O/1044/25

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 3859175

IN THE NAME OF SEVENTY FIVE TRADING LTD
TO REGISTER THE FOLLOWING TRADE MARK:

London Shark

IN CLASS 32

AND

IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 440570
BY

OSOTSPA PUBLIC COMPANY LIMITED

Background and pleadings

1. Seventy Five Trading Ltd ("the applicant") applied to register the trade mark 'London Shark' ("the contested mark") in the UK on 13 December 2022 (application no. UK00003859175). It was accepted and published for opposition purposes on 3 March 2023 in respect of the following goods:

Class 32 Beverages

2. On 2 May 2023, Osotspa Public Company Limited ("the opponent") opposed the trade mark on the basis of Section 5(2)(b) of the Trade Marks Act 1994 ("the Act"). This is on the basis of its earlier UK Trade Marks ("UKTM"):

UKTM no. 903856689

SHARK

Filing date 4 June 2004; registration date 30 August 2005. The following goods are relied upon in this opposition:

Class 32 Mineral and aerated waters and other non-alcoholic drinks;[1]

("the First Earlier Mark")

UKTM no. 900168427

[1] Whilst the mark stands registered for goods in classes 32 and 33 and the opponent has ticked 'all' at Q1 in the TM7, they have listed only some goods from class 32 namely "mineral and aerated waters and other non-alcoholic drinks" in the box below. Their submissions are also reflective of this narrower specification. I therefore intend to deal with this matter as though the opponent is only relying on those goods shown above.

Filing date 1 April 1996; registration date 12 May 1998. The following goods are relied upon in this opposition:

Class 32 Non-alcoholic drinks;

("the Second Earlier Mark")

3. The opponent's marks qualify as 'earlier marks' in accordance with section 6 of the Act. They have both been registered for more than five years at the filing date of the contested mark and are, therefore, subject to the proof of use requirements in section 6A of the Act.

4. 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.

5. The applicant filed a counterstatement denying the claims made and requesting that the opponent provides proof of use of its earlier trade marks as relied upon.

Representation

6. The opponent is represented by Baron Warren Redfern and the applicant is represented by Trade Mark Wizards Limited. No hearing was requested, however both parties filed additional submissions in lieu of a hearing, the opponent's were dated 18 January 2024 and the applicant's were filed on 18 April 2024 but were undated. This decision is taken following a careful consideration of the papers filed.

Preliminary Issues

7. The opponent filed both evidence and submissions during the evidence rounds. Within their submissions they stated:

"1.2 The Applicant put the Opponent to proof of use. However, the Applicant failed to identify either the Opponent's Frist [sic] Registration or the Opponent's

Second Registration at section 7 of the Form TM8. Therefore, it is contended that the request for proof of use was not properly made out, and should therefore be dismissed. The Opponent does not know for which of its two registrations proof of use is being requested.

1.3 However, despite the Applicant's failure to identify either of the Opponent's earlier registrations in its request, the Opponent hereby submits evidence of use which supports both the Opponent's First Registration or the Opponent's Second Registration".

8. Within its written submissions, the applicant filed a response to the opponent, as well as details as to the background of the company and some of its activities. It has also attempted to provide evidence on the matter. This evidence cannot be taken into account as it was not provided in the correct format. The applicant indicated that he wished to file evidence and requested a number of extensions of time, which were granted, albeit that no evidence was filed. Whilst I am unable to take the evidence into account, I will consider the submissions made by the applicant when making my decision.

9. I note that the opponent has gone on to provide proof of use evidence in respect of both marks. As I have evidence from the opponent in respect of both marks, I will consider all of the evidence before me and make a finding in respect of proof of use for both marks.

Evidence and Submissions

10. The opponent's evidence consists of the witness statement of Mr Pratharn Chaiprasit, dated 12 January 2023, which is accompanied by five exhibits (PC1 – PC5). Mr Chaiprasit is the Senior Vice Chairman of the opponent's company and he provides evidence of use of the earlier marks as relied upon.

11. 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

12. 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

13. 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."

As the earlier marks are comparable marks, paragraph 7 of Part 1, Schedule 2A of the Act is also relevant. It reads:

"7.— (1) Section 6A applies where an earlier trade mark is a comparable trade mark (EU), subject to the modifications set out below.

(2) Where the relevant period referred to in section 6A(3)(a) (the "five-year period") has expired before IP completion day—

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM; and

(b) the references in section 6A(3) and (4) to the United Kingdom include the European Union.

(3) Where [IP completion day] falls within the five-year period, in respect of that part of the five-year period which falls before IP completion day —

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM ; and

(b) the references in section 6A to the United Kingdom include the European Union".

14. 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."

15. The relevant period for the purposes of assessing genuine use is from 14 December 2017 to 13 December 2022. As the contested marks are comparable marks, the opponent can rely upon use of the marks in the EU for any and all parts of the relevant periods which fall prior to IP Completion Day, namely, 31 December 2020, and thereafter use must be shown in the UK.[2]

[2] paragraphs 7 and 8 of Part 1 Schedule 2A of the Act.

16. 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 Bundervsvereinigung 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]."

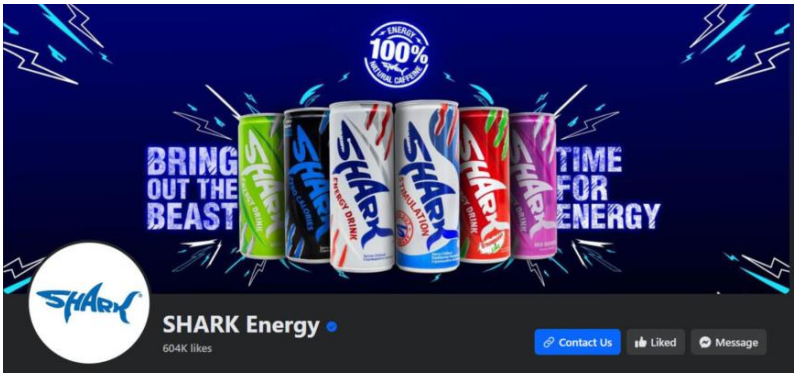
17. In *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*, Case BL O/404/13, Mr Geoffrey Hobbs QC (as he then was), sitting as the Appointed Person stated that:

"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."

18. 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

19. In his witness statement, Mr Chaiprasit states that the opponent manufactures and exports carbonated energy drinks under the mark, SHARK. The mark beverage is produced in a variety of flavours which is supplied in a can, upon which the Second Earlier Mark is depicted as follows[3]:



However, these images are undated.

20. Mr Chaiprasit states that the opponent has sold SHARK energy drinks in the EU for over 20 years[4]. The total sales numbers and values for the calendar years 2018 to 2020 are as follows:

[3] Exhibit PC1
[4] Witness statement of Mr Chaiprasit, para 3

Year	Number of Cans	Value in €
2018	11,019,432	€3,590,662
2019	12,813888	€4,081,137
2020	7,885,320	€2,483,711

Mr Chaiprasit states that the sales outlined above "relate[d] to exports in Austria, Bulgaria, Cyprus, Czech Republic, Ireland, Latvia, Malta, Slovenia and Spain, who either retail the goods directly to the public themselves in their own or in neighbouring territories, and/or distribute them wholesale to other retailers who then sell them directly to the public in their own or in neighbouring territories. Such retailers include supermarkets and other retail outlets which sell them as canned drinks, as well as bars, restaurants and other catering establishments which serve them as beverages to consume on site"[5].

21. Mr Chaiprasit has provided a selection of invoices dated between 8 January 2018 and 13 October 2020[6]. I note the following:

a. Mr Chaiprasit states that the invoices provided represent a sample of sales in the years 2018-2020[7].

b. In total, these invoices amount to €1,946,073.84 of sales.

c. 35 invoices have been provided and all of the invoices display Osotspa in the header. I note that the products sold all relate to SHARK energy drinks of varying flavours and are sold to importers who either retail the goods themselves or distribute them to other retailers.

d. The invoices confirm the goods are to be delivered to a number of addresses across Austria, Bulgaria, Cyprus, Czech Republic, Ireland, Latvia, Malta, Slovenia and Spain, and that there is repeat custom.

[5] Witness statement of Mr Chaiprasit, para 3
[6] Exhibit PC2
[7] Witness statement of Mr Chaiprasit, para 3

e. The invoices relate to a range of flavours within the SHARK energy drinks range including Apple/Melon, Red Berries, Strawberry/Lime, Zero Calories, Stimulation and Energy Drink.

22. Mr Chaiprasit has provided photographs of the SHARK products displaying the earlier marks on the products themselves and on packaging on shelves in various "EU member state retail outlets in 2020"[8]. No further information has been provided in relation to this exhibit and it is therefore unclear whether these photographs relate to sales in different countries or whether they represent the beverages on sale in one member state. I note that the price on display in each photograph is in Euros. The photographs themselves are undated. An example of these photographs is as follows:

23. Mr Chaiprasit has provided photographic images illustrating marketing and promotion of the brand, depicting a can of the beverage bearing the second earlier

[8] Exhibit PC3

mark alongside the slogan “bring out the beast”. I note the following examples are included[9]:

a. A display in Paphos Mall, Cyprus dated 2018-2019

b. Zoom kiosk, Nicosia, Cyprus dated 2017-2019

c. In-store advertising dated 2017-2019. The location is cut off the exhibit.

d. Bus, location unknown, 2018-2019

[9] Exhibit PC4

e. Concert sponsorship, location unknown, 2019

f. Concert sponsorship, Makronssos beach, Cyprus, 2019

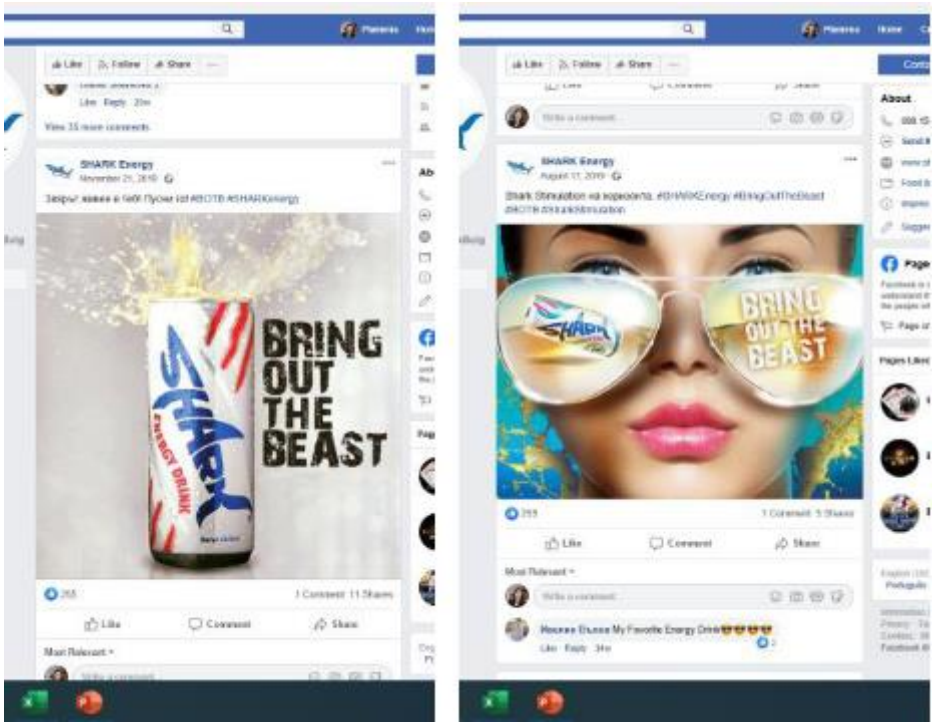
g. Billboard, location unknown, July 2018

h. BOTB game shop, location unknown, 2019

i. Inspot sponsorship, 2019

j. Cyprus rally, 16-18 October 2020

k. Various social media posts in Bulgaria 2018-2020



l. Music festival, Bulgaria, 2018 (I note a reference to attendance of 1000 people)

m. Billboards, Latvia, 2020

I note that there are no details as to the spend on marketing activities to promote the mark within the EU or the UK, or the opponent's marketing strategy.

24. I note that the opponent also operates a website at www.sharkenergy.com which it is said "was accessible to the whole of the EU between 2017 and 2020, the Company also operates European Instagram and Facebook profiles which were also active in the same period"[10]. Screenshots are provided in support of this[11], however, I note that these are undated. The opponent appears to have 1,528 followers on Instagram and in excess of 600,000 followers on Facebook. I also note that one of their Facebook posts has 604,000 likes. There is only one screenshot of the opponent's website (the rest relate to various social media profiles) and there is nothing to indicate that the

[10] Witness statement of Mr Chaiprasit, para 6
[11] Exhibit PC5

advertisements which appear on the site are aimed at consumers in the EU/UK[12]. Whilst I note that the opponent submits that they have referenced use throughout the EU, I note that there is no evidence of anything specifically directed at UK consumers.

Sufficient Evidence

25. 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[13].

26. The evidence before me does have its limitations. There are no details in relation to the size of the relevant market or the share of that market held by goods bearing the opponent's marks, and neither do I have information of the opponent's spend on marketing activities. There is also no evidence of use within the UK after IP Completion Day, although I note that the mark has been used consistently within the EU up until this time. The applicant has made submissions regarding the fact that the opponent has submitted invoices for products which were manufactured in Austria, however, they closed their manufacturing facility in Austria in 2020 and terminated any commercial activity in the EU at this time. The applicant submits that because of this the opponent's marks should be revoked due to non-use. As will become clear later in my decision this submission is not relevant to my decision.

27. The opponent's evidence indicates that it has traded in goods bearing the SHARK mark in its figurative form and by reference to the word only mark for over 20 years and this is reflected in its significant sales figures each year. Both forms of the mark are set out throughout the evidence, and this is use upon which the opponent can rely. Despite the fact that there is no evidence of use within the UK after IP completion day, the evidence of use prior to this time, when taken as a whole, is sufficient to show genuine use of the Marks during the relevant period in relation to energy drinks.

[12] *Lifestyle Equities CV and another (Respondents) v Amazon UK Services Ltd and others* [2024] UKSC 8, at [24] to [31]
[13] *New Yorker SHK Jeans GmbH & Co KG v OHIM*, T-415/09

Fair Specification

28. I must now consider whether, or the extent to which, the evidence shows use of the earlier marks in relation to the goods relied upon. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*,[14] Mr Geoffrey Hobbs Q.C. (as he then was) as the Appointed Person summed up the law as being:

> "In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned."

29. In *Merck KGaA v Merck Sharp & Dohme Corp & Ors* [2017] EWCA Civ 1834 the Court of Appeal set out the proper approach to partial revocation, as follows:

> "245. First, it is necessary to identify the goods or services in relation to which the mark has been used during the relevant period.
>
> 246. Secondly, the goods or services for which the mark is registered must be considered. If the mark is registered for a category of goods or services which is sufficiently broad that it is possible to identify within it a number of subcategories capable of being viewed independently, use of the mark in relation to one or more of the subcategories will not constitute use of the mark in relation to all of the other subcategories.
>
> 247. Thirdly, it is not possible for a proprietor to use the mark in relation to all possible variations of a product or service. So care must be taken to ensure this exercise does not result in the proprietor being stripped of protection for goods or services which, though not the same as those for which use has been proved,

[14] BL O/345/10

are not in essence different from them and cannot be distinguished from them other than in an arbitrary way.

248. Fourthly, these issues are to be considered having regard to the perception of the average consumer and the purpose and intended use of the products or services in issue. Ultimately it is the task of the tribunal to arrive at a fair specification of goods or services having regard to the use which has been made of the mark.

249. This approach does strike an appropriate balance. It gives effect to the clear intention of the EU legislature that marks must actually be used or, if not used, be subject to revocation. […] It is also fair to proprietors for it does not require a proprietor to prove that he has used his mark in relation to all possible variations of the goods or services covered by its registration but only those which are sufficiently distinct to constitute coherent categories or subcategories. I am also satisfied that it gives appropriate protection to the legitimate interest of a proprietor in being able in the future to extend his range of goods or services within the scope of the terms describing the goods or services for which its mark is registered."

30. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch) at [47], the late Carr J pointed out that it is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do; for example, in *Pan World Brands v Tripp Ltd (Extreme Trade Mark)* [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally.

30. The opponent's specification includes the terms *mineral and aerated waters and other non-alcoholic drinks*. No evidence has been produced that the opponent has used the marks in relation to mineral and aerated waters although I note that there is some evidence of other marks being used for these goods. The opponent's evidence is clear that SHARK products are energy drinks which are available in different iterations/flavours, and this is reiterated throughout. Whilst I accept that energy drinks

are non-alcoholic beverages, I consider this term to be too wide in respect of the goods which are being sold under the opponent's marks.

31. The opponent has provided no evidence of use of its marks in relation to *non-alcoholic beverages* at large. This is a very wide category and would include all non-alcoholic beverages. I note from the evidence that some of the opponent's goods are available in various different fruit flavours, however, it is plain from the evidence that the goods that are being sold are energy drinks, and indeed this is confirmed within the opponent's evidence. Consequently, I do not consider that the opponent should be entitled to rely on the broad category *non-alcoholic beverages* in its specification.

32. With that in mind, I consider a fair specification to be:

Class 32 Energy Drinks

33. The opponent had indicated within their TM7 that they only wished to rely upon some of the goods for which the mark is registered, albeit that they ticked the "all" box at question1. Even if I had considered all the goods within their registration, this would not have altered my assessment as no use has been shown for those additional goods and therefore I would have reached the same outcome.

Decision

Section 5(2)(b)

34. 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".

35. 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

36. 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

37. Given my earlier findings, the competing goods are shown in the table below:

The earlier marks	The contested mark
Class 32 – Energy Drinks	Class 32 - Beverages

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 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."

39. The opponent submits "the goods: "*Beverages*" in class 32 of the Application are identical to the goods "*mineral and aerated waters and other non-alcoholic drinks*" in class 32 of the opponent's registration".

40. The applicant submits as follows:

> "Even if we determine that two trademarks are confusingly similar, determining whether there is a likelihood between them also depends on whether the goods or services associated with each trademark are related.
>
> UK trade mark registration No 903856689 (the "Opponent's First Registration") is filed in the following list of goods:

- Class 32 – Beers; mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages.
- Class 33 – Alcoholic beverages (except beers); Alcoholic essences; alcoholic extracts; fruit extracts (alcoholic)

UK trade mark registration No Non-alcoholic drinks; syrup and other preparations for the making beverages 900168427 (the "Opponent's Second Registration") is filed in the following list of goods:

- Class 32 – Non-alcoholic drinks; syrups and other preparations for making beverages.

The Applicant's trademark application n.3859175 is filed for all "beverages". It can be argued that the goods protected by the Opponent in class 32, which are limited to non alcoholic drinks, are not identical to the applicant's goods under trademark application n.3859175".

Class 32

Beverages

41. A beverage is any drinkable liquid consumed for hydration, nutrition or enjoyment. The opponent's specification includes *energy drinks*. The term *beverages* is a wide term which encompasses different types of drinks. These goods are therefore identical on the principles outlined in *Meric*.

The average consumer and the purchasing act

42. 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. (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 word "average" denotes that the person is typical. The term "average" does not denote some form of numerical mean, mode or median."

43. The goods at issue are all beverages. 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. 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).

44. 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 shops where there may be an oral component to the selection process, such as requests to staff. Even where the goods are ordered orally, the selection process may still be in the context of a visual inspection of drinks within a refrigerator, for example. 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

45. 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."

46. 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.

47. The respective trade marks are shown below:

Earlier Trade Marks	The Contested Mark
SHARK ("the First Earlier Mark")	London Shark

 ("the Second Earlier Mark")	

48. The opponent submits as follows:

> "1.2 Visually the Applicant's Sign is the two word term LONDON SHARK, while the Opponent's First Sign is the word SHARK. The geographical place name LONDON has little or no visual distinctive character as it simply refers to a geographical location of manufacture or sale of goods. The most distinctive visual part of the Applicant's Sign is the word SHARK which is identical to the Opponent's First Sign. Therefore, whilst the Applicant's Sign and the Opponent's First Sign are not visually identical, they are so visually similar that there is a likelihood of confusion between them.
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> 1.3 Phonetically the Applicant's Sign is the two word term LONDON SHARK, while the Opponent's First Sign is the word SHARK. The geographical place name LONDON has little or no phonetic distinctive character as it simply refers to a geographical location of manufacture or sale of goods. The most distinctive phonetic part of the Applicant's Sign is the word SHARK, which it [sic] identical to the Opponent's First Sign. Therefore, while the Applicant's Sign and the Opponent's First Sign are not phonetically identical, they are so phonetically similar that there is a likelihood of confusion between them.
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> 1.4 Conceptually the Applicant's Sign refers to a distinctive predatory fish from, or somehow associated with, the capital city of the United Kingdom. The Opponent's First Sign is a direct reference to the same kind of distinctive animal. The geographical place name LONDON has little or no conceptual distinctive character as it simply refers to a geographical location of

manufacture or sale of goods. Therefore, the most distinctive conceptual part of the Applicant's Sign is the reference to sharks, which is the identical concept in the Opponent's First Sign. Therefore, while the Applicant's Sign and the Opponent's First Sign are not conceptually identical, they are so similar that there is a likelihood of confusion between them".

49. The applicant submits as follows:

"As the entire strategy of the Opponent is centred on the use of the word Shark, the analysis of the likeliness of confusion has to concentrate on the potential conflict of the two trademarks which use the word Shark.

Trademarks don't have to be identical to be confusingly similar, Instead, they could just be similar in sound, appearance, or meaning, or could create a similar commercial impression. For the following reasons the respective trademarks, "Shark" and "London Shark", cannot be found to be confusingly similar.

a. Sound

The two trademarks are clearly unsimilar because they are spelled differently and because the word "London" before the word "Shark" prevents that they are pronounced the same way

b. Visual impression

The trademarks are different because the word London before the word Shark prevents form conveying the same overall visual commercial impression. The Opponent's dominant verbal element is the word "London" and not the work [sic] "Shark".

Moreover, to identify its products, the Opponent regularly uses the word and device trademark n.UK0090016842

and not the verbal trademark n.UK00903856689

"SHARK"

For these reasons the visual impression between the two trademarks is clearly different".

My Approach

50. I will proceed with my assessment of this matter in respect of the First Earlier Mark, as given that it is a word only mark, I consider this to be the mark that is closer in terms of similarity to the applicant's. I accept that the form of the opponent's mark used on the product itself and shown in evidence is the figurative form, however, the products are also used by reference to the word only mark. If the opponent succeeds by reliance on this mark the opposition will succeed in its entirety. I will return to consider the Second Earlier Mark later, should it become necessary to do so.

Overall impression

51. The applicant's mark is a word only mark and consists of the words 'London Shark'. This is presented in a plain typeface and there are no other elements to contribute to the overall impression of the mark which resides in the words themselves. The word LONDON will be seen simply as the geographical location of the undertaking and plays a lesser role in the overall impression of the mark, and less trade mark significance will be attached to it as a result. I consider the word SHARK to be the dominant element of the mark.

52. The earlier mark is a word only mark and consists of the word SHARK. There are no other elements to contribute to the overall impression of the mark which resides in the word itself.

Visual comparison

53. A word trade mark protects the notional use of the word itself, irrespective of font, capitalisation or otherwise and therefore the difference in casing will have little impact on my assessment. Visually, the competing marks both share the use of the word SHARK being the second word of the contested mark and the totality of the earlier mark. The marks differ by the addition of the word LONDON in the contested mark, with there being no counterpart in the earlier mark.

54. The word LONDON is the first word in the earlier mark and since it is at the beginning of the mark is generally considered to have more impact[15]. However, as stated above, LONDON has a lesser role in the overall impression of the mark as it will be seen as a geographical location, and SHARK is therefore the dominant element. Weighing up the differences as against the similarities and the fact that the average consumer normally perceives a mark as a whole, I consider there is between a medium to high degree of visual similarity between the marks.

Aural Impression

55. The words in both marks are ordinary English dictionary words and they will be pronounced in the normal way.

56. The point of aural overlap lies with the word SHARK, as this is the same in both marks, and will be pronounced identically. The first word in the contested mark, LONDON, has two syllables. There is no comparator in the earlier mark, and this will be a point of difference between the marks. However, as the word LONDON is not the distinctive element of the mark, I find the marks to be aurally similar to between a medium to high degree.

Conceptual impression

57. The distinctive element of both marks can be attributed to the word, SHARK, which appears identically in both marks and refers to a predatory fish. LONDON is the capital city of the United Kingdom, and the use of this in the contested mark indicates that the

[15] *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

business is located in London, or the goods are produced in London, which is a point of conceptual difference but not significantly so. Given the above, I find that overall, there is a high degree of conceptual similarity between the marks.

Distinctive character of the earlier trade mark

58. 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 *WindsurfingChiemsee* v *Huber and Attenberger* [1999] ECR I-0000, paragraph 49).
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> 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)."

59. 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. The opponent has made submissions regarding the

distinctiveness of the applicant's mark, but not of their own mark. I will therefore proceed to make my own assessment.

60. The opponent's word only mark consists of the word SHARK. The word is a widely used dictionary word to the average consumer in the UK. Being a dictionary word which is not descriptive or directly allusive of the goods, I consider the earlier mark to be inherently distinctive to a medium degree.

61. 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.

62. As discussed in detail above, the opponent filed a witness statement by Mr Chaiprasit to evidence its use of the earlier mark during the relevant period, and evidencing sales to distributors in various member states. Whilst I have determined that the opponent has provided sufficient evidence to prove use of the marks, 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 there is nothing in the way of promotional or marketing expenditure. Further any claim for enhanced distinctive character must be from the perspective of the UK consumer and I note that the opponent has only provided evidence from the EU. Therefore, whilst I have found the evidence provided to be sufficient in respect of genuine use, the evidence was insufficient to establish enhanced distinctiveness.

Conclusions on Likelihood of Confusion

63. 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.

64. 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.

65. I have found as follows:

- The goods at issue are identical upon the principles in *Meric*;
- 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 earlier mark to between a medium to high degree;
- The contested mark is aurally similar to the earlier mark to between a medium to high degree;
- I have found the contested mark and the earlier mark to be conceptually similar to a high degree;
- I have found the earlier mark overall to be inherently distinctive to a medium degree;

66. I begin by considering a likelihood of direct confusion. The contested mark is a two-word mark, LONDON SHARK, which shares the second word of the earlier mark,

SHARK. Whilst I note that the consumer normally attaches more importance to the first word/element of a mark, the presence of LONDON, in the opposing mark has low distinctive character for the reasons set out in paragraph 51. Therefore, the distinctive element of both marks can be attributed to the word, SHARK. The word LONDON has low distinctive character, and as it is a geographical location, little weight will be placed upon it. Therefore, the average consumer is likely to attach most weight to the dominant element of the mark, SHARK. This is identical to the opponent's mark and therefore, noting that the marks are unlikely to be compared side by side and also noting the principles of imperfect recollection and interdependency, I consider that this is a case in which the applied for mark is likely to be misremembered one for the other. I find that there will be a likelihood of direct confusion. In case I am wrong about that, I will move on to consider indirect confusion.

67. In *L.A. Sugar Limited v By Back Beat Inc*, BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, explained that:

> "16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: 'The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark'.
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> 17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right ('26 RED TESCO' would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as 'LITE', 'EXPRESS', 'WORLDWIDE', 'MINI' etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension ('FAT FACE' to 'BRAT FACE' for example)."

68. These three categories are not exhaustive; rather, they were intended to be illustrative of the general approach, as has been confirmed by the Court of Appeal[16]. I recognise that a finding of indirect confusion should not be made merely because the competing marks share a common element. In this connection, it is not sufficient that a mark merely calls to mind another mark; this is mere association not indirect confusion[17]. The Court of Appeal has also emphasised that, where there is no direct confusion, there must be a "proper basis" for finding indirect confusion.

69. For indirect confusion to arise the average consumer must consider that as a result of the common element, there is an economic connection between the respective marks, such that the goods provided under one is regarded as a brand extension or sub brand of the other, for example.

70. When assessing indirect confusion, I find that as a result of the common word, SHARK, consumers will be confused between the two entities as this appears identically in each mark. When considering the differences within the marks, namely the word LONDON in the contested mark, the average consumer is likely to interpret

[16] *Liverpool Gin Distillery and others v Sazerac Brands, LLC and others* [2021] EWCA Civ 1207
[17] *Duebros Limited v Heirler Cenovis GmbH,* BL O/547/17

LONDON as the geographical origin of the goods. Therefore, whilst I have found that LONDON has less impact, I find that it will be interpreted to mean that LONDON SHARK is a sub-brand or indicative of the geographical origin of the goods provided by the same, or a linked undertaking. Therefore, when considering the contested mark, and taking account of the common element in the context of the mark as a whole, the consumer is likely to conclude that it is another brand of the owner of the earlier mark. As a result of this, I find a likelihood of indirect confusion.

Final Remarks

71. As the First Earlier Mark leads to the opposition being successful in its entirety, there is no need to consider the remaining trade mark upon which the opposition is based, as this does not place the opponent in any stronger position given my earlier findings.

Conclusion

72. The opposition is successful. Therefore, subject to any successful appeal, the application will be refused.

Costs

73. As the opponent has been successful in opposing the applicant's mark, it is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 1/2023 which governs costs in proceedings issued after 1 February 2023. In the circumstances, I award the opponent the sum of £950.00 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
Preparing a witness statement, and written submissions and considering the applicant's observations	£600.00

Official fee:	£100.00
Total:	**£950.00**

74. I therefore order Seventy Five Trading Ltd to pay Osotspa Public Company Limited the sum of £950.00. The above sum should 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 10th day of November 2025

LA Bailey

For the Registrar