

O-409-19

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION NO. 3305374
BY PUREARTH LIFE LIMITED
TO REGISTER THE FOLLOWING TRADE MARK
IN CLASSES 32 AND 35**

BOOST ON THE GO

AND

**OPPOSITION THERETO UNDER NO. 413701
BY BOOST JUICE HOLDINGS PTY LTD.**

BACKGROUNDS AND PLEADINGS

1. On 20 April 2018 Purearth Life Limited (“the applicant”) applied to register the trade mark shown on the cover page of this decision in respect of a range of goods and services in classes 32 and 35.
2. The application was accepted and published for opposition purposes on 13 July 2018.
3. The application was opposed in full by Boost Juice Holdings Pty Ltd. (“the opponent”). The opposition is based upon Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). Relevant details of the marks relied upon are:



(“the First Earlier Mark”)

International Registration number: R1409758

Priority date: 31 October 2017; International registration date: 04 April 2018;

Date of protection of the international registration in UK: 20 December 2018.

Registered services (all relied upon):

Class 43: *Juice bars, restaurant, cafe and catering services; services for providing food and drink including take-away and fast food outlets and mobile businesses; provision of food and beverages.*



(“the Second Earlier Mark”)

UK trade mark number: 3151239

Filing date: 23 February 2016; Date of entry in register: 10 June 2016.

Registered goods and services (all relied upon):

Class 32: *Fruit juices; Vegetable juices; Fruit smoothies; Vegetable smoothies; Beverages consisting principally of fruit; Beverages consisting principally of vegetable; Beverages containing both fruit and vegetable juice; Beverages containing non-dairy milks; Fruit flavoured beverages; Vegetable flavoured beverages; Energy drinks; Concentrated fruit juice; Concentrated vegetable juice; Cordials; Frozen fruit beverages; Frozen vegetable beverages; Smoothies containing grains and oats; Fruit extracts; Vegetable extracts for use in beverages; Bottled waters; Flavoured water; Flavoured mineral water; Carbonated water; and other non-alcoholic beverages included in this class.*

Class 35: *Retail services in relation to non-alcoholic beverages; Wholesale services in relation to non-alcoholic beverages; Retail services in relation to preparations for making beverages; Wholesale services in relation to preparations for making beverages; Retail services in relation to foodstuffs; Wholesale services in relation to foodstuffs; Advertising services to promote the sale of beverages; Providing consumer information relating to food or drink products; Loyalty, incentive and bonus program services; Loyalty scheme services; Loyalty card services; Management of customer loyalty, incentive or promotional schemes; Organisation, operation and supervision of customer loyalty schemes.*

Class 43: *Cafés; Bars; Juice Bars; Providing drink services; Preparation of food and drinks; Services for the preparation of food and drinks; Serving food and drinks; Preparation of food and drink for immediate consumption.*

BOOST
JUICE BARS

and **BOOST**
Juice bars

(series of two marks)

("the Third Earlier Mark")

UK trade mark number: 2483546

Filing date: 28 March 2008; Date of entry in register: 27 March 2009.

Goods and services relied upon:

Class 32: *Beverages in this class; mineral and aerated waters and other non-alcoholic drinks; fortified beverages including beverages containing energy and/or vitamin supplements; beverages served cold or hot; fruit drinks and juices including fruit based nutritional drinks and juices; vegetable drinks and juices including vegetable based nutritional drinks and juices; fruit flavoured drinks; vegetable flavoured drinks; punches; sports drinks; bottled drinking water; a blended mixture of fresh fruit, fruit juice, sorbet and ice, in a variety of flavours; a blended mixture of fresh vegetables, vegetable juice, sorbet and ice, in a variety of flavours; smoothies; fruit juice based smoothies; non-alcoholic beverages and smoothies derived from fruit and / or vegetables or from natural ingredients.*

Class 43: *Services for providing food and drink including take-away food and drink services, restaurant services, cafeteria services and health and juice bar services, including but not limited to bar services relating to the provision of beverages including beverages served hot or cold, fortified beverages including beverages containing energy and/ or vitamin supplements, fruit juices, vegetable juices, dairy products including milk and yoghurt based products and beverages with or without fruit additives including smoothies and desserts, flavoured milk; yoghurt; fruit and vegetable based foods and health foods.*

4. The three marks relied upon by the opponent under Sections 5(2)(b) are earlier marks, in accordance with section 6 of the Act. Only the Third Earlier Mark completed its registration procedure more than five years prior to the publication date of the contested mark and it is subject to the proof of use conditions, as per section 6A of the Act.

5. The applicant filed a counterstatement in which it denies the grounds of opposition and put the opponent to proof of use of its Third Earlier Mark.


6. Only the opponent filed evidence and written submissions. The applicant filed nothing beyond the counterstatement. Neither party asked to be heard nor did they file written submissions in lieu of attendance at a hearing. This decision is reached following careful consideration of the papers.

7. In these proceedings, both parties are professionally represented, the applicant by Trade Mark Wizards Limited and the opponent by Groom Wilkes & Wright LLP.

The opponent's evidence

8. The opponent's evidence consists of a witness statement from Nishad Alani, the opponent's Director and CEO. The aim of this evidence is to show that the Third Earlier Mark (which is subject to proof of use) has been used in the UK in relation to the registered goods and services during the five-year period 13 July 2013 - 12 July 2018. Mr Alani states that the opponent operates juice and smoothie bars throughout the UK. The mark was first used in Australia in 2000 and has been used in the UK since 2007. Exhibit NA1 includes an article dated April 2007; it indicates that the opponent had become the Australian's fastest growing franchise and had entered the UK market. Details of 27 stores operating in the UK with their opening dates are given. The opening dates are between April 2007 and September 2016 and the locations show a geographically spread business. Exhibit NA2 includes black and white photocopies of pictures showing various dates between 2013 and 2018; these show



the mark  (which is the second mark in the series of the Third Earlier Mark) used on signage on bar outlets. Mr Alani gives UK turnover and advertising figures between 2013 and 2018. The turnover proportionally increased from around £5 million in 2014 to around £11 million in 2018 for a total of around £45 million. The advertising spent proportionally decreased from £100k in 2014 to £59K in 2015, 21K in 2016, 13K in 2017 and 13K 2018 for a total of around £200K. Black and white photocopies of three representative samples of invoices are provided (Exhibit NA3). These are dated 8 October 2015, 2 August 2017 and 11 June 2018 and feature the mark shown above. The rest of the evidence includes advertising material, namely (1) menus (with prices in pounds) and product information, both of which include pressed

juices and smoothies (Exhibits NA4-5); (2) promotional material relating to various UK marketing and promotional campaigns run in 2014, 2016, 2017 and 2018 (Exhibits 6-7) and (3) copies of webpages of the opponent's website (at www.boostjuicebars.co.uk) from the WayBack Machine as they appeared on various dates in 2013, 2014, 2015 and 2017 illustrating use of the mark in relation to smoothies. The copies also show use of a mark incorporating the word BOOST (as it appears in the Third Earlier Mark) with the words "the way you feel" underneath.

Preliminary remarks

9. Given the breadth of services covered by the Second Earlier Mark (in classes 32, 35 and 43), I will deal with this mark first. However, as the marks also differ in some figurative elements and in the respective specifications, I will consider the other marks and explain why (if at all) the differences affect the analysis.

DECISION

10. Section 5(2) of the Act reads:

"A trade mark shall not be registered if because –

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

(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."

Section 5(2)(b) - case-law

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

- (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 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 and services

12. In comparing the respective specifications, all the relevant factors 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:

“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”.

13. 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.

14. In *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

"... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless, the principle should not be taken too far. *Treat* was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."

15. In *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another*, [2000] F.S.R. 267 (HC), Neuberger J. (as he then was) stated that:

“I should add that I see no reason to give the word “cosmetics” and “toilet preparations”... anything other than their natural meaning, subject, of course, to the normal and necessary principle that the words must be construed by reference to their context.”

16. 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 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”.

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

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

18. Whilst on the other hand:

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

19. In *Gérard Meric v OHIM*, Case T- 133/05, the 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 fur Lernsysteme v OHIM- Educational Services* (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

20. The competing goods and services are:

Applicant’s goods and services	Opponent’s goods and services (Second Earlier Mark)
<p>Class 32: <i>Dairy-free kefir beverages; beverages containing live and active probiotic cultures; flavoured waters; fruit drinks and juices; mixed fruit juices; mineral and aerated waters; fruit drinks and juices; mixed fruit juices; aerated fruit juices; carbonated and still non-alcoholic drinks; frozen slush drinks; smoothies; fruit squashes; fruit beverages; fruit smoothies; smoothies containing grains and oats; orange juice; grape juice; cranberry juice; mango juice; pomegranate juice; guava juice; melon juice; grapefruit juice; sorbets (beverages); whey beverages containing fruit juices; fruit smoothies; smoothies; syrups and other preparations for making beverages; non-alcoholic drinks.</i></p>	<p>Class 32: <i>Fruit juices; Vegetable juices; Fruit smoothies; Vegetable smoothies; Beverages consisting principally of fruit; Beverages consisting principally of vegetable; Beverages containing both fruit and vegetable juice; Beverages containing non-dairy milks; Fruit flavoured beverages; Vegetable flavoured beverages; Energy drinks; Concentrated fruit juice; Concentrated vegetable juice; Cordials; Frozen fruit beverages; Frozen vegetable beverages; Smoothies containing grains and oats; Fruit extracts; Vegetable extracts for use in beverages; Bottled waters; Flavoured water; Flavoured mineral water; Carbonated water; and other non-alcoholic beverages included in this class.</i></p>

<p>Class 35: <i>Advertising; marketing and promotional services; marketing services; office functions; public relations services; product demonstrations and product display services; trade show and exhibition services; loyalty, incentive and bonus program services; provision of advertising space, time and media; distribution of advertising, marketing and promotional material; retail and online retail services relating to the sale of non-alcoholic beverages, dairy-free kefir beverages, beverages containing live and active probiotic cultures, flavoured waters, fruit drinks and juices, mixed fruit juices, mineral and aerated waters.</i></p>	<p>Class 35: <i>Retail services in relation to non-alcoholic beverages; Wholesale services in relation to non-alcoholic beverages; Retail services in relation to preparations for making beverages; Wholesale services in relation to preparations for making beverages; Retail services in relation to foodstuffs; Wholesale services in relation to foodstuffs; Advertising services to promote the sale of beverages; Providing consumer information relating to food or drink products; Loyalty, incentive and bonus program services; Loyalty scheme services; Loyalty card services; Management of customer loyalty, incentive or promotional schemes; Organisation, operation and supervision of customer loyalty schemes.</i></p> <p>Class 43: <i>Cafés; Bars; Juice Bars; Providing drink services; Preparation of food and drinks; Services for the preparation of food and drinks; Serving food and drinks; Preparation of food and drink for immediate consumption.</i></p>
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Class 32

21. The opponent's specification in class 32 includes a list of non-alcoholic beverages specifically identified, followed by the words "and other non-alcoholic beverages included in this class". The words "and other non-alcoholic beverages included in this class" is broad enough to cover all of the applied for non-alcoholic drinks and

beverages in class 32, namely *Dairy-free kefir beverages; beverages containing live and active probiotic cultures; flavoured waters; fruit drinks and juices; mixed fruit juices; mineral and aerated waters; fruit drinks and juices; mixed fruit juices; aerated fruit juices; carbonated and still non-alcoholic drinks; frozen slush drinks; smoothies; fruit squashes; fruit beverages; fruit smoothies; smoothies containing grains and oats; orange juice; grape juice; cranberry juice; mango juice; pomegranate juice; guava juice; melon juice; grapefruit juice; sorbets (beverages); whey beverages containing fruit juices; fruit smoothies; smoothies and non-alcoholic drinks.* **The goods must be considered identical on the principle outlined in *Meric*.**

22. The applicant's specification also includes *syrops and other preparations for making beverages.* The opponent's goods cover *Concentrated fruit juice; Concentrated vegetable juice; Fruit extracts; Vegetable extracts for use in beverages,* all of which are preparations for making beverages and could come in the form of syrups. On that basis the applicant's *syrops and other preparations for making beverages* are encompassed by the opponent's *Concentrated fruit juice; Concentrated vegetable juice; Fruit extracts; Vegetable extracts for use in beverages.* **The goods must be considered identical on the principle outlined in *Meric*.**

Class 35

23. Both specifications include the term *loyalty, incentive and bonus program services.* **The services are self-evidently identical.**

24. The applicant's *retail and online retail services relating to the sale of non-alcoholic beverages, dairy-free kefir beverages, beverages containing live and active probiotic cultures, flavoured waters, fruit drinks and juices, mixed fruit juices, mineral and aerated waters* are encompassed by the opponent's *Retail services in relation to non-alcoholic beverages.* **The services must be considered identical on the principle outlined in *Meric*.**

25. The applicant's *Advertising; marketing and promotional services and marketing services* are broad enough to encompass the opponent's *Advertising services to*

promote the sale of beverages. The services must be considered identical on the principle outlined in Meric.

26. *Provision of advertising space, time and media* is the sale of space or time on media for advertisements. *Distribution of advertising, marketing and promotional material* is the dissemination of advertising material. *Product demonstrations* are promotions where products are demonstrated to potential customers with the aim of introducing customers to the products in hopes of getting them to purchase the items. *Trade show and exhibition services* consist in the organisation of trade shows and exhibitions for commercial and advertising purposes. These services are all types of advertising services which could be provided in the same field as the opponent's *advertising services to promote the sale of beverages*. Consequently, I consider that the applicant's *provision of advertising space, time and media; distribution of advertising, marketing and promotional material; product demonstrations and product display services* and *trade show and exhibition services* encompass (or are encompassed by) the opponent's *Advertising services to promote the sale of beverages (Meric)* and so are identical. If I am wrong in this finding, then the services overlap in uses, user, and purpose, since they are all aimed at providing others with assistance in the sale of their goods and services. Further, the services are likely to be provided by the same advertising agencies, so they share trade channels and are in a complementary relationship of the type where "customers may think that responsibility for the goods lies with the same undertaking". **The services are either identical or similar to a high degree.**

27. There is also a link between the applicant's *public relations services* and the opponent's *advertising services to promote the sale of beverages*. *Public relations services* serve to improve a company's image (by monitoring its current image about the company or its products) and present the company and its products in a favourable light to the public, for example in news releases or press conferences. Consequently, these services are similar to the opponent's *advertising services*, as the services coincide in their nature and purpose as well as their end users. **The services are similar to a medium degree.**

28. *Office functions* are services used in relation to the day to day administrative functions of a business or office, such as finance, personnel and general office tasks. The closest services I can see here are the opponent's *management of customer loyalty, incentive or promotional scheme and organisation, operation and supervision of customer loyalty schemes*. The services can be offered by the same specialised suppliers, they are aimed at the same consumers, namely, business users, and they contribute to the same purpose, namely, the proper running and success of an undertaking. **The services are similar to a low degree.**

The average consumer and the nature of the purchasing act

29. As the case law above indicates, it is necessary for me to determine who the average consumer is for the goods and services at issue. I must then determine the manner in which these goods and services will be selected in the course of trade. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

30. The average consumer of the parties' goods in class 32 is the general public. The goods are non-alcoholic beverages, plus goods used for the preparation of beverages. These are familiar goods and regular purchases. The goods are inexpensive and will be selected visually from the shelves of a shop or its on-line equivalent with an average degree of attention, though I do not discount completely aural considerations in the form, for example, of requests to sale assistants.

31. In relation to the selection of the retail services at issue, the average consumer will also be a member of the general public. The services will be encountered on the high street or online, suggesting a process of visual selection, although the aural impact will not be ignored completely. The services will be selected with an average degree of attention, not materially higher or lower than the norm.

32. Finally, the parties' advertising, marketing and promotional services, public relation services, office functions and loyalty, incentive and bonus program services, are largely aimed at business users and are likely to be purchased fairly infrequently. In respect of all of the services, the consumer will take various factors into consideration such as cost, suitability for their specific requirements and reputation. The level of attention paid during the purchasing process will, therefore, be highly than the norm (but not of the highest level). The services will often be considered via perusal of brochures, websites or advertisement, which suggests that the visual impacts of the marks are important. However, the aural impacts are also important because this is a field in which word of-mouth recommendations may also play a part, so I do not discount that there will be an aural component to the selection of the services.

Distinctive character of earlier mark

33. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*²⁶, 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).”

34. The opponent’s pleaded case made no mention of a claim to enhanced distinctive character. Moreover, the opponent’s own evidence made it clear that the evidence filed was intended to deal with a requirement for proof of use of the Third Earlier Mark. I shall return to this evidence later, but for now, it suffices to say that although information has been provided in relation to the opponent’s UK turnover, which is not insignificant, the evidence provides no indication of the market share this represents. Further, there is no supporting evidence from the trade going to the reputation of the mark and the advertising figures for the three years period 2016-2018 are not particularly high. Consequently, whilst the opponent may have a real and substantial presence in the UK market place, the evidence filed does not support a finding that any of the marks relied upon in these proceedings enjoys a reputation or public recognition that warrants an enhanced penumbra of protection or a higher distinctive character. Even if I am wrong, the evidence that has been supplied relates only to the Third Earlier Mark and even if the word BOOST (stylised) is a common feature of the opponent’s cited marks, the opponent has not claimed that that element has achieved enhanced distinctiveness in the eyes of the public because, for example, it is common to a “family of marks”.

35. Before approaching the assessment of the distinctive character of the earlier mark, I remind myself that the key is the distinctiveness of the common element. In *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, Mr Iain Purvis Q.C. as the Appointed Person pointed out that the level of ‘distinctive character’ is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar. He said:

“38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that ‘the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion’. This is indeed what was said in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically.

39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything, it will reduce it.”

36. In other words, simply considering the level of distinctive character possessed by the earlier mark is not enough. It is important to ask, ‘in what does the distinctive character of the earlier mark lie?’ Only after that has been done can a proper assessment of the likelihood of confusion be carried out.

37. The applicant has not commented on the distinctiveness of the earlier marks or of the word BOOST *per se*. The opponent claims that its earlier marks have a high degree of distinctive character because they do not describe or even allude to the goods and/or the services for which they are registered.

38. The Second Earlier Mark contains the words “BOOST” and “Turbo” and is stylised. Dictionary definitions of these words includes:

Boost

verb [with *object*]

1. help or encourage (something) to increase or improve: *a range of measures to boost tourism.*

noun

2. a source of help or encouragement leading to increase or improvement: *the cut in interest rates will give a further boost to the economy.*

an increase or improvement: *a boost in exports.*

Turbo

adjective

1. used to describe an engine or machine in which power is produced by a turbine:

It was a very efficient turbo diesel engine.

The company owns a fleet of 10 turbo jets.

They used turbo heaters on the building site.

2. informal very big, powerful, etc.:

He's gone out to a turbo lunch.

I call them turbo beauty products because they transform the surface of your skin.

39. Both the word 'BOOST' and the word 'Turbo' are English words. I consider that the word 'BOOST' is a familiar word and that its meaning will be well-known to the average consumer. As regards the way the word 'Turbo' will be perceived, I consider that (1) given its size and positioning, it is likely to be perceived as being subordinate to the word 'BOOST' and (2) although the term is usually associated with the concept of high power and speed in the field of engines and motors, the average consumer is likely to understand its symbolic association with the concept of something that is exceptionally strong and powerful.


40. The most that can be said is, in my view, that when applied to non-alcoholic drinks and beverages, the word 'BOOST' may be seen, at least to some degree, as allusive of an effect that can be gained from the consumption of some of the goods, i.e. drinks and beverages that give a boost to the drinker. However, the word 'BOOST' is not directly descriptive of the goods or of their qualities because it is not followed by a description of what the boosting property relates to or (so to speak) what is boosted. In my view, whilst the Second Earlier Mark may not be a mark of the highest distinctive character for non-alcoholic beverages, it is nonetheless distinctive to a medium degree. The stylisation of the words and the colour add some distinctiveness to the mark; however, this does not assist the opponent because the applied for mark is a word mark.

Comparison of marks

41. 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 them, 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.”

42. It would be wrong therefore artificially to dissect the marks, although it is necessary to take into account their distinctive and dominant components and to give due weight to any other features which are not negligible and therefore contribute to the overall impression created by the marks. The marks to be compared are:

Application	Second Earlier mark
BOOST ON THE GO	

Overall impression

43. The applied for mark is a word mark. It consists of four words, the word ‘BOOST’, the word ‘ON’, the word ‘THE’ and the word ‘GO’ written in standard upper-case letters. The mark does not contain any element that is, by itself, likely to dominate clearly the overall impression produced by the mark. The words ‘ON THE GO’ form a phrase or

unit having a different meaning to the separate words of which it is composed, and which has a meaning of:

On the go:

1. very busy

I've been on the go all day, and I'm really tired.

2. [UK] in the process of being produced:

Did you know that she's got a new book on the go (= being written)?

44. The phrase is also used to refer to goods that are to be drunk or consumed “on the go” (i.e. while moving, for example, travelling or walking). The element ‘ON THE GO’ will be regarded as qualifying the first element ‘BOOST’ which will be perceived independently in the expression ‘BOOST ON THE GO’. The mark as a whole is likely to be understood as referring to the concept of a ‘boost’ that is gained ‘on the go’. When considered in the context of the goods and services in question, I find that (1) for several of the goods and services in the application, namely the various non-alcoholic drinks and beverages (in class 32) and the retail services relating to the sale of non-alcoholic beverages (in class 35), the combination of the word ‘BOOST’ with the qualifying expression ‘ON THE GO’ is likely to be perceived by the average consumer as allusive of the ‘boost-effect’ gained from the consumption of the goods ‘on the go’; (2) however, when faced with the mark ‘BOOST ON THE GO’ in relation to the other services, which are in the nature of advertising, marketing and promotional services or office functions, the average consumer is unlikely to contextualise the meaning of the mark and will perceive its semantic content as having no relevance for the services at issue.

45. The Second Earlier mark consists of the word ‘BOOST’ written in capital letters, in a bold thick stylised typeface. The letter ‘B’, ‘S’ and ‘T’ are in orange with a red border and the letters ‘OO’ are in yellow with a green border. The mark also contains the word ‘Turbo’ positioned underneath the letters ‘ST’ and written in a slightly stylised typeface, in green. This element will be seen by the average consumer as subordinate to the word ‘BOOST’, which, by virtue of its significantly larger size is the dominant element as it is the most eye-catching within the sign. The colour and stylisation of the letters are likely to be seen as decorative and will play a lesser role in the overall impression

of the mark. In terms of how the mark is likely to be seen, the applicant has suggested that 'BOOST Turbo' means "to improve fast", however, it is more likely in my view that the combination will convey no particular meaning and will simply be seen as the bringing together of two elements with 'BOOST' as a visually prominent and distinct element. The different size, colour and positioning of the words 'BOOST' and 'Turbo' seems to me to reinforce the impression that the mark is made up of independent elements that have been brought together but which do not particularly 'hang together' in the sense of creating a new idea that overrides the meaning of the component words.

Visual similarity

46. Visually, the signs coincide in the word 'BOOST'. The signs differ (1) in the remaining words 'ON THE GO' of the applied for mark; (2) in the word 'Turbo' as well as in the stylisation and the colours of the earlier sign. The marks are visually similar to a medium degree.

Aural similarity

47. The pronunciation of the marks coincides in the sound of the letters 'BOOST', present identically in both marks. The pronunciation differs in the sound of the words 'ON THE GO' of the applied for mark. The differing component 'Turbo' is not likely to be pronounced given its diminutive size within the sign. The marks are aurally similar to a medium to high degree.

Conceptual similarity

48. Conceptually, the identical word 'BOOST' has the same meaning in both marks. The word 'BOOST' is complemented in both marks by a qualifying expression, namely 'ON THE GO' (in the application) and 'Turbo' (in the Second Earlier Mark), which introduces a different concept, however, this does not detract from the fact that the word 'BOOST' will be perceived independently in both marks. For the reasons outlined above at paragraphs 43-45, I reject the applicant's submission that the marks are conceptually dissimilar because the words 'BOOST' and 'Turbo' in the opponent's

mark convey the meaning of “to improve fast” whilst the applied for ‘BOOST ON THE GO’ mark has the meaning of “TO INCREASE IN THE PROCESS OF DOING SOMETHING ELSE”. In my view, the marks are conceptually similar to a medium degree.

Likelihood of confusion

49. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. I must also keep in mind the average consumer for the goods and services, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has retained in his mind.

50. There are two types of relevant confusion to consider: direct confusion (where one mark is mistaken for the other) and indirect confusion (where the respective similarities lead the consumer to believe that the respective goods and services come from the same or a related trade source). This distinction was summed up by Mr Iain Purvis Q.C. sitting as the Appointed Person in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10:

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

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

51. Earlier in my decision, I found that the similarity of the competing goods and services ranges from identical to similar to a low, medium and high degree. The goods and services at issue will be selected visually, although I do not completely discount aural considerations. The average consumer will pay a degree of attention varying from average to above average (but not of the highest level). The marks coincide in the word element ‘BOOST’ and are visually similar to a medium degree, aurally similar to a medium to high degree and conceptually similar to a medium degree. The word ‘BOOST’ is the dominant element within the Second Earlier Mark; it is not descriptive of any of the earlier goods and services and is possessed of a medium degree of distinctiveness. This is even in relation to the goods for which the word ‘BOOST’ can be said to be somehow allusive of an effect gained from the consumption of the goods themselves. Whilst the mark also contains other non-negligible elements, namely the differing stylisation (and colour) and the element ‘Turbo’, the stylisation is not particularly elaborated, and it is important to note the comparatively small size of the word ‘Turbo’ against the word ‘BOOST’. It is therefore the word ‘BOOST’ that will be the part of the sign by which the consumer will primarily identify the goods and services covered by the opponent’s mark. As regards the applied for mark inasmuch as the average consumer will perceive the meaning of the text ‘BOOST ON THE GO’ as a complete phrase, the word ‘BOOST’ will be perceived independently within that phrase and the unit ‘ON THE GO’ will be seen by the relevant public merely to qualify it. In light of all of the above, I find that whilst it is unlikely that the average consumer will mistake the applied for mark for the earlier mark, taking into account the independent and distinctive role that the word ‘BOOST’ retains in both marks it is reasonable to assume that the consumers would believe that the identical and similar goods in question (even those similar to a low degree) come from the same undertaking or, as the case may be, from economically-linked undertakings. **There is a likelihood of indirect confusion.**

CONCLUSION

52. As a consequence of the above conclusions, the opposition based on the Second Earlier Mark succeeds in relation to all of the goods and services and, subject to any successful appeal, the application will be refused.

The other earlier marks

53. There are two other marks to consider. Although I express my views very briefly, the ground under Section 5(2)(b) would succeed for both but only in relation to some of the applied for goods and services. In terms of marks, the differentiating element of the mark I have based my findings on thus far, i.e. the Second Earlier Mark, contained a degree of stylisation and the word 'Turbo', but the other marks are even closer to the applied for mark. This is because (1) the other earlier marks consist of the word 'BOOST' stylised in an identical or very similar manner to that of the Second Earlier Mark without any other element or with elements, i.e. the words Juice Bars, which are merely descriptive (in relation to the goods and services for which the mark has been used) and play very little role in the overall impression the marks convey.

54. I should add for the sake of completeness, that if the opponent had had to rely on these marks, I would have accepted that genuine use had been made of the Third Earlier Mark at least in relation to juices and smoothies (in class 32) and health and juice bar services (in class 43). On that basis, I would have found that:

- a) As regards the opposed services in the applicant's class 35 specification, I would have found that the class 43 services of the opponent's First and Second Earlier Marks were (i) similar to a low degree to the applied for retail services relating to the sale of non-alcoholic beverages insofar the opponent's services could engage in the retail of the same goods and (ii) plainly dissimilar to the remaining services of the applied for specification including office functions and the various advertising and marketing services;

b) As regards the opposed goods in the applicant's class 32 specification, I would have found that they were (i) identical to the class 32 specification of the opponent's Second Earlier Mark and (ii) similar to a low degree to the class 43 specification of the opponent's First Earlier Mark to the extent that the opponent's services could be connected with the provision of the applied for goods.

55. Accordingly, on the basis of the other earlier marks the opposition would have partially succeeded to the same extent, namely against (1) the applied for class 32 specification; (b) the applied for retail services of the Class 35 specification.

OVERALL CONCLUSION

56. The opposition is successful against all of the applied for goods and services on the basis of the Second Earlier Mark.

COSTS

57. The opponent has been successful and is entitled to an award of costs. Awards of costs are governed by Tribunal Practice Notice ("TPN") 2/2016. I award costs to the opponent on the following basis:

Official fee:	£100
Preparing the notice of opposition and considering the counterstatement:	£200
Preparing evidence and written submissions:	£500
Written submissions	
Total:	£800

58. I order Purearth Life Limited to pay Boost Juice Holdings Pty Ltd. the sum of £800. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

15 July 2019

Teresa Perks

For the Registrar

The Comptroller – General