

IN THE MATTER OF A TRADE MARK APPLICATION NO T04/07494A BY AW HOLDINGS CORP

AND

**OPPOSITION THERETO BY
BOOST JUICE HOLDINGS PTY LIMITED**

*Before Principal Assistant Registrar of Trade Marks Mr Wong Sheng Kwai
27 November 2007*

Trade Marks – Opposition to registration – Likelihood of confusion - whether the Application Mark 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 - Section 8(2)(b) of the Trade Marks Act 1998 [Cap. 332]

The Applicants, AW Holdings Corp, applied for registration of a mark on 11 May 2004, which comprised the words “BOOSTER JUICE”, for the goods “Non-alcoholic and low alcohol beverages (containing not more than 1.2% of alcohol by volume); smoothies, shakes and drinks consisting of or containing fruit, vegetables and juices; juice and juice drinks; water; mineral and aerated waters; beer, lager, ale and porter; syrups and preparations for making beverages” in class 32.

The Opponent, Boost Juice Holdings Pty Limited, are the proprietors in Singapore of the mark, “BOOST” for the following:

	Trade Mark Registration No.	Trade Mark	Specification of Goods & Services	Class
1	T04/09808E	"BOOST"	Mineral and aerated water and other non-alcoholic drinks; fruits drinks and fruit juices; syrups and other preparations for making beverages; none of the above containing jujube (phutsa) juice.	32
2	T04/09809C	"BOOST"	Take-away and restaurant services providing mineral and aerated waters and other non-alcoholic drink, fruit drinks and fruit juices; including fruit- based nutritional drinks and juices, vegetable drinks and vegetable-based nutritional drinks and juices, fruit flavoured drinks, ades (fruit flavoured fizzy or soft drinks) and punches, sports drinks, bottled drinking water, a blended mixture of fresh fruit, fruit juice, sorbet and ice, in variety of flavours, a blended mixture of fresh vegetables, vegetable juice, sorbet and ice in a variety of flavours, yoghurt based drinks, vegetable and meat filled wraps and sandwiches, healthy snacks, muffins, muesli bars and nutritional supplements.	43

The Opponents raised objections under sections 7(1), 7(6) and 8(2) (b) of the Trade Marks Act (1998) (hereinafter referred to as “TMA”) in their Notice of Opposition but proceeded only on section 8(2) (b) of the TMA at the hearing.

Preliminary matters

The Applicants, noting that the Opponents only indicated that they are not proceeding on section 7(1) and 7(6) of the TMA at the hearing itself, applied for costs thrown away in respect of preparatory work done on the said grounds. They also sought security for costs on the basis that the Opponents being a foreign entity, has not commenced business operations in Singapore.

Held:

1. Application for costs thrown away in respect of preparatory work done on section 7(1) and 7(6) of the TMA allowed in favour of the Applicants.
2. No order made on the application for security for costs.

The Applicants first used the “BOOSTER JUICE” mark in Canada around November 1999 on juices and derivative products. The Opponents opened its first “BOOST” juice bar in Australia in April 2000 selling mainly fruit and yoghurt based beverages or smoothies. Both parties’ mode of business expansion is via franchising.

The Opponents contended that the Applicants’ mark “BOOSTER JUICE” is similar to Opponents’ earlier marks “BOOST” in respect of identical or similar goods and services which is likely to cause confusion and should be refused registration because -

- a. the Applicants’ mark incorporates the Opponents’ mark in its entirety with the addition of the suffix “ER” and the descriptive word “JUICE”.
- b. the Applicants’ specification of goods in class 32 largely overlaps with those of Opponents. The Applicants’ business is that of juice bars, which focuses on the sale of juices directly to customers which is substantially the same business as that of the Opponents.
- c. with the possibility of imperfect recollection, there is a real risk that the public might believe that the goods came from the same source or economically linked source.

The Applicants contended that –

- a. their mark is visually and aurally different because it is made up of two words which is tri-syllabic, as opposed to the Opponents’ single word mark which is mono-syllabic. Conceptually, it is different from the “BOOST” mark which is a commonly used word in the English language and does not indicate the type of goods or services it covers.
- b. the Opponents’ registration in class 43 is irrelevant to the proceedings as it concerns the provision of “take away and restaurant services and not goods. Some of their goods are not the same or similar to the goods in the Opponents’ class 32 registration.
- c. Many Singaporeans who have had the opportunity to travel to Canada, the USA and the Middle East would have been exposed to the Applicants’ mark and with their substantial online presence, the public in Singapore can easily resolve any doubt or confusion between the Applicants’ mark and the Opponents’ mark through the internet.

Held, disallowing the application mark to proceed to registration

1. It is pertinent that both proprietors are in the same market space of selling juices and related beverages to the general public. It is likely in the marketplace that the marks would be remembered and referred to by consumers by the respective distinctive parts of the marks i.e. “BOOST” and “BOOSTER”. Given the visual, aural and conceptual similarity of the two words, the marks in question are similar for the purposes of section 8(2) (b) of the TMA.
2. As this opposition is against an application under class 32 for goods and not for an application in class 43 for services, the pertinent issue is as to similarity of goods. On the goods specified in the Opponents’ registration under class 32, the Applicants’ goods are identical for non-alcoholic beverages and similar for low-alcohol beverages.
3. A substantial number of consumers, with possible imperfect recollection, if confronted with both “BOOSTER JUICE” and “BOOST” Juice marks in the context of high density shopping and pedestrian traffic, would in all likelihood be confused into thinking that the marks in question came from the same source or economically related source. Taking into account all of the circumstances of the case, there exist a likelihood of confusion amongst the public here with regard to the marks in question.

Provisions of Legislation discussed:

- Trade Marks Act 1998 (Cap. 332, 2006 Rev. Ed.) Section 8(2) (b).

Cases referred to:

- The Polo/Lauren Co, LP v Shop-in Department Store Pte Ltd [2006] 2 SLR 690.

- The Polo/Lauren Co, LP v Shop-in Department Store Pte Ltd [2005] 4 SLR 816
- British Sugar plc v James Robertson & Sons Ltd [1996] RPC 281.
- Richemont International SA v Goldlion Enterprise (Singapore) Pte Ltd [2006] 1 SLR 401.
- Clark v Sharp [1898] 15 RPC 141
- Darmik Laboratories Inc v Galdema SA [2005] SGIPOS 17
- Cooper Engineering Co Pty Ltd v Sigmund Pumps Ltd [1952] HCA 15; 86 CLR 536;
- Opposition by Bencom s.r.l. to Registration of Trade Mark Application 912346(25) – KILLER INSTINCT;
- Stichting Lodestar v Austin Nichols & Co Inc [2006] SGIPOS 11.
- Re Jellinek's Application (1946) 63 RPC 59
- Pianotist Co's Application [1906] 23 RPC 777

Representation:

- Mr Lim Yee Ming (M/s Kelvin Chia Partnership) for the Applicants.
- Mr Gilbert Leong with Mr Calvin Lim (M/s Rodyk & Davidson LLP) for the Opponents.