

O/706/18

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION UK3318484

BY

GWA DESIGN LTD AND GORDON WILSON

TO REGISTER THE FOLLOWING SERIES OF TRADE MARKS IN CLASS 30

**'Plan B'**

**'PLAN B'**

AND

OPPOSITION THERETO (NO. 600000924)

BY

PLAN BEE LTD

## Background and Pleadings

1. GWA DESIGN LTD and GORDON WILSON (the Applicants) applied to register the series of two trade marks, shown on the cover page of this decision, on the 17 June 2018 for goods outlined in class 30 below. It was accepted and published on the 6 July 2018.

CLASS 30: Cachou [confectionery], other than for pharmaceutical purposes; Chocolate flavoured confectionery; Cocoa-based ingredients for confectionery products; Dairy confectionery; Dragees [non-medicated confectionery]; Flavoured sugar confectionery; Herbal honey lozenges [confectionery]; Low-carbohydrate confectionery; Lozenges [confectionery]; Mint flavoured confectionery (Non-medicated -); Non-medicated confectionery candy; Non-medicated confectionery for use as part of a calorie controlled diet; Non-medicated confectionery products; Orange based confectionery; Pastila [confectionery]; Pastilles [confectionery]; Peppermint pastilles [confectionery], other than for medicinal use; Sherbet [confectionery]; Snack foods consisting principally of confectionery; Sugar confectionery; Sweets (Non-medicated -) in the nature of sugar confectionery; Confectionery; Confectionery bars; Confectionery having liquid fruit fillings; Confectionery having liquid spirit fillings; Confectionery having wine fillings; Confectionery in the form of tablets; Confectionery made of sugar; Truffles (rum -) [confectionery].

2. PLAN BEE LTD (the Opponent) opposes the application by way of the Fast Track opposition procedure, under section 5(2)(b) of the Trade Marks Act 1994 (the Act), relying on its earlier UK registered trade mark PLAN BEE number UK3045853 which was filed on the 9 March 2014 and registered on the 19 September 2014, for goods and services in classes 3, 4, 5, 10, 28, 29, 30 and 32 and 33.

3. For the purposes of this opposition the Opponent is only relying on its goods in class 30, listed below, for which the mark is registered, claiming that there is a likelihood of confusion because under section 5(2)(b) the trade marks are similar and are to be registered for goods identical or similar to those for which the earlier mark is protected.

Class 30: Preparations made from cereals, bread, pastry, cakes, biscuits; confectionary; edible ices; honey; sauces; prepared meals.

4. The Applicants filed a defence and counterstatement denying the claims made, submitting that

*“The PLAN B trademark is not as claimed ‘almost identical’ to PLAN BEE.”*

*“...it is not similar according to the IPO search system.”*

5. Neither party has applied for leave to file evidence and the matter has proceeded in accordance with the Fast Track procedure. Neither party is represented. This decision is taken upon the careful perusal of the papers as filed.

## **Decision**

6. The opposition is 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”.

7. An earlier trade mark is defined in section 6 of the Act, which states:

“6. - (1) In this Act an “earlier trade mark” means –

(a) a registered trade mark, international trade mark (UK), Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

8. In these proceedings, the Opponent is relying upon its UK trade mark registration, shown above, which qualifies as an earlier mark under section 6 of the Act. As the earlier mark had been registered for less than five years at the date the application was published it is not subject to the proof of use provisions contained in section 6A of the Act. Consequently, the Opponent is entitled to rely upon all its Class 30 goods of its registration, as specified, without having to establish genuine use.

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 greater 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 to mind the earlier mark, 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.

### **Comparison of goods**

10. When conducting a goods comparison, all relevant factors should be considered as per the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon Kabushiki Kaisha v Metro Goldwyn Mayer inc* Case C-39/97, where 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”.

11. I am also guided by the relevant factors for assessing similarity identified by Jacob J in *Treat*, [1996] R.P.C. 281 namely:

- (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 service;
- (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. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

12. In addition, in *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), Floyd J 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."

13. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court ("GC") stated that:

"29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 Institut fur Lernsysteme v OHIM- Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark".

14. I note that there is an overlap between the parties' specifications within class 30 where the identical wording is used as per the table below and on the *Meric* principle. I take no issue with the misspelling of the word confectionery in the Opponent's specification for the purposes of this comparison.

<b>Applicant</b>	<b>Opponent</b>
Cachou [confectionery], other than for pharmaceutical purposes; Chocolate flavoured confectionery; Dairy confectionery; Dragees [non-medicated confectionery]; Flavoured sugar confectionery; Herbal honey lozenges [confectionery]; Low-carbohydrate confectionery; Lozenges [confectionery]; Mint flavoured confectionery (Non-medicated -); Non-medicated confectionery candy;	confectionary;



<p>Non-medicated confectionery for use as part of a calorie controlled diet;</p> <p>Non-medicated confectionery products;</p> <p>Orange based confectionery;</p> <p>Pastila [confectionery];</p> <p>Pastilles [confectionery];</p> <p>Peppermint pastilles [confectionery], other than for medicinal use;</p> <p>Sherbet [confectionery];</p> <p>Snack foods consisting principally of confectionery;</p> <p>Sugar confectionery;</p> <p>Sweets (Non-medicated -) in the nature of sugar confectionery;</p> <p>Confectionery;</p> <p>Confectionery bars;</p> <p>Confectionery having liquid fruit fillings;</p> <p>Confectionery having liquid spirit fillings;</p> <p>Confectionery having wine fillings;</p> <p>Confectionery in the form of tablets;</p> <p>Confectionery made of sugar;</p> <p>Truffles (rum -) [confectionery].</p>	
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15. In *Les Editions Albert Rene v Office for Harmonisation in the Internal Market (Trade marks and Designs)(OHIM)* – T-336/03, the General Court (“GC”) stated that:

“61.....the mere fact that a particular good is used as part, element or component of another does not suffice in itself to show that the finished goods containing those components are similar since, in particular, their nature, intended purpose and the customers for those goods may be completely different.”

16. With regard to the contested “*Cocoa-based ingredients for confectionery products*” and the Opponent’s “*confectionary*”, as per *Les Editions Albert Rene*, the fact that a particular product is used as an ingredient of another is not sufficient to show that the finished goods containing that ingredient are similar to the product in its original form because the nature, intended purpose and the customers of those goods may be very different. However, cocoa-based ingredients for confectionery products covers chocolate, which is a form of confectionery. These goods are, therefore, identical.

### **Average consumer**

17. When considering the opposing trade marks, I must determine first of all who the average consumer is for the goods and the purchasing/selection process.

18. 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.”

19. The average consumer of the goods at issue is a member of the general public who is likely to choose the goods from a shop or supermarket through self-selection or following an advertisement. The purchasing process is therefore likely to be a visual rather than an aural process although I do not discount the possibility of a sales assistant assisting in the process.

20. I consider that the average consumer would pay a low to average degree of attention in their selection process taking into account the inexpensive nature of the goods, the size, ingredients and appeal of the product.

### **Comparison of the marks**

21. 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.”

22. It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to consider 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.

23. The respective trade marks are shown below:

Applicants' Mark 1	Applicants' Mark 2	Opponent's Mark
'Plan B'	'PLAN B'	PLAN BEE

24. For the purposes of this comparison I will proceed on the basis of the second in the series of the Applicants' marks. There is no difference between the variation in the casing because a word trade mark registration protects the word itself irrespective of the font, capitalisation or otherwise. Therefore, a trade mark in capital letters covers notional use in lower case and vice versa<sup>1</sup>.

25. The Opponent's mark consists of two words "PLAN BEE" presented in block capitals in conventional font. Both words in isolation are well known to the average UK consumer. Although the mark contains two identifiable elements, in my view, neither word is more dominant than the other in the overall impression of the mark.

26. The Applicants' mark consists of the single word "PLAN" and the letter "B" presented together in conventional font, within a single quotation/speech mark. It is the word "PLAN" which is the more distinctive and dominant element in the overall impression of the mark, the letter "B" being less so. The speech marks play little or no distinctive role in the mark.

## **Visual**

27. The marks share an obvious common element in that they both begin with the word "PLAN" which is identical in both marks. The difference between the respective marks rests in the inclusion of the word "BEE" in the Opponent's mark and the letter "B" and the speech quotation marks in the Applicants' mark. Both these second elements begin with the letter B. The average consumer paying an average degree of attention may not even notice the quotation marks. I consider therefore that there is a medium degree of visual similarity between the marks.

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<sup>1</sup> *Bentley Motors Limited v Bentley 1962 Limited* BL O/159/17

## **Aural**

28. From an aural perspective the Applicants' mark comprises of the word PLAN, which is identical in both marks and which will be articulated in an identical manner. Both have a second component to their marks, namely the word "BEE" in the Opponent's and the letter "B" in the Applicants'. Despite the visual difference between the word "BEE" and the letter "B" they will be articulated in the same way. When both elements are read together they will be articulated in an identical manner in both marks and therefore there is a high degree of aural similarity between them.

## **Conceptual**

29. Conceptually the word "PLAN" in both marks is the more distinctive element as it will raise the question of what is being planned. The Applicants submit that the addition of the letter "B" with the word "PLAN" forms a unit and creates a meaning as a whole namely

*"PLAN B wording /meaning is - when PLAN A 'fails'."*

This is likely to be recognised by the average consumer as meaning an alternative approach to something or the second option.

30. In the Opponent's mark the use of the word "BEE" may be suggestive of bee-related products. When read together with the word "PLAN" some consumers may recognise a play on words which will have the same conceptual meaning as the Applicants' mark. If the play on words is recognised there will be a good degree of conceptual similarity between the marks, whilst also recognising the meaning of BEE. If not, the conceptual similarity will be medium, owing to the common element PLAN.

## **Distinctiveness**

31. The degree of distinctiveness of the earlier mark is important as this directly relates to whether there is a likelihood of confusion; the more distinctive the earlier mark the greater likelihood of confusion. As no evidence has been filed by the Opponent regarding use of its mark then the matter must be considered based on inherent characteristics.

32. 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).”

33. The earlier mark consists of the words “PLAN” and “BEE” which individually are clearly English words. The word “Bee” may be allusive to confectionery which contains honey. Overall the level of distinctive character is average.

### **Likelihood of Confusion**

34. When considering whether there is a likelihood of confusion between the two marks I must consider whether there is direct confusion, where one mark is mistaken for the other or whether there is indirect confusion where the similarities between the marks lead the consumer to believe that the respective goods originate from the same or related source.

35. In determining whether there is a likelihood of confusion there are a number of factors to bear in mind. The first is the interdependency principle i.e. a greater degree of similarity between the respective goods may be offset by a lesser degree of similarity between the respective trade marks and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the Opponent’s trade mark, the average consumer for the goods and the nature of the purchasing process. In doing so, I must consider 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 that he has retained in his mind.

36. I do not consider that there is sufficient conceptual difference between the meaning of ‘PLAN B’ and ‘PLAN BEE’ to counteract the medium visual similarity and aural identity between the marks. If the play on words is recognised, there is a good degree of conceptual similarity between them and, if the play on words is not recognised, the conceptual similarity is still medium. Factoring in the identical nature of the goods and a low to average level of attention in the purchasing process, the marks may be imperfectly recalled, causing a likelihood of confusion.

37. 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 recognised 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, 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.”

38. In case I am wrong about direct confusion, I will consider indirect confusion as explained in *L.A.Sugar*. The play on words would lead the average consumer to perceive the Applicants’ mark as a sub brand or extension of the earlier mark. There is sufficient similarity in the Applicants’ mark to give the impression that it is a variant mark used by the same undertaking or linked trade source. There is therefore a likelihood of indirect confusion.

### **Outcome**

39. The opposition under section 5(2)(b) therefore succeeds; subject to any successful appeal, the application is refused.

### **Costs**

40. The Opponent being unrepresented was invited by the Tribunal to complete and return a pro forma indicating the time spent on various activities associated with the proceedings. As the Opponent has not provided such information, I therefore make no award as a contribution towards costs of the proceedings other than to award the opposition fee of £100.

41. I order GWA Design Ltd and Gordon Wilson to pay to Plan Bee Ltd the sum of **£100**. This sum is to be paid within 14 days of the expiry of the appeal period or within 14 days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 8<sup>th</sup> day of November 2018

Leisa Davies  
For the Registrar