**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. 2189258**
**BY TROPICAL DELIGHT LIMITED TO REGISTER A MARK**
**IN CLASS 32**

**AND**

**IN THE MATTER OF OPPOSITION THERETO UNDER NO. 49998**
**BY SUNDOR BRANDS, INC**

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**BACKGROUND**

1. On 19 February 1999 Tropical Delight Limited of London applied to register the mark **SUPREME DELIGHT** in Class 32.

2. Following examination the application was accepted and published for the following specification of goods:

> "Non-alcoholic drinks and preparations for making such drinks; fruit drinks; fruit juices".

3. On 16 July 1999 Sundor Brands, Inc of Cincinnati, Ohio, United States of America filed notice of opposition. The grounds of opposition are, in summary:

(a) under Section 5(2)(b) of the Act in that the mark for which registration is sought is confusingly similar to earlier trade marks owned by the opponents and is applied for in respect of goods which are identical or similar to those for which the opponents' earlier trade marks are registered. Full details of the registered marks on which the opponents rely can be found in the Annex to this decision

(b) under Section 5(4)(a) of the Act given the use the opponents have made of their SUNNY DELIGHT marks in the United Kingdom

(c) under Section 3(6) of the Act, the opponents contend that the applicants adopted the trade mark the subject of the application in suit deliberately and with the intention of appropriating the opponents' goodwill arising from their extensive use and reputation in their SUNNY DELIGHT range of beverages.

4. On 20 October 1999 the applicants filed a counterstatement in which the grounds of opposition were denied.

5. Both parties filed evidence in these proceedings and both sides ask for an award of costs. The matter came to be heard on 10 August 2001. The applicants were represented by Dr Mary Vitoria of Her Majesty's Counsel instructed by Langer Parry; the opponents were represented by Mr James Graham of Counsel instructed by D Young & Co.

**OPPONENTS' EVIDENCE**

6. This consists of a statutory declaration dated 25 April 2000 by Penelope Nicholls. Ms Nicholls explains that she is a registered trade mark attorney and a partner in the firm of D Young & Co who are the opponents' professional representatives in these proceedings.

7. The purpose of Ms Nicholls declaration is to exhibit a copy of a statutory declaration by Arthur John Bennett dated 10 March 2000 together with copies of its five exhibits originally filed in another set of opposition proceedings (No. 49853) between the parties.

8. In his declaration Mr Bennett explains that he is employed by Procter & Gamble UK as Marketing Director, Foods and Beverages UK a position he has held since 1998. He has been a Director of the company since 1993. Mr Bennett adds that his company is a wholly owned subsidiary of the Procter & Gamble Company, as is Sundor Brands, Inc who are the opponents in these proceedings. The information in his declaration comes from both his own personal knowledge and from information available to him from company records.

9. Having confirmed that the opponents are the registered proprietors of the trade marks shown in the Annex to this decision, the following points emerge from Mr Bennett's declaration:

- that the opponents' SUNNY DELIGHT trade mark has been in use in the United Kingdom in relation to a citrus flavoured fruit juice drink which has been enriched with vitamins A, B1, B6 and C, since 1 April 1998

- that SUNNY DELIGHT was initially marketed in two distinct styles. These were "Florida style" and "California Style" both of which have been continuously available in the United Kingdom since April 1998. Exhibit AJB1 is a copy of an undated in-store poster advertising the availability of SUNNY DELIGHT "Florida style" which Mr Bennett says appeared in supermarkets such as Tesco, J Sainsbury, Asda, Safeway and Somerfield

- that since its introduction in April 1998 the SUNNY DELIGHT product has been sold in a variety of bottle sizes making it suitable for use in packed lunches, in the home or as an impulse purchase

- that the SUNNY DELIGHT product has been extremely popular in the United Kingdom with approximate annual sales of £200m

- that the company spend on average £18m per year advertising the SUNNY DELIGHT product in the United Kingdom with an additional £10m spent on in-store promotions. Mr Bennett adds that in the period April 1998 to November 1998 the company spent a

total of £4.1m promoting the mark on television in the United Kingdom. During this period, Mr Bennett says that it is estimated that 90% of all mothers of 6-18 year old children will have seen a SUNNY DELIGHT television commercial. Exhibit AJB2 consists of copies of story boards from the SUNNY DELIGHT television commercials all of which carry dates in 1998

- that the SUNNY DELIGHT product has been extensively advertised in children's magazines and in magazines aimed at the retail grocery trade. Exhibits AJB3 and AJB4 consist respectively of sample advertisements for the SUNNY DELIGHT product which appeared in Smash Hits (in June and September 1998), Bliss (date uncertain) the Dandy (SUNNY DELIGHT not actually shown) and Forecourt Trader (March 1998)

- that the mark SUNNY DELIGHT has also been promoted in the United Kingdom at various trade exhibitions including the Convenience Show and Food Expo (March 1998) and the Professional Retail Show (April 1998) and by means of direct mail advertising. Exhibit AJB5 consists of copies of direct mail advertising of the SUNNY DELIGHT product dated April, July and November 1998. Mr Bennett states that approximately 5 million households were targeted by these campaigns with the approximate cost of the campaigns amounting to some £5m

- that to the best of his knowledge there are no other brands using the DELIGHT element on fruit drinks of any kind in the United Kingdom. Mr Bennett concludes his declaration in the following terms:

  "I would also point out that the principal customers for the SUNNY DELIGHT product are children, young teenagers and their mothers and our products are largely sold through supermarkets and retail outlets such as newsagents. Purchasers of frequently bought low cost items, within a distracting environment such as a supermarket are likely to pay less attention to the trade mark for those goods than will purchasers of higher value items.....".

**APPLICANTS' EVIDENCE**

10. This consists of a witness statement dated 19 October 2000 by Andrew Shupick. Mr Shupick explains that he is the Company Secretary of Tropical Delight Limited adding that he is authorised to make this statement on the applicants' behalf.

11. The following points emerge from Mr Shupick's statement:

- that the word DELIGHT when applied to drinks and foodstuffs is not in his view distinctive in isolation (given that it is a noun meaning extreme pleasure or something that causes extreme pleasure) and needs to be combined with another/other elements in order to be considered registrable

- that the United Kingdom and Community Trade Marks Registers contain many marks

in Class 32 which feature the word DELIGHT and that these marks are in a range of different ownerships. Exhibit AS1 consists of copies of marks on both the United Kingdom and Community Trade Marks Registers in Class 32 and which feature the word DELIGHT. Of the various marks provided, Mr Shupick states that he is aware that the marks SOUTHERN DELIGHT and TROPICAL DELIGHT are in use, contrary to Mr Bennett's statement that there are no other DELIGHT marks being used for fruit drinks in the United Kingdom

- exhibit AS2 consists of copies of marks on the United Kingdom and Community Trade Marks Registers in Classes 29 and 30 which contain the word DELIGHT. From this evidence Mr Schupick concludes that the average consumer would be familiar with the use of the word DELIGHT on all sorts of goods and would as a result be readily able to discern the differences between such products from other distinctive elements within the respective marks

**OPPONENTS' EVIDENCE-IN-REPLY**

12. This consists of a witness statement by Jane Harlow dated 25 January 2001. Ms Harlow explains that she is a trade mark attorney and associate in the firm of D Young & Co the opponents' professional representatives in these proceedings. She confirms that she is authorised to make her witness statement on the opponents' behalf.

13. I do not propose to summarise Ms Harlow's witness statement in any great detail. It is, in essence, a response to the applicants' "state of the Register" evidence provided in exhibits AS1 and AS2. Suffice to say that Ms Harlow submits that the existence of the various DELIGHT marks listed in the exhibits mentioned are irrelevant to the present proceedings. In reaching this conclusion, Ms Harlow comments that while the marks in exhibit AS1 each contain the word DELIGHT, in her view the remaining elements of the various marks are less similar than the words SUPREME and SUNNY which appear in the marks the subject of these proceedings. In addition Ms Harlow points out that the state of the United Kingdom and Community Trade Marks Registers is not necessarily representative of the situation in the market place.

14. Ms Harlow levels much the same criticisms at the marks contained in exhibit AS2 noting in addition that the goods specified in these marks are in respect of foodstuffs which are not considered to be similar goods to non-alcoholic beverages.

15. That concludes my review of the evidence in so far as I think it necessary.

**DECISION**

16. In her skeleton argument, Ms Vitoria drew attention to the fact that the opponents had not provided details of their earlier registrations. She asked me therefore to dismiss the opposition because the Registrar had insufficient material to undertake the comparison between the trade mark the subject of the application for registration and the earlier trade marks (see Andreas Giesen's Trade Mark application 'ORADENT' - BL 0/136/98).

17. For his part Mr Graham asked me to admit some additional evidence, a witness statement dated 9 August 2001 by Jane Harlow of the opponents' attorneys exhibiting copies of the Trade Marks Registry's database in respect of the trade marks the opponents relied upon.

18. I decided not to dismiss the opposition summarily and to admit the evidence. The opponents' point had been taken very late - and certainly years after the applicants' attorneys would have themselves considered the relevant details. Thus admitting the opponents' additional evidence at this very late stage (under Rule 13(11) of the Trade Marks Rules 2000), did not in my view, prejudice the applicants in this case. I go on to consider the substantive issues.

19. First of all there is no evidence to support the opponents allegation that this application for registration was made in bad faith. The ground of opposition based upon bad faith under Section 3(6) of the Act is therefore dismissed.

20. Secondly, Mr Graham acknowledged that the opponents were no better off under the ground of opposition based upon Section 5(4)(a) than they were under Section 5(2)(b). I therefore need only consider, and decide upon, the latter ground of opposition.

Section 5(2)(b) states:

> "5.-(2) A trade mark shall not be registered if because -
>
> (a) .....
>
> (b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,
>
> there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark."

An earlier right is defined in Section 6(1)(a) which states:

> "a registered trade mark, international trade mark (UK) or Community trade mark which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,"

21. Neither side disputed the fact that the goods covered by the application for registration are the same or similar to the goods covered by the opponents' registrations. I proceed on that basis.

22. Mr Graham agreed that his client's best case lay in registration No 1213373 which is for the word SUNNY DELIGHT in plain block capitals and is registered for "Citrus beverages,

mineral waters, aerated waters, non alcoholic beverages, preparations for making beverages and syrups, all included in Class 32". I thus compare that trade mark registration with the application in suit for the trade mark SUPREME DELIGHT.

23. In doing so I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] E.T.M.R. 1, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] E.T.M.R. 1, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG* [2000] E.T.M.R. 723.

It is clear from these cases that:-

(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG,* paragraph 22;

(b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v. Puma AG*, paragraph 23, 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; *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* paragraph 27;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v. Puma AG*, paragraph 23;

(d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v. Puma AG*, paragraph 23;

(e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17;

(f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v. Puma AG*, paragraph 24;

(g) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v. Puma AG*, paragraph 26;

(h) further, 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; *Marca Mode CV v. Adidas AG*, paragraph 41;

(i) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 29.

24. Mr Graham sought to persuade me that the opponents' trade mark as a result of the use made of it (by reference to the statutory declaration of Mr Bennett) had an enhanced reputation. For the reasons I have set out at greater length in related opposition proceedings between the parties (No 50315) I do not consider the evidence is robust enough for that purpose. I therefore consider the matter on the basis of notional and fair use of the respective trade marks across the full range of goods covered by their specifications (REACT Trade Mark [2000] RPC 285).

25. The applicants' trade mark is SUPREME DELIGHT and the opponents' trade mark is SUNNY DELIGHT. The second element is therefore common to both. The applicants for their part submitted that the word DELIGHT, because there are other trade marks on the register which consist of or contain that word, must have a low imaginative content or lack distinctive character. Thus the public would distinguish the respective trade marks on the basis of the first element; different but ordinary words of the English language.

26. Mr Graham, correctly, submitted that what was on the register was not indicative of anything without evidence of the position in the market place. Thus I intend, as the authority (Sabel BV v Puma AG) requires me, to consider the trade marks as wholes.

27. The goods in question are bought, I accept, by or for children and teenagers. The relevant public is therefore that group and their mothers who predominately, but not exclusively consume and purchase these soft drinks. Visually the two trade marks consist of two words the first element of which differs, the second is the same. The meanings of the first elements are different as is their pronunciation. Therefore, I do not consider the respective trade marks as having any visual, aural or conceptual similarity. Even though the goods covered by the opponents' earlier trade mark are the same or similar to the goods set out in the applicants' specification, I see no reason to believe that the relevant public are likely to be confused. The words SUNNY and SUPREME are different and even reliance upon an imperfect picture of the opponents' trade mark is not, in my view, going to produce a situation where someone buys the applicants' SUPREME DELIGHT product in error.

28. In the circumstances I consider that the applicants' trade mark is not similar to that of the opponents and if the applicants' trade mark is placed on the register there is no likelihood of confusion on the part of the public. The grounds of opposition based upon Section 5(2)(b) is therefore dismissed.

29. As the opposition has been dismissed the applicants are entitled to an award of costs. I order the opponents to pay to the applicants the sum of **£600**. This sum to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 9TH Day of November 2001**

**M KNIGHT**
**For the Registrar**
**The Comptroller-General**

**ANNEX**

| TM No: | App Date | Mark | Cl | Goods |
|---|---|---|---|---|
| 1213373 | 23/2/84 | SUNNY DELIGHT | 32 | Citrus beverages, mineral waters, aerated waters, non-alcoholic beverages, preparations for making beverages and syrups, all included in Class 32 |
| 1228524 | 18/10/84 |   | 32 | Mineral waters, aerated waters, non-alcoholic drinks, syrups and preparations for making beverages, all included in Class 32 |
| 2040893 | 12/10/95 | SUNNY DELIGHT CITRUS PUNCH | 32 | Beers; mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages; all containing, being flavoured with or having the flavour of citrus fruits |
| 2040920 | 11/10/95 | SUNNY DELIGHT SMOOTHIE | 29 | Fruit based dairy beverages |
| 2160593 | 11/3/98 |   | 29, 32 | **29** Meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies, jams; eggs, milk; fruit based dairy beverages; preserves<br>**32** Beers; mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages |