

O/0831/25

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00004132597  
IN THE NAME OF NOOSH BRAND HOLDINGS LTD.  
TO REGISTER:



AS A TRADE MARK

IN CLASS 32

AND

IN THE MATTER OF FAST-TRACK OPPOSITION THERETO  
UNDER NO. 600003601  
BY LA COSTE DISTRIBUTION

## BACKGROUND AND PLEADINGS

1. On 03 December 2024, NOOSH Brand Holdings Ltd. (“the applicant”) applied to register the trade mark shown on the cover page of this decision, in the UK. The application includes the following mark description:

*“Mark Description/Limitation: the logo contains the company name NOOSH. On the logo the two “o”s are joint. The logo has a very thin rim.”*

2. The mark was accepted and published in the Trade Marks Journal on 13 December 2024, in respect of the following goods:

**Class 32:** *Non-alcoholic beverages; Non-alcoholic beverages flavoured with coffee.*

3. On 11 February 2025, the application was opposed in full under the fast-track procedure by LA COSTE DISTRIBUTION (“the opponent”). The opposition is brought under Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”) with the opponent relying on the following trade mark and all of the goods covered by the same, as shown below:

UK00003971254

NOOH

Filing date: 24 October 2023

Priority date: 19 October 2023<sup>1</sup>

Registration date: 19 January 2024

**Class 32:** *Alcohol free wine ; Non-alcoholic beverages; Aperitifs, non-alcoholic; Cocktails, non-alcoholic; Preparations for making non-alcoholic beverages; Fruit-based beverage; Vegetable drink; Smoothies; Non-alcoholic fruit juice beverages; Juices; Non-alcoholic beverages containing vegetable juices ; Fruit nectars, non-*

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<sup>1</sup> European Union Intellectual Property Office (Euiipo) 018939681

*alcoholic ; Vegetable juices [beverages]; Waters ; Flavoured waters; Aerated water; Carbonated non-alcoholic drinks ; Soya-based beverages, other than milk substitutes; Beers and non-alcoholic beers; Ales; Shandy; Syrups for beverages.*

4. By virtue of its earlier filing date, the above registration constitutes an earlier mark within the meaning of Section 6 of the Act. As the earlier mark had not completed its registration process more than five years before the filing date of the application in issue, it is not subject to the use provisions contained in Section 6A of the Act. The opponent can, therefore, rely upon all of the goods it has identified without having to demonstrate genuine use.

5. The opponent submits that the marks are highly similar and that the competing goods are identical or similar leading to a likelihood of confusion.

6. The applicant filed a counterstatement in which it denied the claims. It states:

*“The mark NOOSH contains an additional letter “S,” which materially alters both its spelling and overall appearance compared to NOOH. When spoken, NOOSH includes the “SH” sound at the end, whereas NOOH ends with an “H” or silent breath sound. The UK average consumer is capable of perceiving and articulating these distinct endings. Our mark, NOOSH, is used in relation to caffeinated drinks. The Opponent’s mark, NOOH, is associated with low alc/non-alcoholic wine. These two sets of products differ substantially in taste profile, consumer purpose, and method of consumption. Caffeinated beverages (commonly classified in Class 30 or 32) do not compete with, nor complement, non-alcoholic wine (generally in Class 33). The primary function, usage, and target consumer base of these goods are clearly distinct. Under Section 5(2)(b) of the Trade Marks Act 1994, the question is whether there is a likelihood of confusion on the part of the public. Given the marked differences in both the marks and the goods, no reasonable consumer would mistake a caffeinated drink for a low alc/non-alcoholic wine. These products do not complement one another in use, nor are they typically marketed in joint promotions. They serve very different consumption occasions, further negating any claim of confusion or association.”*

7. Rule 6 of the Trade Marks (Fast Track Opposition) (Amendment) Rules 2013, S.I. 2013 2235, disapplies paragraphs 1-3 of Rule 20 of the Trade Mark Rules 2008, but provides that Rule 20(4) shall continue to apply. Rule 20(4) states that:

“(4) The registrar may, at any time, give leave to either party to file evidence upon such terms as the registrar thinks fit.”

8. The net effect of these changes is to require the parties to seek leave in order to file evidence in fast-track oppositions. No leave was sought by either party.

9. The applicant is unrepresented, and the opponent is represented by Forrester IP LLP. Rule 62(5) (as amended) states that arguments in fast-track proceedings shall be heard orally only if (i) the Office requests it or (ii) either party to the proceedings requests it and the registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost; otherwise, written arguments will be taken. A hearing was neither requested nor considered necessary and neither party filed written submissions in lieu. This decision is taken following a careful consideration of the papers.

### **Relevance of EU Law**

10. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, Section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

### **DECISION**

#### **Section 5(2)(b)**

11. Section 5(2)(b) of the Act reads as follows:

“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.”

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

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing

in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings to mind the earlier mark, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

### **Comparison of goods**

13. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. In the judgment of the

Court of Justice of the European Union (“CJEU”) in *Canon*, Case C-39/97, the court stated at paragraph 23 that:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary.”

14. Guidance on this issue has also come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and, in particular, whether they are or are likely to be found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance, whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

15. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity

between goods. In *Boston Scientific Ltd v OHIM*, Case T-325/06, the General Court (“GC”) stated that “complementary” means:

“[...] there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking.”

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

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

17. Whilst on the other hand:

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

18. In *Gérard Meric v OHIM*, Case T- 133/05, the GC stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut fur Lernsysteme v OHIM- Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or

where the goods designated by the trade mark application are included in a more general category designated by the earlier mark.”

19. The competing goods are as follows:

<b>The applicant’s goods</b>	<b>The opponent’s goods</b>
<p><b>Class 32:</b> <i>Non-alcoholic beverages; Non-alcoholic beverages flavoured with coffee.</i></p>	<p><b>Class 32:</b> <i>Alcohol free wine; Non-alcoholic beverages; Aperitifs, non-alcoholic; Cocktails, non-alcoholic; Preparations for making non-alcoholic beverages; Fruit-based beverage; Vegetable drink; Smoothies; Non-alcoholic fruit juice beverages; Juices; Non-alcoholic beverages containing vegetable juices ; Fruit nectars, non-alcoholic ; Vegetable juices [beverages]; Waters ; Flavoured waters; Aerated water; Carbonated non-alcoholic drinks ; Soya-based beverages, other than milk substitutes; Beers and non-alcoholic beers; Ales; Shandy; Syrups for beverages.</i></p>

20. One of the points raised by the applicant in its counterstatement is that their mark ‘NOOSH’ is used in relation to caffeinated drinks, whereas the opponent’s mark ‘NOOH’ is associated with low alcoholic/non-alcoholic wine. The opponent argues, essentially, that the goods offered by the parties belong to different markets, and that no reasonable consumer would mistake a caffeinated drink for a low alcoholic/non-alcoholic wine. Such an argument is not pertinent. The comparison of the goods under Section 5(2)(b) must be conducted based on the goods as they are registered and applied-for respectively, and the particular segment of the market in which the parties have so far chosen to trade is irrelevant. Consequently, I must include consideration of the likelihood of confusion if both parties (and their successors in title to the marks)

decide to target the same segment of the market. Therefore, the fact that the parties are currently, or currently intend to, target different market segments is irrelevant where the goods at issue are fundamentally the same or similar.

21. The applied-for goods in class 32 are *Non-alcoholic beverages; Non-alcoholic beverages flavoured with coffee*. The opponent's goods include *Non-alcoholic beverages* at large which is not restricted to any type of beverage, and it is sufficiently broad to encompass all of the applied-for goods. The goods are identical on the principle outlined in *Meric*.

### **Average consumer**

22. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective goods. I must then determine the manner in which the goods are likely to be selected by the average consumer. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. (as he then was) described the average consumer in these terms:

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

23. The average consumer for the goods at issue is a member of the general public. Such goods are every day or regular purchases where the level of care and attention is not higher than average (i.e. medium). The purchasing act is predominantly visual in nature with the products being selected from the shelf in a shop or the online equivalent, however, I do not rule out that aural considerations may play a part in some circumstances, for example, where a drink is ordered at a bar. Nevertheless, even in


such circumstances, visual considerations remain important because the consumer is still likely to visually select the drink from a display of bottles or cans before ordering.

### Comparison of marks

24. 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.”

25. 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. The respective marks are shown below:

The applied-for mark	The opponent's mark
	NOOH

## **Overall impression**

26. The opponent's mark is a word-only mark consisting of the word 'NOOH' presented in capital letters. This is where the overall impression of the mark resides.

27. The applied-for mark is a figurative mark consisting of the word 'NOOSH' presented in lower-case letters in a slightly stylised typeface with the two 'OO' in the middle marginally overlapping. The word 'noosh' is placed within an off-white circle. Whilst the word itself is the most dominant and distinctive element of the mark, both the stylisation of the letters and the circle still play a role in its overall impression, however, this is minimal because the stylisation is not striking, and the circle is banal.

## **Visual similarity**

28. In making the visual comparison between the marks in issue, I remind myself that notional use of the opponent's mark is not limited to its use in upper-case letters, because a word-only mark covers use in all possible fonts and typefaces. Consequently, I must include consideration of the visual similarity if the opponent's mark was presented in the same font and case as those used in the applied-for mark. However, since the overlapping 'OO' in the applicant's mark go beyond notional use of the opponent's mark, I must take this difference into account.

29. The dominant and distinctive elements of the marks, namely the words 'NOOSH' and 'NOOH' coincide in the first three letters 'NOO-' and in the last letter 'H'. Although the marks have different lengths, being five and four letter long respectively, this does not make a striking impression because the two 'OO' in the middle of the applied-for mark are slightly squeezed, reducing the impact of the length added by the supplementary letter 'S'. Furthermore, the fact that the additional letter 'S' in the applied-for mark appears in the middle of the mark further reduces its visual impact. Overall, I consider these elements of the marks to be visually similar to a medium to high degree. The presence of the circle and the stylisation are banal and do not materially reduce the medium to high degree of visual similarity which I find to exist between the marks.

### **Aural similarity**

30. Aurally, the marks will be pronounced as 'NOO-SCH' (the applied-for mark) and 'NOO-U' (the opponent's mark). Overall, I consider the marks to be aurally similar to a medium degree.

### **Conceptual similarity**

31. Conceptually, neither mark has any meaning (as it has not been submitted otherwise). Therefore, the conceptual position is neutral.

### **Distinctive character of the earlier mark**

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

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of

commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

33. Registered trade marks possess various degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use made of it.

34. The earlier mark consists of the words ‘NOOH’. The word ‘NOOH’ is an invented word which does not evoke any concept. I consider the mark to be distinctive to a high degree.

#### **Likelihood of confusion**

35. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind, including that a lesser degree of similarity between the respective marks may be offset by a greater degree of similarity between the respective goods and vice versa. I must keep in mind the distinctive character of the earlier mark, the average consumer for the goods and the nature of the purchasing process. I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between marks and must instead rely upon the imperfect picture of them that they have retained in their mind.

36. Earlier in this decision I found that:

- The marks are visually similar to a medium to high degree, aurally similar to a medium degree and conceptually neutral.
- The goods are identical.
- The goods will be selected visually with an average degree of attention, although aural considerations cannot be discounted completely.
- The earlier mark is distinctive to a high degree.

37. I consider that given the identity of the goods and the high distinctive character of the earlier mark, and in the absence of any conceptual hook in relation to the earlier mark upon which the memory could hang, the medium to high degree of visual similarity between the marks is sufficient to cause the average consumer to directly confuse them. In reaching this conclusion, I bear in mind that the dominant and distinctive elements of the marks, namely the words 'noosh' and 'nooh' are of nearly equal length, consisting of five and four letters respectively, and as it is obvious the first three and the last letters of each of the marks are the same, including the double 'oo' vowel in the centre of the words. I have also taken account of the fact that the letter 'S' in the mark applied for is a point by which it differs from the earlier mark; however, this difference has more impact aurally than visually because the identical letter 'H' at the end of both marks is not verbalised. Nevertheless, this is not fatal for the opponent as the goods are selected mainly visually and one can easily foresee the marks being confused in the imperfect recollection of the average consumer.

38. There is a likelihood of direct confusion. The opposition succeeds under Section 5(2)(b) in its entirety.

## **OUTCOME**

39. The opposition is successful, and the application is refused registration.

## **COSTS**

40. The opponent has been successful and is, therefore, entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 1/2023 which governs costs in Fast Track proceedings issued after 1 February 2023. In the circumstances, I award the opponent the sum of £350.00 as a contribution towards the costs of proceedings. The sum is calculated as follows:

Filing a notice of opposition and considering the  
Applicant's counterstatement: £250.00  
Official fee: £100.00  
Total: £350.00

41. I therefore order NOOSH Brand Holdings Ltd. to pay LA COSTE DISTRIBUTION the sum of £350. This sum is to be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 10<sup>th</sup> day of September 2025

TERESA PERKS

For the Registrar