

O-521-17

**TRADE MARKS ACT 1994  
IN THE MATTER OF  
TRADE MARK APPLICATION NO 3166743  
BY NAURUS PVT LTD  
TO REGISTER**

**CHATKHAAR**

**AS A TRADE MARK  
IN CLASSES 29 & 30  
AND OPPOSITION THERETO (UNDER NO. 407242)  
BY  
WALFOOD S.A.**

## BACKGROUND AND PLEADINGS

1. On 27 May 2016 Naurus PVT Ltd ('the applicant') applied to register the mark **CHATKHAAR** in classes 29 and 30.
2. The trade mark was published on 24 June 2016. Following publication Walford S.A. ('the opponent') opposed the application on the grounds of sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 ('the Act'). The first two of those grounds are based on the following earlier Trade Marks.

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| <p>UK TM No. 772051</p> <p><b>Chatka</b></p> <p>Filing date: 10 December 1957</p> <p>Registration date: 10 December 1957</p>   | <p>Class 29: All goods included in Class 29</p>   |
| <p>EU TM No. 943670</p> <p><b>CHATKA</b></p> <p>Filing date: 28 September 1998</p> <p>Registration date: 4 February 2003</p>   | <p>Class 29: Fish; fresh and refrigerated shellfish, tinned shellfish, including fresh and refrigerated crab, tinned crab.</p>  |
| <p>IR No. 1102674</p>  <p>Designation date: 15 November 2011</p> <p>International registration in the UK: 2 August 2012</p> | <p>Class 29: Fresh, frozen and preserved fish and crustaceans (not live), including fresh, frozen and preserved shellfish and crabs; prepared dishes mainly consisting of fish, shellfish and/or crustaceans; sturgeon and salmon caviar.</p> <p>Class 35: Import-export of fish and/or crustaceans and of goods made from fish and/or crustaceans.</p> |

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|  | Class 43: Services for providing food and drink; bar, cafe, tea room, catering services  |
| IR No. 876349<br><br><b>CHATKA</b><br><br>International registration date: 12 January 2006<br><br>EU designate date: 12 January 2006<br>Status: Application received | Class 29: Fresh fish and shellfish, deep-frozen and preserved, including fresh crab, deep-frozen and preserved, dishes made with fish and/or shellfish.<br><br>Class 43: Services for providing food and drink, bars, cafés, tea rooms, catering services. |

3. With regard to the grounds pleaded under Section 5(4)(a), the opponent is relying on the use of the sign CHATKA throughout the UK since 2002 in relation to ‘food products, meat, processed meat, fish, tinned meat, crab meat’. It further claims that the application would constitute a misrepresentation likely to deceive the relevant public as to the origin of the goods and services resulting in damage to the opponent.

4. The applicant filed a counterstatement denying the grounds of opposition.

5. The opponent’s trademarks are earlier marks, in accordance with Section 6 of the Act and as UK TM 772051 and EU TM 943670 completed their registration procedure more than 5 years prior to the publication date of the applicant’s mark, they are subject to the proof of use conditions, as per section 6A of the Act. The opponent made a statement of use in respect of all the goods it relies on.

6. Both parties filed evidence and the opponent filed written submissions in lieu of a hearing. I make the following decision from the papers before me.

## OPPONENT'S EVIDENCE

7. The opponents submitted a witness statement from Mrs Alexandra Dalluge and Mr Christian Bühlmann ('the directors'), both directors of the opponent, and appended nine exhibits. These are summarised below:

8. Exhibit 1 comprises the case details of the marks the opponent is relying on.

9. It is said that the CHATKA brand has built up a significant reputation in the tradition, exclusivity and quality of the products sold under it and is considered to be some of the best seafood in the world. The opponent has licensed use of the CHATKA mark to Food Partners Co SA since 30 March 2010. The licensee has responsibility for manufacture and sales of CHATKA products throughout the EU. Exhibit 2 comprises undated web pages from the website of Food Partners & Co,. The web pages are bilingual (French and English) and show the CHATKA mark primarily being used on/in relation to a number of crab products, including tinned and fresh crab. Page 18 of the exhibit states that 'All Chatka products consist exclusively of king crab'. There is also some use of the mark 'Chatka Selection' on/in relation to what is described as a 'new range' offering other fish and shellfish products such as salmon, cod and shrimp. It is not clear the date from which this 'new range' was offered.

10. Exhibit 3 comprises further undated web pages from Food Partners & Co showing a selection of the opponent's products which are said to be available for purchase in the UK and EU. All of the goods are crab products bearing earlier mark IR 1102674.

11. The directors explain that CHATKA has been consistently used in the UK since at least 2002 and that products have always borne the word CHATKA. Exhibit 4 is said to show recent representative examples of packaging which have been used from 2011 – 2016. The exhibit comprises photos of tins and jars of crab all of which bear IR 1102674.

12. The directors state that products under the CHATKA brand are sold in the UK in a number of retailers and distributors. Exhibit 5 comprises web pages from three retailers including Harvey Nichols showing the opponent's tinned crab product bearing IR 1102674.

13. Exhibit 6 comprises a product guide dated 2016 from Petty Wood, who are stated to be the UK distributors for the opponent's goods. The opponent's tinned crab product bearing IR 1102674 is shown in the guide. .

14. Exhibit 8 is said to comprise invoices for UK customers dated between 2013 – 2016. Most of the invoices are addressed to the opponent's UK distributor, Petty Wood in Hampshire and are in the French language. There are also some addressed to retailers such as Fortnum and Mason. All of the products in the invoices appear to be crab products bearing the CHATKA mark; they are described as 'Crabe CHATKA...'

15. Exhibit 9 comprises invoices for EU customers dating between 2012 – 2016. These are in the French language. Most products in the invoices are described as 'CRABE CHATKA...' and therefore appear to be crab products.

16. In addition the declarants' state that the UK turnover for the opponents' goods between 2011–2016 were as follows:

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| 2011 | €12,100 |
| 2012 | €23,400 |
| 2013 | €20,400 |
| 2014 | €18,200 |
| 2015 | €15,900 |
| 2016 | €16,300 |

17. For the same time period the declarants' state that the opponent's turnover in the EU was approximately €5M equating to 550,000 products sold. No further

breakdown on the annual turnover in relation to the individual goods, for example the 'tinned crab' or 'sturgeon and salmon caviar', is provided.

## **APPLICANT'S EVIDENCE**

18. The applicants submitted a witness statement from Waheed Zafar, a director of the applicant, and appended seven exhibits. I have reviewed the evidence but there was nothing relevant within the material provided that assists me in this decision. It suffices to record here that Mr Zafar states his company operates in Pakistan selling numerous food products such as syrups, pickles and sauces and he provides examples of that use.

## **DECISION**

19. I shall deal first with the opposition based on Section 5(2)(b) of the Act which states:

"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.

20. The leading authorities which guide me are from the Court of Justice of the European Union ('CJEU'): *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.

## APPROACH

21. The opponent relies upon the four marks set out in the table at paragraph 2. The first two of those marks are subject to proof of use. The status of the fourth mark indicates that it is not yet protected. The third mark in the table is protected in the UK, is not subject to proof of use and has a broader specification than the second and fourth marks. Bearing all of this in mind, I will proceed initially on the basis of the third mark, returning to consider the other marks only if it becomes necessary to do so.

## COMPARISON OF GOODS AND SERVICES

22. The goods and services to be compared are:

| Opponent's specifications  | Applicant's specifications   |
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| <b>IR no. 1102674</b><br>Class 29: Fresh, frozen and preserved fish and crustaceans (not live), including fresh, frozen and preserved shellfish and crabs; prepared dishes mainly consisting of fish, shellfish and/or | Class 29: Bombay mix; green split peas; beans; lentils; foods made or prepared from lentils; Asian foods made or prepared from lentils; chick peas; processed fruits, fungi and vegetables (including nuts and pulses); prepared Asian savoury foodstuffs in the form of |



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| <p>crustaceans; sturgeon and salmon caviar.</p> <p>Class 35: Import-export of fish and/or crustaceans and of goods made from fish and/or crustaceans.</p> <p>Class 43: Services for providing food and drink; bar, cafe, tea room, catering services</p> | <p>snack foods; prepared meals without rice; prepared curry dishes with or without rice; snack food; Asian snack foods; prepared foodstuffs; ready cooked meals; prepared meals, snacks and desserts; chilled prepared meals; frozen prepared meals; meat; fish; poultry; game; meat extracts; preserved, dried and cooked fruits; canned fruits; jellies; eggs; milk and milk products; cheese; dairy products and dairy substitutes; yogurt products; lassi drinks; yogurt; yogurt based drinks; frozen milk products; beverages made from or containing milk, prepared milk and fruit desserts; non-alcoholic milk beverages; edible oils and fats; stocks; pickles; preserved fruits and jams; dried pulses; edible seeds; nut products for foods; processed nuts; preserved nuts; processed peanuts; roasted nuts; processed monkeynuts; canned lentils; canned fruits; canned pulses; canned beans; canned chick peas; dips; canned milk products; potato based food products; potato crisps in the form of snack foods; chips (potato); crisps; ground almonds; dried coconut; coconut desiccated; foods made from or containing any of the aforesaid goods.</p> <p>Class 30: Convenience food and savoury snacks; Asian cakes; cake</p> |
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|  | <p>preparations; cake (flavourings other than essential oils); cake pastes; cakes; cake rusk; rusks; cakes (rice-); all types of celebration cakes; cream cakes; fruit cakes; fruit cake snacks; tea cakes; madeira cake; fruit malt loaf; sponge cakes; fairy cakes; flour and preparations made from cereals; bread; bread flavoured with spices; flat bread; spiced flat bread; poppadum; indian bread and indian style bread; naan bread; chapattis; bread rolls; doughnuts; scones; buns; Asian pastries; pastries; chocolate pastries; croissants; madeleines; almond pastries; danish pastries; frozen pastry; pastry; puff pastry; puff pastry products; baking powder; frozen pastry sheets; fruit filled pastry products; pastry confectionery; fruit pastry; pastry dough; filled bread products; bakery and patisserie products; sandwiches; pies; pasties containing meat; savoury pastries; pastry based snack foods; desserts; toasted bread; french toast; tarts [sweet or savoury]; biscuits; Asian biscuits; puff finger biscuits; biscuits flavoured with fruit; biscuits [sweet or savoury]; cookies; almond cookies; coconut cookies; almond and pistachio biscuits; almond paste; almond confectionery; flavourings of almond; flavourings for snack foods [other than essential oils];</p> |
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|  | hot and cold filled rolls; confectionery; chocolates; halvah; sugar confectionery; dairy confectionery; Asian confectionery snack foods; confectionery based snack foods; popcorn; processed corn snacks; samosas; savoury sauces; cooking sauces; ready-made sauces; fruits sauces; spicy sauces; chilli sauce; curry powders; curry sauces; curry pastes; curry mixes; sauces (condiments); chutneys; turmeric for food; farinaceous foods; dried snack foods; spices; mixed spices; curry spices; baking spices; spices in the form of powders; curry [seasoning]; powders for culinary use; marinades containing herbs; marinades containing spices; spice mixes; spice mixes for prepared meals; salts, seasonings, flavourings and condiments; dried herbs; culinary herbs; cocoa; sugar; rice; tapioca; sago; ices; honey; treacle; sorbets; yeast; mustard; peppercorns; vinegar; non-medicated confectionery; pasta; noodles; prepared rice; vermicelli; food products made from rice; cereal and cereal preparations; cereal base preparations for human consumption; flakes (corn); flakes (maize); corn roasted; maize roasted; cereal based snack foods; candy [sweets]; boiled sweets; prepared savoury foodstuffs in the form of snack |
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|  | foods; prepared meals with rice; rice crisps. |
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23. In the judgment of the Court of Justice of the European Union 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, as the French and United Kingdom Governments and the Commission have pointed out, 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 uses of the respective goods or services
- b) The respective users of the respective goods or services
- c) The physical nature of the goods or acts of services
- d) The respective trade channels through which the goods or services 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 or services are competitive.

25. In *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch), Floyd J. (as he then

was) stated that:

"... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."

26. In *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another*, [2000] F.S.R. 267, Neuberger J. (as he then was) stated that:

"I should add that I see no reason to give the word "cosmetics" and "toilet preparations"... anything other than their natural meaning, subject, of course, to the normal and necessary principle that the words must be construed by reference to their context."

27. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criteria capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the General Court stated that "complementary" means:

"...there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking".

28. In *Sanco SA v OHIM*, Case T-249/11, the General Court ('GC') indicated that goods and services may be regarded as 'complementary' and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL-0-255-13:

"It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes."

Whilst on the other hand:

".....it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together."

29. In the applicant's evidence, they submit that:

"... the products range that is offered by both the companies are entirely different. CHATKA is mainly selling CRAB MEAT and other seafood products. Whereas CHATKHAAR is currently selling a range of pickles, condiments & sauces..."

30. I have not overlooked the applicant's submissions regarding the kinds of goods that they currently use their mark on, however the way in which either party currently uses their marks is irrelevant. I must compare the parties' goods on the basis of

notional and fair use of the goods listed in the parties' specifications. In *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220, Kitchen L.J. stated that:

“78. ....the court must.... consider a notional and fair use of that mark in relation to all of the goods or services in respect of which it is registered. Of course it may have become more distinctive as a result of the use which has been made of it. If so, that is a matter to be taken into account for, as the Court of Justice reiterated in *Canon* at paragraph [18], the more distinctive the earlier mark, the greater the risk of confusion. But it may not have been used at all, or it may only have been used in relation to some of the goods or services falling within the specification, and such use may have been on a small scale. In such a case the proprietor is still entitled to protection against the use of a similar sign in relation to similar goods if the use is such as to give rise to a likelihood of confusion.”

31. A number of goods in the applicant's class 29 specification are prepared meals which may contain fish, shellfish or crustaceans or they are goods which consist of fish per se or may have fish as a primary ingredient ('stocks', 'dips' for example). Accordingly, I find the following goods to be identical or at least highly similar to the opponent's 'Fresh, frozen and preserved fish' or 'prepared dishes consisting of fish, shellfish and/or crustaceans':

*Class 29: prepared Asian savoury foodstuffs in the form of snack foods; prepared meals without rice; prepared curry dishes with or without rice; snack food; Asian snack foods; prepared foodstuffs; ready cooked meals; prepared meals, snacks; chilled prepared meals; frozen prepared meals; fish; stocks; dips; foods made from or containing any of the aforesaid goods.*

32. Turning to the applicant's remaining goods, the opponent's best case appears to lie with its 'Services for providing food and drink' in class 43. The nature of goods *per se* differs to the services. Further, the respective purpose is also different. The goods are for sustenance. The purpose of the services is to provide consumers with a

convenient choice of food and drink options, at least some of which will usually be prepared to order. However, there is a degree of competition and complementarity between some of the applicant's goods and the opponent's 'Services for providing food and drink' because the consumer may choose between ordering those foods to be prepared through the opponent's services or purchasing an off-the-shelf food or drink product instead. The applicant's goods, in some cases, may also be important for or indispensable to the opponent's services in such a way that the consumer may think they come from the same undertaking<sup>1</sup>. I find there to be a medium degree of similarity between the opponent's 'services for providing food and drink' and the following goods of the applicant:

Class 29: foods made or prepared from lentils; Asian foods made or prepared from lentils; processed fruits, fungi and vegetables (including nuts and pulses); desserts; meat; poultry; game; preserved and cooked fruits; jellies; milk and milk products; dairy products and dairy substitutes; yogurt products; lassi drinks; yogurt; yogurt based drinks; frozen milk products; beverages made from or containing milk, prepared milk and fruit desserts; non-alcoholic milk beverages; preserved fruits; potato based food products; chips (potato).

Class 30: Convenience food and savoury snacks; Asian cakes; cake preparations; cakes; all types of celebration cakes; cream cakes; fruit cakes; fruit cake snacks; tea cakes; madeira cake; fruit malt loaf; sponge cakes; fairy cakes; preparations made from cereals; bread; bread flavoured with spices; flat bread; spiced flat bread; poppadum; Indian bread and Indian style bread; naan bread; chapattis; bread rolls; doughnuts; scones; buns; Asian pastries; pastries; chocolate pastries; croissants; madeleines; almond pastries; Danish pastries; frozen pastry; pastry; puff pastry; puff pastry products; fruit filled pastry products; pastry confectionery; fruit pastry; filled bread products; bakery and patisserie products; sandwiches; pies; pasties containing meat; savoury pastries; pastry based snack foods; desserts; toasted bread; French toast; tarts [sweet or savoury]; biscuits; Asian biscuits; puff finger biscuits; biscuits flavoured with fruit; biscuits [sweet or savoury]; cookies; almond cookies; coconut cookies; almond and pistachio biscuits; almond confectionery; hot and cold filled

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<sup>1</sup> In this connection, I have also borne in mind case T-562/14, paragraphs 25-28.



rolls; confectionery; chocolates; halvah; sugar confectionery; dairy confectionery; Asian confectionery snack foods; confectionery based snack foods; processed corn snacks; samosas; farinaceous foods; dried snack foods; rice; tapioca; ices; sorbets; non-medicated confectionery; pasta; noodles; prepared rice; vermicelli; food products made from rice; cereal preparations; cereal base preparations for human consumption; cereal based snack foods; candy [sweets]; prepared savoury foodstuffs in the form of snack foods; prepared meals with rice.

33. That leaves the following goods:

Class 29: Bombay mix; green split peas; beans; lentils; chick peas; meat extracts; dried fruits; canned fruits; eggs; cheese; edible oils and fats; pickles; jams; dried pulses; edible seeds; nut products for foods; processed nuts; preserved nuts; processed peanuts; roasted nuts; processed monkeynuts; canned lentils; canned fruits; canned pulses; canned beans; canned chick peas; canned milk products; potato crisps in the form of snack foods; crisps; ground almonds; dried coconut; coconut desiccated.

Class 30: cake (flavourings other than essential oils); cake pastes; cake rusk; rusks; cakes (rice-); flour; baking powder; frozen pastry sheets; pastry dough; almond paste; flavourings of almond; flavourings for snack foods [other than essential oils]; popcorn; savoury sauces; cooking sauces; ready-made sauces; fruits sauces; spicy sauces; chilli sauce; curry powders; curry sauces; curry pastes; curry mixes; sauces (condiments); chutneys; turmeric for food; spices; mixed spices; curry spices; baking spices; spices in the form of powders; curry [seasoning]; powders for culinary use; marinades containing herbs; marinades containing spices; spice mixes; spice mixes for prepared meals; salts, seasonings, flavourings and condiments; dried herbs; culinary herbs; cocoa; sugar; sago; honey; treacle; yeast; mustard; peppercorns; vinegar; cereal; flakes (corn); flakes (maize); corn roasted; maize roasted; boiled sweets; rice crisps.

34. I cannot see that any of these goods are similar to any of the opponent's goods or services. It does not seem to me that there is any real competitive or complementary relationship between these goods and the opponent's services in the

sense described in the case-law and the nature and purpose of these goods is very different to the opponent's goods. There is no similarity here.

## **AVERAGE CONSUMER AND THE PURCHASING PROCESS**

35. I must next consider the role of the average consumer and consider how the goods and services are purchased. 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*.


36. 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.”

37. The average consumer for the goods and services in this case are members of the general public. An average consumer will probably pay a low to average level of attention. The act of purchasing will be mainly visual as consumers will likely make a selection of goods from a bricks and mortar retail outlet or an online retail website, for example, and the services will also be sought by primarily by eye such as on signage outside a restaurant or café. However, I do not discount aural considerations which may also play a part.

## COMPARISON OF THE MARKS

38. The marks to be compared are:

| Opponent's marks  | Applicant's mark |
|---|------------------|
|  | <b>CHATKHAAR</b> |

39. 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 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.”

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.

40. The opponent's mark consists of the word CHATKA in a stylised font, in colour with a device of a crab and two stars. In relation to seafood goods and services relating to the same, the device of a crab is non-distinctive. In those circumstances, the distinctive word CHATKA would strongly dominate the mark. In relation to other foodstuffs and services the crab device would play a greater role in the overall impression but I still consider the word CHATKA would be more dominant given that it is that element by which the mark will be referred to. In both scenarios, the stars carry little weight in the overall impression conveyed by the mark. The applicant's mark consists of the word CHATKHAAR in plain block capitals; its overall impression is based solely on that word.

41. In a visual comparison of the marks, the first five letters of the opponent's word element and the applicant's mark, CHATK, are identical. In *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02, the General Court noted that the beginnings of word 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.

42. Although the applicant's mark is longer, an average consumer's eye will likely be drawn to the beginning of the words which are, as stated above, identical. The crab device and the stars are points of visual difference. I find there to be a medium degree of similarity when considering a visual comparison.

43. In an aural comparison the beginnings of both marks will be pronounced in the same way. It is unlikely that a consumer would vocalise any of the device elements of the opponent's mark. The ending of the opponent's mark is a single letter A and the applicant's mark ends with the letters HAAR. The pronunciation of both these endings will closely resemble each other in producing an 'ar' sound. On that basis, I find there to be high degree of aural similarity.

44. In considering the conceptual similarity, I note that both the opponent and applicant's marks consist of invented words. On the basis that the respective words do not have any immediately graspable concept<sup>2</sup>, I find them to be conceptually neutral. The stars in the opponent's mark are unlikely to form part of the conceptual hook. Insofar as the crab device is concerned, this will not create a distinctive difference where the goods/services are seafood or relate to seafood. In those circumstances, the conceptual position is therefore effectively neutral when the marks are considered as a wholes. However, I accept that where the goods/services are obviously not seafood related, the crab device creates a point of (distinctive) conceptual difference between the marks when considered as wholes.

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<sup>2</sup> It has been highlighted in numerous judgments such as *The Picasso Estate v OHIM*, Case C-361/04 that it is only concepts capable of immediate grasp by the consumer that are relevant.

## **DISTINCTIVE CHARACTER OF THE EARLIER MARK**

45. The distinctive character of the earlier mark must be considered. The more distinctive it is, either inherently or through use, the greater the likelihood of confusion (*Sabel BV v Puma AG*). In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 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).”

46. The opponent filed evidence in support of its marks in relation to the goods in class 29. However no evidence was provided in support of classes 35 or 43. Therefore I can consider enhanced distinctiveness in class 29 but only inherent distinctiveness in the other two classes.

47. Although I have said that the device of the crab will not always play a distinctive role, I remind myself that it is the distinctiveness of the common element which is

key.<sup>3</sup> More importance should therefore be placed on the distinctiveness of the CHATKA element. That is an invented word which does not describe the goods or services of the earlier mark in any way and as such has a high level of inherent distinctiveness. I accept that the opponent has used its mark in relation to crab products in the UK. This is shown by the invoices to UK addresses for crab meat and the websites prints and product brochures showing tinned crab meat etc. all bearing the mark. However, the UK sales figures are modest and there is no evidence of any marketing or promotion of the opponent's mark in the UK. Accordingly, the evidence does not suggest that the opponent's mark should be considered as having achieved enhanced distinctiveness through use for crab products.

48. There is no evidence of use of any of the other goods or services relied upon aside from the few examples of other types of seafood shown under the mark 'Chatka Selection' exhibit 2. However, this is described in the exhibit as a 'new selection'. As exhibit 2 is not dated and the directors do not state when those goods were introduced, it is not clear to me whether they were produced or sold prior to the relevant date. There is also no other use in the evidence for those types of seafood, such as invoices or anything else prior to the relevant date to satisfy me that there was use on those types of seafood prior to that date.

## **LIKELIHOOD OF CONFUSION**

49. I must now draw together my earlier findings into the global assessment of the likelihood of confusion, keeping in mind the following factors:

- a) The interdependency principle, whereby a lesser degree of similarity between the services may be offset by a greater similarity between the marks, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Meyer Inc*).
- b) The principle that the more distinctive the earlier mark is, the greater the likelihood of confusion (*Sabel BV v Puma AG*).
- c) The factor of imperfect recollection i.e. that consumers rarely have the opportunity to compare marks side by side but must rather rely on the

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<sup>3</sup> See the comments of Mr Iain Purvis QC in *Kurt Geiger v A-List Corporate Limited*, BL O-075-13.

imperfect picture that they have kept in their mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*).

50. I have found some of the contested goods to be identical or highly similar to the opponent's goods. In addition I have found others to have a medium degree of similarity with the opponent's class 43 services. With regard to the comparison of the marks, I found there to be a medium degree of visual similarity, a high degree of aural similarity and that the marks are conceptually neutral in relation to goods or services which are seafood or relate to seafood. For other goods and services, the crab device creates a point of conceptual difference. With regard to the purchasing process, I have found that there is likely to be a low to average level of attention paid. The purchase of the goods and services is likely to be mainly visual but aural considerations are borne in mind. As to the distinctiveness of the earlier mark, I have taken the view that the mark is of high distinctiveness. Taking all these factors into account, I find that there is a likelihood of confusion for the identical and highly similar goods and those which are similar to a medium degree. Even if the consumer does not mistake one mark for the other, they are, at the very least, likely to believe that the respective goods come from the same or linked undertakings.

51. As for the applicant's goods for which I found no similarity with the opponent's goods or services, there can be no likelihood of confusion and therefore the opposition under section 5(2)(b) on the basis of earlier mark 1102674 fails in relation to those.<sup>4</sup>

## **OTHER MARKS AND GROUNDS RELIED UPON**

52. In relation to the applicant's goods which have survived the 5(2)(b) ground (which I have decided on the basis of earlier mark 1102674), I have considered whether the other marks may put the opponent in any stronger position as regards those goods. However, as I indicated earlier, two of the earlier marks (772051 & 943670) are subject to proof of use and the only use shown in the evidence prior to

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<sup>4</sup> *Waterford Wedgwood plc v OHIM* – C-398/07 P (CJEU)



the relevant date is in respect of crab products. 'Crab products' (which have already been considered in relation to earlier mark 1102674) are not similar to the remaining goods of the application for reasons already explained. Further, the specification of earlier mark 876349 is largely the same as that for 1102674; the remaining goods of the applicant are not similar to those in 1103674 for reasons already explained. It follows that none of the other marks put the opponent in any stronger position under section 5(2)(b).

53. Turning to the ground under section 5(3), my earlier comments about the use shown in the evidence (although made in the context of assessing enhanced distinctiveness) show that none of the marks relied upon under that ground would get over the reputation hurdle; without reputation there can be no link or damage. Further, even if the reputation hurdle had been overcome, the opponent has not explained why, in the absence of confusion, there would be unfair advantage or why there would be detriment to the earlier marks' distinctive character. As to the argument advanced in support of detriment to reputation, this is based on the possibility of the applicant's goods being poor quality. There is no evidence before me to show that the applicant already provides poor quality goods and therefore I reject that claim as being pure conjecture. Finally, as the opponent's case under section 5(4)(a) is materially the same as that under section 5(2)(b), it cannot be in any better position under the former ground than the latter.

## **CONCLUSION**

54. The opposition succeeds under section 5(2)(b) of the Act for the following goods in classes 29 and 30:

Class 29: Foods made or prepared from lentils; Asian foods made or prepared from lentils; processed fruits, fungi and vegetables (including nuts and pulses); prepared Asian savoury foodstuffs in the form of snack foods; prepared meals without rice; prepared curry dishes with or without rice; snack food; Asian snack foods; prepared foodstuffs; ready cooked meals; prepared meals, snacks and desserts; chilled prepared meals; frozen prepared meals; meat; fish; poultry; game; preserved and cooked fruits; jellies; milk and milk products; dairy products and dairy substitutes;

yogurt products; lassi drinks; yogurt; yogurt based drinks; frozen milk products; beverages made from or containing milk, prepared milk and fruit desserts; non-alcoholic milk beverages; stocks; preserved fruits; dips; potato based food products; chips (potato); foods made from or containing any of the aforesaid goods.

Class 30: Convenience food and savoury snacks; Asian cakes; cake preparations; cakes; all types of celebration cakes; cream cakes; fruit cakes; fruit cake snacks; tea cakes; madeira cake; fruit malt loaf; sponge cakes; fairy cakes; preparations made from cereals; bread; bread flavoured with spices; flat bread; spiced flat bread; poppadum; Indian bread and Indian style bread; naan bread; chapattis; bread rolls; doughnuts; scones; buns; Asian pastries; pastries; chocolate pastries; croissants; madeleines; almond pastries; Danish pastries; frozen pastry; pastry; puff pastry; puff pastry products; fruit filled pastry products; pastry confectionery; fruit pastry; filled bread products; bakery and patisserie products; sandwiches; pies; pasties containing meat; savoury pastries; pastry based snack foods; desserts; toasted bread; French toast; tarts [sweet or savoury]; biscuits; Asian biscuits; puff finger biscuits; biscuits flavoured with fruit; biscuits [sweet or savoury]; cookies; almond cookies; coconut cookies; almond and pistachio biscuits; almond confectionery; hot and cold filled rolls; confectionery; chocolates; halvah; sugar confectionery; dairy confectionery; Asian confectionery snack foods; confectionery based snack foods; processed corn snacks; samosas; farinaceous foods; dried snack foods; rice; tapioca; ices; sorbets; non-medicated confectionery; pasta; noodles; prepared rice; vermicelli; food products made from rice; cereal preparations; cereal base preparations for human consumption; cereal based snack foods; candy [sweets]; prepared savoury foodstuffs in the form of snack foods; prepared meals with rice.

55. The opposition fails under section 5(2)(b) of the Act for the remaining goods in classes 29 and 30:

Class 29: Bombay mix; green split peas; beans; lentils; chick peas; meat extracts; dried fruits; canned fruits; eggs; cheese; edible oils and fats; pickles; jams; dried pulses; edible seeds; nut products for foods; processed nuts; preserved nuts; processed peanuts; roasted nuts; processed monkeynuts; canned lentils; canned fruits; canned pulses; canned beans; canned chick peas; canned milk products;

potato crisps in the form of snack foods; crisps; ground almonds; dried coconut; coconut desiccated.

Class 30: Cake (flavourings other than essential oils); cake pastes; cake rusk; rusks; cakes (rice-); flour; baking powder; frozen pastry sheets; pastry dough; almond paste; flavourings of almond; flavourings for snack foods [other than essential oils]; popcorn; savoury sauces; cooking sauces; ready-made sauces; fruits sauces; spicy sauces; chilli sauce; curry powders; curry sauces; curry pastes; curry mixes; sauces (condiments); chutneys; turmeric for food; spices; mixed spices; curry spices; baking spices; spices in the form of powders; curry [seasoning]; powders for culinary use; marinades containing herbs; marinades containing spices; spice mixes; spice mixes for prepared meals; salts, seasonings, flavourings and condiments; dried herbs; culinary herbs; cocoa; sugar; sago; honey; treacle; yeast; mustard; peppercorns; vinegar; cereal; flakes (corn); flakes (maize); corn roasted; maize roasted; boiled sweets; rice crisps.

## **COSTS**

56. As both parties have had a reasonable degree of success, I do not consider it appropriate to favour either party with an award of costs.

**Dated this 18<sup>th</sup> day of October 2017**

**June Ralph**

**For the Registrar**

**The Comptroller-General**