

O-084-18

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION 3204204 BY
NEW YOLK LIMITED
TO REGISTER THE FOLLOWING TRADE MARK IN CLASSES 29 & 30:**

BECS

AND

OPPOSITION THERETO (NO. 408973) BY GERARD BECH CROSA

Background and pleadings

1. New York Limited (“the applicant”) applied to register the trade mark **BECS** in the UK on 28 December 2016. It was accepted and published in the Trade Marks Journal on 10 February 2017 in respect of the following goods:

Class 29: Meat, fish, poultry and game; meat extracts; preserved, frozen, dried and cooked fruits and vegetables; jellies, jams, compotes, eggs; milk and milk products; edible oils and fats.

Class 30: Coffee, tea, cocoa and artificial coffee; rice; tapioca and sago; flour and preparations made from cereals; bread pastries and confectionery; edible ices; sugar, honey, treacle; yeast, baking-powder; salt; mustard; vinegar, sauces [condiments]; spices; ice.

2. Gerard Bech Crosa (“the opponent”) opposes the registration of the trade mark on the basis of Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). This is on the basis of his earlier European Union (formerly Community) Trade Mark 008858441 which is depicted below:



3. The mark was filed on 4 February 2010 and was registered on 27 July 2010. Given its date of filing, the opponent’s mark constitutes an earlier mark in accordance with section 6 of the Act. I note that the earlier mark was registered more than five years before the date on which the applicant’s mark was published. This means that the earlier mark is subject to the proof of use provisions contained in section 6A and would, ordinarily, mean that the opponent is required to prove that he has made genuine use of his mark, otherwise he would not be able to rely on it. The

opponent made a Statement of Use (as part of his Notice of Opposition) that the mark has been used on all of the goods (as set out below) which are relied upon.

4. The following goods are relied upon in this opposition:

Class 29: Meat, fish, poultry and game; meat extracts; pates; preserved, frozen, dried and cooked fruits and vegetables; fruit in syrup; jellies, jams, marmalades, compotes; eggs, milk and milk products; edible oils and fats; prepared and/or pre-cooked meals made from meat, fish and vegetables.

Class 30: Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery, ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar sauces (condiments); spices; ice; prepared and/or pre-cooked meals made from rice and pasta.

5. The opponent argues that the respective goods are identical or similar and that the marks are similar.

6. The applicant filed a counterstatement on 9 June 2017 denying the claims. It denies the claims with regards to the similarity of marks. It also highlighted that its mark represents the name of a sandwich it is to produce. It also states that although the opponent's condiments may complement cheese (which I take as a reference to the goods the opponent sells) they do not sell cheese per se. The significance of cheese appears to be that the sandwich the applicant intends to sell contains cheese. Despite the reference to what the opponent sells, the applicant also stated that it did not want the opponent to provide proof of use. As a result, the opponent is able to rely on all of the goods relied upon without having to prove genuine use.

7. The applicant has represented itself during the proceedings. The opponent is represented by Urquhart-Dykes & Lord LLP. Neither side filed evidence. No hearing was requested. The opponent filed written submissions in lieu of a hearing which will not be summarised but will be referred to as and where appropriate during this

decision. Although the applicant did not file written submissions, I will, of course, take the comments made in its counterstatement into account.

Section 5(2)(b)

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

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

(a).....

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

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

9. 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.

Comparison of goods

10. For ease of reference, I copy the specifications of both marks below. As can be seen, all of the applied for goods have identically worded counterparts in the specification of the earlier mark (highlighted in bold in both specifications). The goods are, therefore, identical:

Opponent's specification	Applicant's specification
<p><i>Class 29</i> Meat, fish, poultry and game; meat extracts; pates; preserved, frozen, dried and cooked fruits and vegetables; fruit in syrup; jellies, jams, marmalades, compotes; eggs, milk and milk products; edible oils and fats; prepared and/or pre-cooked meals made from meat, fish and vegetables.</p>	<p><i>Class 29</i> Meat, fish, poultry and game; meat extracts; preserved, frozen, dried and cooked fruits and vegetables; jellies, jams, compotes, eggs; milk and milk products; edible oils and fats.</p>
<p><i>Class 30</i> Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery, ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar sauces (condiments); spices; ice; prepared and/or pre-cooked meals made from rice and pasta.</p>	<p><i>Class 30</i> Coffee, tea, cocoa and artificial coffee; rice; tapioca and sago; flour and preparations made from cereals; bread pastries and confectionery; edible ices; sugar, honey, treacle; yeast, baking-powder; salt; mustard; vinegar, sauces [condiments]; spices; ice.</p>

11. In its counterstatement the applicant made a number of comments about the goods for which it may use its mark and the goods for which the opponent may be using the opponent's mark. However, given that all of the applied for goods have identical counterparts in the opponent's specification, the applicant's points are not pertinent. It is settled law that in assessing whether there is a likelihood of confusion the comparison is to be made on the basis of notional and fair use over the whole range of goods covered by the Applicant's and (since the opponent has not been required to prove use under section 6A of the Act) the Opponent's respective specifications. The applied for goods are identical to goods covered by the earlier mark. That the opponent has further terms that are not identical does not matter.

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 identical goods at issue are foodstuffs and beverages in classes 29 and 30. These are everyday consumer items that would be purchased from supermarkets and the like. The average consumer would be a member of the general public (as


outlined in the opponent's written submissions) who is likely to pay an average level of attention to the selection of the goods. It is also likely that the goods will be selected visually since these are items that would be found on the shelves of stores or their online equivalents. This does not, however, limit my overall assessment just to the visual comparison of the marks, even though the visual impact will take on more significance.

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 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. The respective trade marks are shown below:

	<p style="text-align: center;">BECS</p>
<p style="text-align: center;">Earlier trade mark</p>	<p style="text-align: center;">Contested trade mark</p>

17. The mark applied for is made up of the letters/word BECS. Therefore, this is the only thing that contributes to its overall impression. The opponent's mark, on the other hand, consists of two words "Can" or "Cam" (the stylisation introduces ambiguity in terms of which of these words will be appreciated - it will, in my view, be a roughly equal split in consumers as to which word will be perceived) and "Bech" in a stylised format. The opponent argues that Can, in its mark, will be seen as a reference to canned goods, so making Bech the dominant element. This is noted, however, the combination of Can (for those that see it that way) and Bech is an odd one and the way in which the stylisation brings those words together means, in my view, that neither word really dominates the other. Both words contribute, roughly equally, to the overall impression of the mark. The stylisation, appearing in what might be seen as the style of writing often seen on neon signs, plays less of a role than the words, but it still makes a reasonably important contribution.

18. When the marks are compared visually, the only similarity is that they both contain the letters "B", "E"/"e" and "C"/"c" (in that order); those letters represent the first three letters of the contested mark, whereas they represent the first three letters of the second word of the earlier mark. The earlier mark, however, contains much more than this in that those letters are preceded by the word "Can"/"Cam" and they have a "h" on the end as opposed to an "S". The stylisation also creates a visual difference. Having regard to the similarities and differences, and bearing in mind the marks' overall impression, I consider there to be only a low level of visual similarity.

19. The opponent submits that the second word in his mark (Bech) would be pronounced in the same way as BECS, with the latter sounding like the possessive form of the former. I consider that BECS will be articulated as a single syllable – BECKS-. In comparison, the whole of the earlier mark has a two syllable articulation. I consider that the earlier mark would be pronounced as “can” (like a can of cola) or “cam” (as in cambelt) and “beck” (with the ch being given a hard K sound). I accept, as submitted by the applicant, that some consumers may pronounce the second word slightly differently, for example, as “besch” (as in the beginning of the word ‘béchamel’)¹, but this is likely to be the exception rather than the rule. The ending of the earlier mark is highly similar to the whole of the applied for mark, but there is a noticeable difference given the extra syllable difference. I consider that this equates to a medium degree of aural similarity.

20. From a conceptual perspective, neither of the marks has an obvious meaning. The opposed mark could be perceived as an abbreviation or acronym, or even just an invented word. The earlier mark consists of the known words “can” or “cam” with the addition of the word Bech, which creates nothing meaningful as a whole. I see no material conceptual similarity or dissimilarity between the marks, the conceptual position being neutral.

Distinctive character of the earlier trade mark

21. 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*

¹ The applicant stated that it may be articulated as BETCH

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)."

22. I can only consider the inherent distinctiveness of the earlier mark since no evidence has been provided by the opponent. The mark consists of the stylised words "Can Bech" or "Cam Bech" which, as I have said, appear to have no specific significance in relation to the goods and services for which it is registered. In fact, it creates an odd combination. This is so even if it is possible that some of the goods come in cans. The mark's stylisation also adds to its distinctiveness overall, however, any added distinctiveness on this basis does not assist the opponent as the level of distinctive character is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar².

23. For the purposes of my assessment, the relevant level of distinctiveness is, in my view, slightly above average, but not of the highest degree.

² See, for example, the decision of Mr Iain Purvis Q.C., as the Appointed Person, in *Kurt Geiger v A-List Corporate Limited*, BL O-075-13,

Likelihood of Confusion

24. A global assessment of the various factors must be conducted in order to determine whether a likelihood of confusion arises (*Sabel BV v. Puma AG*, paragraph 22). There is no scientific formula in order to conduct such an assessment, all of the factors must be considered from the viewpoint of the average consumer and a judgement made as to whether those factors, considered together, would lead to a likelihood of confusion.

25. Confusion can be direct (effectively occurring when the average consumer mistakes one mark for the other) or indirect (where the average consumer realises the marks are not the same, but puts the similarity that exists between the marks/goods down to the responsible undertakings being the same or related).

26. The goods, as outlined previously, are identical. This is an important factor since a lesser degree of similarity between the marks can be offset by a greater degree of similarity between the goods. In terms of the marks, I note the opponent's submission that the earlier mark consists of the word CAN and the word BECH, so making BECH the dominant and distinctive element, an element which is similar to the applied for mark BECS. Whilst this is noted, I consider the marks themselves to be sufficiently different to avoid direct confusion. As already discussed, the earlier mark consists of two words, 'Can'/'Cam' and 'Bech' presented in a stylised manner whilst the mark under opposition consists of 'BECS' alone. Even for consumers that see Can rather than Cam, the whole mark is a slightly odd combination. Therefore, notwithstanding the concept of imperfect recollection, the average consumer will not mis-remember or mis-recall one mark for the other.

27. In terms of indirect confusion, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, explained that:

"16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on

the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: "The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right ("26 RED TESCO" would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as "LITE", "EXPRESS", "WORLDWIDE", "MINI" etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension ("FAT FACE" to "BRAT FACE" for example)."

28. Mr Purvis' three categories of indirect confusion must be borne in mind, however, they are merely illustrative (given that he said that indirect confusion "tends" to fall in one of them). They must not, therefore, be taken as a straightjacket.

29. I also bear in mind that the point of similarity (Bech and BECS) need not be identical for indirect confusion to arise, as was held by Mr Justice Arnold in *Aveda Corporation v Dabur India Ltd* [2013] EWHC 589 (Ch). However, even taking this into account, I am not satisfied that indirect confusion will arise. The combination of the

differences between the common element Bech and BECS, together with the differences between the marks overall, in circumstances where the purchasing process is primarily a visual one, would not signify a same stable product. This is so even for those consumers that saw the first word in the earlier mark as Can. Even in what I regard as the relatively unlikely event that the average consumer would perceive the earlier mark as a whole as a reference to canned Bech products, they would not assume that the goods (even the identical goods at issue) come from the same (or related) economic source. The ground under Section 5(2)(b) fails.

Conclusion

30. For the reasons outlined above, I consider that there is no likelihood of confusion, either direct or indirect. The mark may, therefore, and subject to appeal, proceed to registration.

Costs

31. The applicant wrote to the tribunal at the end of the evidence stage to say that it would not be claiming costs. Therefore, even though the applicant has succeeded, no costs award is to be made.

Dated this 2nd day of February 2018

**For the Registrar,
The Comptroller General**