

O-521-15

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION 3072886
BY D&G BALTIC LTD
TO REGISTER THE TRADE MARK:**

POLY POSTAL

IN CLASS 16

AND

OPPOSITION 403376 THERETO BY MOROAK

Background and pleadings

1. D&G Baltic Ltd (the Applicant) applied to register the above trade mark on 16 September 2014. It was accepted and published in the Trade Marks Journal on 10 October 2014 in respect of the following goods in Class 16:

Class 16

Bags [envelopes, pouches] of paper or plastics, for packaging; Bags incorporating bubble plastics for packaging; Bags made of plastics for packaging; Bags of bubble plastics for packaging; Plastic bubble packs for wrapping or packaging; Plastic wrap; Air bubble plastics for packaging; Air bubble plastics for wrapping; Bags of bubble plastics for packaging; Bubble packs (plastic-) for wrapping or packaging; Bubble packs for wrapping; Plastic bubble packs for wrapping; Bubble packs (Plastic -) for wrapping or packaging; Plastic wrap.

2. Moroak (the Opponent) opposes the application in full on the basis of Sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 (the Act). This is on the basis of its earlier UK trade mark 2558330 'POLYPOST', filed on 9 September 2010 and registered on 10 December 2010, which it claims has a reputation. The mark is registered only in respect of the following goods, which are relied upon in this opposition:

Class 16

Envelopes

3. The Opponent argues that the respective goods are identical or similar and that the marks are similar. The Opponent also argues that the applicant will benefit from the reputation of the earlier mark; that the Applicant's goods will not be of a comparably high standard, which will cause detriment to its reputation and business; and that use of the later mark will dilute the distinctive character and reputation of its marks.
4. The Applicant filed a counterstatement denying the claims made and requesting that the Opponent provide proof of use of its earlier trade mark relied upon. The Opponent's mark constitutes an earlier mark in accordance with Section 6 of the Act, however it had not been registered for more than five years at the date on which the Applicant's mark was published, meaning that the proof of use provisions contained in Section 6A do not apply. Consequently, the earlier mark may be relied upon without having to prove use.
5. The Opponent filed evidence and written submissions in these proceedings. The Applicant filed nothing beyond its counterstatement. The evidence is summarised below, and submissions are referred to where appropriate. No hearing was requested and so the decision is made on the basis of the material before me.

Evidence

6. The Opponent's evidence comprises the witness statement of Tim Browning, Operations Director of the Opponent, Moroak, which trades as Blake Envelopes Limited.
7. Mr Browning states that the Opponent is the UK's leading envelope stockist, supplying one in eight envelopes in the UK, and that the Opponent's mark denotes one range of envelopes sold by the Opponent. Mr Browning states that the Opponent has made extensive use of the mark since at least 2011. In support of this he exhibits at TB1 an undated photograph of such an envelope bearing the words "POLYPOST TAMPER EVIDENT SECURITY ENVELOPES" repeated twice. These words are printed on what appears to be a paper insert attached to the product, which Mr Browning describes at paragraph 4 of his witness statement:

"This particular range is made from a strong polythene material, rendering it durable and capable of reliably carrying larger documents, such as magazines and periodicals."

8. He also exhibits TB2, a printout from the Opponent's website said to date to 6 June 2015 (after the date of the application), showing use of the mark in conjunction with product descriptions, and TB3, a series of advertising banners which he states have appeared on the website since 2011, (however they are presented without any context). £10,000 is said to have been spent advertising goods bearing the mark. Sales of goods bearing the mark between 2011 and June 2015 have amounted to £98,653.
9. In its counterstatement the Applicant simply states that its goods can be viewed on its website "www.polypostal.co.uk". It is not for me to conduct evidence gathering on behalf of parties engaged in opposition proceedings; parties wishing to rely on evidence of goods being offered for sale via a website should submit printouts showing the website as it was at the relevant time.

DECISION

10. Section 5(2)(b) of the Act is as follows:

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

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

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

11. 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 Multimedia Sales Germany & Austria GmbH, Case C-120/04, Shaker di L. Laudato & C. Sas v OHIM, Case C-334/05P and Bimbo SA v OHIM, Case C-591/12P:

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 might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Average consumer and the purchasing act

12. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer, Case C-342/97*.

13. 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.”

14. The average consumer of envelopes and other packaging materials in Class 16 is the general public, though I do not discount that there may be a wholesale aspect with goods being sold to businesses. The selection of envelopes by a member of the general public will be subject to a degree of care and attention lesser than the norm as they are a low-value item of stationery which is utilitarian in nature. For a business user, given the likely need to buy in bulk, the level of care will be somewhat higher than for a member of the general public, but no higher or lower than the norm. For other goods, there will be an average to slightly below average level of care and attention paid during the purchasing process owing to the need to ensure the packaging materials is fit for purpose. In these cases the level of care and attention will vary according to the nature and value of the items to be mailed. The purchasing process will be primarily visual, with products selected from shop shelves or websites. Some, for example business users, may place orders aurally via the telephone.

Comparison of marks

15. 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 Court of Justice of the European Union (“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.”

16. 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.

17. The respective marks are shown below:

Earlier trade mark	Contested trade mark
POLYPOST	POLY POSTAL

18. The Opponent’s mark consists of the single word ‘POLYPOST’, a conjunction of two well-known words. The prefix ‘poly’ may denote that something is multiform, e.g. polygon, polyglot. It is also a common prefix denoting various synthetic substances e.g. polythene, polystyrene. ‘POST’ refers to the mailing, carriage and delivery of correspondence, packages etc, or such packages in their own right, and is strongly allusive of the purpose of the goods in question. ‘POLY’ therefore takes on the greater significance in the overall impression of the mark, although I bear in mind that it is a whole mark comparison that must be made.

19. The Applicant’s mark consists of the words ‘POLY POSTAL’ in a bold font which is very mildly graduated grey to black from top to bottom. It has been filed as a stylised word mark, but the typography is so unremarkable that it plays very little role in the overall impression of the mark, which is therefore dominated by the words themselves, with the greater significance resting with the word ‘POLY’ than with ‘POSTAL’.

20. Conceptually, neither mark has a specific meaning beyond being allusive of either plastic (polythene) post/postal products, or perhaps a multiform post/postal product. Whatever allusive meaning the average consumer takes, they will take the same one for each of the marks. Accordingly there is a high degree of conceptual similarity.

21. Aurally both marks will be pronounced identically, save as for the final syllable of the applied for mark, ‘AL’. The similarity at the start of the marks is more marked than the difference at the end, and I assess the aurally similarity as high.

22. Visually there is a space between the words POLY and POSTAL in the applied for mark, as well as the additional ‘AL’ at the end. The mark is presented in a very mildly stylised text, though this is not relevant to the consideration of visual similarity as the earlier mark could equally be presented in a similar typeface. Taking into account the differences I have identified, I assess the visual similarity as reasonably high.

Comparison of goods

23. In the judgment of the CJEU in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

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

24. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- a. The respective users of the respective goods or services;
- b. The physical nature of the goods or acts of services
- c. The respective trade channels through which the goods or services reach the market
- d. 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;
- e. The extent to which the respective goods or services 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 or services in the same or different sectors.

25. Both specifications cover goods in Class 16. The Applicant's specification covers “Bags [envelopes, pouches] of paper or plastics, for packaging” which is identical to the Opponent's “Envelopes”. I also consider that “Bags incorporating bubble plastics for packaging; Bags made of plastics for packaging; Bags of bubble plastics for packaging” to be identical to envelopes, as such bags may be in the form of envelopes, as is exemplified by the first term in the Applicant's specification. Even if they are not identical, they are at the least highly similar in purpose and nature, and may be competitive products, being sold in the same shops and found in the same aisles.

26. The Applicant's specification also covers:

Plastic bubble packs for wrapping or packaging; Plastic wrap; Air bubble plastics for packaging; Air bubble plastics for wrapping; Bubble packs (plastic-

) for wrapping or packaging; Bubble packs for wrapping; Plastic bubble packs for wrapping; Bubble packs (Plastic -) for wrapping or packaging; Plastic wrap.

27. The respective users and channels of trade are the same for the Opponent's goods as for all those of the Applicant. Where sold in shops they are likely to be found in the same aisles. They are similar in nature and very similar in purpose to envelopes, all being materials into which items may be packaged for postage. They may compete with envelopes, in so far as a consumer may choose to package their items in either an envelope or in plastic wrap.

Distinctive character of the earlier trade mark

28. In Case C-342/97 *Lloyd Schuhfabrik Meyer*, the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

29. As a word combination with an allusive aspect, 'POLYPOST' bears a lower than medium degree of inherent distinctive character. Mr Browning has given evidence as to the revenues generated from sales of goods bearing the mark since 2011, which appear relatively low considering the length of time covered. Whilst Mr Browning states that the Opponent sells 1 in 8 of all envelopes sold in the UK, this does not go to show the market share enjoyed by those bearing the POLYPOST mark, which are only one among many of the Opponent's products. In the absence of data showing the size of the market involved for these particular goods, I am unable to find from the evidence provided that such use has enhanced the distinctive character of the mark.

Likelihood of Confusion

30. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is 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. It is also necessary for me to keep in mind the distinctive character of the opponent's trade mark as the more distinctive this trade mark is, 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 upon the imperfect picture of them he has retained in his mind.

31. Earlier in this decision I found that:

- the average consumer is a member of the general public who pays a lesser degree of care and attention during the selection of envelopes, (or an average degree of care and attention where they are a business user);
- for other packaging materials an average to slightly below average degree of care and attention will be paid;
- the goods are variously identical (i.e. envelopes), highly similar (e.g. bags made of plastics for packaging) and similar (e.g. air bubble plastics for wrapping);
- the competing marks are conceptually and aurally similar to a high degree and visually similar to a reasonably high degree; and
- the earlier mark is possessed of a below medium degree of inherent distinctive character.

32. I also bear in mind the case of *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02, in which the General Court noted that the beginnings of words tend to have more visual and aural impact than the ends. The court stated:

"81. It is clear that visually the similarities between the word marks MUNDICOLOR and the mark applied for, MUNDICOR, are very pronounced. As was pointed out by the Board of Appeal, the only visual difference between the signs is in the additional letters 'lo' which characterise the earlier marks and which are, however, preceded in those marks by six letters placed in the same position as in the mark MUNDICOR and followed by the letter 'r', which is also the final letter of the mark applied for. Given that, as the Opposition Division and the Board of Appeal rightly held, the consumer normally attaches more importance to the first part of words, the presence of the same root 'mundico' in the opposing signs gives rise to a strong visual similarity, which is, moreover, reinforced by the presence of the letter 'r' at the end of the two signs. Given those similarities, the applicant's argument based on the difference in length of the opposing signs is insufficient to dispel the existence of a strong visual similarity.

82. As regards aural characteristics, it should be noted first that all eight letters of the mark MUNDICOR are included in the MUNDICOLOR marks.

83. Second, the first two syllables of the opposing signs forming the prefix 'mundi' are the same. In that respect, it should again be emphasised that the

attention of the consumer is usually directed to the beginning of the word. Those features make the sound very similar.

33. Taking into account all of these factors and bearing in mind the above case law, I find that there is a likelihood of confusion. Bearing in mind the average consumer's imperfect recollection and the fact that they do not directly compare marks, these factors will lead to one mark being mistaken for another and therefore there will be direct confusion.

Conclusion

34. The opposition under Section 5(2)(b) has succeeded.

35. As the opposition is successful in its entirety based upon this ground, there is no need to consider the claim under Section 5(3).

36. The application is refused.

COSTS

37. The Opponent has been successful and is entitled to a contribution towards its costs. I note that the Applicant relied solely on its witness statement. Accordingly the Opponent has not had to consider evidence or submissions other than its own. In these circumstances I award the Opponent the sum of £600 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

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

Preparing evidence and submissions: £200

Official fees: £200

Total: £600

38. I therefore order D&G Baltic Ltd to pay Moroak the sum of £600. The above sum should 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 9th day of November 2015

**Andrew Wall
For the Registrar**