

O/441/21

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION
NO. 3336750 BY
PRESSED JUICERY, LLC
TO REGISTER:**

PRESSED JUICERY

AS A TRADE MARK IN CLASSES 32 & 35

AND

**OPPOSITION THERETO
UNDER NO. 415417
BY
HOUSE OF NAT B.V.**

Background & Pleadings

1. Pressed Juicery, LLC (“the applicant”), applied to register the trade mark shown on the front page of this decision in the United Kingdom on 7 September 2018. It was accepted and published in the Trade Marks Journal on 9 November 2018 in respect of the following goods and services:

Class 32: Mineral and aerated waters and other non-alcoholic beverages; water and flavoured water; fruit beverages and fruit juices; syrups and other preparations for making beverages; vegetable juice drinks; frozen juices; non-alcoholic beverages flavoured with coffee.

Class 35: Retail store services and online retail store services relating to mineral and aerated waters and other non-alcoholic beverages, water and flavoured water, fruit beverages and fruit juices, syrups and other preparations for making beverages, vegetable juice drinks, non-alcoholic beverages flavoured with coffee, frozen juices, and herbal supplements.

2. House of Nat B.V. (“the opponent”) opposes the application on the basis of Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent is the proprietor of the EUTM registration number 015220271¹ for the following word mark:

THE COLD PRESSED JUICERY

3. The mark was filed on 15 March 2016 and registered on 01 August 2016 for the following goods and services in Classes 30, 32, and 35:

¹ Although the UK has left the EU and the EUTMs relied upon by the opponent now enjoy protection in the UK as comparable trade marks, the EUTMs remain the relevant rights in these proceedings. That is because the opposition was filed before the end of the Transition Period and, under the transitional provisions of the Trade Marks (Amendment etc.) (EU Exit) Regulations 2019, I am obliged to decide the opposition on the basis of the law as it existed before the end of the Transition Period.

Class 30: Coffee, tea, cocoa and artificial coffee; Rice, tapioca, sago; Flour and preparations made from cereals, bread, pastry and confectionery, edible ices; Sugar; Honey, treacle; Yeast, baking-powder; Salt, mustard; Vinegar, sauces (condiments); Fruit sauces; Spices; Ice; Farinaceous foods; Bread; Bread rolls; Sandwiches; Sandwiches; Wrap [sandwich]; Pasta; Puddings; Honey; Syrups and treacles; Yeast; Food leavening agents; Pasta, pasta-based meals; Cereal preparations and products; Muesli; Cereal bars; Nutritional bars, included in this class.

Class 32: Beers; Mineral and aerated waters and other non-alcoholic beverages; Fruit beverages and fruit juices; Smoothies; Vegetable drinks and vegetable juices; Syrups and other preparations for making beverages; Sherbets [beverages].

Class 35: Advertising; Business management; Business administration; Office functions; Advertising and advertising agency services; Publicity and merchandising; Arranging and conducting events for commercial purposes; Business organisation and management consultancy; Professional management of restaurants and catering establishments, including in connection with franchising; Public relations services; Import and export services; Business mediation in the wholesaling of foodstuffs, beverages, nuts, seeds and food supplements; Promotion in the field of foodstuffs, beverages, nuts, seeds and food supplements, including business consultancy relating to the selection and combination of foodstuffs, beverages, nuts, seeds and food supplements; Business mediation in the purchase, sale, import and export of foodstuffs, beverages, nuts, seeds and food supplements; Business mediation of retailing in relation to foodstuffs, beverages, nuts, seeds and food supplements; Shop window dressing; Promoting goods and services of others by placing advertisements and promotional displays on an electronic site accessible via a computer network; Compilation of information into computer databases; Retailing and wholesaling in the field of foodstuffs, beverages, nuts, seeds and food supplements; Promotion

of retail with the aid of loyalty cards and incentive schemes, focussing in particular on foodstuffs, beverages, nuts, seeds and food supplements; Organisation of trade fairs for commercial or advertising purposes; Information and consultancy relating to the aforesaid services; All the aforesaid services whether or not provided via electronic channels, including the Internet.

4. Under Section 6(1) of the Act, the opponent's trade mark clearly qualifies as an earlier trade mark. Further, as the registration of the opponent's earlier mark was completed less than five years before the application date of the contested mark, proof of use is not relevant in these proceedings as per Section 6A of the Act.
5. The opponent, in its notice of opposition, claims that the goods and services listed in the applicant's specification are identical and similar to the opponent's goods and services. Also, the opponent contends that the respective marks share the identical word elements PRESSED JUICERY, which are the dominant and distinctive parts of the earlier mark. Further, it states that "the additional THE COLD word elements in the Earlier Trade Mark do not serve to enable the Later Trade Mark to be distinguished from the Earlier Trade Mark." Therefore, registration of the contested mark should be refused under Section 5(2)(b) of the Act.
6. The applicant filed a defence and counterstatement, denying the opponent's claims as to the likelihood of confusion while claiming bad faith registration of the earlier mark. The applicant contends that "it is the creator and first user of the mark PRESSED JUICERY, that it owns the earlier rights in the name not only in the US where the applicant is based and first launched a product under this brand, but in the UK and elsewhere too." Further, the applicant states that "the goods in Class 32 are identical [...] [and] the services "Retailing and wholesaling in the field of beverages" in Class 35 of the earlier registration are identical with [...] the challenged application" putting "the opponent to proof of the remaining claims of identity or similarity between the remaining goods and services."

7. I note that the applicant of these proceedings brought an invalidation action at the EUIPO against the opponent's earlier EUTM 015220271 on the basis of bad faith under Article 59(1)(b) EUTM. On 17 November 2020, the Cancellation Division issued the Cancellation No C 36740 decision, rejecting the invalidity application in its entirety. During the EUIPO proceedings concerning the opponent's earlier mark, the UK opposition proceedings were stayed by the UK IPO. Now that the EUIPO proceedings have been resolved, the UK opposition proceedings may now continue to determination on the basis that the earlier mark is a validly registered mark, which may consequently be relied upon by the opponent.
8. Neither side filed evidence, written submissions, nor requested a hearing. Thus, this decision has been taken following a careful consideration of the papers.
9. In these proceedings, the opponent is represented by Wilson Gunn and the applicant by HGF Limited.
10. 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 Trade Marks 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.

Decision

Section 5(2)(b)

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

“A trade mark shall not be registered if because-

[...]

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

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

12. The principles, considered in this opposition, stem from the decisions of the European 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 BV* (Case C-342/97), *Marca Mode CV v Adidas AG & Adidas Benelux BV* (Case C-425/98), *Matratzen Concord GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (Case C-3/03), *Medion AG v Thomson Multimedia Sales Germany & Austria GmbH* (Case C-120/04), *Shaker di L. Laudato & C. Sas v OHIM* (Case C-334/05 P) and *Bimbo SA v OHIM* (Case C-519/12 P):

- 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 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 Goods & Services

13. The General Court confirmed in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, paragraph 29, that, even if goods

or services are not worded identically, they can still be considered identical if one term falls within the scope of another, or vice versa:

“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”.

14. The applicant’s goods in Classes 32 and 35 are as follows:

Class 32: Mineral and aerated waters and other non-alcoholic beverages; water and flavoured water; fruit beverages and fruit juices; syrups and other preparations for making beverages; vegetable juice drinks; frozen juices; non-alcoholic beverages flavoured with coffee.

Class 35: Retail store services and online retail store services relating to mineral and aerated waters and other non-alcoholic beverages, water and flavoured water, fruit beverages and fruit juices, syrups and other preparations for making beverages, vegetable juice drinks, non-alcoholic beverages flavoured with coffee, frozen juices, and herbal supplements.

15. The opponent’s specification is voluminous in nature. Thus, I do not intend to repeat it all here, but I note that it includes “*mineral and aerated waters and other non-alcoholic beverages; fruit beverages and fruit juices; syrups and other preparations for making beverages*” and “*retailing and wholesaling in the field of foodstuffs, beverages, nuts, seeds and food supplements; All the aforesaid services whether or not provided via electronic channels, including the Internet.*”

16. In the notice of opposition, the opponent provides a more detailed comparison of the goods:

“The class 32 goods of the Application are identical to the class 32 goods of the Registration, with both the Application and the Registration covering the broad term *mineral and aerated waters and other non-alcoholic beverages*.

The class 35 services of the Application are identical to the class 35 services of the Registration, because the retail store services and on-line retail store services of the Application fall within the term *retailing and wholesaling in the field of beverages* under the Registration.

For the sake of completeness, the class 32 goods of the Application are similar to the class 30 goods of the Registration as non-alcoholic beverages are similar to coffee, tea, cocoa and artificial coffee (if not identical) as well as the foodstuffs under the class 30 specification of the Registration.”

17. In response, the applicant, in its counterstatement, admits identity and similarity between the respective goods and services, stating:

“10. The applicant admits that the goods protected by earlier EUTM registration No. in Class 32 are identical with the goods in Class 32 of the challenge application.

11. The applicant admits that the services “Retailing and wholesaling in the field of beverages” in Class 35 of the earlier registration are identical with the services in Class 35 of the challenged application.”

18. Given the applicant’s admission, strictly speaking, there is nothing for me to decide. However, I should highlight that the contested goods and services clearly fall within the ambit of the broad terms covered by the opponent’s mark (as highlighted above), and, thus, I agree that they are identical as per *Meric*.

Average Consumer and the Purchasing Act

19. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purposes of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods and services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97. In *Hearst Holdings & Anor v A.V.E.L.A. Inc & Ors*, [2014] EWHC 439 (Ch), at paragraph 70, Birss J described the average consumer in these terms:

“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.”

20. The average consumer for the respective goods and retail services will be the general public at large. All goods and services may be sold through a range of channels. They may be purchased in retail premises, such as supermarkets and off-licence stores, online or by mail order. Also, the service provider will be on the high street with the marks encountered through signage, advertisements, posters or use on websites. In retail premises, the goods at issue will be displayed on shelves, where they will be viewed and self-selected by the consumers. Similarly, for the online stores, the consumers will select the goods relying on the images displayed on the relevant web pages. They may also be sold through bars, clubs, restaurants and public houses, where the goods are displayed on, for example, shelves behind the bar, and may be requested orally from a member of staff. In this regard, I bear in mind the Case T-3/04, *Simonds Farsons Cisk Plc v OHIM*, where the Court of First Instance (now the General Court) stated that:

“[...] as OHIM quite rightly observes, it must be noted that, even if bars and restaurants are not negligible distribution channels for the applicant’s goods, the bottles are generally displayed on shelves behind the counter in such a way that consumers are also able to inspect them visually. That is why, even if it is possible that the goods in question may also be sold by ordering them orally, that method cannot be regarded as their usual marketing channel. In addition, even though consumers can order a beverage without having examined those shelves in advance they are, in any event, in a position to make a visual inspection of the bottle which is served to them.”

21. Consequently, even if these goods can be ordered orally in the premises exemplified above, a visual inspection of the bottles containing the goods is most likely to occur. Although these goods are relatively inexpensive, the average consumer may examine the product to ensure that they select the correct type and flavour of the beverage. Therefore, the selection process is predominantly a visual one. Very similar considerations also exist in respect of Class 35 retail services. Taking into account all the factors, the average consumer is likely to pay a reasonable (but not high) level of attention to selecting the goods and services at issue.

Comparison of Trade Marks

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

“[...] it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration

is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

23. 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.

24. The marks to be compared are:

THE COLD PRESSED JUICERY

v

PRESSED JUICERY

Overall Impression

25. Both the contested mark and the earlier mark consist of the words “THE COLD PRESSED JUICERY” and “PRESSED JUICERY”, respectively, presented in capital letters, and a standard font. Registration of a word mark protects the word itself presented in any regular font and irrespective of capitalisation.² The overall impression of the respective marks lies in the words themselves. Nevertheless, I acknowledge that the average consumer may attribute less significance to the definite article “THE” within the overall impression of the mark.

Visual Comparison

26. The competing marks share the common words “PRESSED JUICERY”. The only visual point of difference is the presence of the additional words

² See *Bentley Motors Limited v Bentley 1962 Limited*, BL O/158/17, paragraph 16.

“THE COLD” in the earlier mark. I also note that this diverging element appears at the beginning of the earlier mark, a position which is generally considered to have more impact due to consumers in the UK reading from left to right.³ Taking into account the overall impression of the marks and the similarities and differences, I consider there to be a medium to high degree of visual similarity between the marks.

Aural Comparison

27. The earlier mark consists of four words, from which the first three are single-syllable words and the last a three-syllable one. The average consumer will articulate them as “THUH KOLD PREST JOO-SE-RY”. The contested mark consists of the last two verbal elements of the earlier mark, which will be pronounced similarly to the earlier mark, namely “PREST JOO-SE-RY”. Therefore, the marks will be aurally similar to a medium to high degree.

Conceptual Comparison

28. The words “PRESSED JUICERY” convey the same concept in both marks, namely a manufacturing or producing facility of pressed juices. The only difference is that the words “THE COLD”, appearing in the opponent’s mark, suggest that the juices are pressed cold in some way. Notwithstanding the difference highlighted, there is still a high degree of conceptual similarity.

Distinctive Character of the Earlier Trade Mark

29. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97, paragraph 22 and 23, the CJEU stated that:

“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

³ See *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02.

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).

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).”

30. Registered trade marks possess varying degrees of inherent distinctive character from the very low, because they are suggestive of, or allude to, a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities.
31. In the absence of evidence of use, I have only the inherent distinctiveness of the opponent’s mark to consider. As outlined in the previous section, the earlier word mark suggests some form of manufacturing or producing facility (a juicery) of pressed juices. There is no evidence to show whether “juicery” is a known and used term in the field. However, notwithstanding this, the mark is still clearly allusive/suggestive in relation to the goods and services offered by the opponent. Thus, I consider it to be inherently distinctive to a low degree.

Likelihood of Confusion

32. In assessing the likelihood of confusion, I must adopt the global approach set out in the case law to which I have already referred above in this decision. Such a global assessment is not a mechanical exercise. I must also have regard to the interdependency principle, that 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.⁴ It is essential to keep in mind the distinctive character of the opponent's trade mark since the more distinctive the trade mark, the greater the likelihood of confusion. I must also keep in mind that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon imperfect recollection.⁵
33. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other. Indirect confusion is where the consumer notices the differences between the marks but concludes that the later mark is another brand of the owner of the earlier mark or a related undertaking. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Iain Purvis Q.C., sitting as the Appointed Person, explained that:

“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

⁴ See *Canon Kabushiki Kaisha*, paragraph 17.

⁵ See *Lloyd Schuhfabrik Meyer*, paragraph 27.

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.”

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(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).”

34. I note that the categories identified above by Mr Purvis Q.C. are not exhaustive.⁶

35. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, James Mellor Q.C., sitting as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association not indirect confusion.

36. Earlier in this decision, I have concluded that:

⁶ *Thomson Hotels LLC v TUI Travel Amber E&W LLP* BL- O-440/14 at paragraph 29.

- the goods/services at issue are identical;
- the average consumer of the parties' goods and services is a member of the general public, who will select the goods and services by predominantly visual means, but without dismissing the aural means, and will likely pay a reasonable (but not high) degree of attention to the selection of such goods and services;
- the competing marks are visually and aurally similar to a medium to high degree, and conceptually similar to a high degree; and
- the earlier mark has a low degree of distinctive character.

37. Taking into account the above, including the doctrine of imperfect recollection and the high conceptual similarity between the marks, I am satisfied that there is a likelihood of direct confusion. The differences, based on the additional words "THE COLD" in the earlier mark, are not sufficient to allow the average consumer to distinguish between the respective marks. Although I have found earlier in this decision that the inherent distinctiveness of the earlier mark is of a low degree, this does not prevent a likelihood of confusion.⁷ I note that the similarities coupled with the identity of the goods and services between the marks are such that they will be mistakenly recalled as each other, even though a reasonable degree of attention will be paid during the purchasing process. I, therefore, consider there to be a likelihood of direct confusion.

38. Even if the differences between the marks are identified by the average consumer, bearing in mind the similarities between the marks and that the opponent's mark has a low degree of inherent distinctive character, I consider that the marks will be seen as variants used by the same or economically linked undertakings. Thus, I consider that there will be a likelihood of indirect confusion.

⁷ See *L'Oréal SA v OHIM*, Case C-235/05 P.

Outcome

39. The opposition under Section 5(2)(b) of the Act is successful in its entirety. Therefore, subject to appeal, the application will be refused.

Costs

40. The opponent has been successful and is entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 2/2016. In the circumstances, I award the opponent the sum of £350 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

£100	Official opposition fee
£250	Filing a notice of opposition and considering the counterstatement
£350	Total

41. I, therefore, order Pressed Juicery, LLC to pay House of Nat B.V. the sum of £350. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 14th day of June 2021

Dr Stylianos Alexandridis
For the Registrar,
The Comptroller General