

O-106-11

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO 2499735**

**BY**

**WESERGOLD GETRANKEINDUSTRIE GMBH & CO KG**

**TO REGISTER THE TRADE MARK:**



**IN CLASS 32**

**AND**

**THE OPPOSITION THERETO**

**UNDER NO 98734**

**BY**

**LIDL STIFTUNG & CO KG**

**Trade Marks Act 1994**

**In the matter of application no 2499735  
by Wesergold Getrankeindustrie GmbH & Co KG  
to register the trade mark:**



**in class 32  
and the opposition thereto  
under no 98734  
by Lidl Stiftung & Co KG**

1) On 11 January 2000 Wesergold Getrankeindustrie GmbH & Co KG (Wesergold) applied to the Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) to register the above trade mark. On 23 September 2008 OHIM advised the Intellectual Property Office that it had accepted a request to convert the application to a national trade mark in the United Kingdom. The application was published, for opposition purposes, on 12 December 2008 with a specification of:

*non-alcoholic drinks; fruit drinks and fruit juices.*

The above goods are in class 32 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) On 12 February 2009 Lidl Stiftung & Co KG (Lidl) filed a notice of opposition to registration of the trade mark. Lidl bases its opposition on section 5(2)(b) of the Trade Marks Act 1994 (the Act). According to section 5(2)(b) of the Act a trade mark shall not be registered if because:

“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.”

3) Lidl relies upon 2 United Kingdom trade mark registrations of the trade mark **VITAFIT**. No 1226850 was filed on 21 September 1984 and the registration process was completed on 9 July 1986. It is registered for:

*non-alcoholic beverages included in Class 32.*

No 1457027 was filed on 28 February 1991 and the registration process was completed on 20 May 1994. It is registered for:

*fruit juices, fruit nectars and fruit juice beverages; syrups and preparations for making beverages; non-alcoholic beverages; all included in Class 32.*

4) As the trade marks had been registered for more than five years at the date of the publication of Wesergold's application they are subject to proof of use<sup>1</sup>. Lidl claims that it has used the trade mark in respect of all of the goods of the registrations. It claims that the respective goods are identical and that the respective trade marks are similar. Consequently, there is a likelihood of confusion. Lidl states that the parent OHIM application was refused by the General Court (GC) as a result of an opposition that it had filed, case T-111/06.

5) Wesergold filed a counterstatement. It required Lidl to prove use of its earlier trade mark. It denies that the respective trade marks are similar and so denies the grounds of opposition.

6) Both parties filed evidence.

7) A hearing took place on 11 March 2011. Lidl was represented by Mr Simon Malynicz of counsel, instructed by Urquhart-Dykes & Lord LLP. Wesergold was represented by Mr Malcolm Chapple of counsel, instructed by Dr Walther Wolf & Co.

## ***EVIDENCE***

### ***Evidence of Wesergold***

#### *Witness statement of David Neville Peters*

8) Mr Peters is a chartered patent attorney and registered trade mark attorney. Virtually all of his statement consists of submission rather than evidence of fact. The submissions are borne in mind in the writing of the decision but are not summarised here. He exhibits at DNP1 samples of OHIM, international and United Kingdom trade mark registrations that include ampersands as being illustrative of the widespread use of the ampersand in the United Kingdom. The ampersands can be seen in a number of differing forms.

*Witness statements of Eberhard Niethammer*

9) Mr Niethammer is in-house counsel for Wesergold. He comments on the business of Wesergold. He states that “[p]roducts marked with ‘VITAL & FIT’ (device) have been sold in Germany and in the Netherlands”. Mr Niethammer states that the “trade mark ‘VITAL & FIT’ (device) was first used in relation to non-alcoholic beverages and soft drinks in the year 2000 in Germany” Exhibited at EN2, EN3 and EN4 are colour layouts of labels showing the trade mark as it is currently used in Germany. In all of the reproductions the trade mark the subject of these proceedings is in a secondary position, the dominant trade mark being ACE. At EN5 are colour layouts of labels showing the trade mark as it is used in Belgium, again the dominant trade mark is ACE. Mr Niethammer goes on to make various submissions. He lists countries where the trade mark is protected and where applications are pending. He states that he is not aware of any instances of confusion in any marketplace of products bearing Wesergold’s trade mark and products bearing Lidl’s trade mark. Mr Niethammer states that Wesergold has supplied and continues to supply Aldi Einkauf with “its ‘VITAL & FIT’ products. Aldi in 2007 created a new label VITAL-FIT, this was used by Aldi without the consent or approval of the legal department of Wesergold.”

***Evidence of Lidl***

*Witness statement of Martin Alfred Kottbauer*

10) Mr Kottbauer is the purchasing director of Lidl UK GmbH, which is an affiliated company and licensee of Lidl.

11) Lidl owns and operates a chain of supermarkets and has been trading in the United Kingdom since 1994. As of 21 August 2009 Lidl had more than 380 stores throughout England, Scotland, Wales and Northern Ireland.

12) Mr Kottbauer states that Lidl has used the trade mark VITAFIT in the United Kingdom in respect of a variety of fruit juice products since 2003. As of 21 August 2009 it was being used on apple juice, orange juice, lemon juice, tomato juice, prune juice drink, pineapple juice, grape juice, Acerola cherry juice drink, blackcurrent nectar, sour cherry nectar, multi fruit juice blends and vegetable juices. He states that the trade mark is also used on vitamin tablets. Mr Kottbauer states that goods bearing the VITAFIT trade mark have been sold in each of the 530 stores (sic) operated by Lidl in the United Kingdom.

13) Mr Kottbauer gives turnover figures for goods sold under the trade mark in the United Kingdom. Reproduced below are the figures for goods sold up to and including 2008.

<b>Apple juice - 250 ml</b>	Units sold
2003	173,118
2004	2,959,500
2005	3,749,916
2006	4,021,590
2007	3,556,212
2008	3,397,212
<b>Orange juice – 750 ml</b>	
2004	2,223,672
2005	2,618,040
2006	2,590,560
2007	2,125,164
2008	1,965,066 (A figure of 586,640 units is also given for this year.)
<b>Apple juice - 1.5 l</b>	
2003	3,927,542
2004	5,985,168
2005	7,441,904
2006	7,040,480
2007	6,099,712
2008	6,015,144
<b>Tomato juice – 1 l</b>	
2005	1,792,240
2006	1,712,112
2007	1,490,976
2008	1,554,396
<b>Grapefruit juice – 1 l</b>	
2007	111,096
2008	677,214
<b>Tropical fruit juice – 1 l</b>	
2007	164,880
2008	1,066,284
<b>Pineapple juice – 1 l</b>	
2007	475,920
2008	2,516,232
<b>Multi-vitamin juice – 1 l</b>	
2006	562,176
2007	1,470,720
2008	1,163,496
<b>Apple juice – 1 l</b>	
2005	218,484
2006	1,439,344
2007	1,444,032
2008	1,214,856

<b>Multi-vitamin juice – 330 ml</b>	
2008	430,514
<b>Apple juice – 330 ml</b>	
2008	405,720
<b>Orange juice – 330 ml</b>	
2008	454,342

14) Copies of newsletters distributed by Lidl are to be found at exhibit 1. Pictures of products are to be found at exhibit 2. The use of the trade mark is in the form of *vitafit*. Invoices from undertakings which produce the products for Lidl are to be found at exhibit 3.

*Witness statements of Alison Elizabeth Fraser Simpson*

15) Ms Simpson is a trade mark attorney. She exhibits a copy of the judgment in French of case T-111/06 with an English translation. Ms Simpson also exhibits a copy of the opposition decision, in German, which gave rise to the appeal that led to the judgment of the GC. Also exhibited is a sworn translation of the opposition decision.

*Witness statement of Michael Schaeffer*

16) Mr Schaeffer is a lawyer representing Lidl in intellectual property matters in Germany.

17) Mr Schaeffer states that in July 2007 Lidl became aware of the use of the designation VITAL-FIT for several fruit drinks by some suppliers of Lidl's main competitor in Germany, Aldi Einkauf GmbH & Co KG, including Wesergold. Lidl sent a cease and desist letter to one of the main suppliers, Jacobi-Scherbening GmbH & Co KG. The attorney of Aldi answered and the matter was settled by an amicable agreement. One part of the agreement was that all suppliers of the VITAL-FIT products in question should sign a cease and desist letter. Wesergold signed such a letter and it is exhibited (with a translation). Examples of the packaging to which the letter relates are also exhibited. These show use of VITAL-FIT in an oval. The wording is in a normal script, with the letter V slightly taller than the other letters.

**SECTION 5(2)(B) – LIKELIHOOD OF CONFUSION**

18) At the hearing Mr Chapple accepted that Lidl had proved use of its earlier trade mark. There is no doubt, and there was no argument, that the respective goods are identical.

19) The matter has to be considered on the basis of the position of the average consumer for the goods in the United Kingdom. Consequently, decisions in relation to other jurisdictions do not have a bearing upon this case.

***Average consumer, nature of purchasing decision and standard for likelihood of confusion***

20) The average consumer “is deemed to be reasonably well informed and reasonably circumspect and observant”<sup>iii</sup>. The goods of the application and the earlier registrations will not be high cost items, indeed they are quite likely to be low cost items. They are everyday goods that will be bought by the public at large. The purchasing process will not be carefully planned and educated and the goods could be bought on impulse. Consequently, the effects of imperfect recollection are likely to be increased. The goods are likely, if off-sales, to be bought from the supermarket shelf or a cool cabinet.

21) They may be bought as on-sales in establishments selling beverages eg cafés and public houses.

22) In *Koipe Corporación SL v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-363/04* the GC commented on the purchasing process from supermarket shelves:

“110 It should be noted in support of this, that where the marks at issue are examined at the distance and the speed at which the consumer in a supermarket selects the goods he is looking for, the differences between the signs at issue are more difficult to distinguish and the similarities are more apparent, since the average consumer perceives the mark as a whole and does not proceed to analyse its various details.”

The selection process will primarily be made by the eye and so visual similarity will be of greater importance than aural similarity.

23) The GC has considered the nature of the purchasing process in on-premises. In *Simonds Farsons Cisk plc v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-3/04* it stated:

“58. In that respect, as OHIM quite rightly observes, it must be noted that, even if bars and restaurants are not negligible distribution channels for the applicant’s goods, the bottles are generally displayed on shelves behind the counter in such a way that consumers are also able to inspect them visually. That is why, even if it is possible that the goods in question may also be sold by ordering them orally, that method cannot be regarded as their usual marketing channel. In addition, even though consumers can order a beverage without having examined those shelves in advance they are, in any event, in a position to make a visual inspection of the bottle which is served to them.”

In *Bitburger Brauerei Th Simon GmbH v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Cases T-350/04 to T-352/04* the GC stated:

“112 Furthermore, Bitburger Brauerei has not furnished the slightest proof to show that its goods are generally sold in such a way that the public does not perceive the mark visually. In that regard, it must be borne in mind that, even if bars and restaurants are not negligible distribution channels for the products of Bitburger Brauerei, it is common ground that the consumer will be able to perceive the marks at issue visually in such places, inter alia by examining the bottle served to him or by other means (glasses, advertising posters etc.). Moreover, and above all, it is not disputed that bars and restaurants are not the only sales channels for the goods concerned. They are also sold in supermarkets or other retail outlets. Thus, clearly when purchases are made there consumers can perceive the marks visually since the drinks are presented on shelves (see, to that effect, Case T-3/04 *Simonds Farsons Cisk v OHIM* [2005] ECR II-0000, paragraphs 57 to 59). It follows that the argument of Bitburger Brauerei relating to the conditions under which the products in question are sold must, in any event, be rejected.”

The average consumer is likely to see the container of the beverage, the beverage will be served from the container or the consumer will be given the container. Consequently, the effects of the oral order are offset by the sight of the container of the beverage<sup>iii</sup>.

24) In *New Look Ltd v Office for the Harmonization in the Internal Market (Trade Marks and Designs) Joined Cases T-117/03 to T-119/03 and T-171/03* the GC considered the effects of the principal nature of the purchasing decision:

“49 However, it should be noted that in the global assessment of the likelihood of confusion, the visual, aural or conceptual aspects of the opposing signs do not always have the same weight. It is appropriate to examine the objective conditions under which the marks may be present on the market (*BUDMEN*, paragraph 57). The extent of the similarity or difference between the signs may depend, in particular, on the inherent qualities of the signs or the conditions under which the goods or services covered by the opposing signs are marketed. If the goods covered by the mark in question are usually sold in self-service stores where consumer choose the product themselves and must therefore rely primarily on the image of the trade mark applied to the product, the visual similarity between the signs will as a general rule be more important. If on the other hand the product covered is primarily sold orally, greater weight will usually be attributed to any aural similarity between the signs.”



The nature of the goods means that for the average consumer in the average purchasing situation, the visual effect of the trade marks is of more importance than the oral effects and so of greater importance in considering the similarity of the trade marks.

### **Comparison of trade marks**

25) The trade marks to be compared are:



**VITAFIT**

26) The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details<sup>iv</sup>. 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<sup>v</sup>. Consequently, there cannot be an artificial dissection of the trade marks, although it is necessary to take into account any distinctive and dominant components. The average consumer rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he/she has kept in his/her mind and he/she is deemed to be reasonably well informed and reasonably circumspect and observant<sup>vi</sup>. The assessment of the similarity of the trade marks must be made by reference to the perception of the relevant public<sup>vii</sup>.

27) In *Mary Quant Cosmetics Japan Ltd v Able C & C Co Ltd* BL O/246/08 Mr Geoffrey Hobbs QC, sitting as the appointed person, stated:

“10. The present oppositions under Section 5(2)(b) are based on the rights conferred by registration of a device mark recorded in the register in black-and-white. It follows that colouring is immaterial to the distinctiveness of the Opponent’s device mark as registered and therefore irrelevant for the purposes of the assessment of similarity in both oppositions.”

In *Specsavers International Healthcare Limited & Others v Asda Stores Limited* [2010] EWHC 2035 (Ch) Mann J stated:

“119. It is not clear to me that this is a debate which advances the case very much, but the position seems to me to be as follows. As a matter of principle the exercise involves comparing the offending sign with the registered mark and assessing the likelihood of confusion or association. The two things have to be compared. Since we live in a visual world, and signs are visual, some form of appearance has to be considered. If the registered mark is limited to a colour, then the mark that is used has to be compared, as used, to the mark that is registered, as registered (and therefore in colour). If the registered mark is unlimited as to colour then it is registered for all colours. This means that the colour of the offending sign becomes irrelevant. It will not be possible to say that its colour prevents there being an infringement. At this point one can take one of two courses, each of which ought to have the same result. The first is to imagine the registered mark in the same colour as the offending sign. The second is to drain the colour from the offending sign. Either way one then has the material for comparison. One could even imagine them both in a third colour. It does not matter. So in a sense both Mr Purvis and Mr Bloch are right. As a matter of visual convenience it seems to me to be easier to imagine the registered mark in a colour than to imagine the offending sign drained of colour, and I propose to adopt that course.”

As Lidl’s trade mark is registered in black and white it is necessary to drain the colour from Wesergold’s trade mark when comparing the trade marks.

28) Mr Chapple analysed the trade mark of Wesergold in a great deal of detail. He submitted that:

- It uses two different shades of blue.
- It contains two separate words, VITAL and FIT.
- The words are on different lines.
- The letter i in each of the words is presented so that it seems as though the letter is being seen through a glass tumbler with a drinking straw protruding a substantial distance upwards and leaning to the right.
- Each of the two glass tumblers is presented as either having a light blue colour with opaque surfaces or being full of a light blue, bubbly liquid.
- Between the words VITAL and FIT there is an ampersand in a light blue colour.
- The ampersand is next to the word VITAL.
- The words and character have a thin but distinct and prominent dark blue boundary line all the way around.
- The boundary line protrudes at the top in order to enclose the representations of the two straws.

- The words VITAL and FIT are presented so that the letters VTAL and FT are in dark blue and a prominent bold font.
- Unless a close examination is made, the trade mark reads V TAL and F T.
- The words and character are common.
- The i in VITAL will be spoken as a long i, the i in FIT will be spoken with a short i.
- The trade mark has four syllables.

29) The average consumer does not dissect trade marks, he or she does not spend time analysing the contents of trade marks. It is the overall impression of the trade mark that is of importance, taking into account the dominant and distinctive components. As Mr Chapple states VITAL and FIT are common words, they will immediately be picked up and identified by the eye. These are the components which have an immediate and clear effect on the eye. The character at the end is faint and there is no certainty that it will be seen as an ampersand, rather than a simple design embellishment. The tumblers and straws are matters that will require the application of imagination and analysis by the average consumer. If the tumblers and straws are seen, for beverages these are not distinctive devices, they are iconic indications of the purpose of the product. The dominant and distinctive components of Wesergold's trade mark are the words VITAL and FIT. The other elements must be borne in mind in comparing the trade marks but are, to a large extent, drowned by the dominant words VITAL and FIT. For the average consumer in the supermarket or the bar, a VITAL FIT trade mark with some get-up will be perceived.

30) Just as the average consumer will not analyse and dissect the trade mark of Wesergold, he or she will not analyse and dissect the trade mark of Lidl. He or she, even if equipped with a knowledge of Latin, will not conduct a philological exercise and discover the Latin for life and the English word FIT<sup>viii</sup>. Consumers do not spend their time dissecting and analysing trade marks. The average consumer will see the trade mark of Lidl as an invented word. Within the invented word there is no single dominant or distinctive component. In *Les Editions Albert René v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-336/03* the GC stated:

“75 It should be noted in this regard that the attention of the consumer is usually directed to the beginning of the word (Joined Cases T-183/02 and T-184/02 *El Corte Inglés v OHIM – González Cabello and Iberia Líneas Aéreas de España (MUNDICOR)* [2004] ECR II-0000, paragraph 83).”

This is not a case where that rule of thumb is broken and so the beginning of the trade mark in this case is more important, marginally, than the end in the consideration of similarity.

31) VITAL and FIT are in normal type face and are clearly legibly, despite Mr Chapple's submissions about straws, tumblers and bubbles. The respective

trade marks coincide in respect of 7 letters. VITA comes at the beginning of each trade mark and FIT at the end. There is, of course, the faint ampersand, if it is seen as such, and the faint rectangles of colour, line and outline. The words VITAL and FIT are also on separate levels. These are not elements which are going to greatly impinge on the memory and perception of the average consumer. Overall, there is a high degree of visual similarity.

32) VITAL and FIT are common English words and there are very standard pronunciations for them. The first i will be pronounced as eye and the second i will be pronounced to rhyme with hit. There is nothing in the trade mark of Lidl to guide the average consumer as to pronunciation of the first i. There are no orthographical hints as to whether the first i will be pronounced as in vital or as in vim. The absence of a clear orthographical practice means that the i in vituperative is pronounced in both fashions. As the vital pronunciation is as likely as the vim pronunciation, the phonetic analysis will be made on the former basis. On this basis, the sole phonetic difference between the trade marks is the l sound in the middle of Wesergold's trade mark; a sound that is soft and falling away before the strong, short word FIT. Mr Chapple submitted that the ampersand would be pronounced as the word and. This, of course, depends on the faint shape being seen as an ampersand by the average consumer. If this argument is accepted, and it is considered a doubtful argument, there is an extra syllable in the trade mark of Wesergold. This is a soft syllable between the hard and clear syllables of VIT and FIT. If the ampersand in the trade mark of Wesergold is not perceived there is a very high degree of aural similarity, if the ampersand is perceived there is a good degree of aural similarity.

33) As stated above the average consumer will not conduct a philological analysis of the trade mark of Lidl and seek meaning in the constituent parts. It will be perceived as an invented word. Wesergold's trade mark has two common English words with clear meanings. Consequently, the trade mark of Wesergold is conceptually dissimilar to that of Lidl. This is dissimilarity rather than dissonance, the latter occurring when the trade marks have different meanings.

### ***Likelihood of conclusion***

34) In considering whether there is a likelihood of confusion various factors have to be taken into account. There is the interdependency principle – a lesser degree of similarity between trade marks may be offset by a greater degree of similarity between goods, and vice versa<sup>ix</sup>. In this case the respective goods are identical. It is necessary to consider the effects of imperfect recollection. Owing to the nature of the goods these effects will be increased. It is necessary to consider the distinctive character of the earlier trade mark; the more distinctive the earlier trade mark the greater the likelihood of confusion<sup>x</sup>. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public<sup>xi</sup>. 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 from those of other undertakings<sup>xii</sup>. There is no claim that Lidl's trade mark enjoys a reputation that would increase its inherent distinctiveness. The trade mark of Lidl is neither descriptive nor allusive of the goods for which it is registered. It is considered that Lidl's trade mark enjoys a reasonable degree of inherent distinctiveness.

35) 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 CJEU stated.

“60 According to further settled case-law, the global assessment of the likelihood of confusion, in relation to the visual, aural or conceptual similarity of the marks in question, must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components (see *OHIM v Shaker*, paragraph 35 and the case-law cited).

61 In particular, the Court has held that in the context of examination 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 (see order in *Matratzen Concord v OHIM*, paragraph 32; *Medion*, paragraph 29; and *OHIM v Shaker*, paragraph 41).

62 In that regard, the Court has also held that, according to established case-law, the overall impression created in the mind of the relevant public by a complex trade mark may, in certain circumstances, be dominated by one or more of its components. However, it is only if all the other components of the mark are negligible that the assessment of the similarity can be carried out solely on the basis of the dominant element (*OHIM v Shaker*, paragraphs 41 and 42, and Case C-193/06 P *Nestlé v OHIM* [2007] ECR I-114, paragraphs 42 and 43 and the case-law cited).”

In *Nokia Oyj v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-460/07 the GC stated:

“66 Furthermore, it must be recalled that, in this case, although there is a real conceptual difference between the signs, it cannot be regarded as making it possible to neutralise the visual and aural similarities previously established (see, to that effect, Case C-16/06 P *Éditions Albert René* [2008] ECR I-0000, paragraph 98).”

In this case the overall impressions of the respective trade marks, taking into account the nature of the goods and the purchasing process and the particular representation of Wesergold's trade mark, are such that the conceptual dissimilarity does not overcome the visual and phonetic similarities between the trade marks.

36) The absence of confusion in the market place has been raised by Wesergold. There is a tranche of case law to the effect that lack of confusion in the market place is indicative of very little: *The European Limited v The Economist Newspaper Ltd* [1998] FSR 283, *Rousselon Freres et Cie v Horwood Homewares Limited* [2008] EWHC 881 (Ch), *Compass Publishing BV v Compass Logistics Ltd* [2004] RPC 41 and *Aceites del Sur-Coosur SA v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case C-498/07 P*. In *The European Limited v The Economist Newspaper Ltd* Millet LJ stated:

“Absence of evidence of actual confusion is rarely significant, especially in a trade mark case where it may be due to differences extraneous to the plaintiff's registered trade mark.”

It would appear from the evidence that the Lidl products are all sold in the Lidl stores. No evidence of use of Wesergold's trade mark in the United Kingdom has been provided. Consequently, the absence of confusion in the United Kingdom is not indicative of anything.

**37) There is a likelihood of confusion and the trade mark is to be refused in its entirety.**

## **COSTS**

38) Lidl having been successful is entitled to a contribution towards its costs. Costs are awarded on the following basis:

Opposition fee:	£200
Preparing statements and considering the statement of Wesergold:	£300
Preparing evidence and considering the evidence of Wesergold:	£800
Preparing for and attending the hearing:	£500
Total:	£1,800

**Wesergold Getrankeindustrie GmbH & Co KG is ordered to pay Lidl Stiftung & Co. KG the sum of £1,800. 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 18 day of March 2011**

**David Landau  
For the Registrar  
the Comptroller-General**

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<sup>i</sup> Section 6A of the Act 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), (b) 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 period of five years ending with the date of publication.

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(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 period of five years ending with the date of publication of the application 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 differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, 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) In relation to a Community trade mark, any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

(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.

(7) Nothing in this section affects –

(a) the refusal of registration on the grounds mentioned in section 3 (absolute grounds for refusal) or section 5(4)(relative grounds of refusal on the basis of an earlier right), or

(b) the making of an application for a declaration of invalidity under section 47(2) (application on relative grounds where no consent to registration).”

Under Section 100 of the Act the onus is upon the proprietor of the earlier trade mark(s) to show genuine use:

“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.”

<sup>ii</sup> *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* Case C-342/97.

<sup>iii</sup> It is noted that in *Och-Ziff Management Europe Limited and another v Och Capital LLP and others* [2010] EWHC 2599 (Ch) Arnold J commented upon initial interest confusion:

“97. It again seems clear from this that there can be a likelihood of confusion within the meaning of Article 9(1)(b) at the point when a consumer views an advertisement, whether or not the advertisement leads to a sale and whether or not the consumer remains confused at the time of any such sale.”



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The initial interest confusion he relates to the consumer. In an on-premises if the server misheard or misunderstood what had been said this would not be the confusion of the consumer, who would know what he or she was ordering.

<sup>iv</sup> *Sabel BV v Puma AG* Case C-251/95.

<sup>v</sup> *Sabel BV v Puma AG* Case C-251/95.

<sup>vi</sup> *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV* Case C-342/97.

<sup>vii</sup> *Succession Picasso v OHIM - DaimlerChrysler (PICARO)* Case T-185/02.

<sup>viii</sup> The average consumer will not be aware of the Latin translation of the aphorism of Hippocrates:

Ars longa,  
**vita** brevis,  
occasio praeceps,  
experimentum periculosum,  
iudicium difficile.

<sup>ix</sup> *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* Case C-39/97.

<sup>x</sup> *Sabel BV v Puma AG* Case C-251/95.

<sup>xi</sup> *Rewe Zentral AG v OHIM (LITE)* Case T-79/00.

<sup>xii</sup> *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97.