

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION No. 2229248  
BY AUNTY G LIMITED  
TO REGISTER A TRADE MARK IN CLASSES 29 AND 30**

**AND**

**IN THE MATTER OF OPPOSITION THERETO UNDER No. 51381  
BY NETBIZ LIMITED**

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by Aunty G Limited to register a Trade Mark in Classes 29 and 30**

**AND**

**IN THE MATTER OF Opposition thereto under No. 51381  
by Netbiz Limited**

### **BACKGROUND**

1. On 12 April 2000 Aunty G Limited applied to register the trade mark AUNTY G'S JOLLY GOOD MEALS in Class 29 and 30 of the Register for the following specifications of goods:

#### **Class 29:**

Meat, fish, poultry and game; seafoods; fruit and vegetables, all being preserved, dried, cooked, processed or frozen; preparations made from all the aforesaid goods; dairy products; cheeses; curds; sweetened curds; savoury curds; frozen curds; frozen yoghurt; fruit yoghurt; savoury yoghurt; vegetable yoghurt; savoury vegetable yoghurt; mousses, chilled desserts, desserts made from dairy products; soups; sweet spreads, savoury spreads; salads; drinks, fillings, snack foods, prepared meals and constituents for meals; proteinaceous substances; dips; lentils, beans, pulses; all included in Class 29.

#### **Class 30:**

Rice, pasta; cereals and cereal preparations; tea, coffee, cocoa; spiced tea, herbal tea; drinking chocolate, coffee essence, coffee extracts, mixtures of coffee and chicory, chicory and chicory mixtures, all for use as substitutes for coffee; non-medicated confectionery; pastries, cakes, biscuits; ices, ice-cream, ice-cream products, frozen confections; chilled desserts, mousses, sorbets; bread; pastry; drinks, fillings; sweet spreads, savoury spreads, condiments, sweet chutney, savoury chutney; spices; snack foods, prepared meals and constituents for meals; chocolate; pizzas; pizza bases; sauces and toppings for pizza; sauces for pasta, rice and curry; salad dressings; mayonnaise, sauces; dips; all included in Class 30.

2. The application was subsequently accepted by the Registrar and published in the Trade Marks Journal.

3. On 7 September 2000 Netbiz Limited filed a Notice of Opposition. In summary the Statement of case (as amended) set out the following grounds:

(i) Under Section 5(2)(a) and/or Section 5(2)(b) of the Act because the mark is identical with or similar to the following earlier trade mark owned by the opponent and is to be registered for the same and similar goods as the opponent's goods and services in Classes 29, 30 and 35 and there exists a likelihood of confusion on the part of the public:

NUMBER	MARK	APPLICATION DATE	GOODS AND SERVICES
2211183	auntie G	13 October 1999	<p><b>Class 29:</b>            Meat, fish, poultry, game; meat extracts; seafoods; fruit and vegetables, all being preserved, dried, cooked or processed; preparations made from all the aforesaid goods; jellies; jams; egg products; milk foods; dairy products (foods); cheeses; curds; sweetened curds; savoury curds; fruit yoghurt; savoury yoghurt; vegetable yoghurt, savoury vegetable yoghurt; desserts made from dairy products; soups; sweet spreads; savoury spreads; salads; fillings, snack foods; proteinaceous substances; dips; lentils; beans, pulses; edible oils and fats; preserves; pickles; food preparations made from the aforesaid goods; prepared meals and constituents for meals; all supplied by e-commerce means.</p> <p><b>Class 30:</b>            Coffee, tea, cocoa, and coffee substitutes; spiced tea, herbal tea; drinking chocolate; coffee essence, coffee extracts, mixtures of coffee and chicory, chicory and chicory mixtures, all for use as coffee substitutes; all being foods; sugar, rice, pasta, tapioca, sago, flour, cereals and cereal preparations; bread, biscuits; cakes, pastry and confectionery; fillings; sweet spreads, savoury spreads; condiments, sweet chutney, savoury chutney; honey; treacle, yeast, baking powder; salt, mustard, pepper, vinegar, spices; snack foods, prepared meals and constituents for meals; chocolate; sauces for pasta, rice and curry; salad dressings; mayonnaise, sauces; dips; all supplied by e-commerce means.</p> <p><b>Class 35:</b>            Services which assist UK businesses to advertise and manage business undertaking</p>

			and affairs; arranging and conducting promotions and partnerships between businesses and classified advertising; all provided via an internet; accountancy services.
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(ii) Under Section 3(3)(b) of the Act as the mark would be deceptive, because of the words JOLLY GOOD MEALS if used on some of the goods the subject of the present application e.g. raw meat, fish, poultry and game, would not be used in relation to meals.

(iii) Under Section 3(6) of the Act because the application was made in bad faith as the applicant must have known of the main domain name of the opponent (Auntie G.com) which was registered on 7 August 1999, prior to the application in suit being made.

4. Subsequently, application No. 2211183 has been divided into 2211183A and 2211183B, with 2211183A including the Class 29 and 20 specifications and 2211183B including the Class 35 specification of the opponent.

5. The applicant filed a Counterstatement denying the grounds of opposition, stating that the marks are not confusingly similar, that the respective specifications are different, that there is no realistic prospect of the mark in suit deceiving the public and that the application was not made in bad faith as the application contains the applicant's company name, which was registered upon incorporation on 20 July 1999 with Companies House. Furthermore, the applicant states that the applicant's activities are stated in Companies House records to be "Wholesale of other food" whereas the opponent has specified in its annual return to Companies House that its principal activity is "other recreational activities".

6. The applicant has filed evidence and both sides have asked for an award of costs in their favour.

7. The matter came to be heard on 18 February 2003 when the applicant for registration was represented by Mr Malynicz of Counsel instructed by Trademark Consultants Co and the opponent by Mr Tritton of Counsel instructed by M Dean.

### **Applicant's Evidence**

8. This consists of a witness statement by Simon Malvin Walters dated 21 August 2001. Mr Walters states that he is an associate of Trade Mark Consultants Co (the applicant's professional advisors in this opposition).

9. Mr Walters attaches as Exhibits SMW1 to SMW7 to his statement, the following documents in support of the points raised by the applicant in its Counterstatement:

#### **Exhibit SMW**

1                      The Patent Office file for UK Trade Mark Application No. 2211183.

- 2 Pages from the Opponent's web site dated 30th August 2000.
- 3 Letter dated 6<sup>th</sup> September 2000 from the Opponent's trade mark attorney.
- 4 Opponent's original Form TM7 and Grounds for Opposition dated 7<sup>th</sup> September 2000.
- 5 Correspondence between the Applicant's trade mark attorneys and Trade Marks Registry.
- 6 Pages from the Patent Office web site:
  - a) Classification of goods and services.
  - b) Adding a class or classes to an application.
  - c) Change of practice on "Retail Services".
  - d) Classification of On-line and Internet services and associated goods.Trade marks owned by the Opponent and Applicant from the Marquesa Search Systems Limited database.

10. Mr Walters makes no specific comments in relation to the individual documents comprising the exhibits.

11. I now turn to the decision.

## **DECISION**

12. At the hearing Mr Tritton confirmed that the opponent was no longer pursuing the Section 3(3)(b) and Section 3(6) grounds of opposition and that only the Section 5(2)(b) ground remained.

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

“(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.”

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

6.-(1) In this Act an "earlier trade mark" means -

(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,

(b) .....

(c) .....

(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."

15. Following my decision on Opposition Number 52154 in relation to Application Number 2211183A, the specifications in Classes 29, 30 and 31 remain as advertised and that mark remains as advertised and that mark remains an "earlier trade mark" by virtue of Section 6(2) of the Act.

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

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 BV 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 B.V.* 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) account should also be taken 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 is registered;
- (f) 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;
- (g) 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;
- (h) 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 BV v. Puma AG*, paragraph 26;
- (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.

17. In essence the test under Section 5(2) is whether there are similarities in marks and goods which would combine to create a likelihood of confusion. In my consideration of whether there are similarities sufficient to show a likelihood of confusion I am guided by the recent judgements of the European Court of Justice mentioned above. The likelihood of confusion must be appreciated globally and I need to address the degree of visual, aural and conceptual similarity between the marks, evaluating the importance to be attached to those different elements taking into account the degree of similarity in the goods in question and how they are marketed. Furthermore, I must compare the mark applied for and the opponent's registrations on the basis of their inherent characteristics assuming normal and fair use of the marks.

18. Turning first to a consideration of the respective goods covered by the specifications of the application in suit and the opponent's earlier mark it is obvious that both cover identical goods in Classes 29 and 30.

19. In essence the marks differ in that they contain alternate spellings of the word Aunty/Auntie, both of which can be found in the dictionary, and also because the mark in suit contains the descriptive words "JOLLY GOOD MEALS".

20. How then should I approach the comparison of the marks. The opponent submits that I should pay particular attention to the AUNTY G'S/AUNTIE G elements in the marks as the public would see the words JOLLY GOOD MEALS as merely a descriptive tag or as a strap line.

There is merit in such an approach. While I must compare the marks as a whole and by reference to overall impression, in any comparison reference will inevitably be made to the distinctiveness and prominence of individual components, as recognised in *Sabel BV v Puma AG* (mentioned earlier in this decision). I would add that in my view AUNTIE G is an inherently distinctive mark deserving a good penumbra of protection.

21. Turning to a visual comparison of the marks it seems to me that, despite the alternate spellings AUNTY/AUNTIE, there is obvious visual similarity. While I do not overlook the fact that the applicant's mark contains the words JOLLY GOOD MEALS this is a mere laudatory descriptor or claim and in totality the visual similarity between the marks is clear.

22. In relation to aural considerations, it once again seems to me that the words JOLLY GOOD MEALS do little to distinguish the marks. Furthermore in oral use the different spellings of AUNTIE and AUNTY will not be a factor as these words would be spoken and heard in an identical manner. In my view the respective marks, in their totality are aurally similar.

23. On a conceptual comparison of the marks it seems to me that the words AUNTY G's/AUNTIE G elements will, on a relative basis, lend themselves to retention or recollection in the customer's mind. This concept would probably be of an aunt whose name begins with the letter G. In my view there is a close conceptual similarity between the respective marks as a whole.

24. My own knowledge and experience tells me that the customer for foodstuffs is the public at large and in the case of foodstuffs supplied by e-commerce means, those members of the public who possess or who have access to a personal computer. The goods at issue are not specialised and even when purchased via the internet (a not uncommon method of buying groceries in current trading conditions) such goods are not invariably bought with great care and consideration.

## **CONCLUSION**

25. On a global appreciation, taking into account all the relevant factors, I have come to the following conclusions:

- (i) the respective marks are visually, aurally and conceptually similar;
- (ii) the respective specifications cover identical goods;
- (iii) the customer for the goods is not necessarily a specialised or sophisticated consumer and the goods are not necessarily purchased with great care of consideration.

26. Considering the position in its totality I believe that there is a likelihood of confusion on the part of the public. In reaching this decision I have borne in mind the comments of the European Court of Justice in *Canon*:



“Accordingly the risk that the public might believe that the goods or services in question come from the same undertaking or, as the case may be, from economically linked undertakings, constitutes a likelihood of confusion within the meaning of Article 4(1)(b) of the Directive (see SABEL paragraphs 16 to 18).”

27. The opposition is successful under Section 5(2)(b).

### **COSTS**

28. As the opponent has been successful it is entitled to a contribution towards costs. I order the applicant to pay the opponent the sum of £1,000 which takes into account the fact that the only evidence filed in this case (by the applicant) is a copy of that filed in a related Opposition, Number 52154, which was heard on the same day. 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 02 day of April 2003**

**John MacGillivray  
For the Registrar  
the Comptroller-General**