possible to register a mark which is not being used. Infringement in such a case must involve considering notional use of the registered mark. In such a case there can be no confusion in practice, yet it is possible for there to be a finding of infringement. Similarly, even when the proprietor of a registered mark uses it, he may well not use it throughout the whole width of the registration or he may use it on a scale which is very small compared with the sector of trade in which the mark is registered and the alleged infringer's use may be very limited also. In the former situation, the court must consider notional use extended to the full width of the classification of goods or services. In the latter it must consider notional use on a scale where direct competition between the proprietor and the alleged infringer could take place."

12. So far as the applicant's use of his mark is concerned, in *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited*<sup>4</sup>, the Court of Justice of the European Union ("CJEU") stated at paragraph 66 of its judgment that when assessing the likelihood of confusion in the context of registering a new trade mark it is necessary to consider all the circumstances in which the mark applied for might be used if it were registered.

13. Furthermore, in *Devinlec Développement Innovation Leclerc SA v OHIM*,<sup>5</sup> the CJEU stated that:

"59. As regards the fact that the particular circumstances in which the goods in question were marketed were not taken into account, the Court of First Instance was fully entitled to hold that, since these may vary in time and depending on the wishes of the proprietors of the opposing marks, it is inappropriate to take those circumstances into account in the prospective analysis of the likelihood of confusion between those marks."

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<sup>4</sup> Case C-533/06

<sup>5</sup> Case C-171/06P

14. In other words, the way in which the applicant is actually using its trade mark at this point is not a factor which is relevant to the decision. Rather, I must consider all normal and fair uses of the applicant's mark. The same applies to the opponent's earlier marks.

## **DECISION**

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

“(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), (aa) 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...”

The opponent's marks are earlier marks which are not subject to proof of use. This is because, at the date of application of the contested mark, they had not been registered for five years.<sup>6</sup>

## **The opposition**

16. Section 5(2)(b) of the Act states:

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<sup>6</sup> See section 6A(3)(a) of the Act (added by virtue of the Trade Marks Regulations 2018: SI 2018/825) which came into force on 14th January 2019.

“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,

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

### **The relevant law**

17. 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 on 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.

18. 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 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**

19. In *Gérard Meric v Office for Harmonisation in the Internal Market*,<sup>7</sup> the General Court 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 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”.

20. This is clearly the case here. The applicant’s ‘fruit squashes’ are included within the opponent’s broader term ‘non-alcoholic beverages’, which is present in all three of its earlier rights.

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

21. In accordance with the above cited case law, I must determine who the average consumer is for the goods at issue and also identify the manner in which those goods will be selected in the course of trade.

22. 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*<sup>8</sup>, Birss J. described the average consumer in these terms:

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<sup>7</sup> Case T- 133/05


<sup>8</sup> [2014] EWHC 439 (Ch)

“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 word ‘average’ denotes that the person is typical. The term ‘average’ does not denote some form of numerical mean, mode or median.”

23. The goods are normal everyday goods provided to members of the general public. The purchase is likely to be primarily visual, the consumer encountering such goods online, through a catalogue or in a bricks and mortar store. The goods are fairly low cost and fairly frequent purchases. The consumer is likely to pay at least an average degree of attention to the purchase, as they will need to ensure the goods are fit for their particular purpose, for example, a purchaser of fruit drinks may want to look at, inter alia, calorie content, fruit content and colourings.

**Comparison of marks**

24. The opponents marks 3257519 and 3360290 are both registered for the plain word REJOICE. I will consider these two marks together. Given the obvious differences between these two marks and 00917488586 which is for the word REJOICE in a slightly stylised presentation, I will consider that mark separately, later in this decision.

Opponent	Applicant
<p>REJOICE</p>	

25. In making a comparison between the marks, I must consider the respective marks’ visual, aural and conceptual similarities with reference to the overall impressions

created by them, bearing in mind their distinctive and dominant components<sup>9</sup>, but without engaging in an artificial dissection of the marks, because the average consumer normally perceives a mark as a whole and does not analyse its details.

26. The applicant's mark is made up of the letters 're Jooiced'. The letters are presented in a black typeface. The first two letters, 're', are contained within a circle which is made from two semi-circular arrows. The next part of the mark is the letters 'Jooiced'. The letter 'J' appears to be in upper case. The second 'o' in 'Jooiced' has two stylised elements above it which give the impression of leaves or petals. The stylisation is very much part of this mark and I find that the overall impression rests in the mark as a whole.

27. The opponent's first two marks are both the word REJOICE presented in upper case and in plain black typeface with no additional stylisation. The overall impression of the opponent's marks rests in the whole mark.

28. Visual similarity rests in the fact that both marks include the letters 'R', 'E', 'J', 'O', 'C' and 'E'. However, with the exception of the letter J in the applicant's mark, the opponent's marks are in upper case and the applicant's in lower case. Further differences include the fact that the first two letters 're' in the applicant's mark are separated from the remaining part of the mark by a circle element which is the beginning of the mark and is a noticeable feature which will not be ignored by the average consumer. The applicant's mark contains a double 'o' and leaves or petals above the second of those letters. The visual differences outweigh the visual similarities and I find that these marks are visually similar to a fairly low degree.

29. With regard to aural similarity, the stylised elements in the applicant's mark make no difference to the pronunciation of it. The applicant's mark will most likely be pronounced 'RE-JUICED'. The opponent's mark is the common English word 'REJOICE' with which the average consumer will be familiar. These marks are aurally similar in the first two letters which make the same 'REE' sound. They also share the letter 'J' in the next part of both marks. The next syllable in each mark is different with

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<sup>9</sup> *Sabel v Puma AG*, para.23

the opponent's mark being pronounced REE-JOYCE and the applicant's being REE-JOOSD. The applicant's mark is also longer with the additional sound created by 'ED' at the end it. I find these marks aurally similar to a medium degree.

30. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer.<sup>10</sup> The assessment must be made from the point of view of the average consumer who cannot be assumed to know the meaning of everything.<sup>11</sup>

31. In its counterstatement, the applicant submits that the two trademarks have different meanings, though it doesn't say what these are.

32. The opponent's mark is the English word 'REJOICE' which will be given its common meaning by the average consumer, namely, to feel or show great joy. The applicant's mark will be seen as referring to RE-JOOCED, or 'RE-JUICED', which I take to mean something which has regained its 'juice' and I find that this is how the average consumer will see it. This message is reinforced to some extent by the leaves or petals above the second 'o' which could be seen as alluding to a piece of fruit or a vegetable.



33. In addition, it is possible that when the marks are spoken, the applicant's mark may be considered to be the word 'REDUCED', though in the context of the goods, I find this less likely. In either case, the meaning of the applicant's mark is completely different to that of the earlier marks. Consequently, these trade marks have no conceptual similarity.

34. I will now consider the opponent's third mark.

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<sup>10</sup> This is highlighted in numerous judgments of the GC and the CJEU including *Ruiz Picasso v OHIM* [2006] e.c.r.-I-643; [2006] E.T.M.R. 29.

<sup>11</sup> See the comments of Anna Carboni, sitting as the Appointed Person in *Chorkee*, *BL O/048/08*, paragraphs 36 and 37.

Opponent	Applicant
	

35. My analysis of the applicant's mark is the same as that reproduced at paragraph 26 above.

36. The opponent's mark comprises the word 'rejoice' in a stylised black typeface. It is presented in lower case in a slightly condensed form, where the letters are long and quite close together. The tittle of the letter 'i' is replaced with two shapes which could be seen to be splashes. The stylisation of the mark is minimal and whilst the 'splashes' over the letter 'i' may well be noticed, the overall impression of the mark rests in the word 'rejoice'.

37. Visual similarity rests in the fact that both marks include the letters 'r', 'e', 'j', 'o', 'c' and 'e'. The letter J in the applicant's mark is in upper case, while the opponent's is lower case, though this is unlikely to be noticed by the average consumer. The additional 'splash' element in the opponent's mark is in a similar position to the leaves or petals in the applicant's mark, which gives a further point of similarity between the respective marks, though the elements themselves are different and this is a very small factor in the overall comparison. The typeface used in the earlier mark is closer to that used in the applicant's mark, particularly the 're' in lower case. However, as above, differences include the fact that the first two letters 're' in the applicant's mark are separated from the remaining part of the mark by a circle element which is the beginning of the mark and is a noticeable feature which will not be ignored by the average consumer. The applicant's mark also contains a double 'o' and leaves or petals above the second of those letters. Taking all of these factors into account I find that these marks are visually similar to a lower than medium degree.

38. With regard to aural similarity, my comments are the same as above since additional stylised elements do not change the pronunciation of the earlier mark in this case. These marks are aurally similar to a medium degree.

39. The concept of this earlier mark is no different to the two I have already considered. It has not been altered by the change of typeface and additional splashes over the letter 'i'. My findings are the same as above. These trade marks are conceptually different.

### **Distinctive character of the earlier marks**

40. The degree of distinctiveness of the earlier marks must be assessed. This is because the more distinctive the earlier mark, based either on inherent qualities or because of use made, the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24). 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* [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).”

41. I have no evidence of the kind described in paragraph 23 of that decision, so can only make the inherent assessment described in paragraph 22.

42. The earlier trade marks relied on by the opponent are essentially the word REJOICE used in respect of goods in class 32. The additional stylistic elements in the third mark make no material difference to that assessment. The word has no specific descriptive or allusive qualities in relation to the goods and I find each of the three earlier marks to be trade marks possessed of a medium degree of inherent distinctive character.

### **Likelihood of confusion**

43. In assessing the likelihood of confusion, I must adopt the global approach advocated by case law and take into account the fact that marks are rarely recalled perfectly, the consumer relying instead on the imperfect picture of them he has kept in his mind.<sup>12</sup> I must also keep in mind the average consumer for the services, the nature of the purchasing process and have regard to 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 services and vice versa.

44. I have made the following findings:

- The average consumer is likely to be a member of the general public for the identical goods in class 32 which are fruit squashes.
- The level of attention paid to the purchase will be at least average.
- The purchase will be primarily a visual one.
- The opponent’s first two marks possess a fairly low visual similarity to the applicant’s mark and a lower than medium degree with respect to its third earlier mark relied on in this case.

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<sup>12</sup> *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27

- The parties' marks are aurally similar to a medium degree and are conceptually different.
- The earlier REJOICE and rejoice marks have a medium degree of inherent distinctive character.

45. Confusion can be direct (when the average consumer mistakes one mark for the other) or indirect (where the average consumer realises the marks are not the same, but puts the similarity that exists between the marks/services down to the responsible undertakings being the same or related).

46. In this case, taking into account the nature of the average consumer, the nature of the purchase, the level of attention to be paid to the purchase of these goods and the visual and conceptual differences between these trade marks, I do not find that the parties' marks, REJOICE/rejoice (with some stylisation) and the applicant's mark would be directly confused with one another. The differences between the mark applied for and the earlier marks are such that I do not find that the average consumer would directly mistake the applicant's mark for any of the three earlier marks relied on by the opponent and vice versa.

47. In *L.A. Sugar Limited v By Back Beat Inc*,<sup>13</sup> Mr Iain Purvis Q.C., sitting as the Appointed Person said:

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

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<sup>13</sup> BL O/375/10



common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.”

48. There is no common element in these trade marks, nor is there anything about any of them which would lead the consumer to make a connection between them resulting in the conclusion that they originate from linked or related undertakings. The high point of coincidence between these marks is that there are some shared letters, which share a similar pattern. The marks as wholes look quite different, in particular the first circular element in the applicant’s mark which contains the letters ‘re’, which has no equivalent in the earlier marks; and they will be given completely different meanings by the average consumer. No matter how the average consumer assesses the applicant’s mark, they will simply not give it the same conceptual meaning as the earlier marks. Rejoice is a well-known word in the English language and one with which the average consumer will likely be familiar. Even bearing in mind the relatively low cost of the goods at issue, put simply, having been mindful of the global assessment I must make, there is no likelihood of indirect confusion.

## **CONCLUSION**

49. The opposition fails under section 5(2)(b) of the Act.

## **COSTS**

50. The applicant has been successful and is therefore, in principle, entitled to a contribution towards its costs. However, I note that the opponent has not been provided with a costs proforma. As a result, I am unable to deal with the issue of costs at this stage.

51. A copy of the costs proforma will be provided to the applicant upon the issuance of this decision. The applicant is hereby directed to file a completed costs proforma to the Tribunal **within 14 days of the date of this decision**. Once this is received, I will issue a supplementary decision dealing with the issue of costs and setting the appeal period.

52. If the applicant fails to file a costs proforma within 14 days of the date of this decision, I will still issue a supplementary decision dealing with the issue of costs and setting the appeal period.

**Dated this 11th day of June 2021**

**Al Skilton**

**For the Registrar,**

**The Comptroller-General**