

O-181-19

**TRADE MARKS ACT 1994
IN THE MATTER OF
TRADE MARK APPLICATION NO 3173888
BY BNU TEXTILES LIMITED
TO REGISTER**

CORA

**AS A TRADE MARK
IN CLASSES 30 & 32
AND OPPOSITION THERETO (UNDER NO. 408145)
BY
CORA, SOCIETE PAR ACTIONS SIMPLIFIEE A ASSOCIE UNIQUE**


Background & Pleadings

1. BNU Textiles Limited ('the applicant') applied to register the trade mark **CORA** on 11 July 2016 in classes 30 and 32. The mark was published in the Trade Marks Journal on 23 September 2016. Following publication, the applicant filed a form TM21B dated 6 April 2017 to amend its class 32 goods. As a result, the applicant's specifications for classes 30 and 32 currently stand as:

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.

Class 32: Mineral and aerated waters and other non-alcoholic beverages; fruit beverages and fruit juices; syrups and other preparations for making beverages.

2. CORA, Societe par actions simplifiee a associe unique ('the opponent') opposes the application under sections 5(1), 5(2)(a) and 5(2)(b) of the Trade Marks Act 1994 ('the Act') on the basis of its EU trade mark set out below.

EU TM 380071	Goods relied on:
 Filing Date: 3 October 1996 Registration Date: 26 February 2001	<p>Class 29: Meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies, jam; eggs, milk and other dairy products; edible oils and fats; preserves, pickles.</p> <p>Class 30: Coffee, tea, cocoa, sugar, rice, coffee substitutes; flour and preparations made from cereals; bread, biscuits, cakes, pastry and confectionery, ices; honey; pepper, vinegar, sauces; spices.</p>

	<p>Class 31: Agricultural, horticultural and forestry products and grains not included in other classes; living animals; fresh fruits and vegetables; seeds; live plants and flowers; foodstuffs for animals, malt.</p> <p>Class 32: Beer; mineral and aerated waters and other non-alcoholic drinks; syrups and other preparations for making beverages.</p>
--	---

3. The opponent claims under section 5(1) that the applied-for mark is identical to its earlier mark and has identical goods to the earlier mark. In addition, the opponent claims under section 5(2)(a) that the applied-for mark is identical to its earlier mark and has similar goods to the earlier mark and there exists a likelihood of confusion, and under section 5(2)(b) that the applied-for mark is similar to its earlier mark and has identical or similar goods to the earlier mark and there exists a likelihood of confusion.

4. The applicant filed a counterstatement in which it denied that the marks were identical or confusingly similar but accepted there were ‘some similarities’ between its goods and the opponent’s goods.

5. The opponent’s above-mentioned trade mark has a filing date that is earlier than the filing date of the application and, therefore, it is an earlier mark, in accordance with Section 6 of the Act. As the registration was completed more than 5 years prior to the publication date of the contested application, it is subject to the proof of use conditions, as per section 6A of the Act. The opponent made a statement of use in respect of the goods it relies on¹. In section 7 of its form TM8, the applicant stated that it wanted the opponent to provide proof of use only in classes 30 and 32.

¹ There was a discrepancy on the form TM7 between the goods listed in Q1 for class 30 and 32 and the goods for which use was claimed as listed in Q3 i.e. there were fewer goods listed in Q3. Despite a wider range of goods listed in Q1 for these classes, the opponent may only rely on those goods for which it has provided a statement of use.

6. The applicant represents itself in these proceedings and the opponent is represented by Clarke Willmott LLP.


7. No hearing was requested. Only the opponent filed evidence and written submissions in lieu. I make this decision following a careful consideration of the material before me.

Opponent's evidence

8. The opponent supplied a witness statement in the name of its legal manager, Solenn Cadoret, and included 79 exhibits. Notable points from Ms Cadoret's witness statement are that:

- The earlier mark has been used since the 1960s.
- The opponent has 'bricks & mortar' retail premises in France, Belgium, Luxembourg and Romania from which its goods are sold.
- In the period between September 2011 and September 2016 ('the relevant period'), the declarant states that the opponent's annual turnover is at least €4.5 billion p.a.

9. I have reviewed the exhibits and note that the mark appearing on the goods is in

the following form: . For the sake of illustration, I have selected a biscuit product below to more clearly show the mark in situ:



10. Exhibit SC1 comprises screenshots from the opponent's website, coradrive.fr, dated 11/9/18, indicating a current range of foodstuffs bearing the mark set out above. However, this exhibit falls outside the relevant period.

11. Exhibits SC2 to SC12 comprise schematic drawings for packaging and labels for various products namely milk, eggs, tea, pepper, parsley, oregano, paprika, ground and espresso coffee dated between 2014 and 2015. The drawings contain the mark outlined above.

12. Exhibit SC13 comprises screenshots of the opponent's Romanian Facebook pages dated 11/9/18 which show the mark set out above. However, this exhibit falls outside the relevant period

13. Exhibit SC14 comprises a screenshot from the opponent's French Twitter feed dated 11/9/18. However, this exhibit falls outside the relevant period.

14. Exhibits SC15-SC79 all comprise product catalogues dated between 2011 and 2015 issued by the opponent for its French, Belgian and Romanian retail stores. The catalogues feature the opponent's own products and third-party products. There are many examples of the opponent's claimed goods for classes 30 and 32, namely mineral water, energy drinks, cola beverages, fruit syrup (for beverages), fruit juice, cereal bars, cereals, pretzels, biscuits, flour, yeast, rice, pasta, sauces, desserts, confectionery, cakes, ice cream, ices, sugar, bread, vinegar, condiments, honey, cocoa, coffee and tea.

15. That concludes my summary of the evidence.

Proof of use

16. The first issue is whether, or to what extent, the opponent has shown genuine use of the earlier mark. The relevant statutory provisions are as follows:

“Raising of relative grounds in opposition proceedings in case of non-use

6A. - (1) This section applies where -

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if -

(a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes -

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5) In relation to a European Union trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Union.

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.”

17. Section 100 of the Act is also relevant, which reads:

“100. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it”.

18. In *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*, [2016] EWHC 52, Arnold J. summarised the case law on genuine use of trade marks. He said:

“217. *The law with respect to genuine use* . In *Stichting BDO v BDO Unibank Inc* [2013] EWHC 418 (Ch), [2013] FSR 35 I set out at [51] a helpful summary by Anna Carboni sitting as the Appointed Person in *SANT AMBROEUS Trade Mark* [2010] RPC 28 at [42] of the jurisprudence of the CJEU in Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439 , Case C-259/02 *La Mer Technology Inc v Laboratoires Goemar SA* [2004] ECR I-1159 and Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759 (to which I added references to Case C-416/04 *P Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237). I also referred at [52] to the judgment of the CJEU in Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16 on the question of the territorial extent of the use. Since then the CJEU has issued a reasoned Order in Case C-141/13 *P Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and that Order has been persuasively analysed by

Professor Ruth Annand sitting as the Appointed Person in *SdS InvestCorp AG v Memory Opticians Ltd* (O/528/15).

218. An important preliminary point to which Prof Annand draws attention in her decision is that, whereas the English versions of Articles 10(1) and 12(1) of the Directive and Articles 15(1) and 51(1)(a) of the Regulation use the word “genuine”, other language versions use words which convey a somewhat different connotation: for example, “ernsthaft” (German), “efectivo” (Spanish), “sérieux” (French), “effettivo” (Italian), “normaal” (Dutch) and “sério/séria” (Portuguese). As the Court of Justice noted in *Ansul* at [35], there is a similar difference in language in what is now recital (9) of the Directive.

219. I would now summarise the principles for the assessment of whether there has been genuine use of a trade mark established by the case law of the Court of Justice, which also includes Case C-442/07 *Verein Radetzky-Orden v Bundesvereinigung Kameradschaft 'Feldmarschall Radetzky'* [2008] ECR I-9223 and Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR 7, as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor.

Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

19. As the opponent’s trade mark is an EUTM, the comments of the CJEU in *Leno Merken BV v Hagelkruis Beheer BV*, Case C149/11, are relevant. It noted that:

“36. It should, however, be observed that [...] the territorial scope of the use is not a separate condition for genuine use but one of the factors determining genuine use, which must be included in the overall analysis and examined at the same time as other such factors. In that regard, the phrase ‘in the Community’ is intended to define the geographical market serving as the reference point for all consideration of whether a Community trade mark has been put to genuine use”.

And

“50. Whilst there is admittedly some justification for thinking that a Community trade mark should – because it enjoys more extensive territorial protection than a national trade mark – be used in a larger area than the territory of a single Member State in order for the use to be regarded as ‘genuine use’, it cannot be ruled out that, in certain circumstances, the market for the goods or services for which a Community trade mark has been registered is in fact restricted to the territory of a single Member State. In such a case, use of the Community trade mark on that territory might satisfy the conditions both for genuine use of a Community trade mark and for genuine use of a national trade mark”.

And

“55. Since the assessment of whether the use of the trade mark is genuine is carried out by reference to all the facts and circumstances relevant to

establishing whether the commercial exploitation of the mark serves to create or maintain market shares for the goods or services for which it was registered, it is impossible to determine a priori, and in the abstract, what territorial scope should be chosen in order to determine whether the use of the mark is genuine or not. A *de minimis* rule, which would not allow the national court to appraise all the circumstances of the dispute before it, cannot therefore be laid down (see, by analogy, the order in *La Mer Technology*, paragraphs 25 and 27, and the judgment in *Sunrider v OHIM*, paragraphs 72 and 77)".

20. The Court held that,

"Article 15(1) of Regulation No 207/2009 of 26 February 2009 on the Community trade mark must be interpreted as meaning that the territorial borders of the Member States should be disregarded in the assessment of whether a trade mark has been put to 'genuine use in the Community' within the meaning of that provision.

A Community trade mark is put to 'genuine use' within the meaning of Article 15(1) of Regulation No 207/2009 when it is used in accordance with its essential function and for the purpose of maintaining or creating market share within the European Community for the goods or services covered by it. It is for the referring court to assess whether the conditions are met in the main proceedings, taking account of all the relevant facts and circumstances, including the characteristics of the market concerned, the nature of the goods or services protected by the trade mark and the territorial extent and the scale of the use as well as its frequency and regularity".

21. In *London Taxi*, Arnold J. reviewed the case law since the *Leno* case and concluded as follows:

"228. Since the decision of the Court of Justice in *Leno* there have been a number of decisions of OHIM Boards of Appeal, the General Court and national courts with respect to the question of the geographical extent of the

use required for genuine use in the Community. It does not seem to me that a clear picture has yet emerged as to how the broad principles laid down in *Leno* are to be applied. It is sufficient for present purposes to refer by way of illustration to two cases which I am aware have attracted comment.

229. In Case T-278/13 *Now Wireless Ltd v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* the General Court upheld at [47] the finding of the Board of Appeal that there had been genuine use of the contested mark in relation to the services in issues in London and the Thames Valley. On that basis, the General Court dismissed the applicant's challenge to the Board of Appeal's conclusion that there had been genuine use of the mark in the Community. At first blush, this appears to be a decision to the effect that use in rather less than the whole of one Member State is sufficient to constitute genuine use in the Community. On closer examination, however, it appears that the applicant's argument was not that use within London and the Thames Valley was not sufficient to constitute genuine use in the Community, but rather that the Board of Appeal was wrong to find that the mark had been used in those areas, and that it should have found that the mark had only been used in parts of London: see [42] and [54]-[58]. This stance may have been due to the fact that the applicant was based in Guildford, and thus a finding which still left open the possibility of conversion of the Community trade mark to a national trade mark may not have sufficed for its purposes.

230. In *The Sofa Workshop Ltd v Sofaworks Ltd* [2015] EWHC 1773 (IPEC), [2015] ETMR 37 at [25] His Honour Judge Hacon interpreted *Leno* as establishing that "genuine use in the Community will in general require use in more than one Member State" but "an exception to that general requirement arises where the market for the relevant goods or services is restricted to the territory of a single Member State". On this basis, he went on to hold at [33][40] that extensive use of the trade mark in the UK, and one sale in Denmark, was not sufficient to amount to genuine use in the Community. As I understand it, this decision is presently under appeal and it would therefore be inappropriate for me to comment on the merits of the decision. All I will say is

that, while I find the thrust of Judge Hacon's analysis of *Leno* persuasive, I would not myself express the applicable principles in terms of a general rule and an exception to that general rule. Rather, I would prefer to say that the assessment is a multi-factorial one which includes the geographical extent of the use”.


22. The General Court restated its interpretation of *Leno Marken* in Case T-398/13, *TVR Automotive Ltd v OHIM* (see paragraph 57 of the judgment). This case concerned national (rather than local) use of what was then known as a Community trade mark (now a European Union trade mark). Consequently, in trade mark opposition and cancellation proceedings the registrar continues to entertain the possibility that use of an EUTM in an area of the Union corresponding to the territory of one Member State may be sufficient to constitute genuine use of an EUTM. This applies even where there are no special factors, such as the market for the goods/services being limited to that area of the Union.

23. Whether the use shown is sufficient for this purpose will depend on whether there has been real commercial exploitation of the EUTM, in the course of trade, sufficient to create or maintain a market for the goods at issue in the Union during the relevant 5-year period. In making the required assessment I am required to consider all relevant factors, including:

- i) The scale and frequency of the use shown
- ii) The nature of the use shown
- iii) The goods and services for which use has been shown
- iv) The nature of those goods/services and the market(s) for them
- iv) The geographical extent of the use shown.

24. The applicant has made no submissions regarding the opponent's evidence of use.

Form of the mark

25. As noted above in paragraph 9, the mark which has been used on the goods is in this form, , compared to **CORA** which is the registered earlier mark. However, s.6A(4)(a) enables an opponent to rely on use of a mark “in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered. In *Nirvana Trade Mark*, BL O/262/06, Mr Richard Arnold Q.C. (as he then was) as the Appointed Person summarised the test under s. 46(2) of the Act (which is analogous to s. 6A(4)(a)) as follows:

“33. [...] The first question [in a case of this kind] is what sign was presented as the trade mark on the goods and in the marketing materials during the relevant period...

34. The second question is whether that sign differs from the registered trade mark in elements which do not alter the latter’s distinctive character. As can be seen from the discussion above, this second question breaks down in the sub-questions, (a) what is the distinctive character of the registered trade mark, (b) what are the differences between the mark used and the registered trade mark and (c) do the differences identified in (b) alter the distinctive character identified in (a)? An affirmative answer to the second question does not depend upon the average consumer not registering the differences at all”.

26. In terms of the registered mark’s distinctive character, it consists of the slightly stylised word **CORA** in capitals with a longer descending tail coming from the letter R. There are no other distinctive stylistic aspects to the mark. The mark used on the goods consists of the word “cora” presented in lower case letters and in colour on a contrasting white oval shaped background. I do not consider that the use of the word in colour on a white oval background has any material effect on the distinctive character of the trade mark, the effect being merely that the white background provides a contrast against which the word may be read. Further, the particular presentation of the letters is unremarkable as is the oval shape and I do not consider that the distinctive character of the registered mark is altered. The difference in

casing is similarly an insignificant adaptation². Overall I find that the use shown is use of the mark in a form which does not alter the distinctive character of the mark as registered, upon which the opponent is entitled to rely.

Sufficiency of use

27. Firstly there is no evidence of use in the UK, however, it is clear from the case law that this is not a pre-requisite. A figure of €4.5 billion p.a. was stated as the opponent's annual turnover for sales in France, Belgium, Luxembourg and Romania for the relevant 5-year period prior to the publication of the later mark, i.e. 23 September 2011 to 23 September 2016. However, I note that the turnover figures relate to the opponent's business as a whole and are not broken down into turnover figures relating to the contested goods. Although the opponent did not state any figures for advertising expenditure during the relevant period, it produced significant evidence of advertising by means of its product catalogues. Taking all these factors into account I am satisfied that there has been genuine use of the mark in the EU.

Fair specification

28. The next stage is to decide whether the opponent's use entitles it to rely on the goods it claimed in classes 30 and 32. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law as being:

“In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”

² In *Dreamersclub Ltd v KTS Group Ltd*, BL O/091/19, Mr Philip Johnson, as the Appointed Person, found that the use of a stylised mark qualified as use of the registered word-only mark. This was because the stylisation of the word did not alter the distinctive character of the word mark. Rather, it constituted an expression of the registered word mark in normal and fair use

29. The evidence demonstrates that the opponent has used its mark on the following goods in class 30, namely *Coffee, tea, cocoa, sugar, rice, coffee substitutes; flour and preparations made from cereals; bread, biscuits, cakes, pastry and confectionery, ices; honey; yeast, pepper, vinegar, sauces; spices*. In addition, the evidence demonstrated use on *mineral and aerated waters and other non-alcoholic drinks; syrups and other preparations for making beverages* in class 32. Although the opponent was only put to proof of use for class 30 and 32, I should point out that it can also rely on the goods claimed for the other two classes not put to proof of use, namely 29 and 31.

30. With regard to *Beer* which the opponent claimed in class 32, the evidence does not demonstrate that the earlier mark had been used on beer . In exhibit SC73 a beer product was circled, but it is branded as 'Volsberg' and it is not apparent that the earlier mark was applied to the goods.

Sections 5(1) and 5(2)

30. Sections 5(1) and 5(2) of the Act are as follows:

“5(1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods and services for which the trade mark is applied for are identical with the goods and services for which the earlier trade mark is protected.

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

- (a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the 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”.
- (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”.

31. 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.

Identity of the marks

32. The marks to be compared are:

Opponent's mark	Applicant's mark
CORA	CORA

33. In its written submissions dated 13/9/2018, the opponent contends that,

“The sign is the word CORA. The earlier mark consists of the word CORA in a standard typeface with minor stylisation in respect of the ‘tail’ on the diagonal line of the letter ‘R’. The stylised typeface is so insignificant that, when viewed as a whole it would go unnoticed by the average consumer. The earlier mark is therefore identical to the sign”.

34. Whereas the applicant, in its counterstatement, contends that,

“although it used a plain black font, the earlier mark is clearly not a standard word mark. It is a figurative mark with a stylised font highlighted by the elongated letter ‘R’. It is trite law that figurative marks, even when using lightly stylised fonts, cannot be identical to a word mark”.

35. I am guided on the matter of identity from *S.A. Société LTJ Diffusion v. Sadas Vertbaudet SA*, Case C-291/00, in which the CJEU held that:

“54... a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer.”

36. Both sides have drawn my attention to the letter ‘R’ in the opponent’s mark. When viewed overall, the applicant has a word mark whilst the opponent’s mark has a word mark which contains some very slight differences in the letter ‘R’. In my view, those differences are ‘so insignificant that they may go unnoticed by an average consumer’ as per the *Sadas* guidance.

37. Even if I am wrong in this matter, then I find that the marks are visually similar to the highest degree and aurally and conceptually identical.

Comparison of the goods

38. I must now compare the goods of the parties. In the judgment of the CJEU 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”.

39. 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 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.

40. I am also guided by *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, in which the 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 für 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”.

41. The goods to be compared are:

Opponent's goods	Applicant's goods
Class 29: Meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies, jam; eggs, milk and other dairy products; edible oils and fats; preserves, pickles.	
Class 30: Coffee, tea, cocoa, sugar, rice, coffee substitutes; flour and preparations made from cereals; bread, biscuits, cakes, pastry and confectionery, ices; honey; yeast, pepper, vinegar, sauces; spices	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.
Class 31: Agricultural, horticultural and forestry products and grains not included in other classes; living animals; fresh fruits and vegetables; seeds; live plants and flowers; foodstuffs for animals, malt.	
Class 32: Mineral and aerated waters and other non-alcoholic drinks; syrups and other preparations for making beverages.	Class 32: Mineral and aerated waters and other non-alcoholic beverages; fruit beverages and fruit juices; syrups and

	other preparations for making beverages
--	---

42. It is self-evident that the following goods are identical in both parties' specifications in class 30, namely *Coffee, tea, cocoa, sugar, rice, flour and preparations made from cereals; bread, pastry and confectionery, ices; honey, yeast, vinegar; spices* and *Mineral and aerated waters and other non-alcoholic drinks; syrups and other preparations for making beverages* in class 32.

43. Of the remaining goods, I find that *coffee substitutes* in the opponent's class 30 specification and *artificial coffee* in the applicant's specification are merely different ways of describing the same goods, therefore they are identical.

44. With regard to the term *Sauces* in the opponent's specification, this will cover all sauces and so will include *mustard* and *Sauces (condiments)* in the applicant's class 30 specification. As such these goods are considered identical on the *Meric* principle.

45. With regard to *tapioca* and *sago* in the applicant's class 30 specification, I consider these goods to be highly similar to *flour and preparations made from cereals* as both are starchy products, are usually ground and can be used in baking or cooking. The products have a similar nature, a similar purpose and method of use. They will be sold through the same channels, most likely in the same aisle of a retail establishment and have a competitive relationship.

46. With regard to *treacle* in the applicant's class 30 specification, I consider this to be reasonably similar to *honey* in the opponent's specification. Both are viscous substances and used as a way of adding sweetness to a dish so have a similar nature and purpose. In addition, both goods will be sold through the same channels, most likely in the same aisle of a retail establishment and will have a competitive relationship.

47. With regard to *baking-powder* in the applicant's class 30 specification, I consider this to be reasonably similar to *yeast* in the opponent's specification. Both are raising

agents for using in cooking or baking so they have a similar purpose. In addition, both goods will be sold through the same channels, most likely in the same aisle of a retail establishment .

48. With regard to *salt* in the applicant's class 30 specification, I consider this to be similar to a low degree to *spices* in the opponent's specification. Although salt is a mineral, it is used along with spices to season and enhance the flavour of foods so shares a similar purpose.

49. This just leaves the term *ice* in class 30 of the applicant's specification. I can see no similarity between these goods and any of the opponent's goods. *Ice* does not share a similar nature or purpose with the opponent's goods in class 30 nor in any of the opponent's other classes and does not have a competitive relationship with the opponent's goods. Although ice is considered a foodstuff and likely to be sold in the same retail establishments as other foods, this overlap is too general for similarity to occur. Where there is no similarity at all, there is no likelihood of confusion to be considered for these goods.³

50. With regard to *fruit beverages and fruit juices* in the applicant's class 32 specification, these will be covered by the broader term *other non-alcoholic drinks* in the opponent's specification and as such are considered identical on the *Meric* principle.

Average consumer and the purchasing process

51. I now consider who the average consumer for the contested goods is and how the goods 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 in question: *Lloyd Schuhfabrik Meyer, Case C-342/97*.

³ *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA (paragraph 49)

52. 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.”

53. The average consumer of the contested goods in this case is a member of the general public who is likely to make their selection visually from the shelves of a supermarkets (or online equivalent) or product catalogue, although I do not discount an aural aspect to purchasing, say through seeking advice from a sales assistant or by word of mouth recommendations. The goods in question here are generally low cost grocery items and are likely to be purchased reasonably frequently. As such the degree of care and attention paid to the purchase is likely to be fairly low.

Distinctiveness of the earlier mark

54. The distinctiveness of the earlier mark must be considered. 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).”

55. Distinctiveness can be enhanced through use of the mark. Although the opponent has not made a specific claim of enhanced distinctiveness, it has filed evidence of use. For the purposes of this assessment, the relevant market to which I must have regard is the UK market⁴. There is no evidence of sales to the UK. Any evidence of use is confined to other European Union member states. On the basis of the evidence filed, I am unable to determine that the earlier mark has an enhanced distinctive character in relation to the goods at issue.

56. In view of the above, I have only the inherent position to consider. The earlier mark consists of an ordinary word which is likely to be seen as a female forename. It does not describe the goods for which it is registered. As such I find it has an average level of inherent distinctiveness.

Likelihood of confusion

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

⁴ On the irrelevance of a reputation in continental Europe when assessing enhanced distinctiveness for the purposes of Section 5(2), see the comments of Iain Purvis QC, sitting as the Appointed Person, in *China Construction Bank Corporation v Groupement des cartes bancaires* (BL O/281/14) at [30]-[34].

- a) The interdependency principle, whereby a lesser degree of similarity between the goods 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 imperfect picture that they have kept in their mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*).

58. So far, I found the earlier mark to be of average inherent distinctiveness. I also found that the average consumer will be purchasing goods by a primarily visual means, although an aural aspect is not discounted, and will be paying a low degree of attention. Additionally, I have found that the marks are identical and I have identified a number of identical goods. The opposition succeeds under section 5(1) for these goods.

59. With regard to those goods I found to be similar and having weighed up all the relevant factors, in particular my finding that the marks are identical, and that a fairly low degree of attention is likely to be paid during the purchase, I conclude that there is a likelihood of direct confusion under section 5(2)(a) in respect of those similar goods in classes 30 and 32.

60. Even if I am wrong with regard to the identity of the marks, I find there would still be confusion under section 5(2)(b), given the highly similar marks and closeness between the contested goods.

Conclusion

61. The opposition succeeds for the most part, and subject to any successful appeal against my decision, the application is refused for all goods in class 32 and for the following goods in class 30 namely *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.*

62. The opposition does not succeed for *ice* in class 30.

Costs

63. As the opponent has been largely successful, it is entitled to a contribution towards the costs incurred in these proceedings. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 2/2016. Using the guidance in TPN2/2016 and bearing in mind the degree of the opponent's success, I make the following award:

£100	Official fee for filing the Notice of Opposition
£200	Preparing the Notice of Opposition
£700	Preparing evidence
£300	Preparing written submissions
£1300	Total

59. I order BNU Textiles Limited to pay CORA, Societe par actions simplifiee a associe unique the sum of £1300. 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.

4th April 2019

June Ralph
For the Registrar,
The Comptroller General