

TRADE MARKS ACT, 1996

Decision in Hearing

IN THE MATTER OF an application for registration of Trade Mark No. 221880 and in the matter of an Opposition thereto.

SUNSHINE JUICE LIMITED

Applicant

KIELY'S (WESTERN DISTRIBUTORS) LIMITED

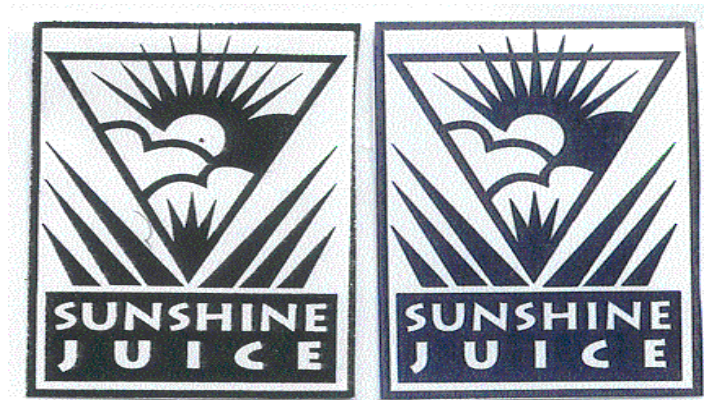
Opponent

The application

1. On 15 June, 2000, Sunshine Juice Limited, of Park House, Carlow, Co. Carlow, made application (No. 2000/02210) under Section 37 of the Trade Marks Act, 1996 ("the Act") to register the marks shown below as a series of trade marks in respect of the following specification of goods in Class 32:

Fruit drinks and fruit juices; mineral and aerated waters and other non alcoholic drinks; vegetable juices for use as beverages; syrups and other preparations for making beverages.





2. The application was accepted for registration and advertised accordingly under No. 221880 in Journal No. 1938 on 20 March, 2002. The advertisement carried a noting to the effect that the first mark in the series would be in the colours orange and yellow on white, the second mark would be in green and yellow on white, the third mark would be in pink/red and yellow on white, the fourth mark would be in black on white and the fifth mark would be in navy blue on white.
3. Notice of Opposition to the registration of the series of marks was filed pursuant to Section 43 of the Act on 17 June, 2002 by Kiely's (Western Distributors) Limited, an Irish company, of Henry Street, Tipperary. The Applicant filed a counter-statement on 25 September, 2002 and evidence was, in due course, filed by the parties under Rules 20, 21 and 22 of the Trade Marks Rules, 1996 ("the Rules").
4. The matter became the subject of a Hearing before me, acting for the Controller, on 26 June, 2006. The parties were notified on 6 July, 2006 that I had decided to uphold the opposition and to refuse registration of the series of marks. I now state the grounds of my decision and the materials used in arriving thereat.

Notice of Opposition

5. In its Notice of Opposition the Opponent refers to its proprietorship of Trade Mark Registration No. 100365, SUNSHINE, which is registered as of 9 July, 1980 in Class 32 in respect of "*non-alcoholic beverages, preparations for making such beverages all included in Class 32, mineral waters, fruit juices, vegetable juices for use as beverages*". It claims to have used that mark for many years in

connection with the goods of the registration and then raises objection to the present application under Sections 6, 8, 10 and 37 of the Act, asserting specifically that,

- *the mark is identical with Opponent's mark and the goods are identical with those for which Opponent's mark is protected,*
- *there is a likelihood of confusion on the part of the public,*
- *the use of the mark would take unfair advantage of, or be detrimental to, the distinctive character or reputation of the Opponent's mark,*
- *the mark is not capable of distinguishing the goods,*
- *the mark is devoid of any distinctive character,*
- *the mark consists exclusively of descriptive designations,*
- *the use of the mark is prohibited by enactment or rule of law including any rule of law protecting an unregistered mark,*
- *the application for registration was made in bad faith,*
- *the mark is not used or proposed to be used in relation to the goods of the application.*

Counter-Statement

6. In its Counter-Statement the Applicant denies all of the grounds of opposition and admits only the Opponent's proprietorship of Trade Mark Registration No. 1000365.

The evidence

Rule 20

7. Evidence submitted by the Opponent under Rule 20 consisted of a Statutory Declaration dated 9 December, 2002, of Noreen O'Kelly, Company Secretary of C&C Ireland Limited. She says that her company and the Opponent are part of the C&C Group of companies and that, by virtue of a Deed of Assignment dated 16 October, 2002, her company has acquired ownership of Trade Mark Registration No. 100635, SUNSHINE in Class 32. She then goes on to offer her opinion on the likelihood of confusion between that mark and the mark propounded for registration, which is, of course, a question for me to decide unaided by this deponent's opinion on the matter.

Rule 21

8. Evidence submitted by the Applicant under Rule 21 consisted of a Statutory Declaration dated 4 April, 2003 of Paul Walsh, Director of Sunshine Juice Limited, the Applicant. In addition to offering his opinion on the likelihood of confusion between the marks, he says that his company produces freshly squeezed juices and “smoothies” containing no artificial colours, additives or preservatives and having a refrigerated shelf life of approximately two weeks. None of the Applicant’s products are made from concentrated fruit juices and the Applicant is unaware of any freshly squeezed juice product produced by the Opponent bearing the name “sunshine” or of any product bearing the name “sunshine juice” being supplied to the businesses that the Applicant supplies in this country.

Rule 22

9. Evidence submitted by the Opponent under Rule 22 consisted of a further Statutory Declaration, dated 16 June, 2003, of Noreen O’Kelly, which does not contain any averments of fact that I regard as relevant to the matters at issue between the parties.

The hearing, issues for decision and arguments of the parties

10. At the hearing the Opponent was represented by Ms. Brenda O’Regan, Trade Mark Agent, of F.R. Kelly & Co. and the Applicant by Mr. Garrett Cunnane, BL instructed by Frank Mulvey, Solicitors. Ms. O’Regan stated at the outset that she intended to argue the case for the Opponent only on the basis of Section 10(1), Section 10(2) and Section 8(3)(b) of the Act and, in the absence of any evidence or argument in support of any other grounds of opposition, I am satisfied that it is sufficient for me to consider only those grounds and that the other grounds mentioned in the Notice of Opposition may be simply dismissed as unsubstantiated.
11. Ms. O’Regan argued that the mark propounded for registration by the Applicant should be regarded as identical with the Opponent’s earlier trade mark, SUNSHINE, on the basis that it reproduces that mark in its entirety and that the additional matter appearing in it, namely the word JUICE and the device element,

are likely to go unnoticed by the average consumer. The word JUICE is entirely descriptive of the relevant goods and will be seen simply as a designation of the nature of the goods by the average consumer while the device element is merely a pictorial representation of sunshine and does not, therefore, imbue the mark with any conceptual significance or identity other than that which is conveyed by the use of the word SUNSHINE. If anything, the device element in the mark will be seen by the average consumer as mere decoration. Given that the respective goods are also identical, Ms. O'Regan argued that the application fell within the scope of Section 10(1) of the Act and that refusal was mandatory.

12. In the alternative, Ms. O'Regan asserted that the Applicant's mark is highly similar to the Opponent's earlier trade mark and that the respective goods are identical such that there is a likelihood of confusion on the part of the public and the application should be refused under Section 10(2) of the Act. She argued that such a likelihood was particularly apparent in the case of sales of beverages in bars and restaurants in which goods are ordered by name and without reference to any device elements that may appear in their respective trade marks. In such a scenario, the goods of both the Applicant and the Opponent would be referred to simply as SUNSHINE and confusion would be inevitable. Even in the case of sales through retail outlets such as supermarkets, confusion would be likely as the primary identifier of each of the respective marks is the word SUNSHINE and the additional elements contained in the Applicant's mark would not have the effect of informing consumers that it identifies a different product to that of the Opponent.

13. Finally, in relation to Section 8(3)(b) of the Act, Ms. O'Regan stated that the specification of goods covered by the present application includes goods other than fruit juices and that the inclusion of the word JUICE in the mark put forward for registration renders it deceptive insofar as those goods are concerned.

14. In reply, Mr. Cunnane asserted that the criterion of identity of marks within the meaning of Section 10(1) of the Act must be interpreted strictly and that the significant figurative element contained in the Applicant's mark cannot be overlooked or ignored when the comparison is made with the Opponent's earlier

trade mark. The two marks are not, therefore, identical and the prohibition on registration contained in Section 10(1) cannot apply.

15. As regards Section 10(2), Mr. Cunnane accepted that there is some similarity between the respective marks but asserted that there is no appreciable likelihood of confusion in practice between them because of the different trading operations of the Applicant and the Opponent. In this regard, he referred to the Applicant's evidence as to the nature of the products that it sells, namely freshly squeezed juices and smoothies, and he stated that the majority of the Applicant's sales are to juice bars, the proprietors of which, being persons in the trade, are aware of the different products on offer and are not likely to be confused as to the origin of the relevant goods or to believe that they emanate from the Opponent in circumstances where the Opponent does not appear to have any trade in such goods. Mr. Cunnane remarked that the likelihood of confusion must be appreciated globally, taking all relevant factors into account, and asserted that the particular circumstances of the respective trades carried on by the Applicant and the Opponent in this case operate to negate any likelihood of confusion between the respective marks arising from the similarity between them. He also pointed out that the Opponent's earlier mark consists of a common word having obvious positive connotations and which, he argued, does not possess a high level of distinctiveness as a trade mark for the relevant goods. That being the case, the likelihood of confusion arising from the use of that word as part of the Applicant's mark is reduced accordingly.

16. On the question of the objection under Section 8(3)(b) of the Act, Mr. Cunnane confirmed, on instruction from Mr. Walsh, Director of the Applicant who was present at the hearing, that the Applicant's only trade under its mark is in relation to fruit juices and smoothies. He asserted that the inclusion of the word JUICE in the mark could not be characterised as deceptive as regards those goods and he indicated that the Applicant would accept a restriction of the specification of goods covered by the mark to cover only those particular goods, if necessary.

Decision

Section 8(3)(b) – is the mark of such a nature as to deceive?

17. Section 8(3)(b) of the Act provides that “*a trade mark shall not be registered if it is of such a nature as to deceive the public, for instance as to the nature, quality or geographical origin of the goods or service (sic)*” in respect of which registration is sought. As noted in paragraph 13 above, Ms. O’Regan argued at the hearing that the application falls foul of this Section because of the inclusion in the mark of the word JUICE. I deal briefly with that contention as follows.
18. Firstly, having reviewed the Notice of Opposition filed in this case, I note that no specific objection to registration was raised therein under Section 8(3)(b) of the Act. While the Notice of Opposition includes, at paragraph 4, the claim that the “*Mark applied for offends against the provisions of the Trade Marks Act, 1996 and in particular offends against the provisions of Sections 6, 8, 10 and 37*”, no specific allegation is made to the effect that the mark is of such a nature to deceive the public. Since several other grounds of opposition that fall within Section 8 are specifically particularised in the Notice of Opposition (see paragraph 5 above), it seems to me that the Applicant could reasonably have assumed that only those specific grounds of opposition were being raised against its application notwithstanding the reference in the Notice of Opposition to Section 8 in general. For that reason, I take the view that a ground of opposition based on Section 8(3)(b) is not expressed in the Notice of Opposition and that the introduction of same would constitute a material alteration of the Notice of Opposition for which no reasons have been given. In the circumstances, I find that the Opponent is not entitled to object to the application on the basis of Section 8(3)(b) of the Act and that the arguments advanced at the hearing on behalf of the Opponent in respect of the alleged deceptiveness of the mark propounded for registration are invalid.
19. If I am wrong in this and the objection under Section 8(3)(b) is validly raised, then it seems to me that it should not succeed for the following reason. The purpose and effect of Section 8(3)(b) is to withhold registration from marks that are inherently deceptive as to some characteristic of the relevant goods or services.

The question of whether a given mark falls foul of the Section must, I think, be assessed by reference to the mark itself, the goods to which it is to be applied and to the presumed expectations of the average consumer of those goods. In the present case, the objection under Section 8(3)(b) is based on the inclusion in the mark of the word JUICE and the fact that not all of the goods for which registration is sought are juices or juice-based drinks. The fact is, however, that the verbal element of the mark propounded for registration is SUNSHINE JUICE and not simply JUICE and I think it is proper to assess whether, to the average consumer of the range of goods covered by the application for registration, the name SUNSHINE JUICE would necessarily be taken to imply that those goods are juices or juice-based drinks. Looked at in that light, it seems to me that the mark cannot be characterised as inherently deceptive as the concept of “sunshine juice” is purely fanciful and it could not be said that the average consumer would expect a product so marked to actually contain such a substance.

20. In my opinion, it is not reasonable to break up the trade mark into its constituent parts and, on the basis that one part, taken alone, could be said to convey a misleading message as to the nature of the relevant goods, to declare that the mark as a whole is deceptive and liable to be refused under Section 8(3)(b). I think that such an approach might result in very many trade marks being found to fall foul of the Section notwithstanding that their use would create no likelihood of deception at all. The Applicant has not sought registration of the words ORANGE JUICE, APPLE JUICE, FRUIT JUICE or even simply JUICE, but SUNSHINE JUICE. Taken as a whole, that term cannot, in my opinion, be said to designate the nature of the relevant goods in a deceptive manner any more than, say, the names STAR JUICE or MOON JUICE. For that reason, I would not have allowed the objection under Section 8(3)(b) even if I had found that it was validly raised.

Section 10(1) – are the respective trade marks and the respective goods identical?

21. Section 10(1) of the Act prohibits the registration of a trade mark that is identical with an earlier trade mark and is to be registered in respect of goods or services that are identical with those for which the earlier trade mark is protected. Trade Mark No. 100365 cited in the Notice of Opposition constitutes an earlier trade mark as against the present application within the meaning of Section 11 of the

Act, which earlier trade mark is protected for the goods of that registration, namely, *non-alcoholic beverages, preparations for making such beverages all included in Class 32, mineral waters, fruit juices, vegetable juices for use as beverages*. As regards *fruit juices, mineral waters, non alcoholic beverages, vegetable juices for use as beverages and preparations for making beverages* included in the application for registration, it can be seen that the respective goods are identical. As to *fruit drinks, aerated waters and syrups for making beverages* included in the application for registration, these goods fall within *non-alcoholic drinks and preparations for making beverages*, respectively, included in the earlier registration and the criterion of identity of goods is therefore satisfied as regards these goods also.

22. The only question then is whether the respective trade marks are identical. If they are, then the application must be refused under Section 10(1). Obviously, the marks are not identical within the ordinary meaning of that word but the question is whether they should be regarded as identical for the purposes of the Act. The European Court of Justice (ECJ) considered the equivalent question in Case No. C-291/00, *LTJ Diffusion SA and Sadas Vertbaudet SA* and declared that,

“a sign is identical with [an earlier] trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer”.

23. In the present case, the mark propounded for registration reproduces all the elements constituting the earlier trade mark, i.e., the word SUNSHINE, and the differences that the Applicant’s mark contains consist of the word JUICE and the device element. I have to agree with the submission made on behalf of the Opponent to the effect that, in the context of the relevant goods, the inclusion of the word JUICE may well go unnoticed by the average consumer, in the sense that the average consumer is likely to subconsciously ignore or “filter out” that word when perceiving the brand name of goods bearing the Applicant’s mark. However, I could not agree that the same could be said of the figurative element of the Applicant’s mark so that it could reasonably be suggested that the average

consumer would be likely not even to perceive that element on exposure to the mark. In my opinion, it is not particularly relevant that the device in question consists of a representation that reinforces the concept evoked by the verbal element of the mark. That may be a factor in determining the likely impact that the device would have on the mind of the average consumer but it does not appear to me to be grounds for suggesting that the average consumer would not even notice the device. The factors affecting that question include the size, prominence and centrality of the device within the mark as a whole and, looked at from those perspectives, I think it is clear that the device is a significant feature of the mark that could not be expected to be overlooked by the average consumer.

24. That analysis leads to the unsurprising conclusion that the Applicant's mark may not be regarded as identical with the Opponent's earlier trade mark within the meaning of the Act and that the prohibition on registration contained in Section 10(1) cannot, therefore, apply. Accordingly, I have decided to dismiss the opposition to registration based on that Section.

Section 10(2) – is there a likelihood of confusion on the part of the public?

25. The relevant part of Section 10(2) of the Act, insofar as the present application is concerned, reads as follows:

“A trade mark shall not be registered if because –

(a)

*(b) it is similar to an earlier trade mark and would be registered for goods
..... 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 of the later trade mark with the earlier trade
mark.”*

Similar marks

26. While I have found that the respective marks are not identical, there can be no doubt but that they are similar. Indeed, I would say that there is a high degree of similarity between them for the following reasons. Firstly, the entire of the

Opponent's mark (the word SUNSHINE) is contained within the Applicant's mark and it stands on a line of its own therein without any other words either side of it that might serve to qualify it or lessen its impact. Secondly, the distinctive element in the Applicant's mark is the word SUNSHINE as it is that word that gives the mark its identity, since JUICE is a descriptive word in respect of certain of the relevant goods and the device element functions mainly to reinforce the message conveyed by the verbal element of the mark. Therefore, the marks are effectively identical from a connotative aspect. Thirdly, the main difference between the marks is the visual difference created by the presence of the device element in the Applicant's mark but, in the context of likelihood of confusion, that device element is less significant than the word SUNSHINE. Words in trade marks "speak" to consumers and it is by words that brands are most often known and identified. For that reason, I believe that the eye of the average consumer would be drawn to the words contained in the Applicant's mark and that the device element is of secondary significance, notwithstanding its prominence in the mark. Finally, the marks when spoken are SUNSHINE and SUNSHINE JUICE, respectively, so that the first word spoken in each case is the same and the second word in the applicant's mark designates certain of the goods for which the Opponent's mark is protected, which goods could properly be called "sunshine juice" in reference to the Opponent's products.

Identical or similar goods

27. As regards the respective goods, I have already found that these are identical but I wish to briefly address the case advanced on behalf of the Applicant at the hearing to the effect that, in practice, the parties trade in different goods and that I should have regard to that when considering the likelihood of confusion on the part of the public. I have already considered a submission of that nature in the matter of Trade Mark No. 216609 *AGRI-LINK* in the name of Glanbia plc and an opposition thereto by Link Interchange Network Limited. For the reasons set out at paragraphs 21 and 22 of the decision dated 23 January, 2006 in that case, I found that the comparison to be made is between the specification of goods/services applied for by the Applicant and that for which the Opponent's mark stands registered and not between the specific goods/services on which each may use its trade mark at the time when the opposition falls to be decided. That remains my

view of the matter and I am not persuaded that identical descriptions of goods as between the Applicant's application and the Opponent's registration may be construed as anything but identical.

Average consumer and circumstances of trade

28. That finding leads also to a rejection of the suggestion made on behalf of the Applicant to the effect that the likelihood of confusion should be assessed from the perspective of persons in the trade, such as the owners of juice bars who are the Applicant's main customers. The question must, rather, be looked at through the eyes of the ultimate consumer of the goods in question, being the average person, since these goods are aimed at consumers generally. The goods in question may be ordered by name in restaurants, bars, etc., in which case the word or words of which the relevant trade marks consist are the primary identifier relied on by consumers to distinguish between them. They are also often purchased in retail outlets such as supermarkets where the consumer has the opportunity to view various brands on display such that, in addition to brand names, figurative elements of trade marks may also function to distinguish between different brands. The goods in question are relatively low-cost items and the average consumer may not be expected to pay especially careful attention to their purchase beyond, perhaps, making sure to purchase a favourite flavour. In most cases, I would say that brand name plays a significant part in the average consumer's selection of products of this nature as the consumer is apt to rely on brand names to ensure that the product in question will be to his taste.

Distinctiveness of the earlier mark

29. In Case No C-251/95, Sabel BV –v- Puma AG and Rudolph Dassler Sport, the ECJ declared that the more distinctive a trade mark is, whether inherently or by virtue of the use that has been made of it, the greater will be the likelihood of confusion arising from the subsequent use by another undertaking of a similar mark in relation to similar goods. In the present case, the Applicant has argued that the Opponent's trade mark displays a low level of distinctiveness and has invited me to find, as a consequence, that the likelihood of confusion is reduced accordingly. I do not agree with that submission. The word SUNSHINE makes no direct reference to any characteristic of the goods for which the Opponent's

mark is registered and nor is it in any way unmemorable or commonplace in the context of those goods. Certainly, it is a word that is apt to evoke positive associations in the mind of the average consumer but that does not render it in any way non-distinctive and a distinctive trade mark is not liable to be given a lesser scope of protection merely because it consists of an inherently attractive word. As Ms. O'Regan pointed out at the hearing, the Opponent's mark was registered in Part A of the Register maintained under the Trade Marks Act, 1963 as a mark adapted to distinguish the relevant goods and I agree that it is an inherently distinctive mark for those goods.

Likelihood of confusion

30. Having regard to the foregoing factors, I have assessed the likelihood of confusion in this case in the manner described by the ECJ in its decision dated 22 June, 1999 in the case of *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV* (Case C-342/97), i.e., that the likelihood of confusion must be appreciated globally, having regard, *inter alia*, to the degree of similarity between the respective marks and the respective goods, the distinctiveness of the earlier mark and the likely perceptions of the average consumer of the relevant category of goods, who is to be regarded as reasonably observant and circumspect but who will rarely have the opportunity to make a direct comparison between the marks and must rely on the imperfect picture of them that he keeps in his mind. I have concluded that there is a strong likelihood of confusion and that the application for registration must be refused under Section 10(2) of the Act. In my view, the fact that the word SUNSHINE is the distinctive feature of both marks is decisive in obviating the visual differences between them, particularly having regard to the nature of the goods and the fact that brand name is the principal criterion upon which the average consumer is apt to identify and distinguish between the products of different undertakings. It seems inevitable that the average consumer who was once exposed to the Opponent's goods bearing the earlier trade mark would, on a subsequent occasion of purchase, assume that similar goods bearing the Applicant's mark were of the same manufacture, given that SUNSHINE is the principal brand identifier in each case. The result would be direct confusion between the respective goods with all of the attendant negative consequences for

both the consumer and the Opponent. For that reason, I have decided to refuse the application on the basis of Section 10(2)(b) of the Act.

Tim Cleary
Acting for the Controller

28 August, 2006