

O-238-03

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 2247456
BY PERDIGAO AGROINDUSTRIAL S/A
TO REGISTER A TRADE MARK IN CLASS 29**

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER No. 80462
BY PLUKON BEHEER B.V**

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by Perdigao Agroindustrial S/A to register a
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**IN THE MATTER OF Opposition thereto
under No. 80462 by Plukon Beheer B.V.**

Background

1. On 4 October 2000 Perdigao Agroindustrial S/A applied to register the following series of two trade marks in Class 29 of the register for a specification of “Meat, meat extracts, poultry and game”:






Mark claim / limit:

The applicant claims the colours red and white as an element of the second mark in the series.

2. The application was accepted by the Registrar and published in the Trade Marks Journal.

3. On 12 December 2001 Plukon Beheer BV filed a Notice of Opposition under Section 5(2)(b) of the Act because the mark applied for is similar to the following earlier registered trade marks owned by the opponent which cover identical or similar goods and there exists a likelihood of confusion on the part of the public:

Registration Number	Mark	Registration Effective	Specification of goods
UK 1103215	FRIKI	20 October 1978	Class 29: Meat; fish, poultry and game none being live; products for

			food made from the aforesaid goods; meat extracts, soups; and snacks included in Class 29.
UK 1490159		8 February 1992	Class 29: Meat; poultry and game; meat extracts; meat products; poultry products; game products; soups; snack foods; prepared meals and constituents for meals; all included in Class 29.
UK 1490160		8 February 1992	Class 30: Pasties, meat pies, sausage rolls and pastry products; snack foods; prepared meals and constituents for meals; all included in Class 30.
CTM 372805		26 July 1996	Class 29: Meat, fish, poultry and game; meat extracts; fresh, deepfrozen, canned or otherwise preserved poultry, game, soups and pies; deepfrozen or non-deepfrozen foodstuffs included in this class; deep-frozen or non-deepfrozen ready-prepared meals. Class 30: Pies; deepfrozen or non-deepfrozen foodstuffs included in this class; deep-frozen and not deep-frozen ready-prepared meals.

4. The applicant filed a Counterstatement denying the grounds of opposition.

5. Both sides filed evidence and asked for an award of costs in their favour. The parties were content for a decision to be taken without recourse to a hearing.

Opponent's Evidence

6. This consists of a witness statement by David Koller dated 25 September 2002. Mr Koller is the Managing Director of Plukoon Beheer B.V. (the opponent).

7. Mr Koller states that his company has sold products bearing the FRIKI trade marks since at least early 1983 on a wide range of food products and he attaches as Exhibit FR1 to his

statement, examples of labels and brochures to demonstrate use of the marks in relation to the relevant goods.

8. As an example of annual retail sales turnover, Mr Koller states that the 2001 UK figure amounted to £9 million. He adds that in terms of volume, between 1997 and 2001, 10,500 tonnes of food were sold to the UK. Turning to the promotion of the marks, Mr Koller states that his company spent 130,000 Euros on advertising and other promotional activities in the UK during 2001.

9. Mr Koller goes on to explain that goods sold under the mark are available throughout the UK and as Exhibit FR2 to his statement is a list of approximately 110 trade customers to whom products bearing the FRIKI trade mark have been sold.

10. Mr Koller concludes by submitting that the marks FRESKI and FRIKI are similar and that they are used on identical products.

Applicant's Evidence

11. This consists of a witness statement by John Arthur Slater dated 17 January 2003. Mr Slater is a partner in Marks & Clerk, the applicant's professional advisors in these proceedings.

12. Mr Slater explains that the applicant's mark is currently in use in Brazil and is intended to be used in the UK pursuant to the conclusion of these proceedings.

13. In relation to the opponent's evidence Mr Slater points out that the only document dated i.e. "The Caterer's Food Guide" at Exhibit FR1, is dated Autumn/Winter 2002/2003 which is after the relevant date for these proceedings. Furthermore, he adds that the mark only shows use of the FRIKI logo. Turning to the opponent's turnover and advertising figures, Mr Slater states that there is no evidence by way of e.g. annual reports, invoices or advertisements, to substantiate these claims.

14. This completes my summary of the evidence filed in this case. I now turn to the decision.

Decision

15. Section 5(2) of the Act reads as follows:

“(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 earlier trade mark is protected, or
- (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.”

16. An earlier right is defined in Section 6, the relevant parts of which state:

“6.-(1) In this Act an "earlier trade mark" means -

- (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,”

17. 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*, page 224, 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*, page 224;
- (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*, page 224;
- (g) account should be taken 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 was registered; *Lloyd*, paragraph 29;
- (h) 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*, page 224;
- (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.

18. The reputation of a trade mark is an element to which importance may be attached in Section 5(2) considerations in that it may enhance the distinctive character of the mark at issue and widen the penumbra of protection of such a mark. The opponent has filed evidence relating to the reputation of its trade marks. However, the evidence submitted only provides a sales figure and a figure relating to promotional activity in relation to 2001 which is after the relevant date for these proceedings (4 October 2000). While the evidence also states that between 1997 and 2001, 10,500 tonnes of food were sold in the UK there is no indication of the market share this represents. Furthermore, no supporting evidence from third parties or the trade has been filed and the only examples of use of the marks which is provided are dated after the relevant date or are undated.

19. While the opponent may have had a real and substantial presence in the UK market place prior to the relevant date for these proceedings, the evidence does not demonstrate a reputation among the relevant public in its earlier cited trade marks. The onus is upon the opponent to prove that its earlier marks enjoy a reputation or public recognition and on the basis of the evidence filed in this case I do not believe the opponent has discharged this onus. In *DUONEBS* (BLO/048/01) a decision of Simon Thorley QC sitting as the Appointed Person, it was said:

“In my judgement I believe what the ECJ had in mind was the sort of mark which by reason of extensive trade had become something of a household name so that the propensity of the public to associate other less similar marks with that mark would be enhanced. I do not believe that the ECJ was seeking to introduce into every comparison required by Section 5(2), a consideration of the reputation of a particular existing trade mark”

20. I conclude that the opponent cannot claim an enhanced level of distinctive character for its marks. However, I would add that the word FRIKI appears to have no reference whatsoever to the goods at issue and accordingly it possesses inherent strength and is deserving a good penumbra of protection.

21. Even if I am wrong in relation to the reputation of the opponent’s marks, I would point out that reputation is only one element which forms part of a global consideration under Section 5(2). It was held in *Marca Mode v Adidas AG* [2000] E.T.M.R. 723:

“The reputation of a mark, where it is demonstrated, is thus an element which, amongst others, may have a certain importance. To this end, it may be observed that marks with a highly distinctive character, in particular because of their reputation, enjoy broader protection than marks with a less distinctive character (Canon, paragraph 18). Nevertheless, the reputation of a mark does not give grounds for presuming the existence of a likelihood of confusion simply because of the existence of a likelihood of association in the strict sense.”

22. In essence the test under Section 5(2) is whether there are similarities in marks and goods which would combine to create a likelihood of confusion. The likelihood of confusion must be appreciated globally and I need to address the degree of visual, aural and conceptual similarity between the marks, evaluating the importance to be attached to those differing elements, taking into account the degree of similarity in the goods, the category of goods in question and how they are marketed. Furthermore, in addition to making comparisons which take into account the actual use of the respective marks, I must compare the mark applied for and the opponent’s registrations on the basis of their inherent characteristics assuming normal and fair use of the marks on a full range of the goods within the respective specifications.

23. I turn first to a consideration of the respective goods covered by the specifications of the marks in suit and the opponent’s earlier registrations. The applicant’s mark has not been used in the UK and the opponent’s marks have use in relation to the goods within their Class 29 and 30 specifications. It is obvious that the respective specifications cover identical goods in Class 29 and I must take this into account in my decision, in particular in relation to notional fair use of the marks.

24. I now go on to compare the marks in suit with the opponent’s earlier marks. The application is for a series of two with the second mark in the series containing the following claim/limit – “The applicant claims the colours red and white as an element of the second mark in the series”. In my view nothing turns on this point as notional, fair use of the opponent’s marks would include use of those marks in the colours red and white. The applicant’s marks comprise the

invented word FRESKI and above the word, a device of two birds, the whole within a border. The opponent's earlier registrations are for the invented word FRIKI and also for that word within a border with a letter F superimposed on a chicken's head device and situated above the word in a circular background. I intend to concentrate in my comparisons on the opponent's word mark ie. registration number 1103215 for the word FRIKI as I do not believe the opponent's composite registrations offer the opponent any greater chance of success under Section 5(2).

25. The respective marks must be compared as a whole and by reference to overall impression but, as recognised in *Sabel BV v Puma AG* (mentioned earlier in this decision) in any decision reference will inevitably be made to the distinctiveness and dominance of individual elements. It is, of course, possible to over-analyse and in doing so shift away from the real test which is how marks would be perceived by customers in the normal course and circumstances of trade and I must bear this in mind when making the comparisons.

26. Firstly, I turn to a visual comparison of the respective marks. The opponent's mark consists of the word FRIKI, a five letter word which shares the same first two and last two letters as the six letter word FRESKI which is a dominant element in the applicant's mark. While I do not lose sight of the fact that the applicant's marks contain the device of two birds and are presented within a border, it seems to me that the device of two birds (albeit not necessarily recognisable as any particular species) is not a particularly distinctive element in relation to poultry or game and in any event, the word element is strongly prominent. As mentioned earlier in my decision, similarity must be considered in the light of overall impression and on this basis, given that the word comprising the opponent's mark and the prominent word element in the applicant's mark share the same beginning and termination and that the differing letters are to be found in the middle of the marks (where the visual impact is less striking overall), and after bearing in mind the potential for imperfect recollection, the respective marks in totality possess obvious visual similarity and it seems to me that there exists considerable scope for visual confusion.

27. In relation to aural comparisons it has long been accepted that in oral use "words speak louder than devices" and in the context of the present case the prominent word element in the applicant's marks is likely to serve as an oral descriptor. The respective marks share the same commencement and the terminations would share the "K1" sound. While clear aural similarities exist I believe the opponent's case for aural similarity to be, on balance, slightly weaker than the visual one.

28. Next I turn to a conceptual comparison of the marks. As the word element within the applicant's mark and the word comprising the opponent's mark are invented then, notwithstanding visual and aural similarity, I do not believe there is any precise conceptual similarity. I would only add that invented words are not likely to be distinguished in the way dictionary words with similar appearances but differing meanings would be and imperfect recollection could well be a factor in the global appreciation.

29. In assessing the degree of similarity between the respective marks and whether it is sufficient to give rise to a likelihood of confusion I must also consider in relation to the goods at

issue, who the average customer is, how the goods are marketed and make allowance for imperfect recollection.

30. The specifications of the applicant and opponent cover a wide range of foodstuffs in Class 29 ie. meat, poultry, game and meat extracts. Such goods would encompass expensive cuts of meat and also relatively cheap cuts of everyday cooking basics e.g. beef, pork, chicken etc. The average customer for the goods is the public at large and the goods will be readily available through self-selection e.g. at supermarkets, or over the counter e.g. at butchers' shops. I do not believe that there are any special circumstances relating to the purchase of the relevant produce. They are not casual "bags of sweets" but the goods are not necessarily expensive, sophisticated or demanding any great care or specialised attention in relation to their purchase.

Conclusion

31. On a global appreciation, taking into account all the relevant factors, I have come to the following conclusions:

- (i) the respective goods are identical;
- (ii) the respective marks are visually and aurally similar;
- (iii) the customer for the goods is the public at large and the goods are not necessarily purchased with great care or consideration.

32. Considering the position in its totality I believe that there is a likelihood of confusion on the part of the public. In reaching this conclusion I have borne in mind that the average customer rarely has the chance to make direct comparisons between marks, but instead must instead rely upon the imperfect picture of them he/she has kept in his/her mind.

33. The opposition under Section 5(2)(b) is successful.

Costs

34. The opponent has been successful and is entitled to a contribution towards costs. I order the applicant to pay the opponent the sum of £900, which takes into account that no hearing took place on this case. 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 19th day of August 2003

**JOHN MacGillivray
For the Registrar
the Comptroller General**