

**IN THE MATTER OF APPLICATION NUMBER 2208294
IN THE NAME OF SWEETMASTERS LIMITED
TO REGISTER A TRADE MARK IN CLASS 30**

And

**IN THE MATTER OF OPPOSITION THERETO
UNDER NUMBER 50696
BY SOCIÉTÉ DES PRODUITS NESTLE S.A.**

**IN THE MATTER OF application number 2208294
in the name of Sweetmasters Limited
to register a trade mark in Class 30**

And

**In the matter of opposition thereto under number 50696
by Société des Produits Nestlé S.A..**

Background

On 11 September 1999, Sweetmasters Limited filed an application to register the trade mark AFTER SEX MINTS in Class 30 in respect of the following goods:

Confectionery and confectionery products..

On 10 February 2000, Société des Produits Nestlé S.A. filed notice of opposition in which they say they have been using and have registered, inter alia, 3 trade marks, details of which can be found in as an annex to this decision. The grounds of opposition are in summary:

Under Section 5(2)(b) because the mark applied for is similar to the opponent's earlier trade marks and is sought to be registered for goods identical or similar to those covered by these earlier trade marks, such that there exists a likelihood of confusion on the part of the public which includes a likelihood of association.

The applicants filed a counterstatement in which they deny the grounds on which the opposition is based. Both sides requests that an award of costs be made in their favour.

Only the opponents filed evidence in these proceedings. Neither side accepted the offer to be heard on the matter, electing instead for a decision to be made from the papers.

Opponent-s evidence

This consists of a Statutory Declaration dated 17 October 2000 by Sarah Dixon, a Legal Adviser in the Legal Department of Nestlé UK Limited, a position she has held since 1992. Ms Dixon confirms that she is responsible for the prosecution and defence of the intellectual property of the Nestlé S.A. group of companies in the United Kingdom, and is an authorised agent of Société des Produits Nestlé S.A. and of Nestlé UK Limited. Ms Dixon confirms that she has full access to the records of her company, and that the facts in her Declaration are from her own knowledge or have been taken from the records of the company or from the sources stated.

Ms Dixon begins by outlining the relationship of Nestlé UK Limited in the corporate structure of the Nestlé group. She refers to the application which is the subject of these proceedings, and to the earlier trade marks upon which the opponents rely.

Ms Dixon continues, saying that the trade mark AFTER EIGHT was first used in the United Kingdom by Rowntree & Company Limited in 1962 upon a range of boxed chocolates, including thin chocolate mints. She outlines a series of changes of corporate identity of that company leading to the acquisition of the Rowntree group companies by Nestlé S.A. which included the acquisition of all of that company's intellectual property rights.

Ms Dixon says that sales of confectionery under the AFTER EIGHT trade mark have been substantial, and she sets out the sales for the years 1993 to 1999, which range from , 28.8 million in 1993, rising year on year to , 40.1 million in 1998, the last full year prior to the relevant date. She refers to exhibit SD1 which consists of samples of packaging, which Ms Dixon says is currently used for her company's AFTER EIGHT confectionery, there being no earlier examples available. The exhibit consists of 4 items of packaging for a range of chocolate confectionery, including mints. The packaging contains the words AFTER EIGHT, either separated by the device of a clock, or placed above such a device. All show what appears to be a 'Best before' date, the earliest being February 2001, the latest being July 2001.

Ms Dixon gives details of the amounts spent in the advertising and promotion of confectionery under the AFTER EIGHT trade mark in the United Kingdom in the years 1993 to 1999, which ranges from , 1.59 million in 1993 rising year on year to a peak of , 4.05 million in 1996, the following years showing a reduction but still representing substantial amounts. Ms Dixon says that most of the early advertising and promotion was by means of press publications, some of which she names, and she introduces exhibit SD2 which she says consists of copies of the advertisements that appeared between 1962 and 1997. The exhibit consists of examples of advertisements, most appearing old but having nothing by which to date them. The earliest that can be dated comes from 1963 and shows the AFTER EIGHT and clock device (shown on the packaging at SD1) being used in connection with a chocolate mint confection. Later examples over the years to December 1997 show consistent use of the same trade mark. The advertisements are noted as having appeared in national publications. Ms Dixon says recent advertising and promotion has been by means of television, exhibit SD3 consisting of a videotape of all such promotion over the preceding seven years. The video shows a series a television advertisement for AFTER EIGHT mints and chocolate confectionery. There is nothing by which to date the advertisements.

Ms Dixon refers to exhibit SD4, which consists of advertisements that appeared in trade publications, some claiming AFTER EIGHT to be the leading after dinner mint, and referring to the substantial promotion and success of the product in the market. Ms Dixon concludes her Declaration saying that by virtue of the reputation acquired by AFTER EIGHT and its use in connection with a clock, which revolves around the idea that the products are for consumption in the evening, the mark AFTER EIGHT if used on mint confectionery will lead to confusion.

That concludes my review of the evidence insofar as it is relevant to these proceedings.

Decision

I turn to consider the ground of opposition under Section 5(2)(b). That section reads as follows:

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

- (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.

An earlier trade mark is defined in Section 6 of the Act as follows:

6.- (1) In this Act an earlier trade mark means **B**

- (a) a registered trade mark, international trade mark (UK) or Community trade mark 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,

In my consideration of a likelihood of confusion or deception I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] E.T.M.R. 2, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] E.T.M.R. 1, *Lloyd Schufabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] 45 F.S.R. 77 and *Marca Mode CV v Adidas AG* [2000] E.T.M.R. 723. It is clear from these cases that:-

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*, paragraph 22;
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v Puma AG*, paragraph 23, 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; *Lloyd Schufabrik Meyer & Co. GmbH v Klijsen Handel B.V.* paragraph 27;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v Puma AG*, paragraph 23;
- (d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v Puma AG*, paragraph 23;

- (e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, paragraph 17;
- (f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v Puma AG*, paragraph 24;
- (g) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v Puma AG*, paragraph 26;
- (h) further, 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; *Marca Mode CV v Adidas AG*, paragraph 41;
- (i) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, paragraph 29.

From the cases above it is clear that the average consumer normally perceives a mark as a whole, and that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, but with regard to the distinctive and dominant components. In the *Decon Laboratories Ltd v Fred Baker Scientific Ltd* (2001 RPC 293), Pumphrey J held that two marks were identical because they consisted of the same word, with a descriptive suffix, which because it referred, inter alia, to the nature of the goods could not distinguish the respective goods. That is also the case here. The word MINTS in the applicant's mark is no more than a reference to the goods for which it is to be used, and that the words AFTER SEX are the distinctive and dominant components.

From the opponent's evidence it appears that AFTER EIGHT is a suggestion to the goods being suitable for consumption in the evening, usually after dinner. That may well be the case, but it is nonetheless a distinctive mark prima facie. The evidence establishes that the opponents have made long and extensive use of AFTER EIGHT, primarily in respect of a thin chocolate mint confection, and I believe it reasonable to say that they will have established a strong reputation in respect of such goods. I believe that it is also relevant to take into account that the opponent's mark has often been promoted or referred to as AFTER EIGHT MINTS, and that in the minds of the consumer the connection between AFTER EIGHT and MINTS is likely to have been established.

Self evidently the respective marks have the word AFTER in common and to that extent there must be some similarity, but the opponents say that it goes beyond this, asserting that the word SEX is close to the numeral SIX, and that as the opponents use their mark on mint flavoured confectionery, the marks as a whole are likely to be confused. Visually the marks have some similarity. There is also a degree of aural similarity, more so if the word MINTS is added to the opponent's mark, which the consumer is likely to do when asking for or referring to the goods. But no matter how

SEX is pronounced, it is unlikely to ever sound anywhere near EIGHT. The opponent's case is essentially one of conceptual similarity, but SEX is a word with its own well known meaning, and as a whole the marks convey a rather different ideas.

The opponent's earlier mark and the application cover identical goods, and I see no reason, other than perhaps to prevent possible offence to some consumers, why they should not be sold in the same outlets, on the same shelves to the same consumers. Notionally that is what the applicants would be entitled to do if their mark achieves registration.

Whilst I have said that the opponent's mark appears to be a suggestion to the use of the goods as after dinner mints, the rationale for the applicant's mark escapes me, and I am led to suspect that they are parodying the opponents, but this is no more than conjecture. As was said in the Sabel-Puma case, mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2), and in the Marca Mode case, that 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. Taking all of the above into account, I come to the view that the applicant's mark may bring to mind the opponent's mark, an association that the opponents may consider distasteful, but will not lead the public to wrongly believe that the respective goods come from the same or economically linked undertakings, and consequently, there is no likelihood of confusion.

The opposition having failed on all grounds I order the opponents to pay the applicants the sum of , 635 as a contribution towards their costs. This sum to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 25TH day of February 2002

**Mike Foley
for the Registrar
The Comptroller General**

Annex

| Number | Mark | Class | Specification |
|---------------|-------------|--------------|---------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
| 816360 | AFTER EIGHT | 30 | Cocoa, chocolate, chocolates and non-medicated confectionery. |
| 950237 | AFTER EIGHT | 30 | Coffee; mixtures of coffee and chicory, coffee essences and coffee extracts; chicory and chicory mixtures, all for use as substitutes for coffee; biscuits (other than biscuits for animals), cakes, pastry, non-medicated confectionery, sauces, spices (other than poultry spices); ice; desserts included in Class 30. |
| 1402772 | | 30 | Coffee, coffee essences and coffee extracts; mixtures of coffee and chicory; Coffee substitutes; tea, tea extracts; |



cocoa, and preparations having a base of cocoa; chocolate, chocolate products (for food), non-medicated confectionery and candy; sugar; flour, preparations made from cereals and/or rice and/or flour for food for human consumption; bread, biscuits (other than biscuits for animals), cookies, cakes, pastry; ice cream, water ices, frozen confections, and preparations for making ice cream and/or water ices and/or frozen confections; honey and honey substitutes; snack foods; prepared meals, desserts and puddings; all included in Class 30.