

**O/0944/25**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. 3957144**

**IN THE NAME OF THE LIONS PREP LTD  
TO REGISTER THE FOLLOWING TRADE MARK:**

**FRIVE**

**IN CLASS 32**

**AND**

**IN THE MATTER OF OPPOSITION THERETO**

**UNDER NO. 445097**

**BY**

**SUMOL+COMPAL MARCAS, S.A.**

## **Background and pleadings**

1. The Lions Prep Ltd (“the applicant”) applied to register the trade mark FRIVE in the UK on 15 September 2023, application no. UK00003957144. It was accepted and published in the Trade Marks Journal on 6 October 2023 in respect of the following goods:

Class 32 - Non-alcoholic beverages; mineral and aerated waters; carbonated drinks; fruit beverages and fruit juices; flavoured water and flavoured drinks; vegetable and fruit smoothies; nutritionally fortified beverages; beverages containing vitamins; non-medicated drinks containing nutrients; powders for the preparation of beverages.

2. On 5 January 2024, SUMOL+COMPAL MARCAS, S.A. (“the opponent”) opposed the application in full under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent relies on the following International Registration (“IR”), FRIZE, IR number: WO00000760025 for the following goods:

Class 32 – Water

3. The opponent’s mark was registered on 8 June 2001 and, with effect from the same date, the opponent designated the UK as a territory in which it seeks to protect its mark under the terms of the Protocol of the Madrid Agreement. Protection was granted on 11 July 2002. The opponent’s mark is derived from an earlier trade mark registered by the opponent in Portugal. As such, the opponent’s mark benefits from an earlier priority date of 18 January 2001, being the filing date of the opponent’s Portuguese mark.

4. The IR relied upon by the opponent qualifies as an ‘earlier mark’ in accordance with section 6 of the Act. It had been registered for more than five years at the filing date of the applicant’s mark and is, therefore, subject to the proof of use requirements in section 6A of the Act.

5. Under section 5(2)(b) of the Act, the opponent claims that there is a likelihood of confusion on the basis that the marks are similar, and the goods are either identical or highly similar leading to a likelihood of confusion, including a likelihood of association, and that the contested mark should be refused registration.

6. The applicant filed a counterstatement denying the claims made and requesting that the opponent provides proof of use of its earlier trade mark relied upon. The applicant submits as follows:

“The marks cannot be described as highly similar and would struggle to be considered as similar as the opponent contends given the various distinctive differences...the applicant submits that the average consumer of the goods covered by the applicant’s mark and the opponent’s mark are not identical nor are they considered to be similar”.

### **Representation**

7. The opponent is represented by Pinsent Masons LLP and the applicant is represented by Stephens Scown LLP. Only the opponent filed evidence in these proceedings, however, the applicant filed submissions in reply. No hearing was requested and neither party filed additional submissions in lieu of a hearing. This decision is taken following a careful consideration of the papers filed.

### **Evidence and Submissions**

8. The opponent’s evidence consists of the witness statement of Mr Diogo Carlos Tição dos Santos Pereira Dias, dated 21 October 2024, which is accompanied by eight exhibits (FR01 – FR08). Mr Tição dos Santos Pereira Dias is the CEO of the opponent and he provides evidence of use of the IR as relied upon. I have read Mr Tição dos Santos Pereira Dias’s evidence in its entirety and have summarised the most pertinent points below.

9. The applicant has filed written submissions during the evidence rounds dated 5 March 2025.

10. I have given due consideration to all of the documents filed by both parties but will only refer to the evidence/submissions as appropriate to the extent that is necessary in my decision.

## **DECISION**

11. 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.

### **Proof of use**

12. The relevant statutory provisions are as follows:

“6A(1) This section applies where:

- (a) an application for registration of a trade mark has been published,
- (b) there is an earlier trade mark of a kind falling within section 6(1)(a), (aa) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and
- (c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

(1A) In this section “the relevant period” means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

(a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes –

a) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5)-(5A) [Repealed]

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.”

13. Section 100 of the Act is also relevant, which reads:

“If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

14. The relevant period for assessing genuine use is the five-year period ending with the filing date of the application in issue, i.e. 16 September 2018 to 15 September 2023. I note that the opponent has filed evidence outside of the relevant periods. I will

not consider this and will only consider evidence which is dated within the relevant periods.

15. In *easyGroup Ltd v Nuclei Ltd & Ors* [2023] EWCA Civ 1247, Arnold LJ summarised the law relating to genuine use as follows:

“105. The principles applicable to determining whether there has been genuine use of a trade mark have been considered by the CJEU in a considerable number of cases, the principal decisions being Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159, Case C-416/04 *P Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bunderversvereinigung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], Case C-141/13 *P Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089], Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434] and Joined Cases C-720/18 and C-721/18 *Ferrari SpA v DU* [EU:C:2020:854].

106. Ignoring issues which do not arise in the present case, such as use in relation to spare parts or second-hand goods and use in relation to a sub-category of goods or services, the principles may be summarised as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29]; *Ferrari* at [32].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer

or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29]; *Gözze* at [37], [40]; *Ferrari* at [32].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56]; *Ferrari* at [33].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed

to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

16. In *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*, Case BL O/404/13, Mr Geoffrey Hobbs QC (as he then was), sitting as the Appointed Person stated that:

“22. When it comes to proof of use for the purpose of determining the extent (if any) to which the protection conferred by registration of a trade mark can legitimately be maintained, the decision taker must form a view as to what the evidence does and just as importantly what it does not ‘show’ (per Section 100 of the Act) with regard to the actuality of use in relation to goods or services covered by the registration. The evidence in question can properly be assessed for sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use.”

17. What I take from this case law is that there is no requirement to produce any specific form of evidence, but that I must consider what the evidence as a whole shows me, and whether on this basis I can reasonably be satisfied on the balance of probabilities that there has been genuine use of the contested mark.

#### The Opponent’s Evidence

18. In his witness statement, Mr Tição dos Santos Pereira Dias states that the company has origins since 1945, and began producing products bearing the IR, FRIZE, for sparkling water in a range of favours in 1994. Mr Tição dos Santos Pereira

Dias has provided print outs from the FRIZE website<sup>1</sup> which provides the background to the brand and shows the mark displayed on bottled water in a figurative form as follows:



However, whilst these print outs are undated, they include a copyright date of 2022.

19. Mr Tição dos Santos Pereira Dias has provided print outs from the opponent's English 2023 catalogue<sup>2</sup> showing FRIZE products on sale for UK distributors and sales partners, alongside other brands within the SUMOL+COMPAL MARCAS group. There are no details of how this brochure was distributed or to how many consumers, however, I note that he says that the company has five major UK partners who sell the products within the UK.

20. Mr Tição dos Santos Pereira Dias has provided a selection of invoices showing goods under the mark being sent to its UK distributors dated between 25 August 2020 and 22 February 2024<sup>3</sup>, however, 8 of these invoices fall outside the relevant period being dated after 15 September 2023.

21. I note the following:

- a. Mr Tição dos Santos Pereira Dias states that the invoices provided do not represent the total sales in the UK but represent a sample of sales in the years 2020-2024<sup>4</sup>.
- b. In total, these invoices amount to €668,997.74 of sales, however, I note that this figure includes sales of other products within their range.

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<sup>1</sup> Exhibit FR01

<sup>2</sup> Exhibit FR02

<sup>3</sup> Exhibit FR04

<sup>4</sup> Witness statement of Mr Tição dos Santos Pereira Dias, para 12

- c. All of the invoices display Sumol+Compal in the header. I note that the products sold relate to various brands within the Sumol+Compal Marcas company and are not solely in relation to sales of FRIZE.
- d. Mr Tição dos Santos Pereira Dias states that the opponent has five major UK partners (Atlantico (UK) Limited, Portugalia Wines (UK) Ltd, Viserra Limited, Requite Brazil Import & Xport Limited and Markimeld Ltd) who sell products bearing the FRIZE mark within the UK, and that the invoices confirm the goods are to be delivered to a number of addresses across Croydon and London.
- e. The invoices appear to include a range of flavours within the FRIZE range which reflect those set out in the remainder of the evidence (Original, Limão, Lima Pepino Gengibr, Groselha, Maracujá, Tangerina and Água Tônica Zimbro).

22. Mr Tição dos Santos Pereira Dias states that FRIZE products are also available in various online shopping websites in the UK through both the 5 UK partners as referred to, as well as through independent retailers, and undated screenshots are produced (save for an access date of 17 October 2024)<sup>5</sup>. I note that a number of the companies appear to be distributors and therefore, whilst the goods have predominantly been shipped to businesses across London, these goods may then be distributed onwards throughout the UK.

23. Mr Tição dos Santos Pereira Dias has provided photographs of the FRIZE products on shelves within Delicias' stores in London<sup>6</sup>. I understand that these photographs were collated in 2022. Data has been provided pertaining to each photograph, including the date it was taken and its location.

24. Mr Tição dos Santos Pereira Dias confirms the following turnover figures for the opponent from 2018 to 2023:

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<sup>5</sup> Exhibit FR06

<sup>6</sup> Exhibit FR05

Year	Amount
2023	EUR 371,5 million
2022	EUR 337,9 million
2021	EUR 262,5 million
2020	EUR 227,8 million
2019	EUR 300,1 million
2018	EUR 299,7 million

This information is supported by the opponent's 2022/2023 annual report<sup>7</sup>.

25. Mr Tição dos Santos Pereira Dias produces UK revenue figures for FRIZE goods from 2019 to 2024 which are as follows:

Year	Net value of FRIZE products sold
Until 09.2024	EUR 14.105
2023	EUR 15.235
2022	EUR 15.645
2021	EUR 14.451
2020	EUR 9.863
2019	EUR 11.073

This amounts to €66,268 within the relevant period.

### **Form of the mark in use**

26. Before I move on to assess the sufficiency of the evidence, I shall begin by addressing the way in which the contested mark has been displayed in relation to the relevant goods in evidence.

27. In *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12, which concerned the use of one mark with, or as part of, another mark, the Court of Justice of the European Union found that:

“31. It is true that the ‘use’ through which a sign acquires a distinctive character under Article 7(3) of Regulation No 40/94 relates to the period before its registration as a trade mark, whereas ‘genuine use’, within the meaning of Article 15(1) of that regulation, relates to a five-year period following registration and,

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<sup>7</sup> Exhibit FR08

accordingly, 'use' within the meaning of Article 7(3) for the purpose of registration may not be relied on as such to establish 'use' within the meaning of Article 15(1) for the purpose of preserving the rights of the proprietor of the registered trade mark.

32. Nevertheless, as is apparent from paragraphs 27 to 30 of the judgment in *Nestlé*, the 'use' of a mark, in its literal sense, generally encompasses both its independent use and its use as part of another mark taken as a whole or in conjunction with that other mark.

33. As the German and United Kingdom Governments pointed out at the hearing before the Court, the criterion of use, which continues to be fundamental, cannot be assessed in the light of different considerations according to whether the issue to be decided is whether use is capable of giving rise to rights relating to a mark or of ensuring that such rights are preserved. If it is possible to acquire trade mark protection for a sign through a specific use made of the sign, that same form of use must also be capable of ensuring that such protection is preserved.

34. Therefore, the requirements that apply to verification of the genuine use of a mark, within the meaning of Article 15(1) of Regulation No 40/94, are analogous to those concerning the acquisition by a sign of distinctive character through use for the purpose of its registration, within the meaning of Article 7(3) of the regulation.

35. Nevertheless, as pointed out by the German Government, the United Kingdom Government and the European Commission, a registered trade mark that is used only as part of a composite mark or in conjunction with another mark must continue to be perceived as indicative of the origin of the product at issue for that use to be covered by the term 'genuine use' within the meaning of Article 15(1)." (emphasis added)

Further, in *Lactalis McLelland Limited v Arla Foods AMBA*, BL O/265/22, Phillip Johnson, sitting as the Appointed Person, considered the correct approach to the test under s. 46(2). He said:

“13. [...] While the law has developed since *Nirvana* [BL O/262/06], the recent case law still requires a comparison of the marks to identify elements of the mark added (or subtracted) which have led to the alteration of the mark (that is, the differences) (see for instance, T-598/18 *Grupo Textil Brownie v EU\*IPO*, EU:T:2020:22, [63 and 64]).

14. The courts, and particularly the General Court, have developed certain principles which apply to assess whether a mark is an acceptable variant and the following appear relevant to this case.

15. First, when comparing the alterations between the mark as registered and used it is clear that the alteration or omission of a non-distinctive element does not alter the distinctive character of the mark as a whole: T-146/15 *Hypen v EUIPO*, EU:T:2016:469, [30]. Secondly, where a mark contains words and a figurative element the word element will usually be more distinctive: T-171/17 *M & K v EUIPO*, EU:T:2018:683, [41]. This suggests that changes in figurative elements are usually less likely to change the distinctive character than those related to the word elements.

16. Thirdly, where a trade mark comprises two (or more) distinctive elements (eg a house mark and a sub-brand) it is not sufficient to prove use of only one of those distinctive elements: T-297/20 *Fashioneast v AM.VI. Srl*, EU:T:2021:432, [40] (I note that this case is only persuasive, but I see no reason to disagree with it). Fourthly, the addition of descriptive or suggestive words (or it is suppose figurative elements) is unlikely to change the distinctive character of the mark: compare, T-258/13 *Artkis*, EU:T:2015:207, [27] (ARKTIS registered and use of ARKTIS LINE sufficient) and T-209/09 *Alder*, EU:T:2011:169, [58] (HALDER registered and use of HALDER I, HALDER II etc sufficient) with R 89/2000-1 CAPTAIN (23 April 2001) (CAPTAIN registered and use of CAPTAIN BIRDS EYE insufficient).

17. It is also worth highlighting the recent case of T-615/20 *Mood Media v EUIPO*, EU:T:2022:109 where the General Court was considering whether the use of various marks amounted to the use of the registered mark MOOD MEDIA. It took the view that the omission of the word “MEDIA” would affect the

distinctive character of the mark (see [61 and 62]) because MOOD and MEDIA were in combination weakly distinctive, and the word MOOD alone was less distinctive still.”

28. The contested mark is a word only mark presented in upper case. Given that normal and fair use of the registration will cover use in any standard typeface or font, where the mark is used in capitals or title case this is use of the mark as registered and is use upon which the registered proprietor may rely. The mark is also shown as follows throughout the evidence:



29. The above variation is a figurative mark in which the word FRIZE is presented in green font. This variation also includes bubbles rising off the letter 'I' with mountains below the word, FRIZE, and the words 'VILA FLOR' below the mountains. I consider that the use of a different colour, the bubbles and mountains do not detract from the word itself, which is the larger / dominant element of the device, and will merely be seen as stylistic elements. The words VILA FLOR, which appear in considerably smaller font beneath the other elements, will not be understood by the average UK consumer as they are Portuguese. I consider that the word FRIZE remains the distinctive element of the figurative mark, and that this figurative form is therefore an acceptable variation of the mark and is use upon which the opponent can rely.

### **Sufficient Evidence**

30. An assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself<sup>8</sup>.

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<sup>8</sup> *New Yorker SHK Jeans GmbH & Co KG v OHIM*, T-415/09

31. The evidence is not without its limitations. For example, whilst marketing brochures have been provided, there are no details as to the spend on marketing activities to promote the mark within the UK or the opponent's marketing strategy. There are also no details in relation to the size of the relevant market or the share of that market held by goods bearing the opponent's mark. I also note that much of the evidence before me relates to the SUMOL+COMPAL group as a whole which includes other brands within their range, and not specifically to FRIZE products. That being said, FRIZE products are present in all of the invoices supplied, and I note the opponent's comments that those invoices submitted as evidence are not representative of all UK sales, but it is clear that the products are regularly being distributed to the UK as evidenced by the repeat sales. The revenue figures for FRIZE goods from 2019 to 2023 illustrate that sales of FRIZE products during this time remain relatively consistent (albeit I note a dip in sales in 2020, which is likely attributable to the COVID global pandemic). Taking the evidence as a whole into account, I am satisfied that the opponent has provided sufficient evidence of genuine use of its IR in the UK in relation to water.

## **Decision**

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

32. Section 5(2)(b) of the Act is as follows:

“5(2) A trade mark shall not be registered if because-

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark”.

33. Section 5A of the Act states as follows:

“Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

## Relevant law

34. The following principles are gleaned from the decisions of the Court of Justice of the European Union (“CJEU”) 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 C120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

### The principles

- (a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;
- (b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
- (d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;
- (e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

- (f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;
- (g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;
- (h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;
- (i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;
- (j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;
- (k) if the association between the marks creates a risk that the public 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**

35. The competing goods are shown in the table below:

<b>The contested mark</b>	<b>The IR</b>
Class 32 - Non-alcoholic beverages; mineral and aerated waters; carbonated drinks; fruit beverages and fruit juices; flavoured water and flavoured drinks; vegetable and fruit smoothies; nutritionally fortified beverages; beverages containing vitamins; non-medicated drinks containing nutrients;	Class 32 - Water

powders for the preparation of beverages.	
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36. When making the comparison, all relevant factors relating to the goods in the specifications should be taken into account, as per *Canon*, where the CJEU stated at paragraph 23 of its judgement:

“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.”

37. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- (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.

38. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court (“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 für 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.”

39. I bear in mind that it is permissible to group goods together for the purposes of the assessment<sup>9</sup>.

#### Class 32

40. The opponent submits that “there is an undeniable likelihood of confusion between the opponent’s earlier mark on the one hand and the Application on the other with respect to the goods for which registration is sought under the Application”.

41. The applicant submits “all the goods which the Application seeks to protect, besides ‘Mineral and aerated waters’, are inherently different from ‘Water’ as they contain various ingredients which easily distinguish them from each other. This, alongside the differences in the marks outlined in the Applicant’s Defence and Counterstatement, eradicates any likelihood of confusion.”

*Mineral and aerated waters;*

42. The aforementioned goods in the applicant’s specification are types of water which are self-evidently identical or fall within the broader category of *water* in the opponent’s specification in class 32. The goods are, therefore, identical on the principle outlined in *Meriç*.

*Non-alcoholic beverages; carbonated drinks; flavoured water and flavoured drinks;*

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<sup>9</sup> *Separode Trade Mark O/399/10*

43. These goods in the applicant's specification are all examples of non-alcoholic drinks. I note that the opponent's specification includes *water* in class 32. The aforementioned goods in the applicant's specification can include types of water which are self-evidently identical or fall within the broader category of *water* in the opponent's specification in class 32 or vice versa. The goods are, therefore, identical on the principle outlined in *Meric*. If I am wrong about that, I consider that the nature of these goods and those of the IR overlap insofar as they are all non-alcoholic beverages. The respective goods are all consumed to quench thirst or hydrate and, as such, they have the same purpose. Further, the method of use for the respective goods is the same, namely, that they will all be consumed by mouth. The respective goods will also share end users, being those who are seeking refreshment from a beverage. The trade channels through which the respective goods reach the market will also overlap as they are all sold in supermarkets and other retail outlets, whereby the goods will be self-selected by consumers. The applicant's goods are likely to be located in the same section of those outlets as the opponent's goods, though I note that this is not without exception. The respective goods are neither important nor indispensable to the use of one another and, thus, are not complementary. However, given the respective goods are all non-alcoholic beverages and have the same intended purpose, I consider them to be in competition; for example, a consumer seeking refreshment may select water over a carbonated flavoured beverage, and vice versa. In light of the above, I consider the respective goods to be similar to between a medium and high degree.

*Vegetable and fruit smoothies; nutritionally fortified beverages; beverages containing vitamins; non-medicated drinks containing nutrients; fruit beverages and fruit juices;*

44. The applicant's above terms comprise of drinks that are fruit, vegetable, or nutritionally fortified drinks. The opponent's specification in class 32 includes the term *water*. The primary purpose of the applicant's goods is to quench thirst, and they may also be consumed in order to obtain important nutrients, including vitamins, whereas the opponent's goods will predominantly be purchased to quench thirst or rehydrate. There may be an overlap in users and the goods will be sold in the same retail outlets, within close proximity to each other. There is competition between them, but they are not complementary. I find that they are similar to a medium degree.

*Powders for the preparation of beverages.*

45. The applicant's above term includes preparations for making beverages. They are typically diluted with water or other liquid to create either still or carbonated drinks. As they are not finished drink products, the nature of the goods differs from that of the opponent's goods. Therefore, the intended purpose of the respective goods is not entirely the same as the applicant's goods are for making beverages, while the opponent's goods are to provide refreshment or hydration. However, there is a degree of overlap when one considers the ultimate purpose of the applicant's beverage-making preparations. The respective goods have a different method of use: the opponent's goods are finished products which will be consumed by mouth, while some form of process is required before the applicant's goods are consumed. There is likely to be an overlap in the trade channels through which the goods reach the market as they are all typically sold in supermarkets and other retail outlets. The goods will all be self-selected by consumers, though in practice they are not likely to be on the same shelves. However, beverage-making preparations may be found nearby. Although the applicant's goods may be used to create beverages, the respective goods are not important or indispensable to one another in such a way that consumers would assume that they are from the same commercial undertaking. As such, they are not complementary. There is, however, a degree of competition between the goods as a consumer may select a finished product or purchase the applicant's goods in order to make the drink themselves. Balancing the similarities against the differences, I consider that the goods are similar to between a low and medium degree

#### **Average consumer and the purchasing act**

46. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' 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. 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 word “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

47. The applicant submits that:

“The average consumer of each party differs significantly. The applicant specialises in a UK based ready-to-eat meal and ready-to-drink beverage delivery subscription service. A subscription service requires the relevant consumer to be well-informed as it is more of a commitment than a one-off purchase. On the other hand, the Opponent is a soft drinks manufacturer and distributor. The Opponent’s mark features on their soft drinks which are primarily distributed outside of the UK. The Applicant and Opponent’s products will not be stocked at the same outlets and so will not feature side-by-side for any consumers to compare the two, Therefore, it is highly unlikely that both marks will be viewed in the same context by the relevant consumer”.

The assessment as to a likelihood of confusion is one to be taken on a notional and fair basis. Therefore, the fact that the applicant specialises in a subscription service does not have any bearing on this assessment. The assessment I must undertake under section 5(2)(b) must take into account only the contested mark, its specification, and any potential conflict with the IR, not the way in which the mark is being used in the marketplace.

48. The goods at issue are all beverages or preparations. The average consumer of the goods will be members of the general public. The goods are likely to be purchased relatively frequently for the purposes of refreshment. The purchasing act will not require an overly considered thought process as, overall, they are relatively inexpensive everyday purchases; the purchasing of the goods is likely to be more casual, however, I do accept that more careful consideration will be given to goods where the consumer is purchasing a nutritionally fortified drink, as they will give more careful consideration to nutritional value although not considerably so. In addition, the average consumer will consider factors such as the cost and taste of the goods as

they will wish to ensure that what they are purchasing to consume meets their individual requirements. Taking the above factors into account, I find that the level of attention of the general public in respect of these goods would be average (medium).

49. The goods are typically sold in supermarkets and convenience stores, where the goods are likely to be selected from shelves or chilled cabinets. In these circumstances, visual considerations would dominate. Beverages are also sold in restaurants and bars where there may be an oral component to the selection process, such as requests to bar and waiting staff. Even where the goods are ordered orally, the selection process would still be in the context of a visual inspection of a drinks list, for example, prior to the order being placed. Considered overall, I am of the view that the purchasing process would be predominantly visual in nature, though aural considerations will play their part.

### **Comparison of marks**

50. 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.”

51. It would be wrong, therefore, to dissect the trade marks artificially, 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.

52. The respective trade marks are shown below:

<b>The IR</b>	<b>Contested trade mark</b>
FRIZE	FRIVE

53. The opponent submits:

“7. The marks depicted in the application are visually and phonetically highly similar to the opponent’s earlier mark.

8. Visually, the respective marks are highly similar as they only differ by one letter. The opponent’s earlier mark and the mark depicted in the application each consist of 5 letters, with the first three letters and the last letter in the respective marks being identical.

9. Phonetically, the respective marks are also highly similar, insofar as the beginning and the ending of the respective marks (“FRI”) would be pronounced identically and the overall pronunciation of the respective marks would be similar in their intonation and flow.

10. Conceptually, neither the opponent’s earlier mark nor the mark depicted in the application have any meaning in the current English language. Consequently, the relevant public would likely perceive the respective marks as conceptually neutral”.

54. The applicant submits:

“11. Although both ‘FRIZE’ and ‘FRIVE’ consist of the same 4 letters, there is a significant difference between them. The difference being that the opponent’s mark makes use of the letter ‘Z’ and the applicant’s mark has a letter ‘V’. Such a difference creates a larger effect than the opponent admits.

12. The differing letters change the visual formation of the words entirely. ‘Z’ and ‘V’ are both letters that stand out to the relevant public when comparing the

respective marks...the letters 'Z' and 'V' are entirely different in shape and the average consumer would not mistake the letter 'V' for 'Z', or vice versa, thus reducing any likelihood of confusion between the respective marks.

13. Furthermore, it is vehemently denied that both marks are almost phonetically identical. The average consumer would pronounce the marks in different ways. The Opponent's assessment focuses solely on the beginning of the marks ("FRI") but fails to address the second half which includes the contrasting letters 'Z' and 'V'.

14. The addition of the letter 'V' in the applicant's mark alters the pronunciation of the mark in its entirety, especially when comparing to how one would pronounce the opponent's mark. It is clear that the applicant's mark is a play on word for "THRIVE", whereas the opponent's mark is attempting to sound similar to "FIZZ", further reducing the likelihood of confusion between the marks. This can be evidenced by the use of the opponent's mark on the website, "Frize. Shakes Things Up". As illustrated, the mark FRIVE (pronounced similarly to THRIVE) and FRIZE (pronounced similarly to FIZZ) are different and distinct phonetically"

### **Overall impression**

55. I note that the IR is a word only mark, 'FRIZE'. The contested mark is also a word only mark, 'FRIVE'. There are no additional elements to either mark and therefore the overall impression lies in the words themselves.

### **Visual comparison**

56. The competing marks both include words made up of five letters, four of which are the same and appear in the same order. The only difference in the words is that the fourth letter in the IR is a 'Z', whereas the fourth letter in the contested mark is a 'V'. A word trade mark protects the notional use of the word itself, irrespective of font, capitalisation or otherwise which means that either mark is capable of being presented in any typeface. Given that four out of five letters in the marks are the same, I consider that the respective marks are visually similar to between a medium and high degree.

## **Aural Impression**

57. Neither mark is an English dictionary word and therefore, to the average consumer, it is not clear how either will be pronounced. However, I consider that the IR will likely be pronounced as FRY-ZE, whereas the contested mark is likely to be pronounced as FRY-VE. I do not agree with the applicant's contention that the IR will be pronounced similarly to FIZZ. The point of aural overlap lies at the beginning of the word as this is the same in both marks<sup>10</sup>. The difference in pronunciation arises from the letter 'Z' as opposed to the letter 'V' in the second half of the words. Overall, I find between a medium and high degree of aural similarity between the marks.

## **Conceptual comparison**

58. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer, as highlighted in numerous judgments of the GC and the CJEU<sup>11</sup>.

59. I note that the applicant submits that their mark is "a play on the word for "THRIVE", whereas the opponent's mark is attempting to sound similar to "FIZZ"...this can be evidenced by the use of the opponent's mark on their website, "*Frize. Shakes things up*". In so far as these submissions regarding the mark in use, the claim under section 5(2)(b) and the assessment as to a likelihood of confusion is one to be taken on a notional and fair basis in relation to the marks as registered/applied for and not in fact how they are being used in the marketplace.

60. Conceptually, I consider that both marks will be perceived as invented words that have no meaning. I note that the applicant submits their mark is a play on words for "THRIVE", however, I do not consider that this would be understood by the majority of consumers. As neither mark has a meaning that is immediately graspable to the average consumer, the marks are conceptually neutral.

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<sup>10</sup> *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02, the GC noted that the beginnings of word tend to have more visual and aural impact than the ends.

<sup>11</sup> *Ruiz Picasso v OHIM* [2006] e.c.r.-I-643; [2006] E.T.M.R 29

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

61. 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).”

62. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods, to those with high inherent distinctive character, such as invented words which have no allusive qualities. In this instance, as acknowledged above, I consider FRIZE to be an invented word. It is neither descriptive nor allusive of the opponent's goods. Consequently, I find that the IR has a high degree of inherent distinctive character.

63. The distinctiveness of a mark can be enhanced by virtue of the use that has been made of it, and such enhanced distinctiveness may affect the likelihood of confusion between that mark and a later mark including the same, or a similar, element.

64. As discussed in detail above, the opponent filed a witness statement by Mr Tição dos Santos Pereira Dias to evidence its use of the IR in the UK during the relevant period, and evidencing sales to distributors in London and Croydon. Whilst I have determined that the opponent has provided sufficient evidence that it has used the IR in the UK during the relevant period, I note that there are limitations to the evidence, particularly that there are no details in relation to the size of the relevant market, which one would expect to be large, or the share of that market held by goods bearing the opponent's mark which makes it difficult for me to assess whether the scale of the use shown is sufficient for establishing enhanced distinctiveness. I also note that, save for one brochure published within the relevant dates, there is nothing in the way of promotional or marketing activity or expenditure and no evidence as to the distribution of the brochure or the opponent's marketing strategy. As noted, whilst I have found this evidence to be sufficient in respect of genuine use, I do not consider that it goes far enough to establish enhanced distinctiveness.

### **Conclusions on Likelihood of Confusion**

65. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods down to the responsible undertakings being the same or related.

66. 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. The first is the interdependency principle, i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the opponent's trade mark, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the

opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

67. I have found as follows:

- The goods at issue range from being identical either self-evidently or on the principles in *Meric* to having a low degree of similarity.
- I have identified that the average consumer will be members of the general public. They will select the goods primarily by visual means, although I do not discount an aural component;
- I have concluded that an average (medium) degree of attention will be paid;
- The contested mark is visually similar to the IR to between a medium and high degree;
- The contested mark is aurally similar to the IR to between a medium and high degree;
- I have found the contested mark and the IR to be conceptually neutral;
- I have found the IR overall to be inherently distinctive to a high degree;

68. Upon considering the above factors, and bearing in mind the principle of imperfect recollection, I consider the present case represents an example of direct confusion. I consider that the average consumer upon seeing the contested mark, FRIVE, is unlikely to recall the exact spelling of the IR, FRIZE. Given the between medium and high levels of similarity between the words both visually and aurally, and that both marks appear to be made up words, I consider that the consumer will overlook the difference created by the fourth letter of the mark, due to its position in the middle of the mark and the overlap in the remaining letters. Despite the respective marks being relatively short marks, and differences in short marks are more noticeable, the difference here is in the middle of the words which is likely to be swallowed up by the remaining letters. This is particularly so because consumers rarely have the opportunity to compare marks side by side. As a result, taking all the above into

account in the global assessment I consider that there exists a likelihood of direct confusion.

## **Conclusion**

69. The opposition succeeds in full and, subject to any successful appeal, the applicant's mark is refused.

## **Costs**

70. The opponent has been successful and is entitled to a contribution towards its costs in line with TPN 1/2023. In the circumstances I award the opponent the sum of £950 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Filing a notice of opposition and considering the applicant's counterstatement:	£250
Preparing evidence and considering the applicant's submissions	£600
Official fee:	£100
<b>Total:</b>	<b>£950.00</b>

71. I therefore order The Lions Prep Ltd to pay SUMOL+COMPAL MARCAS, S.A. the sum of £950. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

**Dated this 6<sup>th</sup> day of October 2025**

**L Bailey**

**For the Registrar**