

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No 2118712
BY SOCIETE DES PRODUITS NESTLE S.A. TO
REGISTER A TRADE MARK IN CLASS 30**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER
No 50211 BY KELLOGG COMPANY AND
KELLOGG MARKETING AND SALES CO (UK) LTD**

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No 50211 by Kellogg Company and Kellogg
Marketing and Sales Co (UK) Ltd**

BACKGROUND

1. On 16 December 1996 Societe des Produits Nestle SA applied to register the following series of four trade marks in Class 30 for a specification of “Breakfast cereals”:-

FROSTBITE
FROSTBITES
FROST BITE
FROST BITES

2. The application was subsequently accepted by the Registrar and published in the Trade Marks Journal. On 23 September 1999 Kellogg Company and Kellogg Marketing & Sales Co (UK) Ltd filed a Notice of Opposition. In summary the grounds were:-

- (i) Under Section 5(2)(b) of the Act because the mark applied for is similar to the following trade marks owned by the opponent and registered for the same goods:-

Mark	Registration Number	Registration Date	Class	Specification
FROSTIES	849093	14.05.63	30	Cereal preparations being breakfast foods in flaked form and coated with sugar
FROSTIES	2189956	24.02.99	30	Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals; bread, pastry and confectionery, ices; honey, treacle; yeast, baking powder;

salt, mustard, vinegar, sauces (except salad dressings); spices; ice; breakfast cereals and cereal preparations for human consumption; breakfast cereal bars; biscuits

- (ii) Under Section 5(4)(a) of the Act in that use of the application is liable to be prevented by the law of passing off.

3. On 17 December 1999 the applicants filed a counterstatement denying all grounds of opposition. Both parties ask for their costs, but no hearing was requested and no written submissions were received.

OPPONENTS’ EVIDENCE

4. This consists of three statutory declarations, one each from Guy Longworth, Alan Walker and Jane More O’Ferrall, dated 20 April 2000, 6 June 2000 and 7 June 2000 respectively.

5. Mr Longworth is the Marketing Director of Kellogg Marketing & Sales Co (UK) Limited. He explains that the product now known as FROSTIES was originally launched in the UK as FROSTED FLAKES in 1954 but was re-launched in 1960 as FROSTIES. Consequently, the opponents have been selling food products under the name FROSTIES in the UK for nearly forty years. Mr Longworth adds that his company does have exact figures for sales and advertising of its FROSTIES product, but for the purposes of his declaration precise figures have not been given. However, he provides the following information:-

<u>Year</u>	<u>Sales (£)</u>	<u>Advertising Expenditure (£)</u>
1985	In excess of 20 million	In excess of 5 million
1986	25 million	5 million
1987	35 million	5 million
1988	40 million	5 million
1989	45 million	5 million
1990	45 million	5 million
1991	45 million	5 million
1992	50 million	5 million
1993	60 million	5 million
1994	60 million	10 million
1995	65 million	10 million
1996	65 million	10 million

6. Mr Longworth states that the FROSTIES product is stocked by almost every class of food retailer in locations throughout the UK, including the largest supermarket chains. He estimates that in 1995, around 38 million boxes of FROSTIES cereals were sold through retail outlets in the UK and that, in addition, further substantial sales of the product would have been made within his company’s VARIETY range of small packs purchased as a set. He

continues by pointing out that FROSTIES is Kellogg's second biggest selling product in the UK, and its biggest seller globally.

7. Mr Longworth goes on to state that the product has been extensively promoted through advertising campaigns and he refers to Exhibit GL1 to his declaration which consists of copies of a series of posters used to advertise FROSTIES, and Exhibit GL2 to his declaration which comprises a video tape showing a selection of some of the advertisements which have appeared in recent years for the FROSTIES product. He adds that while the famous house mark KELLOGG is always used on all of their products, he draws attention to two advertisements within Exhibit GL2 where the name FROSTIES is featured alone, without the house mark. Mr Longworth is in no doubt that the opponents' product is widely known by the name FROSTIES alone and is referred to in that way by consumers and retailers alike.

8. Next, Mr Longworth refers to the fourteenth advertisement appearing on Exhibit GL2, which illustrates the sponsorship by his company, specifically by reference to the FROSTIES product, of the weekly television show "Gladiators". He explains that the "Gladiators" programme was shown early on Saturday evenings in 1993 and that the 1993 average weekly viewing figures for the series were 11.5 million. Mr Longworth concludes by drawing attention to a recent (1998) promotion of FROSTIES for a FROSTIES mug and at Exhibit GL3 to his declaration are copies of cereal packs illustrating this promotion.

9. The opponents' next statutory declaration is filed by Alan Walker who is the Category Development Systems Manager at Kellogg Marketing & Sales Co (UK) Limited. Mr Walker understands that his company's trade mark attorneys (Haseltine Lake) have carried out searches to ascertain the extent of breakfast cereals commencing with the word FROST and as, to the best of his knowledge, the name FROSTED is in fairly common use for the relevant goods, he explains that the information obtained excludes reference to such trade marks.

10. Mr Walker claims an extensive knowledge of trade marks in the UK market place in respect of breakfast cereals and has implemented and maintained a database of such trade marks which form part of his company's records. He explains that his knowledge of the market place comes from his personal observations and from information obtained by personnel in his company involved in sales and marketing.

11. Mr Walker understands that the searches carried out by Haseltine Lake indicate two trade marks of possible relevance, namely FROST FRESH and FROSTA. He states that to the best of his knowledge and belief, neither of these trade marks is in use in the UK in respect of breakfast cereals and he is not aware of any use having been made of them.

12. The opponents' final statutory declaration is by Jane More O'Ferrall, a registered trade mark attorney and partner in the firm Haseltine Lake Trademarks (the opponents' representatives).

13. Ms O'Ferrall explains that in September 1999 she instructed the carrying out of a search of the UK and European Community Trade Mark registers in respect of all trade marks in

Class 30 containing the word FROST. A copy of the search report containing information taken from the Trade Marks Registry database at 17 September 1999 is at Exhibit JMOF1 to her declaration.

14. Firstly, Ms O’Ferrall draws attention to the trade marks in the ownership of the first opponents, Kellogg Company:

KELLOGG’S SUGAR FROSTED FLAKES;
FROSTIES;
FROSTICLES;
FROSTIS;
FROSTIZ;
FROSTIES; and
FROSTIES.

15. She states that with the exception of the first of the above trade marks, where FROSTED is used descriptively in relation to the products, and is disclaimed, all these trade marks *commence* with the element FROST, and cover *cereal preparations/breakfast cereals*.

16. Next, Ms O’Ferrall points out that the following trade marks are in the proprietorship of the applicants, Societe De Produits Nestle Sa:

JACK FROST,
FROSTY,
FROSTED SHREDDIES,
JACK FROST,
FROSTBITE (*the application the subject of this opposition*)

She noted that the first two above-listed registrations do not cover the goods breakfast cereals.

17. As to trade marks in the proprietorship of other companies, Ms O’Ferrall states that the search revealed the following trade marks containing the word FROST registered for breakfast cereals:

BO FROST & device: Boquoi Handels- Kommanditgesellschaft
CRAIGMILLAR GOLDFROST: Unilever Plc
GOLDFROST FLEX: Unilever Plc
GOLDFROST/GOLD FROST: Unilever Plc
GOLDFROST BAKE READY/GOLDFROST BAKEREADY: Unilever Plc
SWEET FROST: Macphie of Glenbervie Ltd
STARFROST: Hansa-Tiefklimenli GmbH & Co
INTERFROST: Bobis Auexenhandels GmbH
LA FROSTELLA: Eurogel Konditorwaren GmbH

She notes that there is no evidence of any trade marks covering relevant goods and with the prefix FROST.

18. Ms O’Ferrall goes on to state that on 30 March 2000 she instructed the carrying out of a common law search for trade marks commencing with FROST in use in the UK for breakfast cereals and at Exhibit JMOF3 to her declaration is a copy of the report which was produced. Ms O’Ferrall states that scrutiny of the search results indicated to her that there were three names which might possibly be applied to breakfast cereals - these being FROST FRESH, FROSTA and FROSTED CHEX. She explains that her firms attempted to locate references upon the internet to the three trade marks in question and that there is no indication that any of these names is currently in use in the UK.

19. As the applicant for registration has not submitted evidence in support of the application this completes my summary of the evidence. I now turn to the decision.

DECISION

20. Firstly, I will consider the ground of opposition under Section 5(2)(b) which reads as follows:-

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

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

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark."

21. An earlier right is defined in Section 6, the relevant parts of which state:

6.-(1)

- (a) a registered trade mark, international trade mark (UK) or Community trade mark 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.

22. I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] ETMR 1, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] ETMR 1, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* [2000] FSR 77 and *Marca Mode CV v Adidas AG* [2000] ETMR 723.

23. It is clear from these cases that:-

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*, paragraph 22;

- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel v Puma AG*, paragraph 23, 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; *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* paragraph 27;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v Puma AG*, paragraph 23;
- (d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v Puma AG*, paragraph 23;
- (e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, paragraph 17;
- (f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v Puma AG*, paragraph 24;
- (g) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel v Puma AG*, paragraph 26;
- (h) further, 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; *Marco Mode CV v Adidas AG*, paragraph 41;
- (i) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, paragraph 29.

24. In light of the opponents' prior registrations in Class 30 it is clear that identical goods are involved. Furthermore, although there is no evidence on the point, my own experience tells me that "breakfast cereals" are not a technically sophisticated or expensive product. They are sold side-by-side on the shelves of retail outlets and as "quick turnover" goods they are, on a relative basis, not subjected to close scrutiny prior to purchase.

25. The reputation of a mark is an element to which importance may be attached in Section 5(2) considerations. It is clear from the statutory declaration of Mr Longworth that the opponents have a long history of use of their mark FROSTIES in the UK (since 1960) on the relevant goods, that the mark has extensively promoted through advertising and that sales of the product (breakfast cereals) under the mark have been consistently high over a considerable

period. I have no hesitation in coming to the view that the opponents' have established a strong reputation in the mark FROSTIES and I will take this into account in my decision.

26. In their statutory declarations filed on behalf of the opponents, Mr Walker and Ms O'Ferrall have provided information and views upon trade marks beginning with the word FROST and used on breakfast cereals. I would only comment that I do not find such information to be of any great assistance. My own knowledge tells me that the word "frosted" used in relation to cereal or confectionery items is a generic term. My decision involves a comparison of the applicant's and opponents' particular marks and must be made on its own merits.

27. In essence, the test under Section 5(2)(b) is whether there are similarities in marks and goods which would combine to create a likelihood of confusion. In this case I accept that identical goods involved and that the opponent's mark possesses a reputation. However, it was held in *Marca Mode v Adidas AG* (2000) ETMR 723:

"The reputation of a mark, where it is demonstrated, is thus an element which, amongst others, may have a certain importance. To this end, it may be observed that marks with a highly distinctive character, in particular because of their reputation, enjoy broader protection than marks with a less distinctive character (*Canon*, paragraph 18). Nevertheless, the reputation of a mark does not give grounds for presuming the existence of a likelihood of confusion simply because of the existence of a likelihood of association in the strict sense."

28. In my consideration of whether there are similarities sufficient to show that a likelihood of confusion I am guided by the recent judgements of the European Court of Justice mentioned earlier in this decision. The likelihood of confusion must be appreciated globally and I need to address the degree of visual, aural or conceptual similarity between the marks, evaluating the importance to be attached to those different elements, taking into account the category of goods in question and how they are marketed.

29. The mark FROSTIES consists of an invented word. Although the word FROSTIES may well allude to "frosted" ie covered with sugar icing, the allusion is both skilful and indirect. Turning to the marks applied for, they are a series of four which are essentially based on the dictionary word FROSTBITE - the alternative presentation of the word as two words ie FROST BITE, or with a letter S on the end ie FROSTBITES and FROST BITES, does not, in my view, have any material effect. Obviously, the dictionary word has no meaning whatsoever in relation to the goods applied for and while, once again, the marks may well allude to "frosted" goods (possibly 'bite' sized), any allusion is both skilful, indirect and overwhelmed by the obvious dictionary meaning. It is, of course, possible to over analyse marks and in doing so shift away from the real test which is how marks would be perceived by customers in the normal course and circumstances of trade and I must bear this in mind when making the comparisons.

30. I first of all turn to a visual comparison of the marks. In my view, the opponent's strongest case lies with a comparison of their mark with the second mark in the series applied for ie FROSTBITES, as both marks consist of one word commencing with the word FROST

and ending with the letters ES. However, despite these similarities in construction, it seems to me that the applicant's mark consists essentially of a well known dictionary word (with its own distinct and separate connotation) which the customer is likely to recognise and retain in visual use and in visual comparisons with other similar products.

31. On the consideration of aural use of the marks, it seems to me that the respective marks sound different and in aural use the dictionary meaning of the applicant's mark is, once again, obvious. I would only add that "breakfast cereals" are primarily identified and purchased through visual means (although this does not mean that aural confusion could not be relied upon if it were shown).

32. Finally, I turn to a conceptual comparison of the marks. While both marks consist of words which may allude to the goods being "frosted" ie covered in sugar icing, this is hardly a novel or distinctive concept in relation to breakfast cereals. In any event, the marks applied for have their own distinct dictionary meaning which would, in my view, be recognised by the vast majority of customers. This point is of particular relevance to considerations on the effect of imperfect recollection of the respective marks as the obvious dictionary meaning is likely to be retained in customer's minds and would assist in enabling them to distinguish the respective marks. For the same reason I do not believe that the applicant's marks will be mistakenly taken to denote 'bite size' FROSTIES.

33. To conclude, given the overall differences between the marks and taking into account all the relevant factors, including imperfect recollection, on a global appreciation I believe the possibility of confusion is sufficiently remote that it cannot be regarded as a likelihood. It is possible that some people encountering that some people encountering the applicant's mark may think it reminiscent of the opponents' mark but it does not follow that a likelihood of confusion exists. The opponents have failed to discharge the onus placed upon them and the opposition under Section 5(2)(b) fails.

34. I now consider the ground of opposition under Section 5(4)(a) which states:

"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, or

(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.

(5) Nothing in this section prevents the registration of a trade mark where the proprietor of the earlier trade mark or other earlier right consents to the registration."

35. In deciding whether the mark in question offends against this section, I intend to adopt the guidance given by the Appointed Person, Mr Geoffrey Hobbs QC, in the WILD CHILD case

(1998 14 RPC 455). In that decision Mr Hobbs stated that to succeed in a passing off action, it is necessary for the opponent's to establish, at the relevant date (16 December 1996), that: (i) they had acquired goodwill under their mark; (ii) that use of the mark would amount to a misrepresentation likely to lead to confusion as to the origin of their goods; and (iii) that such confusion is likely to cause real damage to their goodwill.

36. I have already found that the opponent has goodwill in the trade mark used as the basis of this opposition but concluded that this was not enough to result in a likelihood of confusion under Section 5(2). It seems to me that the necessary misrepresentation required by the tort of passing off would not occur here, either. The ground of opposition under Section 5(4) therefore fails.

37. The applicants are entitled to a contribution towards their costs and I therefore order the opponents to pay them the sum of £600. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 30 day of July 2001

JOHN MACGILLIVRAY
For the Registrar
the Comptroller-General