

**O-132-19**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. 3276615 BY  
EIRIN CORBETT**

**TO REGISTER THE TRADE MARK:**

**Gold PLUS**

**FOR GOODS IN CLASS 31**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER NO. 411728  
BY  
ALEXANDRA FRAZER**

## Background and pleadings

1) On 12 December 2017 Ms Eirin Corbett applied to register the following trade mark:

### **Gold PLUS**

The application was published for opposition purposes on 5 January 2018. Registration is sought for the following goods, all of which are opposed:

**Class 31:** *Animal feed; Animal feeds; Animal feedstuffs; Feedingstuffs for animals.*

2) The application is opposed by Ms Alexandra Frazer. The opposition was initially based upon grounds under sections 5(2)(b), 5(3), 5(4)(a) and 3(6) of the Trade Marks Act 1994 (“the Act”), UK registration No. 3269738 for the following mark (“the earlier mark”) being relied on for the purposes of Ms Frazer’s claims under sections 5(2)(b) and 5(3):

### **ALPHA GOLD**

The earlier mark is registered for the following goods, all of which are relied upon by Ms Frazer for the purposes of this opposition:

**Class 5:** Pharmaceutical and veterinary preparations; dietetic food and substances adapted for medical or veterinary use; dietary supplements for humans and animals; veterinary preparations; antibiotic food supplements for animals; dietary supplements for animals; medicated supplements for foodstuffs for animals; mineral dietary supplements for animals; protein supplements for animals; vitamin supplements for animals; dietary and nutritional supplements; pharmaceuticals, medical and veterinary preparations; sanitary preparations for medical purposes; dietetic food and substances adapted for medical or veterinary use, food for babies; dietary supplements for humans and animals; plasters, materials for dressings; disinfectants.

**Class 31:** Foodstuffs for animals; malt; food and beverages for animals; agricultural, horticultural and forestry products and grains not included in other classes, feedstuff for animals; animal feed; animal feed preparations; animal food; animal foodstuffs; animal foodstuffs consisting of soya bean products; animal foodstuffs containing air-cured hay; animal foodstuffs containing hay; animal foodstuffs derived from air-cured hay; animal foodstuffs derived from vegetable matter; animal foodstuffs in the form of nuts; animal foodstuffs in the form of pellets; animal foodstuffs in the form of pieces.

**Class 35:** Trade fairs; retail services connected with the sale of animal foodstuff; advertising, including television and radio advertising.

**Class 44:** Medical services; veterinary services; hygienic and beauty care for human beings or animals; animal healthcare services; dietary advice; dietary and nutritional guidance; dietitian services for animals.

4) The earlier mark was applied for on 10 November 2017 and its registration process was completed on 23 March 2018. The significance of these dates is that (1) Ms Frazer's mark constitutes an earlier mark in accordance with section 6 of the Act, and (2) it is not subject to the proof of use conditions contained in section 6A of the Act, its registration procedure having been completed less than five years before the publication of the Applicant's mark.

5) Ms Corbett filed a counterstatement, denying the grounds of opposition. Neither Ms Corbett nor Ms Frazer is professionally represented in these proceedings.

6) Claims made under sections 5(3), 5(4)(a) or 3(6) of the Trade Marks Act 1994 cannot be pursued in the absence of evidence. Following the filing of Ms Corbett's counterstatement Ms Frazer was informed in a letter of 7 June 2018 that a period of two months had been allowed for her to file evidence and/or submissions, and that failure to do so would result in the evidence not being admitted into the proceedings. Since Ms Frazer did not file evidence within the set period, the parties were informed in letters of 15 August 2018 that the opposition would proceed in relation to the 5(2)(b) ground only. Ms Frazer did not respond to this letter. Ms Corbett did not file

evidence in the period set for her to do so either. Neither side requested a hearing or filed written submissions in lieu of attendance at a hearing.

7) With the form TM7 which Ms Frazer submitted on 28 March 2018 she had included an affidavit sworn on 14 February 2018 in respect of an application for an interim injunction filed with the County Court in Northern Ireland in “proceedings to protect use of confidential information (trade secrets)”. Ms Frazer’s affidavit was not formally admitted into the proceedings as it was not filed in proper evidential form for the purpose of the current proceedings. The absence of any formal evidence also led to Ms Frazer’s being informed in a letter of 15 August 2018 from the Registry that her initially pleaded grounds of opposition under sections 3(6), 5(4) & 5(3) had been struck out, and that the case would proceed under section 5(2)(b) only, a ground which does not require evidence to support it.

8) On reading the file I considered that it was procedurally irregular not to have asked Ms Frazer if the affidavit was meant to be considered as formal evidence to support the grounds under sections 5(3), 5(4) and 3(6) before moving to strike out those grounds. I therefore directed that a letter be sent to Ms Frazer directing her that, if she wished to rely on grounds under sections 5(3), 5(4) and 3(6), she must confirm that she wished to file the affidavit as formal evidence and provide that affidavit under cover of a formal witness statement for these proceedings by 25 February 2019. Ms Frazer did not respond to that letter, which was sent on 11 February 2019. Accordingly, this opposition must proceed on the basis of the ground under section 5(2)(b) only, under which Ms Frazer claims that the mark applied for is similar to the earlier mark, and that the goods of the competing marks are identical or similar, so that there is a likelihood of confusion.

### **Section 5(2)(b)**

9) Section 5(2)(b) of the Act reads as follows:

“5(2) A trade mark shall not be registered if because – [...]

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark”.

10) The following principles are gleaned from the decisions of the Court of Justice of the European Union (the “CJEU”) 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:

(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.

### **Comparison of the marks**

11) 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 CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

It would be wrong, therefore, to dissect the trade marks artificially, 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.

12) The marks to be compared are shown below:

<b>The opposed mark</b>	<b>The earlier mark</b>
<b>Gold PLUS</b>	<b>ALPHA GOLD</b>

I note that the earlier mark (registration no. 3269738) is subject to the following disclaimer:

*“Registration of this mark shall not give right to the exclusive use, separately, of the words ALPHA or GOLD”*

In this regard I asked that the Registry’s letters of 11 February 2019 should draw the parties’ attention to the following two cases discussed below, and that the parties should be invited to provide submissions on these cases, if they wished. Neither side chose to file such submissions.

13) In *PACO/PACO LIFE IN COLOUR* [2000] RPC 451 the Hearing Officer observed (at paragraph 63):

“It therefore appears to me that the entry of the disclaimer should be regarded as an admission by the proprietor that—in any proceedings based upon the registration with the disclaimer—the disclaimed matter is not to be regarded as in itself distinctive of the trade origin of the proprietor's goods or services. In these circumstances, use of the disclaimed matter by another party, as a trade mark, cannot, without other similarities, be sufficient to give rise to a likelihood of confusion with the registered trade mark concerned.”

14) In *General Cigar Co Inc v Partagas y Cia SA* [2005] EWHC 1729 (Ch) Lawrence Collins J. held (at paragraph 87) that a disclaimer operates to affect the scope of protection by influencing the analysis of the likelihood of confusion and (at paragraph 89) that the decision of the Hearing Officer in *PACO/PACO LIFE IN COLOUR* had been correct.

15) Once the word GOLD as such is discounted as a point of similarity, the most that can be said in this case is that both the marks to be compared consist of two laudatory or largely laudatory words. Such a weak correlation is clearly far too general to be regarded as giving rise to any degree of similarity for the purposes of Section 5(2)(b). In the absence of any other material similarities, therefore, since the word GOLD in the earlier mark is subject to a disclaimer, its use in the opposed mark cannot be sufficient to give rise to a likelihood of confusion. Accordingly, the opposition must fail in its entirety.

16) While the above finding is, strictly speaking, all that is required, it may also be worth adding briefly that, even if I had taken full account of the word GOLD as a point of similarity to be considered in my comparison of the marks, comparing the overall impression of the marks as a whole I still would not have gone on to find a likelihood of confusion. The word GOLD is a common laudatory term of weak distinctiveness. Even where identical products are concerned, I do not consider that the average consumer, showing the normal degree of care appropriate to the selection of foodstuffs for their animals, would consider the inclusion of the word GOLD in both marks as indicating that the respective products were supplied by the



same, or related, undertakings. The distinctive character of the word is not sufficient for its inclusion in both marks to be seen as more than a coincidence.

## **Outcome**

**17) The opposition fails in its entirety.**

## **Costs**

18) Ms Corbett has been successful and would normally be entitled to a contribution towards her costs. As she is not professionally represented, at the conclusion of the evidence rounds the Tribunal invited her to indicate whether she intended to make a request for an award of costs and, if so, to complete a pro-forma giving a breakdown of her actual costs. It was made clear that if the pro-forma was not completed no costs, other than any official fees arising from the action and paid by the successful party, would be awarded. Since Ms Corbett did not respond to that invitation, and was not required to pay any official fees, no costs will be ordered.

**Dated 11 March 2019**

**Martin Boyle  
For the Registrar,  
The Comptroller-General**