

BL O/532/19

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION 3284916

BY

PARLE PRODUCTS PRIVATE LIMITED

TO REGISTER THE FOLLOWING TRADE MARK:

MURANO

IN CLASS 30

AND

OPPOSITION THERETO (NO. 412795)

BY

MERANO SPECK GMBH

Background and pleadings

1. Parle Products Private Limited, (hereafter “the applicant”) applied to register the trade mark:

MURANO

in the UK on 24 January 2018. It was accepted and published in the Trade Marks Journal on 09 March 2018, for the following goods:

Class 30: Biscuits; cookies; cream biscuits; crackers; malt biscuits; chocolates; cakes; candy; confectionery; sugar confectionery; rusk; waffles.

2. Merano Speck GmbH (“the opponent”) opposes the trade mark on the basis of Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”).
3. The opposition is based on earlier European Union Trade Mark (EUTM) no. 15083471 which was filed on 05 February 2016 and registered on 20 June 2016, in classes 29 and 30; for the mark:



4. The opponent relies only on the goods registered in class 30 of the earlier mark, namely:

Class 30: Mustard; Sauces (condiments); Spices; Pasta and noodles.

5. Given the date of registration, the opponent's mark qualifies as an earlier mark in accordance with section 6 of the Act.
6. In its statement of grounds, the opponent claims that the signs at issue are highly similar for the following reasons:
 - The beginnings of the marks are very similar, and it is the first element of a mark to which the consumer attaches most importance.
 - The words 'MURANO' and 'MERANO' are very close phonetically. The words 'MERANO' and 'Speck' dominate the earlier mark but the word 'MERANO' is much larger than the word 'Speck', so is the most highlighted element of the mark.
 - Visually the marks are very similar, with only one letter different between the words 'MURANO' and 'MERANO'.
 - The marks are conceptually similar to an average degree, as the average British consumer will view both words as fantasy words and will not give either word a particular meaning.
 - The goods at issue are similar and all fall within class 30 of the Nice Classification. The earlier mark enjoys protection for pasta and noodles; the contested goods include biscuits; cookies; cream biscuits; crackers; malt cookies; cakes; rusks; waffles. These goods are similar as they are comprised of a base dough (raw material) like pasta.
 - Pasta is also the raw base material for noodles. The term pasta includes, as an umbrella term, products which consist of dough and as such, there is a strong similarity between the goods at issue.
7. In its counterstatement the applicant claims that the marks are visually, conceptually and phonetically different for the following reasons:

- The opponent has concentrated on the first word in the earlier mark 'MERANO', ignoring the contrast between the marks as a whole. The earlier mark is comprised of 23 letters whilst the contested mark contains only six letters. When taken as a whole, the marks do not sound similar.
- Visually the marks are different due to the logo elements in the earlier mark, the bold colours and the inclusion of an ellipse.
- Conceptually the opponent has argued that the relevant British consumer will not understand 'MURANO' or 'MERANO' and claims that they are both fantasy words. This assertion is denied. The applicant believes that the average consumer will see 'MURANO' and think of the small series of islands in the Venetian lagoon famous for manufacturing glass and objects of glass. The same public will also know that 'MERANO' is the name of a small Alpine town. Therefore, the conceptual meanings of these words are quite different.
- The goods at issue are not similar. It is denied that the earlier 'pasta and noodles' are similar to 'biscuits; cookies; cream biscuits; crackers; malt biscuits; cakes; rusks; waffles'. Whilst some of these goods may be made using dough; cakes and waffles are not. For the other goods, it is not accepted that they would be made from the same type of dough as pasta.
- The opponent's claim that the term 'pasta' encompasses 'pasta dough' i.e. a raw dough used to make pasta is denied. Pasta is the made and completed product. In this regard the applicant argues, as an illustration, that 'bread' as a term does not cover 'bread dough' or the ingredients that go into making the dough.
- The contested goods serve different purposes to the earlier pasta and noodles, they are used for different things and are bought in different shops or at least in different areas of shops. The goods at issue are therefore neither complementary nor in competition.

- The opponent has made no mention in submissions or evidence, of the contested goods ‘chocolates; candy; confectionery; sugar confectionery’ other than when opposing all of the applied for goods in the TM7. No reason or explanation has been given as to why the opponent thinks these goods are similar to those in the earlier mark.
8. Both parties filed written submissions and evidence. I will not summarise that information here, but will refer to it later in my decision, where necessary.
 9. A hearing to determine the claim was requested and took place before me on 20 August 2019.
 10. Throughout the proceedings the applicant has been professionally represented by Swindell & Pearson Limited, whilst the opponent has been professionally represented by Jens Nebels. At the hearing the applicant was represented by Mr Taylor of Swindell & Pearson Limited. The opponent was represented by Mr Nebels.

Decision

Section 5(2)(b) of the Act

11. Section 5(2)(b) of the Act is as follows:

“(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.”

12. The following principles are gleaned from the decisions of 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.

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 and services

13. In the judgment of the Court of Justice of the European Union in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary”.

14. 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.

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

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

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

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

Whilst on the other hand:

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

17. As part of my introductory comments at the start of the hearing, I confirmed with Mr Nebel that the opponent's earlier goods in class 29 had not been pleaded in the TM7, and therefore formed no part of the opposition. I also asked Mr Nebel to clarify the scope of opposition in respect of the contested class 30 goods. I asked for this clarification because whilst the opposition had been raised against all of the goods applied for in the later mark, no subsequent arguments had been made in written submissions or evidence, in respect of the applied for 'chocolates; candy; confectionery; sugar confectionery'. Mr Nebel conceded that those particular goods of the applicant were dissimilar to all of the opponent's earlier goods and, as such, need not form part of the goods comparison.

18. The opposition therefore fails in respect of the 'chocolates; candy; confectionery; sugar confectionery' of the application.

19. Following the concession from Mr Nebel, the goods to be compared are:

Opponent's goods	Contested goods
Class 30: Mustard; Sauces (condiments); Spices; Pasta and noodles.	Class 30: Biscuits; cookies; cream biscuits; crackers; malt biscuits; cakes; rusk; waffles.

20. Mr Nebel made no submissions regarding his clients' earlier 'Mustard; Sauces (condiments); Spices'. These goods are all products that are added to a meal in order to provide extra flavour. These goods do not share nature or intended purpose with any of the contested goods. Whilst they may be sold in the same retail establishment, they will not be placed in same area of that shop, supermarket etc. They are neither complementary nor in competition with one another. These goods are dissimilar.

21. In written submissions, and before me at the hearing, Mr Nebel stated that the earlier 'pasta and noodles' and the contested goods, are similar because they are all foodstuffs and could be considered to be snack foods. He added that they will be provided to the same end-user and found within the same retail environments.

22. Mr Nebel told me that pasta is similar to the contested goods due to the fact that these goods are all made from dough. Mr Nebel also suggested that the term 'pasta' encompassed the goods 'pasta dough' which would be similar to e.g. biscuits as biscuits are created from dough. He added that the EUIPO goods comparison database lists 'biscuits' as being similar to 'frozen dough' and 'pastry dough'. This, he felt, supported his argument that biscuits and pasta dough should be found similar. The earlier goods 'noodles' are goods made from pasta dough and are therefore equally similar to the contested goods.

23. Mr Nebel stated that bakery goods, which he considered the contested goods to be, could be both sweet or savoury and could potentially be used as a replacement for a meal. As an example, Mr Nebel suggested that crackers, combined with other food products such as ham, might be a suitable alternative to a pasta dish; and that a cake might act as a dessert following a main meal that included pasta or noodles.

24. Mr Taylor told me that the earlier 'pasta' was a product which required heating or cooking before it could be consumed. This he added, was not the case with any of the contested goods. Mr Taylor agreed that the contested goods could be considered to be snack foods but denied that pasta and noodles fell into the same category, as they required preparation before consumption, unlike e.g. a biscuit or a cracker. He added that pasta or noodles would generally be combined with an additional element such as a sauce, in order to create a finished meal, whereas the contested goods were all products that could be eaten as a snack food without the need to combine them with another foodstuff in order to be enjoyed.
25. Mr Taylor told me that he had conducted some investigation into the placement of pasta/noodles on the one hand, and biscuits, cookies etc on the other, within three different supermarkets. In each retail establishment he noted that the goods at issue were always placed in different aisles and generally in very different sections of the supermarket.
26. In Case T-736/14, *Monster Energy Company v OHIM*, the General Court upheld the finding of the OHIM Board of Appeal that there was no similarity between coffee-based beverages and confectionary/sweets. The court rejected the Appellant's argument that similarity was established by the fact the goods were sold in the same premises and shared the same distribution channels.
27. Mr Taylor denied the claim of Mr Nebel, that the term 'pasta' encompassed 'pasta dough'. He told me that 'pasta' must be considered to be a finished or complete product, whilst pasta dough, a product that he had not seen for sale in any supermarket, was an ingredient that needed to be cooked in order to create the finished article. It was also stated that, once prepared, it was impossible to reverse the process and turn pasta back into its constituent parts.
28. I find the earlier goods 'pasta' and 'noodles' to be goods that require preparation and the addition of further ingredients such as a sauce, in order to be consumed in the way that they are intended to be enjoyed. The same cannot be said of the contested goods, which are snack foods that can be eaten immediately on purchase and do not need to be heated, boiled or cooked before consumption. These goods do not share

nature, method of use or intended purpose and they are neither complementary nor in competition.

29. The opponent's argument that, because all of the goods are made from a dough material, there must be a level of similarity between the finished products is rejected. The fact that e.g. pasta and biscuits are both produced using a type of dough is not sufficient to find that the finished products should be found to be similar.

30. I acknowledge that the EUIPO goods comparison database (the results of which I am not bound by), lists 'biscuits' as being similar to 'frozen dough' and 'pastry dough'. It also, however, lists biscuits as being dissimilar to pasta and noodle based prepared meals. In other words, the EUIPO database makes a clear distinction between the comparison of a finished article (a biscuit) and the basic ingredient required to make that item, and the comparison of two finished products (pasta and biscuits) which merely share the same basic ingredient.

31. In *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, Lady Justice Arden stated that:

"49..... I do not find any threshold condition in the jurisprudence of the Court of Justice cited to us. Moreover, I consider that no useful purpose is served by holding that there is some minimum threshold level of similarity that has to be shown. If there is no similarity at all, there is no likelihood of confusion to be considered.

32. Taking into account all of the submissions and evidence of both parties and applying my own knowledge and understanding of the goods at issue and the relevant market place, as an average consumer of those goods, I find all of the contested goods to be dissimilar to the earlier goods of the opponent, for the reasons set out above.

33. For there to be any possibility of a likelihood of confusion, there must be at least some degree of similarity between the goods at issue. Consequently, as the goods at issue have been found to be dissimilar, there can be no possibility of confusion and the opposition fails.

Conclusion

34. The opposition has failed. The application may proceed to registration.

Costs

35. The applicant has been successful and is entitled to a contribution towards its costs. At the hearing before me, the applicant sought off-scale costs. I have taken note of the submissions made by Mr Taylor in this regard, however I am not convinced that the applicant has been put to a significantly greater burden than would usually be the case in such proceedings. I therefore make an award based on the usual scale (contained in Tribunal Practice Notice 2/2016). I award the applicant the sum of £1500 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Official fee for opposition	£100
Preparing the statement of case and considering the counterstatement	£200
Preparing evidence and considering the evidence of the opponent	£500
Preparing for and attending a hearing	£700
Total	£1500

36. I therefore order Merano Speck GmbH to pay Parle Products Private Limited the sum of £1500. The above sum should be paid within 14 days of the expiry of the appeal period or, if there is an appeal, within 14 days of the conclusion of the appeal proceedings.

Dated this 10 day of September 2019

Andrew Feldon

For the Registrar

The Comptroller-General