

TRADE MARKS ACT 1994

**IN THE MATTER OF Application No 2370346
by Société Anonyme Des Eaux Minérales D'Evian to register
a Trade Mark in Class 32**

and

**IN THE MATTER OF Opposition No.93081
by the Procter & Gamble Company**

BACKGROUND

1. On 11 August 2004, Société Anonyme Des Eaux Minérales D'Evian (hereafter referred to as 'Evian Co'). applied to register the mark "**EVIAN FRUIT FUSION**" in respect of the following specification of goods in Class 32:

“Still or sparkling water (mineral or non-mineral), fruit or vegetable juices, fruit or vegetable drinks, lemonades, sodas, sorbet drinks, drink preparations, syrups for drinks, alcohol-free fruit or vegetable extracts, alcohol-free drinks comprising lactic fermenting agents.”

The application, numbered 2370346, was accepted and published on 01 October 2004.

2. On 30 December 2004, The Procter & Gamble Company (hereafter referred to as 'P&G') filed notice of opposition against this application under Sections 5(2)(b) and 5(3) of the Trade Marks Act 1994. The opposition was based upon P&G's earlier Community trade mark no. 2271104 consisting of the words "**FRUIT FUSIONS**", registered in respect of the following goods in Class 03:

“Hair care preparations, namely shampoos, conditioner, detanglers and styling gels; skin care products, namely body wash, face wash, astringent for cosmetic purposes, toner; skin moisturizers and creams.”

3. In so far as the opposition is based upon Section 5(2)(b), the opponent claims that all of the goods claimed by the applicant are identical or similar to the goods covered by its earlier registration. However, in respect of the grounds based upon Section 5(3), whilst the opponent also claims that all of the applicant's goods would take unfair advantage and/or be detrimental to the distinctive character or reputation of its earlier mark, it only claims a reputation in respect of “hair care preparations, namely shampoos, conditioners, detanglers and styling gels”.

4. In its initial statement filed with the Notice of Opposition, P&G presented the following submissions:

- (i) Under the provisions of Section 5(2)(b) of the Act, the earlier registered mark “FRUIT FUSIONS” is visually, phonetically and conceptually similar to the applicant’s mark “EVIAN FRUIT FUSION” whilst, due to an alleged link between beauty products used externally (such as shampoos, skin creams etc.) and health products taken internally (such as mineral waters, vitamin-based fruit drinks etc.), the opponent’s Class 03 goods are similar to those of the applicant claimed in Class 32.
- (ii) Under the provisions of Section 5(3) of the Act, use of the applicant’s mark would take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier registered mark. In support of this claim, the opponent stated its intention to provide evidence of the reputation enjoyed by the mark “FRUIT FUSIONS” within the UK, in respect of hair care preparations. It also returned to the claim presented in respect of Section 5(2) that a natural brand ‘extension’ and commercial link can be found between the applicant’s Class 32 goods and those of the opponent in Class 03 to the point that registration of the applicant’s mark will inhibit the earlier proprietor’s ability to expand into the beverage sector at a later date.

5. In a counterstatement filed in response to the Notice of Opposition, the applicant presented the following submissions:

- (i) On the grounds that the opponent has failed to make any specific admissions regarding the validity of the earlier Community trade mark, that earlier mark does not constitute a valid basis on which the opposition can be based.
- (ii) In addition to differences in the marks themselves, the applicant contests the opponent’s claims regarding alleged similarity between the goods at issue. By referring to factors such as their nature, their intended purpose and their (allegedly) dissimilar trade channels, the applicant denies any link or similarity between the goods being considered in Classes 03 and 32. Nor does the applicant consider there to be any likelihood of brand extension between such goods. In light of factors such as those just mentioned, the applicant denies the grounds for opposition under Section 5(2)(b).
- (iii) In respect of Section 5(3), the applicant denies that the earlier mark has acquired reputation. In the event that a reputation might be proven through any evidence submitted, the applicant also then further denies that such repute would be adversely affected by use of its mark.

6. Both sides ask for an award of costs in their favour.

7. Following submission of the statement and counterstatement, both parties then filed evidence. Under cover of a letter dated 03 January 2006 forwarded by D Young & Co (the applicant's professional representatives), the opponent filed two witness statements together with accompanying exhibits. This was followed by a further witness statement and exhibits forwarded on 06 February 2006. The applicant then responded by filing a single witness statement and exhibit dated 19 May 2006.

8. Neither side has asked to be heard. Acting on behalf of the Registrar, I therefore now give this decision.

Opponent's evidence

9. The first witness statement submitted was that of Wendy Waller, a paralegal with the firm D Young & Co, who are themselves representing the opponent in this matter.

10. Ms Waller's statement appears to have been submitted primarily in order to demonstrate the commercial phenomena of 'brand extension' and 'brand stretching'. The statement refers to Internet research she has undertaken, and presents evidence indicating the extent to which some brands which already enjoy repute in respect of specific goods or services have been 'extended' into other areas of trade. In support of such claims, three exhibits have been attached to the statement. They are:

Exhibit WLW1: Two articles taken from websites presenting marketing and business theory. The first refers to "Yamaha", "Boots the Chemist" and "Tesco Finest" as examples of brands which have diversified, whilst the second refers to "Arm & Hammer" toothpaste, which was developed out of the brand's established reputation for baking soda. The exhibit also contains an unsourced article, which I assume to be taken from a business/marketing academic text. The first two articles, although undated, were both printed on 25 October 2005. No date has been provided for the unsourced article.

Exhibit WLW2: Screen prints showing two product searches undertaken on a well-known supermarket's electronic shopping platform. The first documents a search for "Bassett's" branded products, and shows identical trade marks being used in respect of both confectionery and vitamin tablets. The second shows a search for "Evian" branded products demonstrating use of the mark upon mineral waters and cleansing wipes. This exhibit also contains a website promoting a range of "Lil-lets" products including both sanitary products and beauty products. Whilst none of the websites are specifically dated, all three examples were printed on 20 October 2005.

Exhibit WLW3: Three internet articles (two of which originate from the same website), documenting the apparent rise in brand diversification and brand extension from established beauty products commonly sold in the form of creams and lotions etc., into newly developed ingestible health products designed to

perform a similar or complementary function. References are made to commercial partnerships between *inter alia* L’Oreal and Nestle (to develop a food supplement for restoring firm skin), OLAY and Pharmavite (to develop a range of ingestible OLAY vitamins), and Coca-Cola Japan and Shiseido (to develop fat-burning soft drinks). As with the previous exhibits, none of these articles show any publication date. They were, however, printed on 08 November 2005.

11. The second witness statement submitted was that of Lisa de-la-Plain, a qualified and accredited beauty therapist who also heads a retailing business engaged in the provision of beauty care products and appliances.

12. Ms de-la-Plain’s statement reflects her own knowledge of the health and beauty sectors, and is supported by seven exhibits. The statement itself attests that health and beauty treatments are commonly presented in an ‘holistic’ fashion, that is to say that a single undertaking may present advice on, for example, diet and nutrition, in combination with (or as a complement to) more conventional beauty and skincare information. Ms de-la-Plain also relates in some detail that (i) vitamins are commonly used as active ingredients in the production of skin and hair products; and (ii) established food producers are increasingly marketing healthier versions of their existing products. References to actual products are made in both cases.

13. The seven exhibits presented in support of the aforementioned witness statement are as follows:

Exhibit LDLP1: Prints taken from searches on numerous electronic retailing platforms, all showing various hand, nail and skincare beauty products promoted on the basis of their vitamin and/or mineral content. The exhibit also contains five examples of internet-based promotional material for beauty products (including shampoos and conditioners) also containing vitamin, mineral or nutrient-based active ingredients. None of these materials contain origin-specific dates, although the pages were printed on 22 September 2005.

Exhibit LDLP2: Prints taken from a supermarket’s on-line shopping platform, showing various health-conscious foodstuffs such as low-fat potato crisps, spreads and desserts; low-sugar soft drinks; and reduced-sugar jams. These prints were made on 28 November 2006.

Exhibit LDLP3: Further examples of Internet pages promoting healthier food and beverage products, namely soya milk, calcium-enriched fruit drinks, and breakfast cereals. These prints were also made on 28 November 2006.

Exhibit LDLP4: A double page advertisement taken from the February 2005 edition of Marie Claire magazine. This advertisement promotes hydrating, cleansing and moisturising skincare products sold

under the “evian affinity” brand. The advertisement clearly states that these products are “formulated with naturally hydrating Evian water from the French Alps”.

Exhibit LDLP5: A photocopy of an aerosol product. The product is described as a “Natural Mineral Water Misting Spray”, and displays the mark “Vittel” in combination with the other marks “L’Oreal” and “Plenitude”. Neither the product nor the photocopy are dated.

Exhibit LDLP6: A selection of front covers and contents pages taken from “Zest” and “Top Sante” magazines. All are technically after the relevant date Both of these publications appear to present a range of features on dieting, alternative therapies, exercise, health and beauty.

Exhibit LDLP7: One small feature taken from the December 2005 edition of “Zest” refers to a new chocolate product containing antioxidants for use in skin treatment, as well as the aforementioned Coco-Cola Japan/Shiseido fat-burning soft drink.

14. The third of the opponent’s witness statements, forwarded at a later date to the previous two, was that of Haya A. Zuberi, Assistant Brand Manager for Procter & Gamble.

15. Ms Zuberi’s statement provides some background and history into the use of its earlier mark “Fruit Fusions”, including details of the way in which the mark has been promoted and advertised. In her own words, Ms Zuberi describes “Fruit Fusions” as “one of three sub-lines of the Herbal Essences Hair care brand”. It was launched within the UK in March 2003, and consists of a range of shampoos, conditioners and other intensive hair treatments. Ms Zuberi claims that products branded under the “Fruit Fusions” mark are sold in 4,894 outlets, including all major supermarkets and that, since the launch, over £6 million has been spent on promotion by means of print and television advertising. In terms of turnover, Ms Zuberi provides an annual figure of over £11 million, whilst stating that the brand enjoys a 2% share in the shampoo and conditioner markets.

16. In respect of promotional activity, the Witness Statement lists three separate advertising campaigns. The first of these, entitled the ‘Tropical Showers’ campaign, apparently ran from July 2003 to December 2003 and consisted of TV, print and in-store advertising. The second, entitled ‘Menu’, ran from July 2004 to October 2004 and also consisted of TV, print and in-store targeting. Finally, the third campaign, also entitled ‘Menu’ was television only, and took place in July 2005.

17. In paragraph 5 of her witness statement, Ms Zuberi provides a range of statistical information regarding consumer exposure to, and awareness of, the ‘Fruit Fusions’ brand. It is claimed that television advertising campaigns have reached an average of 36.458 million adults every year; that over 13 million adult readers have been exposed

to the press ads; and that, according to data from October 2004, 80% of women aged between 18 and 44 are familiar with the 'Fruit Fusions' brand.

18. In support of these claims, and the conclusion that public recognition for the 'Fruit Fusions' brand is extremely high, Ms Zuberi has filed two exhibits. They are as follows:

Exhibit XX1: Four invoices recording sales of the opponent's products, two of which are for sales made to The Boots Company Plc, and two for Tesco Stores Ltd. The first two Boots invoices are dated November 2004 and September 2005, whilst the two Tesco invoices are dated May 2005 and November 2005. Of the four invoices, only two actually refer to the mark in question, where it appears as *part* of the much longer product reference "HERBAL ES (or ESS) FRUITFUSION". The other two invoices make no reference to the mark "Fruit Fusions", but instead make reference to "HERB ESS FF".

Exhibit XX2: A production storyboard for a filmed advertisement, together with four examples of print advertisements. In respect of the storyboard, dated 05 October 2004, a sequence of photographs shows a shampoo bottle displaying the word 'Clairol', underneath which appears a prominent circular device containing the words "HERBAL ESSENCES" together with a figurative presentation of various pieces of fruit. Underneath both of these elements appears the mark "FRUIT fusions" whilst, via a voiceover, one would hear a commentary containing phrases such as "Now there's a new twist to Herbal Essences. New Fruit Fusions shampoos...", "...a fusion of fruit extracts..." and "...Herbal Essences' new Fruit Fusions collection...". In respect of the print advertisements (two of which are dated from publications issued in October 2004 and September 2005, and two of which are undated), all show the same "Clairol / Herbal Essences (and figurative device) / Fruit Fusions" mark as seen in the storyboard.

Applicant's evidence

19. In response, the applicant filed a Witness Statement of Stephen Kinsey, partner in the firm Wildbore & Gibbons which is representing the applicant. In this statement, the applicant refers to findings made by the European Court of Justice (ECJ) in its decision on the *Medion* case, and claims that the opponent's mark "Fruit Fusions" must be considered a descriptive term in respect of hair care products made from a blend of fruits. By making further reference to the presence of the distinctive word "Evian" found in the applicant's mark, Mr. Kinsey concludes that there can be no likelihood of any visual, aural or conceptual confusion.

20. In terms of the goods at issue, Mr Kinsey alleges that health and beauty products (such as those covered by the earlier registration) utilise different channels of trade to those used in the provision of beverages as claimed by the applicant. And where the

goods may be sold in the same outlet, it is claimed that the products in conflict would be provided in different sections of that outlet.

21. Having studied the evidence filed by the opponent, Mr Kinsey emphasises the extent to which the opponent's mark "Fruit Fusions" only appears in combination with other prominent marks such as "Herbal Essences". In this context, where "Fruit Fusions" appears as an (allegedly) subsidiary and descriptive element, Mr Kinsey then questions the extent to which P&G have actually demonstrated any level of reputation and public recognition as has been claimed in the witness statement of Ms Zuberi.

22. As a final point, Mr Kinsey refers to the statements of Ms Waller and Ms de-la-Plain as being insufficient in terms of demonstrating an intention on the part of the opponent to diversify into Class 32 goods. It is alleged that proof of brand extension and diversification by unrelated third parties should not affect the applicant's wish to seek protection for goods in which it has a "genuine and current interest".

DECISION

Section 5(2)(b)

23. The relevant part of the statute reads as follows:

"(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."

24. I take account of the guidance from the following well known cases from the European Court of Justice – *Sabel BV v Puma AG* [1998] ETMR 1, *Canon Kabushiki Kaisha v Metro Goldwyn Mayer Inc.* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* [2000] FSR 77, and *Marca Mode CV v Adidas AG and Adidas Benelux BV* [2000] ETMR 723:

Brand extension and related issues

25. Ms Waller and Ms de-la Plain's evidence deals with brand extension and other trading circumstances that it is suggested should have a bearing on the opponent's case and in particular the issue of similarity of goods. Ms Waller gives examples of brand extensions including instances where successful brands have been extended into new and unrelated product areas. I accept that consumers have become accustomed to

seeing certain brands used across a variety of goods and services. Consumers' expectations in relation to any particular brand will, of course, depend on the actual circumstances of the case.

26. It is also submitted that it is not uncommon for beauty care products to be enriched with vitamins or nutrients and that the term cosmeceuticals is used to define supplements that target skin, health and beauty. I note that Ms Waller says that "such products are apparently seeing fast growth in Europe since emerging as a new concept". It is not clear when the new concept emerged or how far it had developed by the material date. The supporting items in Ms Waller's exhibit WLW3, are a Nutra Ingredients article dated 19 January 2005, a Traditional Skin Care Lines article that cannot readily be dated save for the download date, and a further Nutra Ingredients article dated 31 March 2004. The latter two articles appear to be of US origin. The first Nutra article relates to Europe but is after the relevant date.

27. Ms de-la-Plain's evidence draws predominately on UK material and lends support to the general proposition that there is now a range of beauty care products on the market which contain added vitamins or other supplements to promote health and vitality (see in particular LDLP1). It is also part of Ms de-la-Plain's evidence and submission that her clients – and I assume she means by extension consumers at large – are now generally more aware of healthy lifestyle issues. She gives examples of food and drink manufacturers who have produced 'health variants' alongside their regular product offerings and cites magazines that promote an holistic approach to health and beauty.

28. As I have said I am uncertain as to how recently it has become the trend to incorporate vitamins or nutrients into beauty care products. However, in other respects the opponent's evidence and submissions are up to this point largely uncontentious.

29. The opponent has also offered evidence and submissions bearing more directly on the goods at issue in this case. The second Nutra Ingredients article in WLW3 indicates that "Coca-Cola Japan is to launch a drink flavoured with fragrances thought to activate the fat-burning process. The product is part of a new joint venture with cosmetics firm Shiseido". The article goes on

"The companies said last year that they were to collaborate on a range of products to target the body-conscious consumer. The first products, to be unveiled next month, include Coca-Cola's soft drink Body Style Water and a body lotion developed by Shiseido, both containing grapefruit juice and caffeine."

30. I note that this article appears to be from a US website and reports developments in Japan involving Coca-Cola and Shiseido. It is not entirely clear from the article whether the two companies are simply engaging in technical collaboration as opposed to sharing common branding. The Coca Cola product is referred to under the name Body Style Water. Later in the article it is said that "The soft drinks giant has revealed no plans to launch in other countries." This trading relationship is unlikely, therefore, to have come to the attention of a significant number of consumers in the UK.

31. The second example is contained in Ms de-la-Plain's evidence and relates to the Vittel mineral water company's diversification into a natural mineral water misting spray. There is no obvious way of dating the exhibit (LDLP5). The spray can illustrated carries the trade marks L'Oréal, Plénitude and Vittel. I infer that it is a joint enterprise between the two companies but with their respective brandings retained.

32. The third example involves the applicant company which is shown to have advertised a range of wipes, lotions and creams under the mark Evian Affinity. The copy advertisement at LDLP4 is from Marie Claire magazine for February 2005.

33. The conclusions that I am asked to reach on the basis of this material is

“9. For all of these reasons in following this holistic approach, there is now considerable overlap between health and beauty products and food and drinks products. In my profession, we would encourage client's to associate all these things as contributing to a healthy lifestyle. As a consequence, the public may well expect the same company or manufacturer to operate within all fields.” (Ms de-la-Plain).

and

“11. I believe that these articles provide evidence of the recognition of the combined role of food, water, vitamins and beauty care products for health, vitality and beauty, and that brand extension between these areas is becoming more common.” (Ms Waller).

34. In my view this overstates the position in key respects. In particular the evidence that companies engaged in the product areas at issue in this case had developed a cross-over trade by August 2004 is thin. Still less has it been established that they would choose to do so under the same mark particularly an existing second or third tier mark. The collaborative ventures (Coca-Cola/ Shiseido, Vittel/ L'Oréal) either employ new names (Body Style Water) or reflect the main corporate names of the collaborating companies. On the basis of the evidence filed I am unwilling to accept that trade practices at the relevant date were such that they would have influenced consumer expectations and perception in the areas of trade under examination.

Comparison of goods

35. In assessing the similarity of the goods concerned, all the relevant factors relating to those goods should be taken into account. Such factors include *inter alia* their nature, intended purpose and method of use, and also whether they are in competition with each other or are complementary (see judgment of the European Court of Justice, Case C-39/97, *Canon Kabushiki Kaisha v Metro Goldwyn Mayer Inc*). Further factors include the purpose of the goods, their origin, and their pertinent distribution channels and sales outlets.

36. The opposition is directed against all of the goods covered by the applicant's mark. They are as follows:

Class 32 Still or sparkling water (mineral or non-mineral), fruit or vegetable juices, fruit or vegetable drinks, lemonades, sodas, sorbet drinks, drink preparations, syrups for drinks, alcohol-free fruit or vegetable extracts, alcohol-free drinks comprising lactic fermenting agents.

37. The earlier trade mark has been registered in respect of the following goods, all of which have been presented as a basis for opposition pursuant to Section 5(2)(b):

Class 03 Hair care preparations, namely shampoos, conditioners, detanglers and styling gels; skin care products, namely body wash, face wash, astringent for cosmetic purposes, toner, skin moisturizers and creams.

38. The Trade Marks (Proof of Use, etc) Regulations 2004 do not apply to the opponent's earlier trade mark with the result that it is entitled to rely on the full scope of the specification.

39. The opponent's written submissions acknowledge that conventionally the respective sets of goods would not have been held to be similar but, on the basis of Ms Waller's and Ms de-la-Plain's evidence goes on to say:

“Due to the holistic approach adopted to health and beauty and the trend of brand diversification between different product sectors, the public would now expect that Class 3 and Class 32 products could come from the same undertaking or for [from] economically linked undertakings. Indeed, EVIAN toiletries come from the same source of EVIAN water, VITTEL facial spritz comes from the same source as VITTEL mineral water. ECJ Case Law has established that confusion does include economic confusion as well as direct confusion. Accordingly, the public may well assume that EVIAN FRUIT FUSION products come from the same undertaking as the FRUIT FUSION Class 3 products of the opponent, particularly given that EVIAN have already extended their activities to Skincare products. Under modern standards and taking into account the modern brand trends, it is therefore submitted that the respective goods are similar. Indeed, both types of products would be found in supermarkets. Moreover, since the public has now encountered EVIAN in the health and beauty section (and made the link to water products) it is entirely feasible that now seeing FRUIT FUSION in the drinks cabinet, they would make the link to shampoos.”

40. For the reasons I have given above I do not accept that the public has been educated to make the sort of assumptions that the opponent invites me to accept. The most that I would be prepared to accept is that goods in Class 3 and 32 may contain supplements, vitamins or nutrients and that the presence of such ingredients may be one of the factors influencing the purchasing decision of consumers. But that does not establish a cross-over trade of any significance between the two product areas. In terms of the *Canon* test, it does not change the fundamental nature, intended purpose or method of use of the respective sets of goods. It does not place them in competition one with the other. Nor is there any evidence that such goods would pass through the same distribution channels and/or appear in the same retail areas of shops.

At most, the nature of products that contain the same sorts of things (vitamins, nutrients etc) may be slightly closer than would otherwise be the case and (the strongest point) they might on that account be said to be complementary to a small degree.

41. Whilst I am aware of the need to avoid pre-emptive findings in relation to issues of similarity, whether of goods or marks, (see *The Penguin Trade Mark* BL O/144/05) I believe the points of similarity here to be so slight that realistically, the goods must be held to be dissimilar. However, in deference to the parties' submissions, I will go on to consider the other elements of the test.

Distinctive character of the opponent's mark

42. It is well established that my assessment of the distinctive character of the earlier trade mark must take into account both its inherent qualities and any acquired distinctive character. The trade mark FRUIT FUSIONS is made up of well known dictionary words which are suggestive of the blending of fruit flavours or aromas. Hair care preparations and other toiletry preparations can be scented. The mark alludes to the presence of a combination of fruit extracts or smells in the goods concerned. The opponent's evidence confirms this is the case – "each of our new fruit fusion blends is an exotic cocktail of fragrances and fruit extracts ...". The voice over to the commercial (stills of which are at XX2 of Ms Zuberi's evidence) refers in what appears to be a descriptive manner to the shampoos and conditioners being "A fusion of fruit extracts." I conclude that as an unused mark FRUIT FUSIONS must be considered to be of relatively low distinctive character.

43. The opponent has, however, claimed use of its mark for some seventeen months prior to the relevant date in these proceedings. The turnover and market penetration figures referred to in the evidence summary taken at face value might suggest that the opponent has a basis for claiming that its mark enjoys an enhanced reputation in the marketplace despite its modest inherent qualities.

44. There are difficulties with the claim. The supporting exhibits are from the period after the relevant date or are undated and the annual turnover figure of in excess of £11 million is not related to any particular year (it is mentioned in a witness statement dated 1 February 2006 and so may relate to a later period). Unfortunately, the research document (GfK Media Effectiveness Trading Tool 2004) on which consumer awareness data is based has not been supplied. It is not clear, therefore, what interviewees were responding to. This is of some importance in the light of the overall branding used (as to which see below).

45. Nevertheless it must be acknowledged that the opponent has run a number of high profile TV, print and advertising campaigns. The first of these took place between July and December 2003 and is said to have had the working title, 'Tropical Showers' though this does not seem to marry up with exhibit XX2 which appears to be the Tropical Showers commercial but is dated 5 October 2004. The second took place between July and October 2004 and thus spanned the relevant date. The third was well after the relevant date.

46. Whilst I regard the supporting evidence as being flawed to the extent that most, if not all, of the exhibits post-date August 2004, it would be unrealistic to discount completely the effect of Ms Zuberi's uncontested evidence as to activity in the period from launch of the products in March 2003 up to the relevant date.

47. My rather greater concern is ascertaining what effect the FRUIT FUSIONS element of the overall branding has had on consumers. It is clear from the material at XX2 that the products display a number of marks. There is the Clairol housemark, a roundel device with the words Herbal Essences (and fruit device) and the words FRUIT FUSIONS (usually with the word FRUIT in plain upper case and FUSIONS in lower case script form). The brand name in the heading of the script for the television commercial is Herbal Essences. Although the commercial also refers to FRUIT FUSIONS it does so in a way that leaves me in some doubt as to whether it would be seen as trade mark or purely descriptive use (see the voiceover script at frames 5 to 7).

48. Making the best I can of this material I do not accept that FRUIT FUSIONS has been shown to have an enhanced distinctive character independently of the other marks with which it has been used.

Comparison of marks

49. The respective marks are FRUIT FUSIONS (earlier trade mark) and EVIAN FRUIT FUSION. The opponent submits, and I accept, that nothing is likely to turn on the fact that one of the marks employs the singular form FUSION and the other the plural form.

50. I have been referred to *Medion AG v Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, on the question of how to approach marks where the contested sign is made up of a company name and an element or elements that is/are the same (or nearly so) as the earlier trade mark of another party. The ECJ held in *Medion*:

“30 However, beyond the usual case where the average consumer perceives a mark as a whole, and notwithstanding that the overall impression may be dominated by one or more components of a composite mark, it is quite possible that in a particular case an earlier mark used by a third party in a composite sign including the name of the company of the third party still has an independent distinctive role in the composite sign, without necessarily constituting the dominant element.

31 In such a case the overall impression produced by the composite sign may lead the public to believe that the goods or services at issue derive, at the very least, from companies which are linked economically, in which case the likelihood of confusion must be held to be established.

32 The finding that there is a likelihood of confusion should not be subject to the condition that the overall impression produced by the composite

sign be dominated by the part of it which is represented by the earlier mark.”

51. The underlying factual circumstances in *Medion* were quite different to those pertaining here and involved identical and/or closely similar goods. But the guidance on how to approach marks of this kind (ie where a company name or housemark is involved) is pertinent to the case.

52. I take the view that, although of weak distinctive character, the element FRUIT FUSION can be said to have an independent role within the overall context of the applied for mark such that, from a visual, aural and conceptual standpoint, there is similarity with the opponent’s earlier trade mark notwithstanding the fact that EVIAN is the dominant and most distinctive element of the applied for mark.

Likelihood of confusion

53. The test is a cumulative one requiring similarity of both goods and marks. My finding that the goods are dissimilar means that there can be no likelihood of confusion. If I am wrong in that and it is found that I should have held that there is at least a low degree of similarity in the goods then the interdependency principle is engaged and I would need to consider the net effect of the similarities and dissimilarities in goods and marks.

54. The matter falls to be considered from the standpoint of the average consumer which, for the goods at issue, I take to be the public at large. Neither party’s goods are likely to be particular expensive items though in each case the consumer is likely to have to make a choice from a wide range of competing goods. I anticipate that a moderate but certainly not the highest degree of attention will be paid when purchasing such goods. I also take the view that the products in question are most likely to be purchased on the basis of visual selection though oral ordering/recommendation cannot be ruled out.

55. Taking the matter in the round, and assuming against myself that there is similarity in the goods, I would still hold that there is no likelihood of confusion, direct or indirect within the meaning of Section 5(2)(b). In reaching that decision I have also had particular regard to the low distinctive character (in fact borderline descriptiveness) of the mark/elements that give rise to the opponent’s concern. The opposition fails on this account.

Section 5(3)

56. As a result of Regulation 7 of The Trade Marks (Proof of Use etc) Regulations 2004, Section 5(3) now reads:

“5.-(3) A trade mark which

(a) is identical with or similar to an earlier trade mark,

shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a

Community Trade Mark, in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

57. In order to get its case off the ground the opponent must establish that its earlier trade mark has a sufficient reputation. Guidance on assessing whether the reputation requirement has been met can be found in *General Motors Corporation v Yplon SA*, Case C-375/97, where it was stated:

“23. ..In so far as Article 5(2) of the Directive (is concerned) ...It is only where there is sufficient degree of knowledge of that mark that the public, when confronted by the later trade mark, may possibly make an association between the two trade marks, even when used for non-similar products or services, and that the earlier trade mark may consequently be damaged.”

and

“26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.”

58. In this particular case the single registration relied on is a Community trade mark so the reputation must be in the European Community. In the normal course of events that would call for consideration of what is sufficient to constitute a reputation in the Community. However, it follows from my earlier findings that I do not consider that the opponent has even established a reputation in the UK in the mark FRUIT FUSIONS (solus). The substantiating exhibits are not in my view well directed towards establishing the position at the material date in these proceedings. On a plain reading of the evidence the marks that have been placed before the public are Clairol, Herbal Essences and device and Fruit Fusions (in combination). The evidence does not establish that the latter has acquired independent recognition and reputation with consumers.

59. Although my finding that the opponent has failed to establish the requisite reputation in FRUIT FUSIONS effectively determines the matter, I should for the sake of completeness briefly refer to the nature of the claim made by the opponent in relation to unfair advantage/detriment. The following is taken from the statement of grounds:

“....., it is submitted that detriment will be cause to the Opponent of the kind outlined in the loaded case (*IPC Magazines Limited v Verluci [sic] Designs Limited* – Decision of the Appointed Person Simon Thorley QC of 22

September 2000). In this respect, registration of UK trade mark number 2370346 EVIAN FRUIT FUSIONS will inhibit the opponent's ability to trade in this product area in the future. The cross-over between these two product sectors has been explained above, where indeed Evian have already made a move into class 3 from their existing class 32 activities. Similarly, the opponent may wish to diversify into class 32 products such as water and fruit juices etc which is in keeping with the health/vitality product which they are currently producing in class 3. As the public has become educated that health and vitality depends not only on the cosmetic and toiletry products that we use but also on the food and drinks that we consume, it is submitted that such diversification between these two product sectors will become increasingly common."

60. As I have explained above, I accept certain of the opponent's submissions in relation to brand extension activity, the use of vitamins, nutrients etc in cosmetics, the use of similar items in Class 32 drinks and a general interest on the part of manufacturers and consumers in healthy lifestyle issues. What I do not accept is that the evidence establishes a cross-over trade, as the opponent calls it, between Class 3 and Class 32 goods. There is little, if any, evidence to show that trade practices and related branding would have influenced consumers to expect developments in trade of the kind argued for by the opponent by the material date in these proceedings.

61. The opponent's written submissions develop the inhibition of trade argument by reference to the *IPC Magazines (Loaded)* case. The opponent is correct to say that inhibition was argued in that case though I note that even then it was accepted to be a novel point (see paragraph 58 of the decision). Mr Thorley's eventual findings in that case appear to be based upon the heads of damage referred to in the plain words of the statute rather than inhibition or fettering as such (see paragraphs 63 and 64 of the decision).

62. There is a further point here in relation to the standard of the test to be applied. In *Spa Monopole, compagnie fermière de Spa SA/NV v OHIM*, Case T67/04 the CFI said:

"40. The Court notes, as a preliminary point, that the purpose of Article 8(5) of Regulation No 40/94 is not to prevent registration of any mark which is identical with a mark with a reputation or similar to it. The objective of that provision is, notably, to enable the proprietor of an earlier national mark with a reputation to oppose the registration of marks which are likely either to be detrimental to the repute or the distinctive character of the earlier mark, or to take unfair advantage of that repute or distinctive character. In that connection, it should be made clear that the proprietor of the earlier mark is not required to demonstrate actual and present harm to his mark. He must however adduce prima facie evidence of a future risk, which is not hypothetical, of unfair advantage or detriment."

63. Thus, whilst it is not necessary to demonstrate actual harm (this will not be possible if the mark under attack is as yet unused), the Section is concerned with protecting existing rights not prospective or hypothetical developments in trade that a trade mark proprietor may lay claim to. The opponent's case here seems to me to be based on just such a hypothetical claim. Finally, I note that unlike the *Loaded* case where a relatively strong mark was involved, the opponent bases its case on a mark that has at best only a modest claim to distinctiveness. The area of protection accorded to such a mark must be similarity restricted. For all these reasons the opposition also fails under Section 5(3).

COSTS

64. The applicant is entitled to a contribution towards its costs. I order the opponent to pay the applicant the sum of £1300. This sum is 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 27th day of February 2007

**M REYNOLDS
For the Registrar
The Comptroller General**