

TRADE MARKS ACT 1994

**IN THE MATTER OF REQUEST No. M741230
BY SOCIETE DES PRODUITS NESTLÉ SA
FOR EXTENSION OF PROTECTION OF A
TRADE MARK IN THE UNITED KINGDOM
UNDER THE PROVISIONS OF THE
PROTOCOL TO THE MADRID AGREEMENT**

AND

**IN THE MATTER OF OPPOSITION No. 70552
BY SODIAAL INTERNATIONAL – SOCIETE DES
DIFFUSION INTERNATIONALE AGRO ALIMENTAIRE**

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**IN THE MATTER OF Request No. M741230
By Soci t  des Produits Nestl  SA
for extension of protection of a trade mark in the
United Kingdom under the provisions of the
Protocol to the Madrid Agreement**

AND

**IN THE MATTER OF Opposition No. 70552
By Sodiaal International – Soci t  Des Diffusion
Internationale Agro Alimentaire**

BACKGROUND

1. On 10 August 2000 Societe des Produits Nestl  S.A. sought to extend international registration No 741230 in respect of the trade mark FRUBETTO to the United Kingdom. The request was examined, accepted and published for a specification of goods as follows:

Class 30

Cocoa and preparations made from cocoa, chocolate, chocolate products, confectionery, sweetmeats; sweets; sugar; chewing gum; bakery products, fine pastry articles, biscuits; food products included in this class for making desserts and puddings; edible ices and products for the preparation of edible ices; glazed confectionery; food products based on grains.

2. On 6 March 2001, Sodiaal International – Soci t  des Diffusion Internationale Agro Alimentaire filed a Notice of Opposition.

3. The Grounds of Opposition set out in the Notice of Opposition are based principally upon Section 5(2)(b) of the Act, because the opponents alleged that the earlier registrations for the trade mark FRUBES, details of which are set out in the attached Annex, are sufficiently similar in respect of the trade marks and the goods covered by the registrations to result in confusion. Where the goods are not similar, they consider that Section 5(3) comes into play because use by the applicants of their trade mark is without due cause, takes advantage of and would be detrimental to the distinctive character of the opponents' earlier trade marks which they claim have a reputation. The opponents also claim sufficient goodwill in their trade marks to justify a refusal under the common law tort of passing off, Section 5(4)(a). Only the opponents filed evidence and as is now usual I reviewed the case to determine whether a Hearing was necessary in order that I might decide the issues between the parties. My review concluded that the opposition was based primarily upon Section 5(2)(b) of the Act and taking account of the authorities available I felt that the issue could be determined by a finding in relation to that section (which also required me to take into account any enhanced reputation the opponents might claim with regard to their earlier trade marks). Neither side disagreed

with my conclusions or chose to put in written submissions and therefore my decision below reflects my reading of the pleadings and the opponents' evidence

DECISION

4. The principal ground of opposition is based upon Section 5(2)(b) which reads as follows:

“5.-(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.”

An earlier trade mark is defined, insofar as this case is concerned, in Section 6(1)(a) of the Act.

5. On the basis of the information attached to each of the opponents' earlier registrations as set out in the annex I have no hesitation in accepting that they are earlier trade marks. I go on therefore to consider the matter of whether or not registration of the applicants' trade mark is likely to cause confusion or deception. In doing so 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. 1, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] E.T.M.R. 1, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] 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 Schuhfabrik 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.

6. First of all, I consider whether the respective goods are the same or similar and look to the guidance of Jacob J in *British Sugar Plc v. James Robertson & Sons Ltd* [1996] RPC 281 and the judgment of the European Court of Justice in *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*. I therefore consider:

- (a) the nature of the goods;
- (b) the end users of the goods;
- (c) the way in which the goods are used;
- (d) whether the respective goods are competitive or complementary and how those in trade classify the goods and the trade channels through which the goods reach the market;
- (e) in the case of self-serve consumer items, where in practice they are retrospectively 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) in determining whether similarity between the goods covered by the applicants' and the opponents' trade marks is sufficient to give rise to the likelihood of confusion, the distinctive character and reputation of the earlier marks is to be taken into account.

7. The applicants' specification covers a range of goods which fall within Class 30, whereas the opponents' registrations cover goods all of which fall into Class 29. The opponents' goods are wide ranging, all of them form the basis of food and drink (non-alcoholic), both sweet and savoury. The applicants' goods are both sweet and savoury foodstuffs. With that in mind and the guidance set out above I reach the view that the position is as follows:

Identical Goods

Covered by the Application for registration	Covered by the Opponents' registration
M741230:	2045821
Food products included in this Class for making desserts and puddings	desserts and dessert products, mousse
	2068327
	desserts, dessert products, flavoured desserts, dairy desserts.

Similar Goods

Covered by the Application for registration	Covered by the Opponents' registration
Cocoa and preparations made from cocoa, food products included in this class for making desserts and puddings.	2045821
	non-alcoholic beverages made principally of milk, frozen yoghurt, fromage frais, milkshakes.
	2068327
	milk products, food preparations made principally of milk, cream, double cream, cream products, preparations for making milk products, yoghurts, yoghurt products, drinking yoghurts, flavoured yoghurts, frozen yoghurts, fromage frais, milkshakes.

Dissimilar Goods

Covered by the Application for registration	Covered by the Opponents' for registration
Chocolate, chocolate products, confectionery; Sweetmeats; sweets; sugar; chewing gum; bakery products, fine pastry articles, biscuits; dairy products, imitation dairy products, edible ices and products for the preparation of edible ices; glazed confectionery; food products based on grains.	2045821
	Edible oils and fats, butter, margarine, milk, skimmed milk, cheese, cottage cheese, cheese products.

2068327

Dairy products, imitation dairy products, preparations for making dairy products, skimmed milk, curdled milk, butter margarine, cheese, cottage cheese, fresh cheese, cheese products, edible oils and fats.

8. I go on to consider the respective trade marks, through the eyes of the average consumer for the same or similar goods in issue, which are run of the mill food items consumed by the population at large. For convenience I set out the respective trade marks below.

Opponent's
2068327:

Applicant's
FRUBETTO



2045821:
FRUBES

9. As can be seen each has the letters FRUBE at the start, with the opponents having an additional S and the applicants the letters TTO in addition. There are therefore some visual similarities and, to a lesser extent some aural similarities. However, conceptually the two trade marks are different, in my view. The opponents' trade mark looks and sounds like an invented word whereas the applicants' trade mark looks and sounds like an Italian surname. In that regard I consider that the opponents' trade mark is a distinctive trade mark, as is the applicants and I fully take that into account below. Considering all the factors which I have identified and where the applicants and the opponents' trade marks might be used on identical goods (bearing in mind paragraph 17 of *Canon Kabushiki Kaisha v Metro Goldwin Mayer Inc*), which could be termed the opponents' best case, I reach the view that there would be no confusion caused if these two trade marks were used alongside one another in the market place.

10. Even when used on identical goods there are sufficient conceptual, visual and aural differences between the two trade marks to prevent the confusion that the Act at Section 5(2) seeks to prevent. The trade marks would be perceived by the relevant public as different and even the 'imperfect picture' which the consumer is said to rely upon will not result in them being confused.

11. That is not the end of the matter, however, because the opponents filed evidence which I believe goes to their claim to reputation and goodwill in respect of their trade marks. Though

I have already assessed the likelihood of confusion between the opponents' trade marks and that of the applicants on the basis that each has, prima facie, a distinctive character, I will do so on the basis of any distinctive character acquired through use.

12. The evidence consists of a declaration by Christel Delasson the European Marketing Co-ordinator dated 21 December 2001. The relevant facts I extract from this document are:

- i) the FRUBES trade marks have been used in the United Kingdom since 1996;
- ii) they are used (with the consent of the opponents) by Yoplait Dairy Crest (invoices between the two companies confirm this);
- iii) the trade mark is used on a flavoured fromage frais dessert product (advertising material at PM5);
- iv) turnover and advertising/promotional expenditure has been as follows:

Year	Turnover/£	Advertising/Promotion £
1996	1,247,460	600,000
1997	2,816,687	1000,000
1998	6,382,589	1200,000
1999	7,405,998	1400,000
2000	7,327,515	1380,000

- v) advertising/promotion consisted of television advertising, press advertising, sampling, give-aways, web-site etc.

13. A lot of the support material e.g. trade press articles, advertising material are either after the material date in these proceedings (August 2000) or undated. However, from the evidence it is clear that any reputation the opponents might have is in the area of fromage frais desserts. And in respect of that area they have sold a lot of products. I assume this from the nature of the goods, the sales of which are directed towards children, from which I infer they are relatively low cost. Therefore sales of £7M in a year may be significant, but I am not able to infer that this gives the trade mark a reputation. This is because these sales are not put into any sort of context.

14. Does £7M a year represent a significant market share? Would it suggest that the relevant public would know the trade mark in relation to the type of goods sold under it? For my part I would guess that the market for chilled desserts (children's snacks) is likely to be massive and I am not therefore prepared to infer that sales of £7M per year would contribute to the trade mark's reputation. In reaching this view I do not ignore the advertising/promotion that has been undertaken. But again, there is no indication that this is above, at or below the sector's norm.

15. In the circumstances I am not prepared to accord the trade mark any distinctive character as a result of the use made of it. However, having assessed matters earlier on the basis of the

inherent distinctiveness of the opponents' trade mark and found that the respective trade marks are not sufficiently similar to result in confusion this finding does not effect matters in relation to Section 5(2)(b). The opponents' case is not made out and the opposition fails on that ground.

16. I turn to the ground based upon Section 5(3) which states:

“5.-(3) A trade mark which -

- (a) is identical with or similar to an earlier trade mark, and
- (b) is to be registered for goods or services which are not similar to those for which the earlier trade mark is protected,

shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community trade mark, in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

17. I have already found that some of the opponents and the applicants goods are different. However, I have also found that the respective trade marks are not similar and that I am unable to infer that the opponents' trade marks have a reputation (certainly not on the basis of the criteria laid down in *General Motors v Yplon*) [2000] RPC 572. Thus, I need not consider matters further in order to find that the ground of opposition based upon Section 5(3) fails.

18. Finally I come to the ground of opposition based upon Section 5(4)(a) which states:

“5.-(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented -

- (a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or”

19. The jurisprudence in respect of this ground of objection is set out in the decision of Geoffrey Hobbs QC, Acting as the Appointed Person in *Wild Child* [1998] RPC 455.

20. Taking that decision into account and my findings above I am unable to hold that the opponents' business and trade mark has a reputation and the necessary goodwill (see the views of Pumfrey J in *South Cone* [2002] RPC 19; show that the public will mistake one sign for another; or that any damage will be caused to the opponents' business by the applicants' use of their trade mark. The ground of opposition based upon Section 5(4)(a) also fails.

COSTS

21. The applicants are entitled to a contribution towards their costs. They are entitled to £500 in respect of pursuing the notice of opposition and submitting a statement in reply; for considering the opponents evidence I consider the sum of £700 is reasonable. I therefore order the opponents to pay to the applicants the sum of £1,200. This sum is 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 02 day of January 2003

**M KNIGHT
For the Registrar
the Comptroller-General**

OPPONENT'S TRADE MARKS

**2045821:
FRUBES**

Class 29:

Edible oils and fats, butter, margarine, dairy products, imitation dairy products, milk, skimmed milk, cream, cream products, desserts and dessert products, yoghurts, mousse, milk products, cheese, cottage cheese, yoghurt drinks; non-alcoholic beverages made principally of milk; cheese products; food preparations made principally of milk; frozen yoghurt, fromage frais, milk shakes.

2068327:



Class 29:

Dairy products, imitation dairy products, preparations for making dairy products, milk and milk products, skimmed milk, curdled milk, food preparations made principally of milk, butter, margarine, cheese, cottage cheese, fresh cheese, cheese products, cream, double cream, cream products, preparations for making milk products, yoghurts, yoghurt products, drinking yoghurts, flavoured yoghurts, frozen yoghurts, fromage frais, milkshakes, desserts, dessert products, flavoured desserts, dairy desserts, edible oils and fats.

2163366:



Class 29:

Milk and milk products; preserved milk, curdled milk, flavoured gelified milk, condensed milk, powdered milk, yoghurt, drinking yoghurt, flavoured yoghurt, cow's milk, desserts made from milk, cheese, fresh cheese, cottage cheese, cream, butter.