

O/1088/25

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003939558
BY AMG ASSET MANAGEMENT LTD TO REGISTER:

myfitnesswater

AS A TRADE MARK IN CLASS 32

AND

IN THE MATTER OF THE OPPOSITION THERETO
UNDER NO. 444199 BY
LUCOZADE RIBENA SUNTORY LIMITED

BACKGROUND AND PLEADINGS

1. On 28 July 2023, AMG ASSET MANAGEMENT LTD (“the applicant”) applied to register the trade mark shown on the cover page of this decision in the UK (“the applicant’s mark”). The applicant’s mark was published on 18 August 2023 and registration is sought for the following goods:

Class 32: Drinking water with vitamins.

2. On 20 November 2023, the applicant’s mark was opposed by Lucozade Ribena Suntory Limited (“the opponent”). The opposition is based on sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). Under the section 5(2)(b) and 5(3) grounds of opposition, the opponent relies on the following trade marks:

FITWATER

UK registration no. 2292667

Filing date 14 February 2002; registration date 26 July 2002

Relying on all goods, namely:

Class 32: Non-alcoholic beverages; mineral waters; aerated and carbonated beverages; flavoured waters and flavoured non-alcoholic beverages; fruit juices and fruit drinks; table waters; preparations for making all of the aforesaid.

(“the opponent’s first mark”);

LUCOZADE FITWATER

UK registration no. 912286701¹

Filing date 30 March 2016; registration date 21 July 2016

¹ The opponent’s second mark is a comparable mark based on an earlier EUTM. On 1 January 2021, in accordance with Article 54 of the Withdrawal Agreement between the UK and the European Union, the UK IPO created comparable UK trade marks for all right holders with existing EUTMs. These comparable marks enjoy the same filing and registration dates as their European counterparts.

Relying on some goods only, namely:

Class 32: Mineral waters; aerated waters; non-alcoholic beverages; preparations for making beverages; aerated juices; beers; beverages containing vitamins; bottled water; carbonated non-alcoholic drinks; cola drinks; concentrates for use in the preparation of soft drinks; cordials; pastilles for effervescing beverages; energy drinks; energy drinks containing caffeine; essences for making beverages; flavoured waters; fruit based beverages; fruit flavoured beverages; fruit juices; fruit squashes; isotonic beverages; isotonic drinks; juices; lemonade; lemon squash; low calorie soft drinks; orange juice; orange squash; smoothies; soft drinks; sports drinks; sports drinks containing electrolytes; squashes [non-alcoholic beverages]; syrups for making beverages; vegetable drinks.

("the opponent's second mark"); and

The logo for 'fitwater' features the word 'fit' in a light blue, lowercase, sans-serif font, followed by 'water' in a darker blue, lowercase, sans-serif font. A small, stylized blue wave or drop shape is positioned above the 't' in 'water'.

UK registration no. 3359257

Filing date 7 December 2018; registration date 1 March 2019

Relying on some goods only, namely:

Class 32: Mineral and aerated waters, non-alcoholic drinks; fruit drinks and fruit juices; flavoured waters; bottled water; isotonic beverages; isotonic drinks; sports drinks containing electrolytes; syrups and other preparations for making beverages.

("the opponent's third mark").

3. Under the section 5(2)(b) ground, the opponent claims that the marks at issue are highly similar and that the goods at issue are identical or highly similar. In addition,

the opponent claims that its marks enjoy the benefit of an enhanced distinctive character due to the use made of them. As a result of the above, the opponent's position is that there is a likelihood of confusion between the marks on the part of the relevant public.

4. Turning to the section 5(3) ground, the opponent claims that as a result of the extensive use of its marks, they have established a significant reputation. It is claimed that due to this reputation and the similarity of the marks, it is likely that the relevant public will believe that the marks are used by the same economic undertaking or that the goods derive from, or are authorised by, the opponent. As a result, the opponent's position is that use of the applicant's mark, without due cause, would take unfair advantage of the opponent's marks. In addition (or in the alternative), the opponent claims the use of the applicant's mark, again without due cause, is likely to be detrimental to the distinctive character of the opponent's marks.
5. It is noted that under both the section 5(2)(b) and 5(3) grounds of opposition, the opponent gave a statement of use in respect of its first and second marks for all of the goods relied upon.
6. Lastly, under the section 5(4)(a) ground, the opponent relies on three unregistered signs that are identical to the marks relied upon under the above grounds. I will refer to these in the same way as I have the opponent's marks, albeit with reference to them being 'signs', not marks. Under this ground, the opponent claims to have used all three signs throughout the UK since 2007 in respect of "non-alcoholic beverages", "bottled water", "isotonic beverages", "isotonic drinks" and "sports drinks containing electrolytes". It is claimed that as a result of the use of these signs, the opponent has gained substantial goodwill in the UK. The opponent's position is that use of the applicant's mark in respect of the goods covered has the capacity to cause deception and confusion, including inducing in consumers a belief that the goods supplied by the applicant emanate from, or are associated

with, the opponent. It is claimed that this will cause damage to the opponent's business.

7. The applicant filed a counterstatement. In doing so, it requested that the opponent provide evidence proving the genuine use of its first mark only. While the applicant has acknowledged the opponent's reputation and goodwill in its marks/signs, it has denied the claims against it.
8. The applicant is unrepresented and the opponent is represented by Hogan Lovells International LLP. Only the opponent filed evidence. No hearing was requested and both parties filed written submissions in lieu of the same. This decision is taken after careful consideration of the papers.
9. 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.

EVIDENCE

10. The opponent's evidence came in the form of the witness statement of Ewa Chappell dated 12 August 2024. Ewa Chappell is General Counsel at the opponent, a position they have held since March 2023. Ewa Chappell's evidence is accompanied by eight exhibits, being EC1 to EC8, and was adduced in order to demonstrate genuine use of the opponent's first mark and a reputation and goodwill in all three of the marks/signs relied upon.
11. I do not intend to summarise the opponent's evidence in full here (or the parties' submissions, for that matter). However, I confirm that I have taken all filed

documents into account and will summarise them to the extent that I deem necessary below.

PRELIMINARY ISSUE

12. As set out above, the applicant requested that the opponent prove use for its first mark. That being said, in the same counterstatement when discussing the lack of unfair advantage, the applicant stated as follows:

“We acknowledge the reputation and goodwill that the Opponent’s Sign, “FITWATER”, has garnered over time.”

13. It is noted that when discussing the other two marks relied upon by the opponent, an identical concession is made. In respect of this point, I note that the applicant, in its submissions in lieu of a hearing, appears to challenge the opponent’s evidence insofar as it demonstrates the opponent’s claim of continued goodwill and recognition. Such submissions are, in my view, inconsistent with the applicant’s pleaded case. Where such circumstances arise, it is possible for the submissions to be treated as an application to amend pleadings or as an attempt by a party to resile from its pleaded case.² While I have given that issue consideration here, I am of the view that to treat the submissions in this way is not appropriate in the present circumstances. I say this because, in opposition proceedings, it can reasonably be said that the approach of an opponent in preparing its evidence is likely to be guided by the pleadings of an applicant. For example, if an applicant was to concede the existence of a reputation and the opponent in that case was to subsequently not file any evidence (or very light evidence, for that matter) off the back of said concession, it follows that if the concession was ultimately withdrawn, it could be argued that the section 5(3) ground should fail due to lack of evidence. Such an approach is clearly prejudicial to an opponent and while, in the present

² See the decision of Dr Brian Whitehead, sitting as the Appointed Person, in the case of *BEAK* (BL O/0096/25)

case, the opponent did file evidence, I do not consider that it is open for the applicant to now seek to argue that no reputation or goodwill exists. As such, I will proceed on the basis that the issue of a reputation under section 5(3) and goodwill under section 5(4)(a) is not in dispute. However, the issue as to the strength of the reputation and goodwill remains live, so does the question as to which goods the reputation/goodwill vests in.

14. Another issue that arises off the back of this concession is in relation to the issue of proof of use. As above, the applicant has requested that the opponent prove use for its first mark only. On this point, I remind myself that the test for a reputation under the section 5(3) ground is far more onerous on the opponent than the test for genuine use. As such, it is somewhat illogical to suggest that there exists a reputation in a mark but still contend that it has been genuinely used. In such circumstances, I am of the view that a concession as to a reputation may also be deemed as a concession as to genuine use. While that may be the case, I will still proceed to consider the issue of genuine use in the ordinary way on the basis that (1) I may be wrong to read the concession as to reputation/goodwill as a concession as to genuine use and (2) I would, in any event, still be required to determine what goods use has been shown for as the applicant has remained silent on this point. Further, later on in this decision and despite the applicant's concession, I will be required to determine the strength of the opponent's goodwill and reputation and given that said assessments will be based off the same evidence as that discussed for genuine use, skipping an assessment of the evidence at this point is of no benefit.

DECISION

Proof of use

15. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

“(6)(1) In this Act an “earlier trade mark” means –

(a) a registered trade mark or international trade mark (UK) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

(aa) a comparable trade mark (EU) or a trade mark registered pursuant to an application made under paragraph 25 of Schedule 2A which has a valid claim to seniority of an earlier registered trade mark or protected international trade mark (UK) even where the earlier trade mark has been surrendered or its registration has expired;

(ab) a comparable trade mark (IR) or a trade mark registered pursuant to an application made under paragraph 28, 29 or 33 of Schedule 2B which has a valid claim to seniority of an earlier registered trade mark or protected international trade mark (UK) even where the earlier trade mark has been surrendered or its registration has expired.

[...]

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

16. Section 6A is also relevant. It reads:

“(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.”

17. Section 100 of the Act is also relevant. It reads:

“100. 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.”

18. Given their earlier filing dates, all of the opponent’s marks qualify as earlier trade marks under the above provisions. The opponent’s first and second marks completed their registration processes more than five years prior to the filing date of the applicant’s mark. The opponent’s third mark, however, did not. As above, the applicant only sought to request proof of use for the opponent’s first mark so while it was open for the applicant to request proof of use for the opponent’s second mark, it did not do so meaning that the opponent may rely on this mark (and its third mark, for that matter) for all of the goods highlighted in its notice of opposition. As a result, it is only the opponent’s first mark that is subject to the use provisions.

19. 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].”

20. Section 6A of the Act (cited above) sets out that the relevant period for the present assessment is the five-year period prior to the filing date of the applicant’s mark, being 28 July 2023. The relevant period is, therefore, 29 July 2018 to 28 July 2023 (“the relevant period”).

21. Proven use of a mark which fails to establish that “the commercial exploitation of the mark is real”³ because the use would not be “viewed as warranted in the economic sector concerned to maintain or create a share in the mark for the goods or services protected by the mark” is, therefore, not genuine use.

³ *Jumpman* BL O/222/16

Evidence of use

22. The opponent's evidence includes information as to its entire business operation, which includes brands not at issue here (such as Lucozade at large, Orangina and Ribena, for example). While this is noted, I do not intend to focus on that evidence in any detail but will, instead, focus my assessment of use on the 'FITWATER' branding only.
23. The opponent confirms that it first launched its 'FITWATER' product in the UK in 2017. The product is a 'purified electrolyte water' for the purposes of hydrating the user. Having considered the evidence in full, I note that the 'FITWATER' product is commonly referred to as being spring water that contains electrolytes such as magnesium, calcium, sodium and chloride.⁴ In terms of how the 'FITWATER' goods are packaged, the opponent has provided screenshots of the same.⁵ While the images are taken from screenshots obtained after the relevant period expired, the unchallenged narrative evidence sets out that this branding has always featured on the bottles and multipack packaging. I do not intend to reproduce all images but note the following, for illustrative purposes:



⁴ See pages 4 and 5 of EC2 and page 1 of EC4, for example.

⁵ EC2

24. During the relevant period, it is claimed that the 'FITWATER' products were sold at vending machines in gyms and leisure centres⁶ as well as online via Amazon and in brick and mortar stores, including ASDA.⁷

25. In terms of sales, I note that the opponent has provided a breakdown of the volume of kilolitres sold and the net sales of the 'FITWATER' product between 2017 and 2023 in the UK. While the 2017 figures are of no assistance here (as the relevant period began in July 2018), I have reproduced the entirety of the figures below as they will be relevant to the issue of reputation and goodwill, which I will discuss further below. The figures are as follows:

Year	Volume (kilolitres)	Net sales (£)
2017	1,606	875,000
2018	3,097	1,573,000
2019	1,797	1,050,000
2020	366	295,000
2021	376	336,000
2022	422	407,000
2023	429	437,000
Total	8,093	4,973,000

26. Taking away the figures for 2017, the turnover relevant here stands at £4,098,000 from a total sale of 6,487 kilolitres between 2018 and 2023. On this point, however, I note that given that the relevant period commenced and concluded in July of 2018 and 2023, respectively, a proportion of those figures will be of no assistance also. I have no way to breakdown how the figures are to be apportioned, however, this is something I will bear in mind going forward.

⁶ Images of the same in situ are shown at EC2 and EC3.

⁷ See pages 3 to 8 of EC2

27. Upon launching the brand in 2017, the opponent ran a £3.5 million advertising campaign which featured British boxer Anthony Joshua and fitness influencer Emily Skye. The campaign was publicised in industry publications such as Marketing Week, The Grocer, Convenience Store, The Sport Review, Packaging News and Excel Vending.⁸ In addition, in April 2018, Anthony Joshua participated in the 'largest ever' boxercise class.⁹ While the campaigns may be relevant to the issue of reputation and goodwill, they are from before the relevant period so are of no assistance here. Even in considering this evidence, I note that while Anthony Joshua is a popular figure in UK sport, it is not clear to me the reach of the publications referred to above as no readership figures have been provided.

28. Of the campaigns shown in evidence that are relevant here, I note that in January 2019, the opponent ran a marketing campaign for 'FITWATER' under the tagline 'MORE THAN WATER'. Coverage of this is shown on articles taken from publications such as 'Talking Retail', 'Better Retail', 'Forecourt Trader', 'Scottish Local Retailer' and 'Curious Panda' (something that is confirmed in the narrative evidence as a brand and talent partnership agency).¹⁰ While these articles are noted, I have the same issue here as I did above, namely that there is nothing to suggest the readership of these publications. As such, and given that they are seemingly publications specific to retail (or brand/talent agencies), I am of the view that readership amongst the UK consumer base is likely to be limited.

29. I note that an event recap is provided which comes from an online blog called 'This Bunny Runs'.¹¹ The article make reference to the above mentioned campaign and an event hosted by Gemma Atkinson. While this is noted, again, I have nothing to suggest the reach of this event or the readership for this blog. As such, it is of very little assistance here.

⁸ EC4

⁹ EC5

¹⁰ Pages 1 to 5 of EC6

¹¹ Page 6 of EC6

30. Lastly in respect of the 'MORE THAN WATER' campaign, I note that YouTube screenshots of the adverts associated with this are provided in evidence. The video shown has a publication date of 7 January 2019 and shows that it has obtained a total of 922 views. While noted, the screenshot has a print date of 18 July 2024 meaning that it is likely that some of the views came after the conclusion of the relevant period. Even ignoring this issue and taking the views at their highest, this still reflects a very low level of viewership.

31. In respect of social media, the evidence confirms that while the 'FITWATER' brand does not have its own accounts, it does partner with influencers in order to advertise its brand. I note that screenshots are shown of Instagram posts showing a number of influencers advertising the 'FITWATER' brand.¹² Some posts are from prior to the relevant date in 2017 and early 2018 but some are shown as being dated January and October 2019. The highest engagement total for these posts is a video post from Anthony Joshua in April 2018 (so before the relevant period commenced) which shows 963,850 views. In respect of the relevant period, the largest engagement is 5,237 likes from a January 2019 post, with the lowest showing just 651 likes in October 2019. I consider that even at its highest point, this evidence is of little assistance and I say this on the basis that the nature of social media is such that I consider it likely to suggest that some engagement may have come from users outside of the UK.

Assessment of the evidence

32. I consider it necessary to briefly discuss the form of the mark. The opponent's first mark is a word only mark that consists solely of the word 'FITWATER'. The evidence mostly shows use of this word in a stylised manner, being in line with that reproduced at paragraph 23 above. I consider that the use of the word in this manner is use of an acceptable variant of the opponent's first mark on the basis

¹² EC8

that the differences between the mark as registered and as used do not alter the distinctive character of the mark,¹³ which lies in the word 'FITWATER'. Further, I note that the examples of use show 'FITWATER' accompanied with the words 'LUCOZADE SPORT'. On this point, I refer to the case of *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12 which sets out that use of one mark with, or as part of, another mark is acceptable use of the mark as registered so long as the mark continues to be perceived as indicative of the origin of the goods. In the present case, despite the presence of 'LUCOZADE SPORT', I consider the 'FITWATER' remains an indicator of origin for the goods and, as such, this use is acceptable use of the mark as registered.

33. Turning to the level of use, I appreciate that the sales figures are not significant in the context of the non-alcoholic drinks market in the UK (or the more specific bottled water market, for that matter). However, I remind myself that use need not be quantitatively significant in order for it to be deemed genuine. Further, while the advertising campaign evidence is not particularly compelling, it does demonstrate a genuine attempt to create or preserve a market share for the goods sold. As such, I am content to conclude that the opponent has genuinely used its first mark during the relevant period. However, I consider that this finding applies only to the term "drinking water containing electrolytes", being what I deem to be a fair categorisation of the only category of goods covered by the evidence provided.¹⁴

Section 5(2)(b): legislation and case law

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

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

¹³ See paragraphs 13 to 17 of *Lactalis McLelland Limited v Arla Foods AMBA*, BL O/265/22 for guidance on acceptable variants of registered marks.

¹⁴ I reach this finding following the guidance on fair specification of marks as set out in the case of *Merck KGaA v Merck Sharp & Dohme Corp & Ors* [2017] EWCA Civ 1834

(a) [...]

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood or 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.”

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

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

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to

make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
- (d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;
- (e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;
- (f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;
- (g) a lesser degree of similarity between the goods or services may be offset by a 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. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. In the judgment of the CJEU in *Canon*, Case C-39/97, the court stated at paragraph 23 that:

“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”.

38. 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.

39. The applicant's submission in respect of the goods comparison is based on a claim that the parties cater to different market segments. It contends that 'FITWATER' is positioned as a niche sports hydration drink whereas 'myfitnesswater' is part of a holistic wellness brand. Regardless of whether this is the case or not, I remind myself that when considering the likelihood of confusion under Section 5(2)(b) the assessment must be based, in fact, on the concept of 'notional and fair use' which involves carrying out the comparison of the goods based on the specifications before me, not the goods effectively provided by the parties.¹⁵ As such, the submissions of the applicant are of no assistance here.

40. The applicant's only term is "drinking water with vitamins". I have limited the opponent's first mark to being reliant upon "drinking water containing electrolytes" only. As for its second and third marks, there are registered for a broader selection of goods but, for the purposes of the present assessment, I will focus on the terms "non-alcoholic beverages" and "non-alcoholic drinks", respectively.

41. As far as I understand it, electrolytes and vitamins are not the same thing. As a result, I do not consider that "drinking water with vitamins" and "drinking water containing electrolytes" are identical. However, they are similar. The goods share a general overlap in nature in that they are types of drinking water. Further, they

¹⁵ See *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited*, Case C-533/06 at [66] and *Compass Publishing BV v Compass Logistics Ltd* [2004] RPC 41 at [22]

share the same method of use as they will be consumed in the same way. As for purpose, I have nothing before me to confirm what the actual differences are between the effects of electrolytes and vitamins on the user. It is my understanding that both act as some form of supplement to improve the function of the user's body (either in exercise or recovery). As such, I am of the view that the purposes of the goods overlap. Even if I am wrong as to any direct overlap, there is still some degree of overlap. In terms of trade channels, I am of the view that companies who offer drinking water with electrolytes are also likely to produce and sell water with vitamins. Lastly, in respect of user, I am of the view that this will overlap also but, even if it does not, there is a competitive relationship between these goods on the basis that the user may choose vitamin water over electrolyte water, or vice versa. Overall, I consider that these goods are similar to a high degree.

42. As for the reliance upon the goods in the opponent's second and third marks, I remind myself of the case of *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05 wherein the General Court ("GC") set out that an applicant's goods can be considered identical when they are encompassed in a more general category of goods as covered by the opponent. This is the case here as the applicant's goods are types of non-alcoholic beverages meaning that these goods are identical under the principle set out in *Meric*.

The average consumer and the nature of the purchasing act

43. The case law, as set out earlier, requires that I determine who the average consumer is for the respective parties' goods. I must then decide the manner in which these goods are likely to be selected by the average consumer in the course of trade. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. (as he then was) described the average consumer in these terms:

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

44. The opponent submits that the average consumer for the goods at issue will be members of the general public at large and that they will pay a low degree of attention when selecting the same. In respect of the identity of the consumer, I agree that the goods at issue will be selected by members of the general public at large. However, I do not agree that the level of attention paid will be outright low. I say this because while the goods at issue cover ordinary consumer drinks, the consumer will still likely pay attention to factors such as ingredients and potential benefits, especially since the goods at issue cover drinking water with additional vitamins and electrolytes, both of which have some form of benefit to the user. In my view, the consumer, upon selecting such goods, will pay attention to what vitamins/electrolytes are included and how they will impact upon their body. While I am of the view that the selection process will not be particularly considerate, it will be above low, sitting somewhere between a low and medium degree.

45. In terms of the selection process, the goods at issue are ordinary consumer goods that will be selected frequently and at a low cost. The goods will be available via physical retailers or their online equivalents. In either scenario, the consumer will view the goods before selecting them so, while word of mouth recommendations may play a part (giving the aural component some weight), it is the visual aspect that will dominate.

Comparison of the marks


46. It is clear from *Sabel v Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade 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 trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components.

47. 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.”

48. It would be wrong, therefore, to artificially dissect the trade marks, although it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

49. The respective trade marks are shown below:

The opponent's marks	The applicant's mark
<p data-bbox="341 360 746 454">FITWATER ("the opponent's first mark");</p> <p data-bbox="320 526 767 620">LUCOZADE FITWATER ("the opponent's second mark")</p>  <p data-bbox="341 835 746 875">("the opponent's third mark")</p>	<p data-bbox="906 584 1337 645">myfitnesswater</p>

50. I have submissions from both parties as to the similarity of the marks. While these are noted, I do not intend to reproduce them here but, for the avoidance of doubt, can confirm that I have given them due consideration.

Overall impression

51. The applicant's mark is a figurative mark that consists solely of the word element 'myfitnesswater' presented in a standard black typeface on a white background. While presented as one word, consumers will readily identify the mark as being the conjoining of three words, being 'my fitness water'. On close examination of the mark, it appears as though 'myfitness' is presented in bold whereas 'water' is not. While this may be the case, the difference is very slight and I am not convinced that consumers would notice it. In respect of the overall impression of this mark, I consider that the phrase 'myfitnesswater' will be viewed as a unit, meaning that the overall impression lies in this element as a whole. The stylisation used is so banal that it will go unnoticed.

52. As for the opponent's marks, its first mark is a word only mark consisting of 'FITWATER'. Much like the applicant's mark, this will be viewed as the conjoining of two words, being 'FIT' and 'WATER'. I consider that 'FITWATER' will be viewed as having a unitary meaning. As such, I find that the overall impression of the mark lies in the element 'FITWATER' as a whole.

53. In respect of the opponent's second mark, this is also a word only mark. While it also includes the word 'FITWATER', it has the word 'LUCOZADE' at its beginning. I consider that it is this element that plays the greater role in the overall impression of the opponent's second mark due to the fact that 'FITWATER' has descriptive qualities (as I will come to discuss below).

54. Lastly, the opponent's third mark is a figurative mark that includes the word 'fitwater' presented in a stylised manner with a small figurative flourish element at the top of the letters 'a-t'. The 'fit' element is presented in white with a blue border whereas 'water' is presented in blue. This difference in colour further emphasises the fact that the mark will be viewed as the conjoining of the words 'fit' and 'water'. The meaning associated with 'fitwater' (which I will come to discuss below) is such that, despite the fairly standard stylisation used, the word and the stylisation will play equal roles in the overall impression of the mark.

Visual comparison

55. In comparing the applicant's mark with the opponent's first mark, I note that both include the letters 'FIT' and the word 'WATER' at their ends. They differ in the presence of the word 'my' at the beginning of the applicant's mark and the fact that 'fit' is followed by the letters 'ness'. As a word only mark, the opponent's first mark is capable of being presented in the same typeface as that used by the applicant. So while I have found that the stylisation used by the applicant will go unnoticed, it will not act as a point of visual distinction in any event. Despite the points of similarity, I am of the view that in light of the overall impression of the applicant's

mark and the fact that 'my' sits at the beginning of the mark,¹⁶ the points of difference will carry equal weight. As a result, I find that these marks are visually similar to a medium degree.

56. The visual comparison in respect of the opponent's second mark is very much in line with that discussed above. However, the inclusion of the word 'LUCOZADE' at the beginning of that mark is such that, in my view, it renders the marks visually similar to only a low degree, particularly given that I have found LUCOZADE will play the greater role.

57. Lastly, I appreciate that while the opponent's third mark consists of the word 'fitwater', this is not its only element so the findings reached at paragraph 55 above are not directly applicable here. I say this because, unlike the opponent's first mark, its third mark is presented in a stylised manner and consists of an additional figurative flourish element. Bearing in mind the similarities and differences as discussed at paragraph 55 above, the additional point of difference in the stylisation used in the opponent's third mark is such that it renders the marks visually similar to between a low and a medium degree.

Aural comparison

58. The opponent's first and third marks will be pronounced the same way, as the word 'FIT WATER'. These marks are three syllables in length and will be pronounced in the ordinary way. The applicant's mark consists of five syllables that will be articulated as three words which will be pronounced in the ordinary way. The marks share the same endings, being the word 'WATER'. While the syllable 'FIT' will be the same, it is placed at different points of the marks. Further, this element in the applicant's mark forms part of a different word, being 'fitness'. Lastly, the pronunciation of 'MY' in the applicant's mark is a point of difference at its beginning.

¹⁶ See *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02 which sets out that, generally speaking, the beginnings of marks tend to have more focus than their ends.

In respect of this comparison, I note that the opponent's marks are aurally short marks, and while there is no special test for short marks,¹⁷ the shortness of 'FITWATER' is such that consumers are more likely to notice the differences with 'myfitnesswater'. Overall, I find that these marks are aurally similar to between a low and medium degree.

59. In respect of the opponent's second mark, the comparison in respect of its 'FITWATER' element is very much in line with what I have said above. However, the addition of the three syllable word 'LUCOZADE', which will be pronounced as 'LOO-CUH-ZAYD', is such a significant point of difference that it will render these marks as being aurally similar to a low degree.

Conceptual comparison

60. The concept of the applicant's mark derives from the phrase 'my fitness water'. This will be understood as a reference to 'fitness water' that is possessed by the person making the statement. Fitness water will clearly be understood as a reference to the fact that the water is consumed to assist the user's level of fitness. As for the opponent's first and third marks, the concept of the same derives from 'FIT WATER'. This will be understood as water which is consumed in order to assist the user in keeping fit. In comparing the marks, 'FIT WATER' and 'MY FITNESS WATER' clearly have a similar concept as they both relate to the health benefits of the water. That being said, the reference to possession (stemming from the use of 'my') in the applicant's mark does act as a slight point of conceptual difference. As a result, I find that the marks are conceptually similar to a high degree.

61. The use of 'FITWATER' in the opponent's second mark will be the same as above. However, the addition of 'LUCOZADE' will have no obvious meaning. So while 'LUCOZADE' acts as a point of conceptual neutrality between the marks, I consider

¹⁷ See paragraph 44 of *BOSCO*, BL O/301/20

that the shared use of 'FITWATER' is, as above, conceptually similar to a high degree.

Distinctive character of the opponent's marks

62. 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).”

63. 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 or services, to those with high inherent distinctive

character, such as invented words which have no allusive qualities. The distinctiveness of marks can be enhanced through use, and I note that the opponent has pleaded that due to the use of its marks, they enjoy an enhanced degree of distinctive character. I will, therefore, consider whether the opponent's evidence is sufficient to give rise to a finding that the distinctiveness of the opponent's marks has been enhanced through use. Before doing so, I will consider the inherent position.

64. The opponent's first mark is the word 'FITWATER'. As above, this will be understood as reference to a water that helps the user keep fit. In the context of the goods that this mark has been permitted to proceed on in this opposition (being "drinking water containing electrolytes"), I am of the view that this is descriptive. Further, it has a laudatory element on the basis that the understanding of 'FIT' will be perceived as supporting a claim that the water will help the user keep (or get) fit. As a result, I find that the distinctive character of the opponent's mark sits at a low degree. I consider that the same finding applies to the opponent's third mark on the basis that while the stylisation plays a role in the overall impression of that mark, it is hardly remarkable and will do very little to elevate the distinctiveness of the mark as a whole to any material degree beyond the distinctiveness associated with 'FITWATER'.

65. I turn now to the opponent's second mark, comprising the words 'LUCOZADE FITWATER'. I consider that consumers will see this mark as consisting of two signs, with 'LUCOZADE' being viewed as the house brand and 'FITWATER' as the descriptive sub-brand. 'LUCOZADE' has no meaning and will, instead, be viewed as a made-up word with no obvious connection to the goods at issue. As 'LUCOZADE' dominates the mark, I find that the distinctiveness of the mark as a

whole will be high. That being said, consumers will still associate 'FITWATER' with a low degree of distinctive character due to its descriptive nature.¹⁸

66. I turn now to consider the issue of an enhanced degree of distinctive character. I remind myself that the evidence of the opponent has been summarised at paragraphs 22 to 31 above. I do not intend to reproduce this here but highlight the fact that the evidence covers the sale of £4.9 million worth of electrolyte water between 2017 and 2023. While the turnover may, on the face of it, seem substantial (being in the multiple millions), I must consider it in the context of the relevant market for the goods sold. In the present case, I have no evidence as to the size of the market in which the opponent operates. That being said, I am of the view that it is likely to be a large market that involves high volumes of sales and high levels of turnover. As a result, I find that the turnover provided is very low. Further, I appreciate that the evidence does demonstrate an effort by the opponent to establish its brand between 2017 and January 2019. However, I have my issues with the spread of the advertisement campaigns discussed in that there is nothing sufficiently solid to demonstrate that the knowledge of said campaigns was particularly widespread, with coverage seemingly only coming in niche industry publications. Taking the evidence as a whole, I am of the view that it is not at a high enough level to warrant a finding that, because of the use made of them, the marks enjoy an enhanced degree of distinctive character.

Likelihood of confusion

67. 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

¹⁸ I consider it necessary to point this out here as, when considering a likelihood of confusion, it is important to bear in mind what it is about the earlier mark that gives it its distinctive character. See paragraphs 38 and 39 of *Kurt Geiger v A-List Corporate Limited*, BL O-075-13.

being the same or related. 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 earlier registrations, 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 they have retained in their mind.

68. I have found the goods at issue to be identical or similar to a high degree. The average consumer base is formed of members of the general public who will select the goods via primarily visual means (though not discounting an aural component) whilst paying between a low and medium degree of attention. In respect of the similarity of the marks, I have found the applicant's mark is:

- a. Visually similar to a medium degree, aurally similar to between a low and medium degree and conceptually similar to a high degree with the opponent's first mark;
- b. Visually and aurally similar to a low degree with the opponent's second mark. The position as to the conceptual similarity of the marks is that the 'LUCOZADE' element introduces a point of conceptual neutrality between the marks. However, I note that the 'FITWATER' element in the opponent's second mark remains conceptually similar to a high degree with the applicant's mark; and
- c. Visually and aurally similar to between a low and medium degree and conceptually similar to a high degree with the opponent's third mark.

69. Lastly, I found the opponent's first and third marks to be inherently distinctive to a low degree.¹⁹ Whilst I have found the opponent's second mark enjoys a high degree of distinctiveness character, this is a result of the inclusion of the word 'LUCOZADE'.

70. Taking all of the above factors into account and even bearing in mind the principle of imperfect recollection, I do not consider that the marks at issue will be misremembered or inaccurately recalled for one another. Firstly, while I appreciate that the marks share a high degree of conceptual similarity in respect of the 'FITWATER' and 'myfitnesswater' elements, those elements are descriptive of the goods at issue and as, such, I see no reason why the conceptual similarity would outweigh the visual and aural differences between the marks, namely the inclusion of the word 'my' and the letters 'ness' after 'fit' in the applicant's mark. On this point, and having paid particular attention to the lower degree of distinctiveness of the opponent's marks (and of the 'FITWATER' element in its second mark, for that matter), I find that the differences in the parties' marks will take on a greater significance for the average consumer, even where a lower degree of attention is paid. Consequently, I do not find that there exists a likelihood of direct confusion between the marks at issue, even when viewed on identical goods or in circumstances wherein the consumer is paying a lower degree of attention.

71. I will now proceed to consider indirect confusion. In doing so, I remind myself of the case of *L.A. Sugar Limited v By Back Beat Inc*, BL O/375/10, wherein 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

¹⁹ On this point, I remind myself that a weak distinctive character does not preclude a likelihood of confusion. See *L'Oréal SA v OHIM*, Case C-235/05 P

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'.

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)".

72. While the above examples in *L.A. Sugar* are noted, they are not intended to be treated as an exhaustive list of the only instances whereby indirect confusion occurs.

73. Further, I note the case of *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, wherein Arnold LJ referred to the comments of James Mellor Q.C. (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at paragraph 16 that “a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion”. Arnold LJ agreed, pointing out that there must be a “proper basis” for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

74. The opponent’s submissions in respect of confusion set out that this case falls within either category (a) or (c) of *L.A. Sugar* (cited above). Firstly, category (a) applies in circumstances where the common element between marks is so strikingly distinctive that consumers would believe that only one undertaking uses them. This is not the case here as the common elements of ‘FIT’ and ‘WATER’ are, clearly, not strikingly distinctive. On the contrary, they are low in distinctive character. Further, I see no basis as to why category (c) applies here either. While ‘FIT’ does evoke ‘fitness’, I see no reason why consumers would believe that the undertaking responsible for ‘FITWATER’ would add the word ‘my’ and expand the word ‘FIT’ to ‘fitness’ in order to indicate a brand extension or sub-brand. Instead, I consider that the shared use of ‘FIT’ and the word ‘WATER’ would be viewed as purely coincidental, especially when considering them in light of the goods at issue. For example, consumers would believe that ‘myfitnesswater’ was a wholly unconnected and different brand to that of the opponent that sold its own water products. Consequently, there exists no likelihood of indirect confusion, even when viewed on identical goods or in scenarios where a lower degree of attention is paid.

Section 5(3)

75. Section 5(3) of the Act states:

“5(3) A trade mark which –

is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a European Union trade mark or international trade mark (EC), in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier trade mark.”

76. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, Case 252/07, *Intel*, Case C-408/01, *Adidas-Salomon*, Case C-487/07, *L’Oreal v Bellure*, Case C-323/09, *Marks and Spencer v Interflora*, Case C383/12P, *Environmental Manufacturing LLP v OHIM*. The law appears to be as follows:

(a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Salomon*, paragraph 29 and *Intel*, paragraph 63.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant

consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel*, paragraph 42

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel*, paragraph 68; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel*, paragraph 79.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel*, paragraphs 76 and 77 and *Environmental Manufacturing*, paragraph 34.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel*, paragraph 74.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV*, paragraph 40.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation

and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the holder of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora*, paragraph 74 and the court's answer to question 1 in *L'Oreal v Bellure*).

77. The conditions of section 5(3) are cumulative. Firstly, the opponent must show that the marks at issue are similar. Secondly, the opponent must show that its marks have achieved a level of knowledge/reputation amongst a significant part of the public throughout the relevant territory. Thirdly, it must be established that the level of reputation and the similarities between the parties' marks will cause the public to make a link between them. Finally, assuming the first three conditions have been met, section 5(3) requires that one or more of the types of damage will occur. It is unnecessary for the purposes of section 5(3) that the goods or services be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks.

Reputation

78. I have assessed the opponent's evidence of use at paragraphs 22 to 31 above. I do not intend to repeat this evidence in full here but remind myself that the opponent enjoyed a turnover of £4.9 million between 2017 and 2023 whilst also making efforts (albeit somewhat limited) to advertise its brand between 2017 and 2019. My primary view is that, in line with what I have said above when considering an enhanced distinctive character, this use is not at a high enough level to warrant a finding that the opponent's marks enjoy a reputation. However, in light of the concession of the applicant (which I have discussed at paragraph 12 above), I am bound to proceed as if there does exist some reputation in the opponent's marks.

In the present case, I am of the view that the low level of use is only sufficient to demonstrate that the opponent's marks enjoy a relatively weak reputation. Further, such a reputation only vests in those goods for which use was found, being "drinking water containing electrolytes".

Link

79. As noted above, my assessment of whether the public will make the required mental 'link' between the marks must take account of all relevant factors. The factors identified in *Intel* are:

The degree of similarity between the conflicting marks.

80. Under the section 5(2)(b) ground, I found that that the applicant's mark is:

- a. Visually similar to a medium degree, aurally similar to between a low and medium degree and conceptually similar to a high degree with the opponent's first mark;
- b. Visually and aurally similar to a low degree with the opponent's second mark. The position as to the conceptual similarity of the marks is that the 'LUCOZADE' element introduces a point of conceptual neutrality between the marks. However, I note that the 'FITWATER' element in the opponent's second mark remains conceptually similar to a high degree with the applicant's mark;
- c. Visually and aurally similar to between a low and medium degree and conceptually similar to a high degree with the opponent's third mark.

The nature of the goods or services for which the conflicting marks are registered, or proposed to be registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public.

81. The reputed goods of the opponent formed the basis of my comparison under the section 5(2)(b) ground above. In that comparison, I found those goods to be similar to a high degree with the applicant's goods. That same finding applies here.

The strength of the earlier mark's reputation.

82. The opponent's marks enjoy only a relatively weak reputation in respect of "drinking water containing electrolytes".

The degree of the earlier mark's distinctive character, whether inherent or acquired through use.

83. The opponent's first and third marks are inherently distinctive to a low degree. The opponent's second mark enjoys a high degree of distinctive character but I remind myself that this predominantly vests in the word 'LUCOZADE'.

84. In respect of an enhanced degree of distinctiveness, I remind myself that while the test for enhanced distinctiveness is different to the test for reputation, the factors relevant to both assessments are the same. Therefore, it is common in instances where all other factors are equal for the findings to be the same. However, the reason I have proceeded to find a reputation under the present ground is based on a concession of the applicant. I do not consider that such a concession should automatically equate to a finding that the opponent's marks also enjoy a degree of enhanced distinctive character under the present ground. As such, and given everything I have said with respect to the opponent's evidence above, I do not find that the opponent's marks enjoy a degree of enhanced distinctiveness beyond their inherent levels.

Whether there is a likelihood of confusion

85. I have found that there is no likelihood of confusion between the parties' marks.

Conclusion on link

86. In considering the issue of a link, I note that, in the present case, the opponent has pleaded that a link exists because the relevant public would believe that the applicant's mark was used by the same economic undertaking as the opponent's marks or that the goods offered under the applicant's mark derive from, or are authorised by, the opponent. Such a pleading is akin to a claim that there exists a likelihood of indirect confusion between the marks. While the opponent's marks do enjoy a reputation, this is to a relatively weak degree and given what I have said above in respect of indirect confusion at paragraph 74 above, I see no reason to deviate from the conclusions I have reached under that assessment. As a result, I find that the opponent has failed to demonstrate the existence of a link in the present case.

87. I appreciate that a link may exist in circumstances where the relevant public simply calls to mind a party's mark or if they are caused to wonder whether the marks are linked. However, such an argument has not been raised in the present case so is of no assistance here. Even if such an argument was specifically pleaded, I do not consider that a link would have been found to exist in any event. I say this because even though the opponent's marks enjoy a reputation, I do not consider that the relevant public would believe that the applicant's mark was linked to the opponent's marks. Instead, the common reference to 'FIT' and 'WATER', in the present circumstances, is such that it would likely be viewed as a coincidence, as opposed to there being a link between the parties' marks. On this point, I will say that even if a link was to be made, it would be so fleeting (due to the weak common element of the marks) that no damage would arise.

88. To conclude, I find that the present ground fails in its entirety.

Section 5(4)(a)

89. Section 5(4)(a) of the Act states as follows:

“5(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented -

a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection (4A) is met,

aa)...

b) ...

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of “an earlier right” in relation to the trade mark”.

90. Subsection (4A) of section 5 of the Act states:

“(4A) The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of application for registration of the trade mark or date of the priority claimed for that application.”

91. I consider that I can deal with this ground briefly. I say this because based on the evidence before me (which I have discussed at paragraphs 22 to 31 above) and the concession of the applicant, I find that there exists a level of protectable goodwill in the opponent’s business in respect of the same goods for which there

exists genuine use and reputation.²⁰ Further, I find that the opponent's signs are distinctive of and/or associated with that goodwill.

92. Under the 5(2)(b) ground, I found there to be no likelihood of confusion between the parties' marks, even when viewed on identical goods. In assessing the present ground, I remind myself of the case of *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation* [2016] EWCA Civ 41, wherein Kitchin LJ set out that it was doubtful whether the difference between the legal tests for likelihood of confusion and misrepresentation will (all other factors being equal) produce different outcomes. Because the opponent's signs are identical to the marks relied upon under the section 5(2)(b) ground, I am of the view that this principle applies here. As such, I find that there exists no misrepresentation under the present ground for the same reasons as set out at paragraphs 70 to 74 above. Without a finding of misrepresentation there can be no damage, meaning that this ground of opposition fails in its entirety.

CONCLUSION

93. The opposition fails in its entirety and the applicant's mark will, subject to any successful appeal of my decision, proceed to registration for all of the goods applied for.

COSTS

94. The applicant has been successful and it is, therefore, entitled to a contribution towards its costs. In the present case, I note that the applicant is unrepresented so in order to claim costs, it was required to file a costs proforma. While that may be

²⁰ On this point, I appreciate that the goods for which goodwill is claimed differ slightly from those relied upon under the section 5(2)(b) and 5(3) grounds. However, the evidence is clear in that it shows use for just one type of good and, under the present ground, this term is a suitable subcategory of all of the terms relied upon here.

the case, I note that the applicant has not been provided with a costs proforma and, as a result, I am unable to deal with the issue of costs at this stage.

95. A copy of the costs proforma will be provided to the applicant upon the issuance of this decision. The applicant is hereby directed to file a completed costs proforma to the Tribunal within 14 days of the date of this decision. Once this is received, I will issue a supplementary decision dealing with the issue of costs. In the event that the applicant fails to file a costs proforma within 14 days of the date of this decision, it will not be permitted to recover any costs for these proceedings. Even if no costs proforma is received, I will still issue a supplementary decision dealing with the issue of costs.

96. For the avoidance of doubt, the appeal period for this decision will not begin until my supplementary costs decision is issued.

Dated this 26th day of November 2025

**A COOPER
For the Registrar**