

O-207-14




IN THE MATTER OF CONSOLIDATED OPPOSITION
NOS 104667, 104668, 104669 AND 104670
BY CADBURY ENTERPRISES PTE LTD

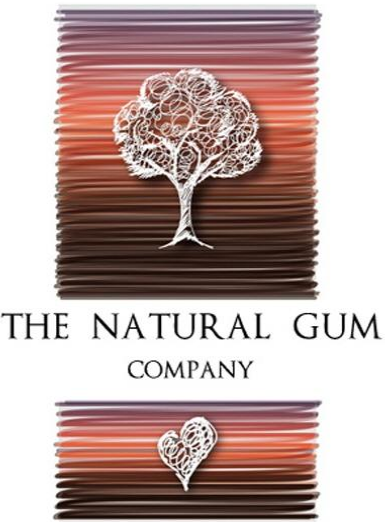
TO

APPLICATIONS FOR REGISTRATION UNDER
NOS 2643540, 2643542, 2643543 AND 2643544
IN THE NAME OF NTA FOODS LTD

Background

1. On 23 November 2012, NTA Foods Ltd (“the applicant”) applied for the registration of the following:



Trade Mark and number	Specification of goods
<p>2643540</p>  <p>THE NATURAL CHOCOLATE COMPANY</p>	<p>Rice, pasta; cereals and cereal preparations; tea, coffee, cocoa; 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, snack foods, prepared meals and constituents for meals; chocolate; pizzas, pizza bases; sauces and toppings for pizzas; sauces for pasta and rice; salad dressings; mayonnaise, sauces; dips; all included in Class 30.</p>
<p>2643542</p>  <p>THE NATURAL FOOD COMPANY</p>	<p>Rice, pasta; cereals and cereal preparations; tea, coffee, cocoa; 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, snack foods, prepared meals and constituents for meals; chocolate; pizzas, pizza bases; sauces and toppings for pizzas; sauces for pasta and rice; salad dressings; mayonnaise, sauces; dips; all included in Class 30.</p> <p>Beers; mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages, all included in class 32</p>
<p>2643543</p>  <p>THE NATURAL SNACKS COMPANY</p>	<p>Meat, fish, poultry and game, sea foods; fruit and vegetables, all being preserved, dried, cooked or processed; preparations made from all the aforesaid goods; dairy products, frozen yoghurt; mousses, chilled desserts; drinks made from dairy products; soups; sweet spreads, savoury spreads; salads; drinks, fillings, snack foods; prepared meals and constituents for meals; proteinaceous substances; dips ; all included in class 29</p> <p>Rice, pasta; cereals and cereal preparations; tea, coffee, cocoa; 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</p>




	<p>confections; chilled desserts, mousses, sorbets; bread; pastry; drinks; fillings; sweet spreads, savoury spreads, snack foods, prepared meals and constituents for meals; chocolate; pizzas, pizza bases; sauces and toppings for pizzas; sauces for pasta and rice; salad dressings; mayonnaise, sauces; dips; all included in Class 30.</p>
<p>2643544</p>  <p>THE NATURAL GUM COMPANY</p>	<p>Rice, pasta; cereals and cereal preparations; tea, coffee, cocoa; drinking chocolate, coffee essence, coffee extracts, mixtures of coffee and chicory, chicory and chicory mixtures, all for use as substitutes for coffee;; pastries, cakes, biscuits; ices, ice cream, ice cream products, frozen confections; chilled desserts, mousses, sorbets; bread; pastry; drinks; fillings; sweet spreads, savoury spreads, snack foods, prepared meals and constituents for meals; chocolate; pizzas, pizza bases; sauces and toppings for pizzas; sauces for pasta and rice; salad dressings; mayonnaise, sauces; dips; Confectionery; non-medicated confectionery confectionery namely, chewing gum, bubble gum, candy and mints. all included in Class 30.</p>

2. Each of the applications was published in *Trade Marks Journal No 6971* on 21 December 2012. Following their publication, notices of opposition were filed against each of them by Cadbury Enterprises Pte Ltd (“the opponent”). In each case, the opposition is directed to the applications only insofar as they seek registration for those goods shown above in bold. The opponent relies on the following objections:

- Under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”) based on its trade mark nos 2335256, 2335404 and 2636429, international registration nos 814337 and 815915 and Community trade mark (“CTM”) no 2685246;
- Under section 5(3) of the Act based on its trade mark nos 2335256 and 2335404 and international registration nos 814337 and 815915;
- Under section 5(4)(a) of the Act based on use of 3 earlier unregistered rights which it claims to have used in the UK since 1 May 2007.

3. The marks relied on by the opponent are as follows:

Mark and grounds	Dates	Specification
<p>2335256 (Ss 5(2)(b) and 5(3))</p> <p>THE NATURAL CONFECTIONERY CO.</p>	<p>Filing Date: 18 June 2003</p> <p>Date of entry in register: 14 November 2003</p>	<p>Non-medicated confectionery</p>
<p>2335404 (Ss 5(2)(b) and 5(3))</p> 	<p>Filing date: 20 June 2003</p> <p>Date of entry in register: 21 November 2003</p>	<p>Non-medicated confectionery</p>
<p>2636429 (s5(2)(b))</p> <p>THE NATURAL CONFECTIONERY COMPANY</p>	<p>Filing date: 27 September 2012</p> <p>Date of entry in register: 11 January 2013</p>	<p>Ice cream; dairy ice cream; non-dairy ice cream; ice cream desserts; edible ices; frozen ices; sorbets (ices); fruit ices; frozen beverages (edible ices); ice desserts; frozen confectionery; frozen confections; frozen desserts; frozen yoghurt (confectionery ices); ice cream cones; sauces for ice cream</p>
<p>814337 (Ss5(2)(b) and 5(3))</p> 	<p>International registration/designation date: 27 June 2003</p> <p>Date of protection in UK: 7 May 2004</p> <p>Priority date: 17 January 2003 (Australia)</p>	<p>Confectionery</p>
<p>815915 (Ss 5(2)(b) and 5(3))</p> <p>THE NATURAL CONFECTIONERY CO.</p>	<p>International registration/designation date:</p>	<p>Confectionery</p>

	<p>8 July 2003</p> <p>Date of protection in UK: 6 June 2004</p> <p>Priority date: 27 June 2003 (Australia)</p>	
<p>CTM 2685246 (s5(2)(b))</p> 	<p>Filing date: 2 April 2002</p> <p>Date of entry in register: 27 August 2003</p>	<p>Class 30: Confectionery; snackfoods</p> <p>Class 35: Wholesaling, retailing and direct selling of confectionery and/or snackfoods</p>
<p>s5 (4)(a) THE NATURAL CONFECTIONERY CO.</p>	<p>Use since 1 May 2007</p>	<p>Confectionery</p>
<p>s 5(4)(a)</p> 	<p>Use since 1 May 2007</p>	<p>Non-medicated confectionery</p>
<p>s 5(4)(a)</p> 	<p>Use since 1 May 2007</p>	<p>Confectionery</p>

4. The applicant filed counterstatements in which it denied the claims made. All proceedings have been consolidated. Both parties filed evidence, which I will refer to

as appropriate later in this decision, but neither sought to be heard and I therefore make this decision on the basis of all of the written material before me.

The objections under section 5(2)(b) of the Act

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

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

(a)

(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, or

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

6. An earlier trade mark is defined in section 6 of the Act, 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 or international trade mark (EC) 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.

(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.”

7. In these proceedings, the opponent is relying on a number of trade marks as set out in paragraph 3 above. Each of them is an earlier mark under the above provisions. Given the interplay between the date on which the applications were published (21 December 2012) and the date on which the opponent’s earlier marks completed their respective registration procedures, UK registration 2636429 is not subject to proof of use and so can be relied on in respect of all goods for which it is registered. The remaining marks relied on, UK registration nos 2335256 and 2335404, International marks 814337 and 815915 and CTM 2685246, are subject to proof of use and, in its counterstatement, the applicant puts the opponent to such proof.

8. Section 6A of the Act states:

“Raising of relative grounds in opposition proceedings in case of non-use

- (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 sections 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.
- (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 or International trade mark (EC), 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 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).

9. In reaching a conclusion on this point, I must apply the same factors as I would if I were determining an application for revocation of a trade mark registration based on grounds of its non-use: the relevant period for present purposes is the five year period ending with the date of publication of the application for registration i.e. 22 December 2007 to 21 December 2012. In *Stichting BDO and others v BDO Unibank, Inc and others* [2013] EWHC 418 (Ch), Arnold J commented on the case law of the Court of Justice of the European Union (CJEU) in relation to genuine use of a trade mark. He said:

“In *SANT AMBROEUS Trade Mark* [2010] RPC 28 at [42] Anna Carboni sitting as the Appointed Person set out the following helpful summary of the jurisprudence of the CJEU in Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159 and Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759 (to which I have added references to Case C-416/04 P *Sunrider v OHIM* [2006] ECR I-4237):

“(1) Genuine use means actual use of the mark by the proprietor or a third party with authority to use the mark: *Ansul*, [35] and [37].

(2) The use must be more than merely ‘token’, which means in this context that it must not serve solely to preserve the rights conferred by the registration: *Ansul*, [36].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish the goods or services from others which have another origin: *Ansul*, [36]; *Sunrider*, [70]; *Silberquelle*, [17].

(4) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, i.e. exploitation that is aimed at maintaining or creating an outlet for the goods or services or a share in that market: *Ansul*, [37]-[38]; *Silberquelle*, [18].

- (a) Example that meets this criterion: preparations to put goods or services on the market, such as advertising campaigns: *Ansul*, [37].
- (b) Examples that do not meet this criterion: (i) internal use by the proprietor: *Ansul*. [37]; (ii) the distribution of promotional items as a

reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle*, [20]-[21].

(3) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including in particular, the nature of the goods or services at issue, the characteristics of the market concerned, the scale and frequency of use of the mark, whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them, and the evidence that the proprietor is able to provide: *Ansul*, [38] and [39]; *La Mer*, [22]-[23]; *Sunrider*, [70]-[71].

(4) Use of the mark need not always be quantitatively significant for it to be deemed genuine. There is no *de minimis* rule. Even minimal use may qualify as genuine use if it is the sort that is appropriate in the economic sector concerned for preserving or creating market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor: *Ansul*, [39]; *La Mer*, [21, [24] and [25]; *Sunrider*, [72]”.

10. Also of relevance is section 100 of the Act which states:

“100. 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.”

11. The opponent’s evidence consists of two witness statements. The first is by Terry Roy Rundle, a registered trade mark attorney employed by Wilson Gunn, the opponent’s representatives in these proceedings. The second is by Kaitlin Georgia Rimington, who says she is the Brand Manager of Candy responsible for a number of candy brands including The Natural Confectionery Co. The two statements are largely identical and from them the following facts emerge:

12. In May 2007, confectionery products under The Natural Confectionery Co brand were first launched in the UK. Use has been continuous since that time. The use has been by Cadbury UK and, subsequently, Mondelez UK Ltd, authorised by the opponent.

13. The annual retail value of sales of products under the trade mark The Natural Confectionery Co is given as follows:

<u>Year</u>	<u>Retail Value Sales (£)</u>
2007	1,477,315.00
2008	5,420,753.00
2009	11,800,027.00
2010	13,894,748.00
2011	12,476,513.40
2012	10,199,513.10

14. Goods under the mark have been sold throughout the UK and in major stores including Boots, Tesco, Budgens, Somerfield and Waitrose. Sample packets showing the marks as used are exhibited. Whilst they bear 'best before' dates in 2013 and 2014 and appear to be contemporary to the witness statements, they are typical of the use made of the marks since their introduction shown elsewhere in the evidence. Also exhibited are a number of invoices to UK addressees for goods sold under the marks and which date from between March 2010 and March 2012.

15. Since launch, some £7.6m is said to have been spent promoting goods under the marks. This is broken down as follows:

Medium	2008	2009	2010	2011
TV	£2,048,197	£839,609	£860,860	£1,068,843
Radio	-	£302,052	-	£257,314
Press	£199,619	-	-	-
Outdoor	£157,050	-	£346,289	£87,100
Cinema Adverts including Foyer Sampling	£184,269	-	-	£260,000
Online/Digital	£250,000	£41,000	£102,573	£431,510
Other	£15,000	-	£29,750	£121,430
Total	£2,854,135	£1,182,661	£1,339,472	£2,226,197

16. Copies of TV advertising, articles or advertising from the press and extracts from social media are exhibited. No details are given as to when and where the television advertising was carried out and the number of people who may have seen it. The press advertising includes trade and consumer press such as national newspapers, weekly and monthly women's magazines, TV listings magazines, monthly food-related magazines and supermarket own-store magazines as well as trade magazines such as *The Grocer*, *Cash & Carry Management* and *Off Licence News*. The examples provided date from between February 2008 and May 2012. The earliest article appears in *The Grocer* and refers to the brand having "failed to make an impact" which a spokesman countered by saying "we gave it a deliberately small launch within independents to see how [it] would sit in the UK market". As with most of the articles, it also refers to forthcoming advertising campaigns.

17. Whilst the font each mark is presented in differs slightly, registration no 2335256 and International mark no 815915 are both for the marks THE NATURAL CONFECTIONERY CO presented in standard upper case letters. Similarly, registration 2335404, international mark 814337 and CTM 2685246 are each figurative marks which are identical in form and shape and contain the words "The Natural Confectionery Co" in the same form and position within them. They differ only in relation to the inclusion of such non-distinctive elements as "no artificial colours" or "99% fat free". Within the evidence there is use shown of the word only and figurative forms of the mark with the vast majority of it being in figurative form. Whilst some of this use is not exactly use of the marks 'as registered' e.g. in some cases the word Binka's is not present or that part of the mark is replaced with the word Tasty on a differently shaped background, such examples of use have the same figurative layout. There are also examples of the mark in use including the word Binka's. The use shown is therefore in forms differing in elements which do not alter the distinctive character of the marks in the forms which they were registered. I

am satisfied on the evidence that genuine use has been made of each of the trade marks subject to proof of use.

18. Having established that genuine use has been made of the trade marks, it is necessary to decide upon a specification that fairly reflects that use. That description must not be pernickety (*Animal Trade Mark* [2004] FSR 19) and must take into account how the relevant public would describe the goods (*Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32). In *Reckitt Benckiser (España), v Office for Harmonization in the Internal Market (Trade Marks and Designs)(OHIM) Case T-126/03*, the General Court stated:

“44 With that in mind, it is necessary to interpret the last sentence of Article 43(2) of Regulation No 40/94 and Article 43(3), which applied Article 43(2) to earlier national marks, as seeking to prevent a trade mark which has been used in relation to part of the goods or services for which it is registered being afforded extensive protection merely because it has been registered for a wide range of goods or services. Thus, when those provisions are applied, it is necessary to take account of the breadth of the categories of goods or services for which the earlier mark was registered, in particular the extent to which the categories concerned are described in general terms for registration purposes, and to do this in the light of the goods or services in respect of which genuine use has, of necessity, actually been established.

45 It follows from the provisions cited above that, if a trade mark has been registered for a category of goods or services which is sufficiently broad for it to be possible to identify within it a number of sub-categories capable of being viewed independently, proof that the mark has been put to genuine use in relation to a part of those goods or services affords protection, in opposition proceedings, only for the sub-category or sub-categories relating to which the goods or services for which the trade mark has actually been used actually belong. However, if a trade mark has been registered for goods or services defined so precisely and narrowly that it is not possible to make any significant sub-divisions within the category concerned, then the proof of genuine use of the mark for the goods or services necessarily covers the entire category for the purposes of the opposition.

46 Although the principle of partial use operates to ensure that trade marks which have not been used for a given category of goods are not rendered unavailable, it must not, however, result in the proprietor of the earlier trade mark being stripped of all protection for goods which, although not strictly identical to those in respect of which he has succeeded in proving genuine use, are not in essence different from them and belong to a single group which cannot be divided other than in an arbitrary manner. The Court observes in that regard that in practice it is impossible for the proprietor of a trade mark to prove that the mark has been used for all conceivable variations of the goods concerned by the registration. Consequently, the concept of ‘part of the goods or services’ cannot be taken to mean all the commercial variations of similar goods or services but merely goods or services which are sufficiently distinct to constitute coherent categories or sub-categories.”

19. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited* BL O/345/10, Mr Geoffrey Hobbs Q.C. sitting as the appointed person stated:

“However, that does not appear to me to alter the basic nature of the required approach. As to that, I adhere to the view that I have expressed in a number of previous decisions. In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”

20. The trade marks the subject of proof of use are registered for confectionery, non-medicated confectionery and snackfoods with CTM 2685246 also being registered for services of wholesaling, retailing and direct selling of confectionery and/or snackfoods. The evidence does not make any reference to the provision of any services under the mark. As for the goods, the specifications as registered cover a very wide range and would not represent a fair specification based on the use shown. Both Ms Rimington and Mr Rundle refer in their witness statements to the goods sold under the mark all being “confectionery products”. Whilst this is undoubtedly true, again this is an overly broad term for the use shown. The use shown in the evidence is much more limited and is exemplified at KGR-2, where there are references in articles in trade magazines to “jelly sweets” and “fruit flavoured gums” and the sample packets exhibited show them be variously flavoured “gums”. I consider a fair description which reflects the use made of the mark and which the average consumer, who is a member of the general public, is likely to use is *jelly sweets* and it is this specification that I will take into account in my comparison.

21. The test for determining whether there is a likelihood of confusion is well established. In his decision in *La Chemise Lacoste SA v Baker Street Clothing Ltd* - BL O/330/10 (approved by Arnold J in *Och-Ziff Management Europe Ltd v Och Capital LLP* [2011] FSR 11), the Appointed Person, Mr Geoffrey Hobbs Q.C., expressed the test under this section (by reference to the CJEU cases mentioned) on the basis indicated below:

The CJEU cases

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 Klijsen Handel B.V.* [2000] F.S.R. 77; *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723; *Matratzen Concord GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-6/01; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04; *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* C-334/05 P.

The principles

“(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, 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, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may, in certain circumstances, be dominated by one or more of its components;

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) 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;

(k) if the association between the marks causes the public to wrongly believe that the respective goods [or services] come from the same or economically-linked undertakings, there is a likelihood of confusion.”

22. In essence, the test under section 5(2)(b) is whether there are similarities in marks and goods which, when taking into account all the surrounding circumstances,

would combine to create a likelihood of confusion. The likelihood of confusion must be appreciated globally and I need to address factors such as the degree of visual, aural and conceptual similarity between the marks, evaluating the importance to be attached to those different elements and taking into account the degree of similarity in the goods, the category of goods in question and how they are marketed.

The comparison of the respective goods

23. Taking into account my findings as regards proof of use and the fact that earlier mark no 2636429 relied on was not subject to proof of use, I set out below the goods to be compared:

Opponent's goods	Applicant's goods subject to opposition
<p>Jelly sweets</p> <p>(2636429 only) Ice cream; dairy ice cream; non-dairy ice cream; ice cream desserts; edible ices; frozen ices; sorbets (ices); fruit ices; frozen beverages (edible ices): ice desserts; frozen confectionery; frozen confections; frozen desserts; frozen yoghurt (confectionery ices); ice cream cones; sauces for ice cream</p>	<p>Non-medicated confectionery; cakes, biscuits; ices, ice cream, ice cream products, frozen confections; chilled desserts, mousses, sorbets; chocolate</p>

24. In *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 28, Jacob J gave advice as to how similarity should be assessed. He identified the following factors to be taken into account:

- (a) The respective uses of the respective goods;
- (b) The respective users of the respective goods;
- (c) The physical nature of the goods;
- (d) The respective trade channels through which the goods reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods in the same or different sectors.”

25. Subsequently, in *Canon Kabushiki Kaisha v MGM Inc* the CJEU stated:

“23. In assessing the similarity of the goods or services concerned.....all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, *inter alia*, their nature, intended

purpose and their method of use and whether they are in competition with each other or are complementary.”

26. In *Gérard Meric v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* (OHIM) Case T-133/05, the General Court said:

“...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...”

27. The term *non-medicated confectionery* as appears in the application includes each of the opponent’s goods and thus these respective goods are identical. Similarly, the applicant’s *ices* are identical to the opponent’s *edible ices*, *frozen ices* and *fruit ices*, whilst *ice cream products* and *frozen confections* are identical goods to the *ice cream desserts* and *frozen confectionery* as appears in the opponent’s specification.

28. The terms *ice cream* and *sorbets* appear in both specifications and so are clearly identical goods. *Chilled desserts* and *mousses* are very highly similar if not identical to the *frozen desserts* and *frozen confectionery* as appears in the opponent’s specification as their natures, users and uses are the same and they differ only in respect of the temperature and method of their storage. *Cakes* will include *gateaux* and are also highly similar if not identical to *frozen desserts* and *frozen confectionery* which will include frozen *gateaux*. *Biscuits* will include *wafers* and are highly similar if not identical to *ice cream cones* as both can be used to contain ice cream or other frozen confections.

29. That leaves *chocolate*. I consider this to be similar to a fairly high degree to the opponent’s *jelly sweets*. Both are bought by the general public as a sweet snack or treat to eat and so they are in competition, they share trade channels as they may be made by the same manufacturers and they are sold on the same shelves.




The average consumer and the nature of the purchasing process

30. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties’ goods and then to determine the manner in which these goods are likely to be selected by the average consumer in the course of trade.

31. All of the respective goods are comestibles and are relatively low cost everyday purchases bought by the general public. They are goods which are widely available and will be bought by self-selection either from a shelf or display stand or from a chiller or freezer cabinet. The nature of the purchase will be primarily a visual one. Whilst some of the goods may be bought on impulse, an average degree of care is likely to be taken over their purchase given they are for ingestion and that the purchaser is likely to have very specific preferences as to what type of confectionery etc. they prefer to eat.

Comparison of marks

32. The opponent relies on six earlier marks. Three are word only marks consisting of the words THE NATURAL CONFECTIONERY COMPANY (or its standard abbreviation CO). The other three are devices incorporating these words. Given the high degree of similarity between each set of three and taking into account the goods for which each is registered, I do not intend to include each of them in my comparison. With that in mind and taking into account the breadth of the respective specification of goods, the marks to be compared are:

Earlier marks	Application
2335256 THE NATURAL CONFECTIONERY CO.	 THE NATURAL CHOCOLATE COMPANY 
2636429 THE NATURAL CONFECTIONERY COMPANY	
2335404 	

33. The opponent's earlier mark nos 2335256 and 2636429 consist of ordinary dictionary words presented in plain block capitals. The word NATURAL is defined in the Oxford Dictionary of English 2nd Ed. as:

“derived from nature”

and

“having had a minimum of processing or preservative treatment; *natural food; our nutritional products are completely natural*”

and is non-distinctive for goods which are made without artificial ingredients. I note, in passing, that the evidence shows the opponent puts great emphasis on the fact that it uses natural colours and natural flavours in its products (see e.g. the packaging exhibited at KGR-3 and television advertisements exhibited at KGR-5). The word CONFECTIONERY is also non-distinctive for sweet preparations or goods

which are rich in sugar. Given the word THE is a determiner and the word CO is, as set out above, a standard abbreviation for the word COMPANY, none of the individual words are distinctive, however, in each case they combine together to create a mark with a degree of inherent distinctive character, albeit a very low one.

34. The same words appear within the opponent's earlier mark 2335404. Although one of the marks in the series is presented in colour, for the reasons given by Mann J in *Specsavers International Healthcare Ltd v Asda Stores Ltd (No 2)*, this does not assist in distinguishing the competing trade marks. The words THE NATURAL are dominant within the mark and are presented in a larger font than the other words and in a way which shows the individual letters to decrease gradually in size at their lower edge and from the outer letters to the middle. Underneath these words, and in smaller type and curved formation, are the words CONFECTIONERY CO. Again, the words combine to form a distinctive element of the mark but, for the reasons given above, one with a very low level of distinctiveness. The words appear on a shaped background which has a curved sausage-shaped banner below them. Beneath, is a roundel across which is the word BINKA'S in much smaller type. I am not aware that the word BINKA'S has any meaning in the English language but the use of the apostrophe and S is suggestive of it being a name. Whilst it is a distinctive element of the mark, the position and size within the overall mark means that the word BINKA'S is not a dominant element of it and may even be overlooked by the average consumer. In my view, the distinctiveness of the mark, which is modest, rests in its whole.

35. Each of the four marks applied for can be broken down into three parts. There is a larger stylised drawing of a tree in curlicue form presented on a linear, rectangular background which graduates from light at the top to darker at the bottom. Below it is a smaller but similarly presented asymmetrical heart shape. Separating the two are the words THE NATURAL CHOCOLATE (or FOOD) (or SNACKS) (or GUM) COMPANY presented in plain block capitals with the word COMPANY on a second line and in smaller font than the other words. Despite the separation, the words hang together and indicate a company making chocolate (food) (snacks) (or gum) products using natural ingredients. Both of the figurative elements are distinctive elements of the marks with the tree device the more dominant element of the two given its size and position.

36. As regards the comparison of earlier marks 2335256 and 2636429 with the marks applied for, as the respective marks all include the words THE NATURAL there is a degree of visual similarity between them. The remaining words within the marks i.e. Confectionery, Chocolate, Foods, Snacks, Gum, lead to some visual differences and the presence of the figurative elements within the marks, add to those differences. The respective marks are visually similar to a very low degree.

37. The marks applied for are likely to be referred to by the words within them and thus the respective marks will be aurally similar to the extent that both share the words THE NATURAL. It is possible, given that CO as appears in earlier mark 2335256 is a commonly used abbreviation for COMPANY, the average consumer will see and refer to CO as COMPANY as appears in 2636429 which would lead to further similarity. The remaining words within the marks differ. The respective marks are aurally similar to fairly high degree.

38. The respective marks each bring to mind a company dealing in products made eschewing artificial ingredients. Even though the word CONFECTIONERY is a term the average consumer is perhaps unlikely to use in everyday parlance (in my view he is more likely to refer to particular goods e.g. sweets, ice creams, chocolate or cakes etc.), it is a word with which the average consumer is likely to be familiar and which he will be aware will include 'foods' such as 'chocolate', 'snacks' and 'gum'. For these reasons, there is a high degree of conceptual similarity between the respective marks which is not altered by the presence in the mark applied for of the figurative elements.

39. As regards the comparison of earlier mark 2335404 with the marks applied for, there is again a degree of visual similarity between them on the basis that both include the words THE NATURAL. The remaining words within the marks lead to some visual differences and the presence of the figurative elements and stylistic presentation add to those differences. The respective marks are visually similar to a very low degree.

40. For the reasons given above, these respective marks share a fairly high degree of aural similarity and a high degree of conceptual similarity.

The distinctive character of the earlier marks

41. I must also assess the distinctive character of the earlier marks. The distinctive character of a mark can be appraised only, first, by reference to the goods for which it is registered and, secondly, by reference to the way it is perceived by the relevant public –*Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. 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 –*Windsurfing Cheimsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

42. As indicated above, earlier marks 2335256 and 2636429 THE NATURAL CONFECTIONERY CO[MPANY] are ones with a very low degree of inherent distinctive character. Earlier mark 2335404 contains the same words, however, the addition of the other elements within the mark lead to its having a higher (though still only modest) degree of inherent distinctive character. The evidence shows the goods are sold in major stores and supermarkets throughout the UK and, being the proverbial "bag of sweets", are low cost goods. Since launch of the goods in May 2007, sales have increased from an initial £1.47m (part year) to a high of £13.8m in 2010. Though sales have gradually decreased since then, the figures for 2011 and 2012 still show sales in excess of £10m. Since launch, some £7.6m has been spent on advertising and promoting the mark through such media as television and radio, the national press and magazines and social networks. Whilst these are significant sums of themselves, I have no details of the size of the relevant market (though it is likely to be vast) or the earlier marks' share of it. As I indicated earlier, the majority of the use shown in the evidence is use of the figurative form. Such use will not necessarily have materially enhanced the distinctiveness of the words alone. There is no evidence from the public or the trade. I am satisfied, however, that the

distinctive character of the marks will have been enhanced through use, though I am unable to say to what degree. I cannot therefore conclude that the words “The Natural Confectionery Co[mpany] had more than a modest degree of distinctiveness at the date of filing of the opposed application.

Likelihood of confusion

43. In determining whether there is a likelihood of confusion, a number of factors have to be borne in mind. The first is the interdependency principle whereby a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. I also have to factor in the distinctive character of the earlier marks, as the more distinctive they are, the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely on the imperfect picture of them he or she has retained in mind.

44. Earlier in this decision I found:

- the respective goods are either identical or fairly highly similar;
- the goods are low cost ones for which the average consumer is a member of the general public who will take an average degree of care over his purchase;
- the earlier (word) marks have a very low degree of inherent distinctive character whilst the earlier (figurative) marks have a modest degree of inherent distinctive character both of which will have been enhanced to some undefined but modest degree through use;
- the respective marks have a very low degree of visual similarity, a fairly high degree of aural similarity and a high degree of conceptual similarity;
- the primary purchasing process is likely to be through a visual selection of the goods.

45. Given the traits which the average consumer, identified above, is likely to display when selecting the respective parties’ goods and bearing in mind the, at best, modest distinctiveness of the earlier marks but taking all matters into account, I consider that rather than assuming that the similarities I have found indicate a connection in trade, the average consumer is likely to think that there are two unconnected companies promoting the use of natural ingredients in their products. That being so, I consider there is no likelihood of confusion between the respective marks. In reaching this view, I have taken into account the possibility of the respective marks being seen or heard separately and the effects that might have as regards imperfect recollection, a risk of which increases where there is a relatively higher degree of conceptual similarity between respective marks. Nevertheless, I consider the differences between the marks, when compared as wholes, are too great to go unnoticed by the average consumer who is deemed to be reasonably well informed and reasonably observant and circumspect, even where the goods are low cost.

The objection under sections 5(3) of the Act

46. Section 5(3) of the Act states:

“ A trade mark which-

(a) is identical with or similar to an earlier trade mark shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community trade mark, in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.

47. The matter must be judged at a particular point(s) in time. In *Last Minute Network Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Joined Cases T-114/07 and T-115/07 the General Court stated:

“50 First, there was goodwill or reputation attached to the services offered by LMN in the mind of the relevant public by association with their get-up. In an action for passing off, that reputation must be established at the date on which the defendant began to offer his goods or services (*Cadbury Schweppes v Pub Squash* (1981) R.P.C. 429).

51 However, according to Article 8(4) of Regulation No 40/94 the relevant date is not that date, but the date on which the application for a Community trade mark was filed, since it requires that an applicant seeking a declaration of invalidity has acquired rights over its non registered national mark before the date of filing, in this case 11 March 2000.”

48. Reputation in this context means that each of the earlier trade marks relied upon is known by a significant part of the public concerned with the goods covered by that mark (see paragraph 26 of the CJEU’s judgment in *General Motors Corp. v Yplon SA (CHEVY)* [1999] ETMR 122). The Court stated:

“27 In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking promoting it.”

49. Whilst, as I indicated above, the turnover figures are significant sums of themselves, the relevant market is likely to be vast and I have no evidence of the earlier marks’ share of that market. Total promotional spend is not insignificant but no evidence is given as to where and when such advertising took place, what was shown in the majority of instances or who and how many people may have been exposed to it. The exception is the evidence of TV advertising where the actual advertisements have been exhibited but, again as indicated above, no evidence is given as to where or when they may have been broadcast nor are any potential viewing figures provided. I have no evidence from the trade or the public. On the basis of the evidence filed, I do not consider the applicant has shown a reputation, in

the sense set out in *Chevy*, amongst the relevant UK public at the relevant date, in any of the marks relied upon under this ground. Even if I am wrong in this finding, given that the majority of the use shown is use of the figurative mark, I do not consider that any link would be made, by the relevant public, with the marks applied for. That being the case, the claims brought under section 5(3) of the Act fails.

The objection under Section 5(4)(a) of the Act

50. As for the objection brought under section 5(4)(a) of the Act, I fail to see how the opponent can be in any better position than I have already assessed under section 5(2). This is because any goodwill the opponent might have, has not been shown to extend beyond the goods which I took into account in my consideration under that ground. On that basis, the objections under these grounds would also fail because without any likelihood of confusion there can be no misrepresentation which is an essential requirement to establish passing off.

Summary

51. The opposition fails on all grounds on which it was brought.

Costs

52. NTA Foods, having successfully defended its applications, is entitled to an award of costs in its favour. In making the award, I note that these proceedings concerned four consolidated cases and that whilst both parties filed evidence, the two witness statements filed by the opponent was largely duplicative but would have taken some time to consider whilst that filed by the applicant consisted only of a very short witness statement which did not assist in determining the matters before me as it referred only to other marks on the register or fruit drinks, which are not the goods in these proceedings. I also note that no hearing took place. I therefore make the award on the following basis:

For filing statements and reviewing the other side's statements:	£500
Preparing evidence and reviewing the other side's evidence:	£500
Total:	£1000

53. I order Cadbury Enterprises Pte Ltd to pay NTA Foods Ltd the sum of £1000 as a contribution towards its costs. This sum is to be paid within seven days of the expiry of the period for appeal against this decision or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 12th day of May 2014

**Ann Corbett
For the registrar**

The Comptroller-General