BL O/1078/24

TRADE MARKS ACT 1994

IN THE MATTER OF UK TRADE MARK APPLICATION NO.00003621905 COPALLI IN CLASS 33 AND TRADE MARK APPLICATION NO. AND 00003621884 COPAL TREE IN CLASS 30, 33, 40 AND 43 IN THE NAME OF COPAL TREE BRANDS, INC.

- AND -

IN THE MATTER OF THE OPPOSITIONS THERETO Nos. OP000426754 and OP000426760

-AND-

IN THE MATTER OF UK TRADE MARKS NOS. 008100701103 AND 00701103 COMPAL IN CLASSES 29, 30 AND 32 IN THE NAME OF SUMOL + COMPAL MARCAS, S.A.

- AND -

IN THE MATTER OF THE APPLICATIONS FOR REVOCATION FOR NON-USE UNDER Nos. CA000505064 & CA000505065

-AND-

IN THE MATTER OF AN APPEAL FROM THE DECISION OF MS JUDI PIKE DATED 6 MARCH 2024

DECISION

---

1. This is an appeal from the decision of Judi Pike (the "Hearing Officer"), BL O/0190/24, dated 6 March 2024, in which she revoked in part the earlier marks of Sumol + Compal Marcas, S.A. ("the Opponent") and upheld in part its opposition to the trade mark applications of Copal Tree Brands, Inc. ("the Applicant").

Background

2. The Applicant filed its two trade mark applications on 6 April 2021. Trade Mark No 00003621905 for **COPALLI** covered a range of alcoholic beverages and goods in Class 33, whilst Trade Mark No. 00003621884 **COPAL TREE** covered a wider range of

goods and services: various food products in Class 30, beverages, etc, in Class 33, distillery etc services in Class 40, and services related to providing food and drink, etc in Class 43. The full specifications are set out in paragraph 64 of the Hearing Officer's decision.

3. The Opponent filed an opposition based on two earlier marks. The first was UK Trade Mark No. 810701103 **COMPAL**, which it relied on in relation to *preserved, dried and cooked fruits and vegetables* in Class 29 and *non-alcoholic beverages; fruit drinks and fruit juices* in Class 32. The second was international registration 701103 for **COMPAL**, and it relied on the same goods and services. The opposition was based upon subsections 5(2)(b) and 5(3) and targeted all but the Class 40 services.

4. The Applicant put the Opponent to proof of use of the earlier marks, but also filed applications to revoke the earlier marks for non-use. All of the proceedings were consolidated.

5. Both parties filed evidence. No hearing was requested, and the Hearing Officer made her decision based upon the papers on file and upon written submissions from both sides. She found limited use of the earlier marks and concluded that genuine use had been proved only in relation to *preserved vegetables* in Class 29 and *fruit drinks and fruit juices* in Class 32.

6. She went on to consider the oppositions and found:
   - 6.1 She found no similarity between the Opponent's *preserved vegetables* and the Applicant's Class 33 goods.
   - 6.2 She found a low to medium level of similarity between its *fruit drinks and fruit juices* and the Applicant's *Alcoholic beverages (except beers); alcoholic cocktail mixes; alcoholic cordials; alcoholic energy drinks; alcoholic beverages of fruit; alcoholic fruit beverages; alcoholic fruit cocktail drinks; alcopops; ciders; fruit wine; pre-mixed alcoholic beverages*. She found no similarity for the rest of the Class 33 goods.
   - 6.3 She found no similarity between the Opponent's goods and most of the services in the Applicant's Class 43 specification save for a very low level

of similarity to its "*Services for providing food and drink; mobile catering; outside catering; food and drink catering; catering of food and drink."*

6.4 The Hearing Officer found some similarities between COMPAL and COPALLI but also noted the differences between them. She concluded that even allowing for imperfect recollection they would not be directly confused. She also found that there was no likelihood of indirect confusion, because the brands would not be seen as brand variants but as two different invented words.

6.5 Then, comparing COPAL TREE to COMPAL she found a level of similarity between the marks but concluded that there was no likelihood of confusion, direct or indirect, in relation to many of the Applicant's goods and services. However, she considered that there was a potential for indirect confusion where consumers might assume that "the first element is a house brand, imperfectly recalled and the TREE element a brand extension or variant reflecting tree-grown fruit-flavoured COMPAL/COPAL goods." She concluded there was a likelihood of indirect confusion for similar goods which are or may be fruit-flavoured.

6.6 She therefore concluded that the opposition under s. 5(2)(b) against COPALLI failed altogether and that against COPAL TREE succeeded only in respect of *Alcoholic beverages (except beers); alcoholic cocktail mixes; alcoholic cordials; alcoholic energy drinks; alcoholic beverages of fruit; alcoholic fruit beverages; alcoholic fruit cocktail drinks; alcopops; ciders; fruit wine; pre-mixed alcoholic beverages*.

6.7 She rejected the s 5(3) ground. There is no appeal on that point.

7. The Opponent filed an appeal on two points. First, it sought to challenge the Hearing Officer's findings as to the extent of genuine use of the earlier marks. She should, it said, have found genuine use in relation to cooked vegetables as well as preserved vegetables. Secondly, the Opponent challenged the Hearing Officer's findings under s 5(2)(b) and her analysis of the similarity of the parties' goods. It submitted that she should have found a wider range of goods similar, and so have found a likelihood of confusion in relation to certain beverages in Class 32 and the whole of the Class 33 application for COPALLI. It also submitted that she should have found a likelihood of

confusion of indirect confusion for certain of the Class 43 services in the COPAL TREE specification.

8. The appeal was heard remotely. It was attended only by the Opponent. The Applicant has taken no part in the appeal.

Standard of appeal

9. The standard of an appeal of this nature is well-established and not contentious. The Opponent referred me, for example, to the principles stated by Sir Anthony Mann in *Stitch Editing v TikTok* [2023] EWHC 1167(Ch). In addition, it is helpful to bear in mind the summary by Arnold LJ in *Lidl Great Britain Ltd v Tesco Stores Ltd* [2024] EWCA Civ 262, [2024] ETMR 25, where he said:

> "110. It is common ground that, in so far as the appeals challenge findings of fact made by the judge, this Court is only entitled to intervene if those findings are rationally insupportable: *Volpi v Volpi* [2022] EWCA Civ 464; [2022] 4 W.L.R. 48 at [2](v) (Lewison LJ). Equally, it is common ground that, in so far as the appeals challenge multi-factorial evaluations by the judge, this Court is only entitled to intervene if the judge erred in law or principle …"

10. A decision may be rationally insupportable "by reason of an identifiable flaw in the treatment of the question to be decided, such as a gap in logic, a lack of consistency, or a failure to take into account a material factor, which undermines the cogency of the conclusion, or for being contrary to principle or plainly wrong."*per* Mr. Geoffrey Hobbs KC in paragraph [10] of his Decision in *LADY LOUISA WATERFORD TM* (O-0646-24). Mr Hobbs added at paragraph [19] "In order to maintain the required distance between the role of decision taker at first instance and decision taker on appeal, it is necessary for this Tribunal to proceed on the basis that the Decision below should stand unless the matters on which the Opponent relies are by force of what they reveal sufficient to establish — to the standard indicated in para. [10] above — that the Decision is vitiated by error."

11. All of the elements of the Decision challenged in this appeal were predominately of an evaluative, factual nature and I bear the points above in mind.

Genuine use in relation to “cooked vegetables”

12. The Hearing Officer carried out a careful analysis of the evidence of use. She concluded at paragraph 51 of the Decision that “The evidence is in relation to fruit juices and nectars, tinned vegetables and tomato puree and juices. Although tomatoes are technically fruits, I believe that the natural way in which tomato puree and tomato juice, or passata, are perceived by consumers is as vegetables, for use in cooking and producing savoury dishes. None of the evidence shows cooked goods or fruit-based goods other than drinks. Consequently, a fair specification for the class 29 specifications for both the earlier registrations, and for reliance upon in the oppositions, is “preserved vegetables”.”

13. The Opponent made a simple point about this analysis. It pointed to the evidence of sales of tinned beans and chickpeas and said that the average consumer would know that such vegetables would be cooked before being preserved, such that the Hearing Officer was wrong to say that there was no evidence of cooked goods being sold, and its specification should properly have retained the separate reference to *cooked vegetables.* This explanation had not, however, been put to the Hearing Officer.

14. It seems to me that there is potentially a distinction to be drawn (and which would be drawn by the consumer) between vegetables which are cooked and vegetables which are cooked and then preserved, and a reference to preserved vegetables would not exclude vegetables which had been cooked prior to preservation. As the Hearing Officer had seen evidence only of use of the earlier marks in relation to tinned or bottled vegetables, in my judgment it was open to the Hearing Officer to find that the appropriate and natural description of such goods was “preserved vegetables.” Such a conclusion was not rationally insupportable, so it would not be right to overturn that finding on appeal.

Merits of the appeal of the s 5(2)(b) objection

15. The Opponent’s first Ground of Appeal on the assessment of the s 5(2)(b) objection related to the Hearing Officer’s failure to find similarity between its remaining Class

32 goods (fruit drinks and fruit juices) and a range of the Applicant's Class 33 goods. At paragraph [70] she had said:

> "The parties' goods are not generally found in close proximity in supermarkets, but both are sold in pubs. There may be an element of competition as one may decide to drink, e.g. an apple juice drink instead of a pint of cider; but there are other goods for which there is no discernable element of competition, such as fruit juice instead of a measure of whisky or a liqueur. Although some of Copal's goods may require or frequently be drunk with a mixer, which could be e.g. orange juice, the goods are not complementary in the sense described in *Boston*. There is no evidence before me that the same undertakings are recognised by consumers as producing alcoholic goods and fruit juice as a mixer. Taking all this into account, I find the following levels of similarity between Sumol's fruit drinks and fruit juice and Copal's class 33 goods:
>
> - low to medium similarity: *Alcoholic beverages (except beers); alcoholic cocktail mixes; alcoholic cordials; alcoholic energy drinks; alcoholic beverages of fruit; alcoholic fruit beverages; alcoholic fruit cocktail drinks; alcopops; ciders; fruit wine; pre-mixed alcoholic beverages*. These goods are, or include, longer drinks and are, or include, drinks which are fruit-based or fruit flavoured;
> - no similarity: *distilled spirits; absinthe; alcoholic aperitifs; alcoholic bitters; alcoholic essences; alcoholic extracts; alcoholic jellies; alcoholic tea-based beverage; anisette; aperitifs; arak; bitters; blended whisky; bourbon whiskey; brandy; cooking brandy; cooking wine; distilled beverages; fermented spirit; flavoured tonic liquors; fortified wines; gin; grape wine; liqueurs; preparations for making alcoholic beverages; sake; sparkling wines; spirits and liquors; vodka; vermouth; whiskey; wine.* Although, for example, wine and brandy are produced from fruit, they are not fruit-flavoured. These are all goods which are high in alcoholic content, or are not drinks *per se* (such as preparations for making alcoholic beverages), or are jellies and not drinks, or are ingredients in cocktails such as bitters. They are not similar to Sumol's goods within the parameters of the case law cited above."

16. The Opponent's central argument on this point of the appeal was that the Hearing Officer drew an incorrect distinction between the fruit-based or fruit-flavoured beverages and those which she considered were not fruit-flavoured. It argued that she

could only have reached that conclusion by failing to give due weight to the similar trade channels for the two groups of goods. I do not accept this criticism of the decision. The mere fact that there may be some similarity of trade channels, as explained by the Hearing Officer, does not mean that there is overall similarity given the other differences between the goods. Taking the trade channels point to extremes would mean that one would risk making a finding of similarity between orange juice and peanuts simply because both might be sold in supermarkets or in pubs. Plainly that cannot be right, when the reason for examining the similarity of the parties' goods is to consider to what extent the two kinds of goods are liable to be perceived as "related" by the average consumer. As Mr Hobbs KC said in *Burn trade mark* O/074/19 at p 14:

> "for the purposes of an objection to registration under section 5(2)(b) [the factors] must be sufficient to establish a basis for maintaining that the goods in issue are what may be termed "kindred goods", the nature or characteristics of which or the nature or characteristics of commerce in which are such that a single economic undertaking would naturally be regarded as directly or indirectly responsible for providing goods of the kind in question."

17. The Hearing Officer considered this point at the beginning of paragraph [70] and in my view the reasons she gave for rejecting any similarity for the second set of the Class 33 goods are perfectly adequate.

18. In addition, the Opponent argued that as the Hearing Officer found *alcoholic beverages* to be similar to its fruit drinks etc, she must have erred in finding no similarity for the remaining specific alcoholic goods, e.g. gin, vermouth, whiskey. In my judgment, "alcoholic beverages" would, as the Hearing Officer said, include alcoholic fruit mixes. However, it does not seem to me that this means necessarily that there is similarity between, say, orange juice and whiskey. The reasons she gave for that finding cannot, in my view, be said to be incorrect.

19. The Opponent also submitted that the Hearing Officer should have found similarity between its goods and the Applicant's *preparations for making alcoholic beverages,* as there was no proper distinction between such preparations and *premixed alcoholic beverages.* Again, I do not accept that the Hearing Officer went wrong on this point. In my judgment preparations for making alcoholic beverages are ingredients for making

alcoholic beverages such as, on a domestic level, a home brewing kit. The Hearing Officer was right to say that such preparations are not drinks *per se.* In my view such goods cannot simply be equated to pre-mixed alcoholic beverages, such as the ready mixed cranberry juice and vodka suggested by the Opponent, nor are they complementary goods in the proper sense of that term. Again, the decision on this point cannot be said to be rationally insupportable.

20. The Opponent referred me to the decision in BL O/399/10 *Sepharode,* suggesting that the Hearing Officer should have grouped more of the Class 33 goods together. Again, I cannot accept this submission. She split the goods into sensible groups, and drew a distinction between the two groups of goods, giving her reasons for doing so. Her reasons or conclusions are not rationally insupportable.

21. For all of these reasons, the appeal against the findings in paragraph [70] must fail.

22. Next, the Opponent submitted that the Hearing Officer erred in her global appreciation of the likelihood of confusion between COPALLI and COMPAL because in carrying out that appreciation she failed to apply her own views of the level of similarity of the marks, and failed to set out any conclusion as to the level of their similarity overall.

23. The Hearing Officer set out her views on similarity of the marks at paragraphs [79]-[83]. She found a low degree of visual similarity between them, and a very low degree of aural similarity. She found them conceptually neutral.

24. The Opponent submitted that the Hearing Officer failed to reach an overall conclusion on the marks' similarity and failed to give due weight to her own findings on similarity when assessing the likelihood of confusion at paragraph [93]. There she said:

> "There is no likelihood of confusion, either directly or indirectly. The marks are too different to be imperfectly recalled to such an extent that they will be confused. The average consumer will not pay so little attention in looking at the goods bearing the marks, or asking for them, that they will make the sort of mistake which leads to direct confusion. There is also nothing about the marks which would lead consumers to recognise the differences but decide that the marks are brand variants. They will simply be seen as two different invented words with nothing substantive

in common. Indirect confusion is not a consolation prize for an opponent which has not succeeded in a finding of direct confusion. Differences between marks which are the reason why there is no likelihood of direct confusion might also be the reason why there is no indirect confusion. I have not forgotten that the Court of Appeal confirmed that the three categories in *L.A. Sugar* are non-exhaustive. Nevertheless, the parties' marks have no obvious connection to each other. There is therefore no reason for anyone to conclude that either is a sub-brand or offshoot of the other, or some type of collaboration. For the avoidance of doubt, I would have found no likelihood of confusion of either type even if Sumol had proven use for all the goods relied upon and even if I had found an enhanced level of distinctive character for the earlier mark."

25. It is right that the Hearing Officer did not state her view at paragraphs [79]-[83] as to the overall similarity of COMPAL to COPALLI. However, that does not seem to me to suggest that she had not reached any such conclusion. On the contrary, it seems clear from the second sentence of paragraph [93] that her view was that, overall, the differences between the marks were greater than the similarities between them. In particular I note that in the middle of paragraph [93] she said, "They will simply be seen as two different invented words with nothing substantive in common." Perhaps this is a point which she could have spelled out more specifically or expressed more clearly, but I consider that this does not amount to an appealable error in her reasoning.

26. The Opponent also pointed out that the Hearing Officer did not expressly take into account the importance of visual similarity in the consumer's choice goods of this nature. I agree that she did not do so expressly, but it appears to me that she did consider that point in the third sentence of paragraph [93]. Bearing in mind that she had, in any event, found only a low-medium level of visual similarity, there is nothing illogical in her conclusion on that point.

27. In the circumstances, the Opponent has not persuaded me that the Hearing Officer's findings in relation to the likelihood of confusion of the of COMPAL and COPALLI marks could be said to be rationally insupportable. I dismiss the appeal on this point.

28. Lastly, in relation to the COPAL TREE mark, the Opponent challenged the Hearing Officer's rejection of any likelihood of indirect confusion in relation to certain of the Applicant's Class 43 services, some but not all of which had been found to be similar to the Opponent's goods.

29. The Hearing Officer dealt at paragraph [72]-[73] with the question of similarity between the Opponent's goods and the Applicant's Class 43 services. She said:

> "72. …. The remaining services are:
>
> *Services for providing food and drink; mobile catering; outside catering; hotel catering services; food and drink catering; catering of food and drink; information, advisory and consultancy services relating to all the aforesaid services.*
>
> 73. The nature of the parties' goods and services are clearly not similar. There is some similarity of purpose in that one might seek the service of drink provision in order to quench a thirst, and for that reason there is also some similarity of trade channels. I do not see any other elements of similarity, other than users which is on too general a level to be meaningful. I also do not think there is any meaningful similarity at all with *hotel catering services*. Unlike mobile catering and other forms of casual food and drink services, which may provide their own drinks and juices e.g. from the catering van, hotel catering is arranged for functions. There is a very low degree of similarity between Sumol's goods and Copal's *Services for providing food and drink; mobile catering; outside catering; food and drink catering; catering of food and drink*. There is no similarity with Copal's *hotel catering services; information, advisory and consultancy services relating to services for providing food and drink; mobile catering; outside catering; hotel catering services; food and drink catering; catering of food and drink*, as these services are too far removed from fruit drinks and fruit juices."

30. The Hearing Officer went on at to consider the likelihood of indirect confusion in relation to the COPAL TREE mark:

> "96. I said earlier in this decision that, notwithstanding COPAL by itself has no meaning to the average UK consumer for the goods and services, in conjunction with TREE, it may be perceived as 'a copal tree', even though average consumers

may not be familiar with the name. Some fruit grows on trees. It could be the case that consumers imperfectly recall the common elements, both of which appear to be invented words, and assume that the additional TREE element denotes a brand variation in relation to goods derived from or flavoured like tree-grown fruit. There could be confusion if consumers assume that the first element is a house brand, imperfectly recalled, and the TREE element a brand extension or variant reflecting tree-grown fruit-flavoured COMPAL/COPAL goods. I find that there is a likelihood of indirect confusion for the similar goods which are fruit-flavoured or are terms which cover goods which are fruit-flavoured:

> Alcoholic beverages (except beers); alcoholic cocktail mixes; alcoholic cordials; alcoholic energy drinks; alcoholic beverages of fruit; alcoholic fruit beverages; alcoholic fruit cocktail drinks; alcopops; ciders; fruit wine; pre-mixed alcoholic beverages.

97. I do not think this would be the case for the remainder of Copal's goods and services which I have found to be similar because there is too tenuous a link: the distance between the marks overall and goods and services which are not fruit tree-related will avoid a likelihood of confusion. For such goods and services, TREE is not a natural brand variant and there is no likelihood of confusion."

31. The Opponent submitted that the Hearing Officer went wrong in rejecting a likelihood of confusion for all of the Class 43 services, given the finding at paragraph [96].

32. First, it must be noted that the Grounds of Appeal refer to certain services which the Hearing Officer had held were not similar to the Opponent's goods. No reason was advanced for seeking to widen the scope of the services in issue, and I suspect that this was an error in the Grounds of Appeal.

33. As to the substantive point, it seems to me that the Opponent was effectively simply asking me to substitute my own view of the likelihood of indirect confusion for that of the Hearing Officer. It submitted that the link was not "too tenuous" as she had said. No real error in her reasoning was identified. In the circumstances, this aspect of the appeal also fails.

Conclusion

34. The appeal is dismissed. As the Applicant has taken no part in the appeal proceedings, I propose to make no order as to the costs of the appeal. The Opponent shall pay the Applicant the costs awarded by the Hearing Officer within 21 days of the date of this decision.

Amanda Michaels

The Appointed Person

13 November 2024

MR. MARK CADDLE (of **Withers & Rogers LLP**) appeared for the Appellant

The Respondent took no part in the appeal