

O-548-15

TRADE MARKS ACT 1994

APPLICATION NO. 3048137 BY HALFOODS LTD

TO REGISTER:



Crunchy Bar

IN CLASS 30

AND

OPPOSITION NO. 402996

BY SUN MARK LIMITED

Background and pleadings

1. On 24 March 2014, Halfoods Ltd (“the applicant”) applied to register the trade mark shown on the cover page of this decision for the following goods in class 30:

Coffee, tea, cocoa and artificial coffee; Rice; Tapioca and sago; Flour and preparations made from cereals; Bread, pastry and confectionery, biscuits.

2. The application was accepted and published in the Trade Marks Journal on 4 July 2014.

3. Sun Mark Limited (“the opponent”) opposed the application on the basis of section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opposition is directed against the following goods in the application:

“Flour and preparations made from cereals”.

The opponent relies upon the goods shown below in the following trade mark registrations:

UK no. 2398799 for the trade mark: GOLDEN COUNTRY which was applied for on 6 August 2005 and which completed its registration process on 27 January 2006:

Class 30 - cereals, flour and preparations made from cereals.

Community Trade Mark (“CTM”) no. 9380081 for the trade mark: GOLDEN COUNTRY which was applied for on 16 September 2010 and which completed its registration process on 7 July 2011:

Class 30 - flour and preparations made from cereals, Breakfast cereals; Cereal breakfast foods; Cereal breakfast products; Cereal products; Food products consisting of cereals.

4. The opponent’s trade marks are earlier trade marks for the purposes of section 6 of the Act. As UK no. 2398799 had been registered for more than five years at the date the application was published for opposition purposes, it is subject to the proof of use provisions contained in section 6A of the Act. The opponent indicates that it has used the trade mark for the goods I have identified. CTM no. 9380081 is not subject to proof of use.

5. The applicant filed a counterstatement in which it denies the basis of the opposition and puts the opponent to proof of use.

6. Both parties filed evidence and the opponent filed written submissions in reply to the applicant’s evidence. Neither party asked to be heard nor did they file written submissions in lieu of attendance at a hearing.

The evidence

7. The opponent's evidence consists of a witness statement from its Managing Director Dr Raminder S Ranger; it is accompanied by four exhibits. The applicant's evidence consists of a witness statement from one of its Directors, Mohamed Thasim, it is also accompanied by four exhibits. I do not intend to summarise this evidence here but will refer to it, where appropriate, later in this decision.

Decision

8. The opposition is based upon section 5(2)(b) of the Act which reads 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.”

The basis of the opposition

9. In its Notice of Opposition, the opponent identified both the goods in its earlier trade marks upon which it was relying and the goods in the application it was opposing; these are outlined above. However, in his witness statement, Dr Ranger provided submissions on what he considered to be the identical/similar nature of all of the goods in the application to various goods in the earlier trade marks (including goods upon which the opponent had not relied). In its written submission in reply, the opponent states:

“5...the opponent requests that the contested application be rejected in full...”

10. As there has been no request by the opponent to amend its pleadings and, as a consequence, no opportunity for the applicant to respond, I intend to proceed on the basis that the scope of the opposition is limited to those goods identified in the Notice of Opposition. I will, however, return to this point when I consider the likelihood of confusion.

Section 5(2)(b) – case law

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

The opponent's best case

12. Both earlier trade marks consist of the words GOLDEN COUNTRY in upper case. However, as CTM no. 9380081 is relied upon for a broader range of goods than the earlier UK trade mark and as it is not subject to proof of use, it is this trade mark I will use for the purposes of comparison.

Comparison of goods

13. The competing goods are as follows:

Opponent's goods being relied upon – CTM no. 9380081	Applicant's goods being opposed
Class 30- flour and preparations made from cereals, Breakfast cereals; Cereal breakfast foods; Cereal breakfast products; Cereal products; Food products consisting of cereals.	Class 30 - Flour and preparations made from cereals.

14. Although in his witness statement, Mr Thasim refers to the goods upon which the applicant currently uses its trade mark i.e. in relation to “snacks and confectioneries made mainly of nuts and dry fruits” (and provides exhibits in support), this is not the comparison I am required to make. As the opponent's trade mark I have identified as its best case is not subject to proof of use, what I must do is compare the goods in its specification upon which it relies with the opposed goods in the applicant's specification (which are not limited in any way). As the opponent's specification in class 30 includes, inter alia, the phrase “flour and preparations made from cereals”, which is the totality of the goods being opposed, the goods are identical.

The average consumer and the nature of the purchasing act

15. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods; I must then determine the manner in which these goods are likely to be selected by the average consumer in the course of trade. 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.”

16. In his witness statement Dr Ranger states:

“8. Given that the goods concerned are likely to be found in supermarket shelves in the UK and are everyday consumer goods, the relevant consumer is likely to be the public at large i.e. the general public...”

And:

“16...What’s more, the goods are inexpensive groceries, i.e. everyday items, reason why the purchasers are presumed to take less care...as in comparison with buying more expensive items or items of a technical nature.”

17. Whilst I agree with Dr Ranger’s conclusions regarding the average consumer of the goods at issue and the manner in they may be selected i.e. from the shelves of a supermarket, such goods are, in my experience, equally likely to be selected from the pages of a website, all of which indicates that visual considerations will dominate the selection process. Although aural considerations cannot be completely discounted, they are, in my view, likely to be a relatively insignificant part of the purchasing process. As to the degree of care taken when selecting the goods at issue, once again I agree with Dr Ranger’s conclusion. Given the low cost and relatively high frequency with which such goods are likely to be selected, the average consumer will, in my view, pay a low to below average degree of attention during the selection process.


Comparison of trade marks

18. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade 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 trade marks must be assessed by reference to the overall impressions created by the trade 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.”

19. It would be wrong, therefore, artificially to dissect the trade marks, although, it is necessary to take into account the distinctive and dominant components of the trade

marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the trade marks. The trade marks to be compared are:

Opponent's trade mark	Applicant's trade mark
GOLDEN COUNTRY	

20. Much like his comments in relation to the goods at issue, in his submissions, Mr Thasim refers to the form in which the parties actually use their competing trade marks (and provides evidence in support). However, for the same reasons indicated above, what I must do is compare the competing trade marks in the form in which they are registered and applied for respectively. In his witness statement (paragraphs 18 to 30), Dr Ranger provides submissions on the similarity in the competing trade marks. I do not intend to summarise all these submissions here, but will refer to them as necessary below. For the avoidance I doubt, I have borne them all in mind in reaching the conclusions which follow.

21. The opponent's trade mark consists of the two words GOLDEN and COUNTRY presented in upper case. In his statement, Dr Ranger states:

“29...The earlier registered mark GOLDEN COUNTRY, for goods inserted in class 30, gives a sense of a large field which (sic) fertile and full of vitality. It highly probably will bring to the minds of consumers an image of golden crops, grain crops and cereal crops...”

22. Although the word GOLDEN is the first of two words making up the opponent's trade mark, I agree with Dr Ranger that the two words of which it consists form a unit to send the conceptual message he suggests; this is the overall impression the trade mark will convey and where its distinctiveness lies.

23. The applicant's trade mark consists of a number of elements. The first is the word “Golden” presented in title case in white in a cursive script and presented at an angle. The second is a red oval device with a gold border, also presented at an angle within which the word “Golden” is located. The third element is the phrase “Crunchy Bar” presented in black in a cursive script which is presented under the other elements. In his submissions, Dr Ranger argues that:

“23...the words “Crunchy” and “Bar” are just describing the product applied for: a cereal **bar** which is **crunchy**.”

24. Although this submission is borne out by the applicant's own evidence, showing how the applicant currently uses its trade mark, I remind myself that the applicant's specification is not limited in any way.

25. Given their relative size and positioning, the overall impression of the applicant's trade mark, in my view, will be dominated by a combination of the word "Golden" and the coloured oval device in which it appears. Dr Ranger states:

"29...GOLDEN CRUNCHY BAR is suggesting a picture of a golden cereal/nut crispy bar which logically originates from a golden field..."

26. As the word "Golden" is, as Dr Ranger suggests, likely to refer to the colour of the goods at issue, it has descriptive qualities. Irrespective of whether the coloured oval device may be distinctive in its own right, given the manner in which it appears in the applicant's trade mark, it performs the role of a background upon which the word "Golden" is presented; it has, in my view, little distinctive character. Finally, notwithstanding the unlimited nature of the applicant's specification, it is, in my view, inevitable that the average consumer will consider the words "Crunchy Bar" to be descriptive/non-distinctive and these words will have little, if any, relative weight in the overall impression the applicant's trade mark conveys. Considered overall, the distinctiveness of the applicant's trade mark lies in the combination of the word "Golden", the oval device and the colours and manner in which these elements are presented.

27. Turning now to the visual, aural and conceptual comparison, both trade marks contain the word "GOLDEN"/"Golden". Although the opponent's trade mark also contains the word "COUNTRY" and the applicant's trade mark the device element I have described and the words "Crunchy Bar" (the first word of which Dr Ranger argues is, by virtue of the letters it shares with the word COUNTRY and their positioning, similar – see below), there is, in my view, a medium degree of visual similarity between them (rather than a high degree as Dr Ranger suggests).

28. As to aural similarity, when a trade mark consists of a combination of words and figurative elements, it is well established that it is most likely to be referred to by the word elements. The pronunciation of the opponent's trade mark is entirely predictable i.e. as two two syllable words GOLD-EN and COUN-TRY. The word Gold-en in the applicant's trade mark will be pronounced in an identical fashion. In his statement, Dr Ranger argues:

"28...Additionally, the words COUNTRY and CRUNCHY will be pronounced similarly as they share five identical vowels and consonants."

29. In view of the above submission and bearing in mind that the word "GOLDEN"/"Golden" will be pronounced in an identical fashion, Dr Ranger concludes that the competing trade marks are aurally similar to a high degree. In relation to goods in the form of "Bars" which are "Crunchy", it is doubtful if the words "Crunchy Bar" will be

articulated at all (resulting in a comparison between the words “GOLDEN COUNTRY” and “Golden” alone), which, once again in my view, results in a medium degree of aural similarity between them. However, if the words “Crunchy Bar” were to be articulated, this would not, in my view, improve the opponent’s position (arguably it would weaken it).

30. Finally, in relation to conceptual similarity, having commented upon the message the opponent’s trade mark will convey, as indicated above, Dr Ranger concludes:

“29...GOLDEN CRUNCHY BAR is suggesting a picture of a golden cereal/nut crispy bar which logically originates from a golden field...”

31. Whilst I accept that the word “GOLDEN/Golden” in the competing trade marks will evoke similar conceptual imagery in the mind of the average consumer, in my view, the opponent’s trade mark will send the more specific conceptual message Dr Ranger suggests, whereas the conceptual message sent by the applicant’s trade mark will be much more general i.e. relating to a “Crunchy Bar” which is “Golden” in colour.

Distinctive character of the opponent’s GOLDEN COUNTRY trade mark

32. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a trade 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 trade 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 Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

33. Although I agree that the opponent’s GOLDEN COUNTRY trade mark evokes the pleasant rural imagery suggested by Dr Ranger, that is a long way from it being descriptive of or non-distinctive for the goods upon which the opponent relies in these proceedings. Absent use, it is, in my view, possessed of an average degree of inherent distinctive character.

34. Exhibit 4 to Dr Ranger’s statement consists of 184 invoices issued by the opponent to various businesses based in the UK; although the invoices are dated between 2006 and 2015 the vast majority are dated prior to the date of the application for registration. The invoices have various entries highlighted, for example, “GOLDEN COUNTRY CORNFLAKES”, “GOLDEN COUNTRY SARDINE VEG/OIL”, “GOLDEN COUNTRY PURE BLO/HONEY” and “G/C COMBO KETCHUP BROWN SAUCE”. Although the invoices demonstrate that the opponent has used the words GOLDEN COUNTRY in relation to goods which are encompassed by those it relies upon in these proceedings, no turnover figures by year have been provided nor has the opponent provided even an estimate of the market share it enjoys in relation to such goods. In addition, as can be

seen from the illustrative examples shown above, a not insignificant number of the entries relate to goods upon which the opponent does not rely in these proceedings. As a consequence, I am unable to conclude, on the basis of the evidence provided, that the opponent's GOLDEN COUNTRY trade mark has acquired any enhanced distinctive character by virtue of the use that has been made of it.

Likelihood of confusion

35. 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 earlier 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. I have concluded that:

- in the absence of a request by the opponent to amend its pleadings, the opposition should only be considered to be based upon those goods identified by it in its Notice of Opposition and against those goods in the application identified by it in its Notice of Opposition;
- proceeding on the basis indicated above, the competing goods are identical;
- the average consumer is a member of the general public who will select the goods by overwhelmingly visual means and who will pay a low to below average degree of attention when doing so;
- the overall impression of the opponent's trade mark and its distinctiveness lies in the unit it creates rather than in the individual elements of which it is made up;
- the overall impression of the applicant's trade mark and its distinctiveness lies in the combination of the word "Golden", the oval device and the colours and manner in which these elements are presented;
- the competing trade marks are visually and aurally similar to a medium degree and conceptually similar to the extent that they both contain the word "GOLDEN/Golden";
- the opponent's GOLDEN COUNTRY trade mark is possessed of an average degree of inherent distinctive character which, on the basis of the evidence provided, I am unable to conclude has been enhanced by the use made of it.

36. In reaching a conclusion, I remind myself that the competing goods are identical, the average consumer will pay only a low to below average degree of attention during the selection process (making them more prone to the effects of imperfect recollection), the competing trade marks are visually and aurally similar to a medium degree and share some conceptual similarity and the opponent's trade mark is possessed of an average degree of inherent distinctive character. However, as the word "GOLDEN/Golden" itself in the competing trade marks has, in my view, descriptive qualities and as it does not play an independent distinctive role in either parties' trade marks, the average consumer will not rely upon this word within the competing trade marks to indicate trade origin. Rather, the average consumer will look to the differing overall impressions conveyed by the competing trade marks for this purpose. I am, therefore, satisfied that even considering the effects of imperfect recollection, there will be neither direct confusion i.e. where the average consumer mistakes one trade mark for the other, nor indirect confusion i.e. where the similarities between the competing trade marks leads the average consumer to assume that the identical goods at issue come from undertakings which are economically linked.

37. Having reached that conclusion, I should comment upon Dr Ranger's submission to the effect that as the opponent's trade mark is registered in upper case, it would be permissible for it to present its trade mark in a similar script and colours to that of the applicant. While that would, I accept, narrow the gap between the competing trade marks from a visual perspective, I am still satisfied that notwithstanding the limited degree of care taken during the purchasing process, the descriptive nature of the word "GOLDEN/Golden" combined with the differing overall impressions the competing trade marks convey, would still be sufficient to avoid either direct or indirect confusion.

38. Finally, for the avoidance of doubt, I should make it clear that as the word "GOLDEN/Golden" is likely to have similar descriptive qualities in relation to all of the goods in the application (as well as upon those goods upon which, from its submissions, it appears the opponent may have wished to rely), I would have come to the same conclusion had the opposition been directed against all of the goods in the application (as it now appears may have been the opponent's intention).

Conclusion

39. The opposition has failed, and subject to any successful appeal, the application will proceed to registration.

Costs

40. The applicant has been successful and is entitled to a contribution towards its costs. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 4 of 2007, details of which can be found at:

<http://webarchive.nationalarchives.gov.uk/tna/20140603093547/http://www.ipo.gov.uk/pro-types/pro-tm/t-law/t-tpn/t-tpn-2007/t-tpn-42007.htm>

41. Using that TPN as a guide, and bearing in mind that the applicant has not been professionally represented, I award costs to it on the following basis:

Preparing a statement and considering the opponent's statement:	£150
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Preparing evidence and considering and commenting upon the opponent's evidence:	£250
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Total:	£400
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42. I order Sun Mark Limited to pay to Halfoods Ltd the sum of **£400**. 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 23rd day of November 2015

C J BOWEN
For the Registrar