

O-034-10

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2476193
BY
SLAMA HUILES
TO REGISTER THE TRADE MARK**



IN CLASS 29

AND

**THE OPPOSITION THERETO
UNDER NO 97851
BY
BORDERFIELDS LIMITED**

Trade Marks Act 1994

**In the matter of application 2476193
by Slama Huiles
to register the trade mark:**



**in class 29
and the opposition thereto
under no 97851
by Borderfields Limited**

1. On 4 January 2008, Slama Huiles (which I will refer to as SH) applied to register the above trade mark. Following examination, the application proceeded to publication in the *Trade Marks Journal* on 30 May 2008 for a goods specification of 'olive oil', which is in class 29¹.
2. Borderfields Limited (which I will refer to as BL) filed notice of opposition to the trade mark application, claiming that registration would be contrary to section 5(2)(b) of the Trade Marks Act 1994 (the Act). It relies upon some of the goods in class 29 of its earlier trade mark registration 2442309:

OLEIFERA

Edible oils, cooking oils, flavoured oils, flavoured roasting oils, oils for crisps.

3. BL's mark was applied for on 22 December 2006 and its registration procedure was completed on 11 January 2008. The application was published for opposition on 30 May 2008. BL's trade mark is therefore an earlier trade mark which is not subject to proof of use² because at the date of publication of the application it had been registered for less than five years.
4. BL claims that the goods of both marks are identical and that the visual, phonetic and conceptual similarities between the marks would cause a likelihood

¹ Class 29 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

² See section 6A of the Act (added by virtue of the Trade Marks (Proof of Use, etc.) Regulations) 2004 (SI 2004/946) which came into force on 5th May 2004.

of confusion. SH filed a counterstatement, admitting that the goods are either identical or similar but denying any similarity between the marks. BL filed evidence and both sides filed written submissions. Neither side requested a hearing, both being content for a decision to be made from the papers on file. In so doing, I have taken into account the contents of BL's statement of case, SH's counterstatement, BL's evidence and the submissions made in reply, and the submissions made in lieu of a hearing.

Evidence

5. BL's chief executive, Richard Palmer, has provided a witness statement and exhibits as support for a claim to a reputation in the mark in the UK since November 2006. From the evidence, it seems that the mark has been used in relation to rapeseed oil; there is no evidence in respect of use on any other goods. The goods are sold throughout the UK via outlets which appear to be independent delicatessens or food specialist shops. There is also reference to Sainsbury's supermarket commencing sales (after the date of application). BL won an award in 2008 for its OLEIFERA oil from the Guild of Fine Food and a design award for its packaging. Exhibit B8 is a Design Council article which refers to the name OLEIFERA as the Latin word for oil-bearing seeds. Turnover figures are given for 2007, 2008 and 2009, although I can only take into account the figure before the date of application (4 January 2008), which is £18,238, and part of the twelvemonth period leading upto March 2008 (£102,088 for the twelvemonth). £73,253 is given as advertising expenditure, but this is not particularised as to year.

6. The remainder of Mr Palmer's witness statement is submission, rather than fact, which I will refer to as necessary.

Decision

7. Section 5(2)(b) of the Act states:

“(2) A trade mark shall not be registered if because –

....

(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.”

8. The leading authorities which guide me in this ground are from the Court of Justice of the European Union, previously called the European Court of Justice: *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v*

Klijzen Handel B.V. [2000] F.S.R. 77, *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) C-334/05 P (LIMONCELLO)*. 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*,

(b) the matter must be judged through the eyes of the average consumer for the goods/services in question; *Sabel BV v Puma AG*, 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 Klijzen Handel B.V.*,

(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*,

(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*,

(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*,

(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*,

(g) in determining whether similarity between the goods or services covered by two trade marks is sufficient to give rise to the likelihood of confusion, the distinctive character and reputation of the earlier mark must be taken into account; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,

(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*,

(i) 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; *Marca Mode CV v Adidas AG and Adidas Benelux BV*,

(j) 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.

k) assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark; the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*

l) it is only when all other components of a complex mark are negligible that it is permissible to make the comparison on the basis of the dominant element; *Shaker di L. Laudato & C. Sas v OHIM*.

Average consumer and the purchasing process

9. Edible oils and oils for cooking are everyday consumer goods, readily available from supermarkets and from specialist food shops (BL's evidence shows it has predominantly sold rapeseed oil from the latter category of outlet). The degree of care to be exercised in purchasing food items may vary according to the price of the goods and frequency of purchase. Brand loyalty may play a part, together with personal preferences in relation to e.g. additive levels, organic products and lifestyle image³. Chefs and professionals in the catering industries may pay more attention to methods of production because of the impact they can have on flavour. The average consumer may be looking for a particular type of oil for a recipe or for a mode of cooking or because some types of oils are cheaper than others. Overall, I consider that the relevant consumer will pay a reasonable, but not the highest, level of attention when purchasing edible oils. SH claims that "the consumer of edible oils make a considered purchase and reviews the origin, type and quality of such goods". I think that will depend upon the nature of the consumer, as discussed above, and the usage: oil for a domestic chip pan may not be subject to the same level of scrutiny as that for making a salad dressing in a restaurant. I have to consider the position in relation to notional and fair use across the goods relied upon.

10. In *Aceites del Sur-Coosur SA v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case C-498/07 P*, the Court of Justice stated that:

"75...olive oil is a consumer product which is very common in Spain, that it is most commonly purchased in supermarkets or establishments where

³ BL's exhibit B8 states that the bottle was designed "with an elegant long neck and graceful shoulders" which "wouldn't look out of place on display on a kitchen worktop rather than pushed away in the back of a cupboard."

goods are arranged on shelves and that the consumer is guided more by the visual impact of the mark he is looking for.”

The purchasing process is primarily visual; even though the decision related to olive oil sold in Spanish supermarkets, where it is perhaps even more widely sold than in the UK, the logic of the visual purchasing process holds in relation to oils sold in UK supermarkets and establishments where goods are arranged on shelves. Even if the various oil types are grouped together, they are to be found cheek-by-jowl upon the shelves.

Comparison of goods

11. The application is made solely in respect of *olive oil*, while the goods relied upon of the earlier mark are *edible oils, cooking oils, flavoured oils, flavoured roasting oils, oils for crisps*. Although BL’s evidence shows use only on rapeseed oil, BL does not have to prove use of its mark and so can rely upon the wider oils. SH has admitted the goods are identical or similar. The goods of the application fall within the scope of the wider terms in the earlier mark and so the goods are identical.⁴

Comparison of trade marks

12. The authorities direct that, in making a comparison between the marks, I must have regard to each mark’s visual, aural and conceptual characteristics. I have to decide which, if any, of their components I consider to be distinctive and dominant, without engaging in an artificial dissection of the marks, because the average consumer normally perceives a mark as a whole and does not analyse its details.

⁴ The General Court (previously the Court of First Instance) said in *Gérard Meric v OHIM*, Case T-133/05: “29 In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 *Oberhauser v OHIM – Petit Liberto (Fifties)* [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 *Vedial v OHIM – France Distribution (HUBERT)* [2002] ECR II-5275, paragraphs 43 and 44; and Case T-10/03 *Koubi v OHIM – Flabesa (CONFORFLEX)* [2004] ECR II-719, paragraphs 41 and 42).”

13.


Earlier mark	Application
OLEIFERA	

Exhibit B8 (the Design Council article) states that OLEIFERA is the Latin word for oil-bearing seeds and SH submits that OLEIFEROUS indicates oil derived from seeds. There is no evidence from dictionaries; it is not a common word. It is more than likely that the average consumer will see it as an invented or ‘fantasy’ word. I say more about this below. The earlier mark is a single word of four syllables, but there is no single element that is distinctive or dominates the mark. The three syllable word in the application is an invented word; this mark contains figurative matter in addition to the word element. It is represented in colour, but colour is not claimed as an element of the mark. BL claims that OLEIVA is a dominant element of the application; SH claims the converse, stating that the device and the stylisation of the ‘O’ are ‘strong’ elements of the mark. The device at the top of the application is a representation of olives and olive leaves. SH submits that the figurative detail in the ‘O’ is an olive with two olive leaves. I consider it to be heavily stylised to the point that the average consumer may not notice its significance. In the context of olive oil, the unstylised olives and olive leaves are not a distinctive element. The invented word is a distinctive element and it is a prominent part of the mark; I consider it to be the dominant part of the mark. The stylisation of the ‘O’, the ‘O’ being at the beginning of the word, also has a certain prominence within the mark, but not the dominance of the word as a whole. SH points to the “distinctive script” of its word element; while it is not plain lettering, I do not consider the font to be particularly distinctive over and above the normal range of font styles encountered in trade marks.

14. The application contains device elements while the earlier mark is a word-only mark. The device elements create a point of difference between the marks. The mark is divided horizontally, approximately halfway, with the olive device at the top and the word at the bottom. Each of these elements takes up half the mark, proportionately. Having said that, the word element is the clearer element visually and the one which is the most striking to the eye. The word element of the earlier mark is four syllables in length and the word in the application is three;

the earlier mark is eight letters long and the application six. The first four letters and the first and second syllables of each mark are identical. Both marks end in 'a', this letter constituting the final syllable in each mark. The difference between the words (in terms of their letters) lies in the role of the 'v' in the application as opposed to the 'fer' of the earlier mark. Visually, this difference has the effect of one mark appearing shorter than the other. However, I consider there to be more similarities between the words when perceived by the eye than there are differences; chiefly on account of the first four letters and the final letter, in what are relatively short words, being the same. I consider there to be a good deal of visual similarity between the marks.

15. The third syllables in both marks are commenced with a 'v' or 'f', both of which have a similar soft sound (they are both fricative consonants). Although the 'f' in the earlier mark precedes 'er' to make the 'fer' syllable, this syllable is in itself quite an open sound; by this I mean that it is not terminated with a harder consonant (such as 'd'). If the syllable had terminated in a harder sound, the aural distance between the marks would have been more marked. The first two thirds of OLEIVA and the first half of OLEIFERA are identical; I consider that OLEI will be pronounced either as 'olay-ee' or just 'olay' in both marks; these sounds are similar in the overall pronunciation of the words. Both words end in 'a'. There is a high level of aural similarity on account of the position of the identical letters, the proportion of the marks which are identical and the role of the 'v/f' sound.

16. Invented words have a high inherent distinctive character, but no obvious concept of their own in contrast to dictionary words. However, invented words can be evocative of an idea⁵. The parties have taken polar views as to the conceptual significance of the marks, which can be summarised as follows.

SH submits:

- The prefix OLEI- or OLEO- is derived from the Latin OLEUM meaning 'oil'.
- OLEIC refers to derivatives of oil or oleic acid.
- The word OLEIFEROUS is an adjective meaning 'give rise to oil' and is used in relation to seeds. BL's mark is a derivative of this word.
- A customer purchasing edible oil would be likely to recognise the prefix OLEI as meaning oil, even though not a scholar of Latin.

⁵ The General Court has considered how trade marks or parts of trade marks may have a conceptual connotation despite not being in themselves dictionary words. In *Usinor SA v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-189/05* the CFI referred to a "suggestive connotation". In *Ontex NV v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T- 353/04* it referred to the "evocative effect" and in *Hipp & Co v OHIM T-221/06* the perception of words that consist of parts with concrete meanings.

- The word OLEIVA creates an impression of the girl's name OLIVIA and is therefore an allusion to an olive girl.
- It is common for food products to bear representations of the product; the olive device will reinforce the association with olives.

As noted above, SH has filed no lexicographic evidence in support of these submissions.

BL submits:

- Latin is a language unlikely to be understood by the relevant UK consumer of edible oils. OLEI would not therefore be seen as descriptive of edible oils.
- In the absence of any evidence, the word OLEIVA is not reminiscent of a girl's name.

17. I think it doubtful that the average UK consumer of the goods in question would recognise a Latin derivative of OLEUM in OLEI. This presupposes that the average consumer would attribute a meaning to OLEUM, which I also doubt. Some consumers may be aware of the word oleic. It is not an obvious word root: the English word 'oil' does not start with 'ol'. An etymologist may decipher an immediate meaning of 'oleiferous' when faced with the earlier mark. I reject SH's submission that the average UK consumer would associate either mark with oil purely on the basis of the word.

18. There is more substance in SH's submission that OLEIVA, seen with the device of olives on a bottle of olive oil, may reinforce the association with olives. There is a suggestion of the word OLIVE, but only because it appears with pictures of olives, and even then it is not a strong suggestion. It is going too far to say that it will be seen as a reference to an olive girl because of its alleged similarity to the girl's name 'Olivia'.

19. If there is a conceptual similarity between the words, it lies with both containing olei-; beyond this, it is doubtful that the words alone are evocative of oil. SH's word element may be evocative of olives; the mark as a whole is definitely evocative of olives because the top half of the mark is comprised of the device of olives and olive leaves. Applied to the goods, the conceptual significance of SH's mark will be olive oil, but this meaning is not attributable solely to the word but more to the top olive device.

20. Overall, the strength of similarity on both the visual and aural levels leads me to conclude that there is a substantial degree of similarity between the marks.

Likelihood of confusion

21. It is necessary to consider the distinctive character of the earlier trade mark; the more distinctive the earlier trade mark (either by nature or nurture) the greater the likelihood of confusion⁶. The distinctive character of a trade mark can be appraised only, first, by reference to the goods or services in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public⁷. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the mark to identify the goods for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings⁸. The level of market share of BL's mark is not evident from the use filed, and the turnover is not at such a level to suggest that the mark has become very well known, thereby benefitting from an enhanced distinctive character. I therefore approach BL's mark on the basis of inherent distinctive character: it will be seen as an invented word and enjoys a high level of distinctive character.

22. SH submits that the OLEI element would not be viewed as distinctive because of its derivation from the Latin 'oleum' for oil, but has provided no evidence to back this up. SH effectively invites me to ignore the OLEI element and concentrate on the suffixes of the words and the totality of its composite mark. SH has submitted that its olive device would reinforce the message of olives. I bear in mind that I should not disregard the device element, which is not negligible. The Court of Justice also said in *Shaker*:

“41 It is important to note that, according to the case-law of the Court, in the context of consideration of the likelihood of confusion, assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark. On the contrary, the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components (see order in *Matratzen Concord v OHIM*, paragraph 32; *Medion*, paragraph 29).”

⁶ *Sabel BV v Puma AG* [1998] RPC 199.

⁷ *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91.

⁸ *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

I should guard against dissecting the marks so as to distort the average consumer's perception of them; the average consumer perceives trade marks as wholes and rarely has the opportunity to compare marks side by side, relying instead upon the imperfect picture he has of them in his mind. I consider that the overall impression of SH's mark is dominated by the invented word since the average consumer will perceive the olive device as a reference to the goods.

23. BL has claimed that the average consumer tends to place most importance on the first syllable in a word mark. This is not a hard and fast rule; if the beginning of both marks is a descriptive or common combining form, the importance may be reduced⁹. In this case, I am unable to find that OLEI has any meaning which might cause the average consumer's focus to shift to the remainder of the marks and so it is important that the first four letters and the final letter of two invented words, which are themselves only six and eight letters in length, are identical. BL points to the UK trade mark register, stating that there are no other UK trade marks for edible oils which begin with OLEI; this is irrelevant because the trade mark register is not a mirror for the actual state of the marketplace. Neither is SH's submission that BL has not provided any instances of confusion of relevance¹⁰ or that BL's mark allegedly coexists with CTM 919431 for OLIVALLE (and device of an olive and olive leaves); SH itself claims that the state of the register is irrelevant (counterstatement).

24. Bearing in mind the interdependency principle (*Canon*), whereby a lesser degree of similarity between trade marks may be offset by a greater degree of similarity between goods, and vice versa, the position here is of a substantial degree of similarity between the marks, together with identical goods. Edible oils are primarily a visual purchase; even allowing for an above average attentiveness in the case of professional consumers (chefs), the perception and memory of the marks will be similar, which will not obviate the risk of imperfect recollection. The dominant elements of the marks (the only element of the earlier mark) are invented words beginning with the same four letters in a sequence which appears to be rarely found in the English language. There is no conceptual distance which would counteract the visual and aural similarities between the marks¹¹. Taking all the factors into account, I consider that there is a likelihood of confusion. The opposition succeeds under section 5(2)(b).

⁹ *Castellani SpA v OHIM*, T-149/06 and *Spa Monopole, compagnie fermière de Spa SA/NV v OHIM*, Case T-438/07.

¹⁰ See Tribunal Practice Notice 4/2009.

¹¹ As per *Devinlec Développement Innovation Leclerc SA v OHIM*, Case T-147/03, in which the CFI stated: "98 It is true that, according to case-law, a conceptual difference between the marks at issue may be such as to counteract to a large extent the visual and aural similarities between those signs (BASS, cited in paragraph 60 above, paragraph 54). However, for there to be such a counteraction, at least one of the marks at issue must have, from the point of view of the relevant public, a clear and specific meaning so that the public is capable of grasping it immediately."

Costs

25. BL has been successful and is entitled to an award of costs on the following basis:

Preparing a statement and considering the other side's statement:	£200
Official fee:	£200
Evidence and considering the other side's submissions:	£600
Written submissions:	£200
Total:	£1200

26. I order Slama Huiles to pay Borderfields Limited the sum of £1200. 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 01 day of February 2010

**Judi Pike
For the Registrar,
the Comptroller-General**