

O-424-15

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 3062320
BY
ICELANDER LTD
TO REGISTER THE TRADE MARK**



ICELANDER

IN CLASS 32

AND

**THE OPPOSITION THERETO
UNDER NO 403218
BY
ICELAND FOODS LIMITED**

BACKGROUND

1. On 1 July 2014, Icelander Ltd (the applicant) applied to register the above trade mark in class 32 of the Nice Classification system¹, as follows:

"Beer; beers; non-alcoholic beer; low alcohol beer; malt beer."

2. The application was published on 8 August 2014, following which Iceland Foods Limited (the opponent) filed a notice of opposition against the application.

3. The opposition is based on section 5(2)(b) of the Trade Marks Act 1994 (the Act) and is directed at all of the goods in the application. The opponent relies upon the following UK registration for a series of three marks, in respect of its opposition:

Mark details and relevant dates	Goods relied upon
<p>TM: 2341223</p> <p>Marks:</p>  <p>Filed: 20 August 2003</p> <p>Registered: 11 April 2014</p>	<p>Class 32</p> <p>Beers, non-alcoholic beverages other than water, mineral and carbonated water; fruit drinks and fruit juices; syrups and other preparations for making beverages.</p> <p>Class 33</p> <p>Alcoholic beverages; wines, spirits and liqueurs.</p>

4. The applicant filed a counterstatement in which it denies the grounds on which the opposition is based.

5. Both parties filed written submissions and the opponent filed submissions in lieu of attendance at a hearing. Neither side asked to be heard.

6. Both sides seek an award of costs in their favour. I make this decision following a review of all of the papers before me.

¹ *International Classification of Goods and Services for the Purposes of the Registration of Marks under the Nice Agreement (15 June 1957, as revised and amended).*

DECISION

7. The opposition is brought under section 5(2)(b) which reads as follows:

“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,

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

8. 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.”

9. I note that throughout its counterstatement and submissions, the applicant requests the opponent to prove use of its mark in respect of particular goods. The opponent’s mark is an earlier mark which had not been registered for five years at the date of publication of the application. Consequently, the proof of use requirements set out in section 6A of the Act, do not apply.² Accordingly in these proceedings, the opponent is entitled to rely on its earlier mark for the full specification as registered.

Section 5(2)(b) case law

10. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson*

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.

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 be dominated by one or more of its components;

(f) however, it is also 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 creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

The average consumer and the nature of the purchasing act

11. In accordance with the above cited case law, I must determine who the average consumer is for the goods at issue and also identify the manner in which those goods will be selected in the course of trade.

12. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited* [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words ‘average’ denotes that the person is typical. The term ‘average’ does not denote some form of numerical mean, mode or median.”

13. The average consumer is a member of the general public.³ The goods are made available through a variety of trade channels. They may be bought in a supermarket or off licence, where the selection is likely to be made by the consumer from a shelf. They may also be bought from a website or mail-order catalogue, where the consumer will also select the goods visually. They may also be sold through bars, clubs and public houses, where the goods may be requested orally, from a member of staff. In considering this point I bear in mind the comments of the Court of First Instance (now the General Court) in *Simonds Farsons Cisk plc v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*⁴ when it said:

“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.”

14. Consequently, even though the purchase of these goods in a bar may involve an aural element, the selection will be made, primarily, from the display of goods on

³ For goods where the alcohol content exceeds 0.5% ABV the average consumer will be over 18 years of age.

⁴ T-3/04

shelves, in fridges and on optics at the back of the bar. Accordingly, the purchase of such goods is primarily visual, though I do not discount an aural element. The level of attention paid to the purchase will vary depending on the nature of the goods. As a general rule the goods are fairly low value, reasonably frequent purchases. However, they also include single malt whisky, expensive/vintage wines and champagne which may give rise to a higher level of attention being paid. In any event the level of attention paid will be that necessary to achieve inter alia, the correct flavour, strength and variety. Accordingly, the average consumer will pay a reasonable level of attention.

Comparison of goods

15. The goods to be compared are as follows:

The opponent's goods	The applicant's goods
<p>Class 32</p> <p>Beers, non-alcoholic beverages other than water, mineral and carbonated water; fruit drinks and fruit juices; syrups and other preparations for making beverages.</p> <p>Class 33</p> <p>Alcoholic beverages; wines, spirits and liqueurs.</p>	<p>Class 32</p> <p>Beer; beers; non-alcoholic beer; low alcohol beer; malt beer.</p>

16. In comparing the goods, I bear in mind the following guidance provided by the General Court (GC) in *Gérard Meric v OHIM*, Case T-133/05, in which it stated:

“29. ...goods can be considered identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark.”

17. The term ‘beers’ appears in the opponent’s specification. The identical term and the singular form, ‘beer’ are both included in the applicant’s specification. These are clearly identical terms.

18. The applicant’s ‘low alcohol beer’ and ‘malt beer’ are included within the broad term beers in the opponent’s specification. The applicant’s remaining term, ‘non-alcoholic beers’ is included within the opponent’s ‘non-alcoholic beverages’.

19. In conclusion, the parties’ goods are identical.

Comparison of marks

20. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“...it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”


21. It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

22. In its submissions dated 25 February 2015, the opponent states:

“11...The third mark in the series covers the ICELAND word in block letters and it is this mark which is closest to the Applicant’s mark.”

23. For the sake of procedural economy, I intend to compare the plain word mark from the opponent’s series of marks relied on in these proceedings.

24. The trade marks to be compared are as follows:

The opponent’s mark	The applicant’s mark
<p data-bbox="359 1615 596 1659">ICELAND</p>	

25. The opponents’ mark consists of a single element, the word ‘ICELAND’, in block capitals with no form of stylization. The overall impression of the mark is based solely on that word.

26. The applicant's mark consists of the word 'ICELANDER', with a minimal degree of stylisation, which does not prevent the word from being read clearly. Above the word is an image of a boat, which appears to be in the style of a Viking long ship. I note that in its submissions the applicant describes the device as, "the Icelandic Viking Ship". Both elements play a role in the overall impression of the mark, but it is the word element, ICELANDER, which will be articulated and plays the slightly greater role.

Visual similarities

27. In respect of the visual similarities the opponent states:

"...the Applicant's Trade Mark is visually very similar to the Opponent's Trade Mark because the dominant element of both marks is the word 'ICELAND'/'ICELANDER'. The marks share 7 identical letters in the same order."

28. Visual differences between the respective marks rest in the addition of an Icelandic Viking ship and the letters '-ER' at the end of 'ICELAND' in the application.

29. Visual similarities between the marks rest in the letters of the word ICELAND, which are the totality of the opponent's mark and the first 7 (of 9) letters of the word, ICELANDER in the application.

30. There is a general rule from cases such as *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02, that the beginnings of word tend to have more visual and aural impact than the ends. In this case the opponent's mark is the word ICELAND and the word in the application has the same first seven letters, which is significant in the visual impression created by the respective marks. Consequently, notwithstanding the ship device, I find the marks to have a fairly high degree of visual similarity.

Aural similarities

31. The opponent submits that there exist clear aural similarities given that the ICELANDER element of the applicant's mark will be pronounced in the same way as ICELAND, but will just have two extra letters at the end of the mark.

32. The applicant submits:

"19 The sign ICELANDER is not perceived either visually or aurally, as the word ICELAND with the component -ER-tagged on the end."

33. The opponent's mark is a familiar word in the English language and will be pronounced accordingly, 'ICE-LAND'.

34. The ship in the applicant's mark will not be articulated by the average consumer. The word element is a familiar word and will be pronounced in a very similar way to the opponent's mark ICE-LAND with the addition of ER at the end.

35. I find the marks are aurally similar to a fairly high degree.

Conceptual similarities

36. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer.⁵ The assessment must be made from the point of view of the average consumer.

37. On the matter of the conceptual similarity between the parties' respective marks, the applicant submits in its counterstatement:

"We believe the Opponent's series of trademarks and the trademark we have registered are vastly different, the word ICELANDER and the Viking ship logo are clearly not related to ICELAND despite sharing 7 identical letters in the same order. The Viking ship logo clearly creates a difference between the Opponent's registered trademark and ours. Our registered trade mark⁶ ICELANDER refers to a replica Viking ship and does not refer to ICELAND."

38. The opponent submits:

"19. The meaning of ICELANDER is as follows:

'noun – a native, citizen, or inhabitant of Iceland'

There is, therefore, a likelihood of confusion between the marks.

20. The Applicant submits that its mark refers to the name of a replica Viking ship called the Icelander and so the analysis that would be made is between the words ICELAND and ICELANDER and the Icelandic looking Viking ship.

21. The Opponent therefore submits that the Applicant's Trade Mark does not have a conceptual meaning wholly different from the Opponent's Trade Mark."

39. The opponent's mark is most likely to be considered, by the average consumer to be a reference to the country, Iceland. Whilst I accept the applicant's submission that its mark refers to a particular ship, the average UK consumer is not likely to be aware of this fact. The mark gives a conceptual impression of someone hailing from Iceland, with the ship simply reinforcing the message. In my view, both of the parties' marks are suggestive of ICELAND, one referring to the country itself and the other referring to someone from that country.

40. I find these marks to share a fairly high degree of conceptual similarity.

⁵ This is highlighted in numerous judgments of the GC and the CJEU including *Ruiz Picasso v OHIM* [2006] e.c.r.-I-643; [2006] E.T.M.R. 29.

⁶ The applicant is referring to the trade mark which is the subject of these proceedings and is not yet registered.

Distinctive character of the earlier mark

41. In determining the distinctive character of a trade mark it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify its goods as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger Joined Cases C-108/97 and C-109/97* [1999] ETMR 585.

42. I have no evidence to consider in this case so need only consider the inherent distinctive character of the earlier mark. 'ICELAND' has no direct meaning in respect of the goods themselves. However, it could be seen to denote the origin of those goods. This is particularly the case here as, in my experience, it is not uncommon to find goods of this type displayed/sold with emphasis on the geographic origin. As a consequence the mark enjoys a low degree of inherent distinctive character.

Likelihood of confusion

43. In assessing the likelihood of confusion, I must adopt the global approach advocated by case law and take into account the fact that marks are rarely recalled perfectly, the consumer relying instead on the imperfect picture of them he has kept in his mind.⁷ I must also keep in mind the average consumer for the goods, the nature of the purchasing process and have regard to the interdependency principle i.e. 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.

44. I have made the following findings:

- The applicant's mark is visually, aurally and conceptually similar to the opponent's mark to a fairly high degree.
- The parties' goods are identical.
- The average consumer is a member of the general public. The purchase of the goods is primarily visual, though I do not discount an aural element. The level of attention paid will be that necessary to achieve inter alia, the correct variety of goods. Accordingly, the average consumer will pay a reasonable level of attention to the purchase.

45. There is a high degree of similarity between these marks. The goods, which are identical, are low cost with no more than a reasonable level of attention being paid to their selection. The conceptual message from both marks is that they have a connection to Iceland. Taking into account the concept of imperfect recollection, I find there is a likelihood of direct confusion, where the average consumer mistakes one mark for the other.

CONCLUSION

46. The opposition succeeds under section 5(2)(b) of the Act.

⁷ *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27

COSTS

47. The opposition having succeeded, the opponent is entitled to a contribution towards its costs. I have taken into account that no hearing has taken place and make the award on the following basis:

Preparing a statement and considering the other side's statement: £200

Preparing submissions: £300

Official fee: £100

Total: £600

48. I order Icelander Ltd to pay Iceland Foods Limited the sum of £600. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 8th day of September 2015

**Ms Al Skilton
For the Registrar,
The Comptroller General**