

O-192-11

TRADE MARKS ACT 1994

**IN THE MATTER OF INTERNATIONAL REGISTRATION NO. 1031791
IN THE NAME OF
FOODCARE SPOLKA Z.O.O.**

IN RESPECT OF THE TRADE MARK



IN CLASS 32

AND

**THE OPPOSITION THERETO
UNDER NO 72156
BY
SUMOL + COMPAL MARCAS, S.A.**

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international registration no. 1031791
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Introduction

1. Foodcare Spolka Z.O.O. is the holder of the above international registration ('the IR'). Protection in the United Kingdom was requested on 28 January 2010 (claiming a priority date of 20 November 2009 from the Polish Office of Origin). The details recorded on the register include the following text under "Mark description": "A black and yellow square on which a number "4" and an inscription "MOVE" is placed; the number "4" is white and the inscription "MOVE" is white with a gray ending". The request for protection was published in the United Kingdom, for opposition purposes, in *The Trade Marks Journal* on 16 April 2010. Protection is sought in respect of the following goods¹:

Class 32: Essences for making beverages; lemonades; lemonades powder; non alcoholic beverages; effervescing beverages; powder for effervescing beverages; fruit nectars; pastilles for effervescing beverages; products and preparations for making energizers; products and preparations for making refreshing beverages and micro-elements concentrated beverages; fruit juices; vegetable juices; sorbets; syrups for beverages; mineral water; aerated water; isotonic and energizing beverages.

2. Sumol + Compas Marcas, S.A. ('the opponent') filed notice of opposition to the granting of protection in the United Kingdom, claiming that protection would

¹ Classified according to the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

be contrary to section 5(2)(b) of the Trade Marks Act 1994 ('the Act'). Section 5(2)(b) of the Act states:

“(2) A trade mark shall not be registered if because –

....

(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.”

The opponent relies upon all the goods of its earlier Community Trade Mark (“CTM”) 4194437, the relevant details of which are as follows:

Mark: MOOVE

Goods: Class 05: *Dietetic, organic and diet beverages; vitamin energy drinks and tonic and fortified drinks.*

Class 30: Coffee, tea and artificial coffee-based beverages, and beverages based on other cereals.

Class 32: Beverages, namely drinking waters, flavoured waters, mineral and aerated waters and other non-alcoholic beverages; energy drinks and sports drinks, soft drinks, fruit drinks and aerated fruit juice drinks, vegetable and plant juices, syrups for beverages, concentrates, powders and other preparations for the manufacture of beverages.

Date of filing: 19 January 2005

Date of completion of registration procedure: 13 February 2006.

3. As the earlier mark had been registered for less than five years at the date on which the IR was published, it is not subject to the proof of use regulations², which means that it can be considered on the basis of notional use of all the goods for which it is registered. The opponent claims that the device element of the IR has no significance and that the comparison of the marks should be considered as MOOVE against 4 MOVE. It claims that MOOVE and MOVE are phonetically and conceptually identical; that MOVE is the dominant element in the IR; and that the numeral 4 would be seen as a descriptive element. The opponent claims that there is a high degree of similarity between the marks and

² See section 6A of the Act (added by virtue of the Trade Marks (Proof of Use, etc.) Regulations) 2004 (SI 2004/946) which came into force on 5th May 2004.

that this, coupled with the identity of the goods in class 32, will give rise to a likelihood of confusion.

4. The holder filed a counterstatement. It admits that the goods are identical or similar, but denies that the marks are similar and consequently denies that there is a likelihood of confusion.

5. Neither side asked for a hearing, both being content for a decision to be made from the papers on file. Both parties filed evidence, and the holder filed written submissions. I bear all the evidence and submissions in mind, together with the content of the holder's counterstatement, in reaching my decision.

Evidence

6. The opponent's evidence comes from Peter John Charlton who is a trade mark attorney at Elkington and Fife LLP, the opponent's professional representatives in these proceedings. Mr Charlton exhibits a copy of a decision of the French Trade Marks Office in parallel opposition proceedings. He highlights the following (translated) paragraph from that decision:

“AND the designation MOOVE also appears to be distinctive for the disputed goods in the earlier mark of which it is the sole component; AND the term MOVE appears to be dominant within the contested sign; AND in fact, the numeral 4, which might be perceived as a simple indication of a product range number or a classification, does not appear to be capable on its own of eliminating the likelihood of confusion between the signs; AND further, contrary to what the Applicant claims, inscribing the contested sign in a square panel in alternating black and yellow colours does not appear to be sufficient to eliminate the likelihood of confusion between the signs, of which the extremely similar word components MOVE and MOOVE appear to be immediately perceptible and essential”.

7. The holder's evidence comes from Alison Clare Wilson who is a trade mark attorney at Murgitroyd & Company, the holder's professional representatives in these proceedings. She exhibits two letters from the Irish Patent Office in relation to the request for protection of the IR in the Irish jurisdiction which state that no objection was raised as a result of the relative grounds examination of the IR. Ms Wilson also exhibits a statement of grant of protection from the Portuguese Trade Mark Office. Ms Wilson has filed these letters to support her submission that the IR, having been found acceptable in Ireland and Portugal, should also be accepted for protection in the UK on the grounds that it is dissimilar to the opponent's mark.

Decision

8. The leading authorities which guide me are from the CJEU (Court of Justice of the European Union): *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77, *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* C-334/05 P (LIMONCELLO). 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*,

(b) the matter must be judged through the eyes of the average consumer for the goods/services in question; *Sabel BV v Puma AG*, 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.*,

(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*,

(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*,

e) assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark; the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*

f) it is only when all other components of a complex mark are negligible that it is permissible to make the comparison on the basis of the dominant element; *Shaker di L. Laudato & C. Sas v OHIM*.

(g) 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*,

(h) 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*,

(i) in determining whether similarity between the goods or services covered by two trade marks is sufficient to give rise to the likelihood of confusion, the distinctive character and reputation of the earlier mark must be taken into account; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,

(j) 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*,

(k) 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 and Adidas Benelux BV*,

(l) 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*.

Comparison of goods

9. Although the holder has admitted that the goods are identical or similar it is necessary to determine the level of similarity of the goods of the parties' competing specifications because similarity levels impact upon the consideration of the interdependency principle (*Canon*), whereby a lesser degree of similarity between the goods may be offset by a greater degree of similarity between the trade marks, and vice versa. Although the opponent relies upon all the goods of its registration, I will firstly look at its class 32 goods in comparison with the IR, since the IR covers only class 32.

10. Some of the terms in each party's specification are identical or fall within the ambit of terms within the competing specification, in which case the goods are held to be identical³. The opponent's *beverages, namely drinking waters, mineral and aerated waters and other non-alcoholic beverages; energy drinks and sports drinks, soft drinks and aerated fruit juice drinks, vegetable and plant juices* are identical to the IR's *lemonades; non alcoholic beverages; effervescing beverages; fruit nectars; fruit juices; vegetable juices; mineral water; aerated water; isotonic and energising beverages*. The opponent's *syrops for beverages, concentrates, powders and other preparations for the manufacture of beverages* are identical to the IR's *essences for making beverages; lemonades powder; powder for effervescing beverages; pastilles for effervescing beverages; products*

³ See *Gérard Meric v Office for Harmonization of the Internal Market*, General Court ('GC'), case T-133/05.

and preparations for making energizers; products and preparations for making refreshing beverages and micro-elements concentrated beverages; syrups for beverages. This leaves the IR's term *sorbets* which, in class 32, are beverages and therefore fall within the ambit of the opponent's term *other non-alcoholic beverages*. The goods of both parties are therefore identical.

Average consumer and the purchasing process

11. The respective goods are non-alcoholic drinks and preparations for making drinks. The average consumer is reasonably well informed and reasonably circumspect and observant, but his level of attention is likely to vary according to the category of goods. The average consumer for these goods is the general public and the goods are those costing relatively little and which will be purchased frequently. A reasonable level of attention (but no higher or lower than the norm) will be paid to their selection, which is largely a visual process. Drinks will be selected from a shelf in a retail outlet. Even in the case of ordering drinks, such as in a restaurant, café or bar, the bottle is still likely to be visible (i.e. behind a counter)⁴ so that there is still a visual element to the purchase in addition to the oral/aural method of selection. Overall, whilst oral considerations are not ignored, visual perception is likely to be primary.


Comparison of trade marks

12. The authorities direct that, in making a comparison between the marks, I must have regard to each mark's visual, aural and conceptual characteristics. I have to decide which, if any, of their components I consider to be distinctive and dominant, without engaging in an artificial dissection of the marks, because the average consumer normally perceives a mark as a whole and does not analyse its details.

13. The marks to be compared are:

⁴ In *Simonds Farsons Cisk plc v Office for Harmonization in the Internal Market* (OHIM) Case T-3/04, the GC said: "58 In that respect, as OHIM quite rightly observes, it must be noted that, even if bars and restaurants are not negligible distribution channels for the applicant's goods, the bottles are generally displayed on shelves behind the counter in such a way that consumers are also able to inspect them visually. That is why, even if it is possible that the goods in question may also be sold by ordering them orally, that method cannot be regarded as their usual marketing channel. In addition, even though consumers can order a beverage without having examined those shelves in advance they are, in any event, in a position to make a visual inspection of the bottle which is served to them.

59 Moreover, and above all, it is not disputed that bars and restaurants are not the only sales channels for the goods concerned. They are also sold in supermarkets or other retail outlets (see paragraph 14 of the contested decision), and clearly when purchases are made there consumers can perceive the marks visually since the drinks are presented on shelves, although they may not find those marks side by side."

| Opponent's mark | IR |
|-----------------|--|
| MOOVE |  |

14. The opponent's mark consists of a single component which does not separate into comparative distinctive and dominant components. The holder's mark is composed of a number of elements. The holder contends that the use of bold colours makes the mark visually more striking; however this is irrelevant for the purposes of my comparison: see *Mary Quant Cosmetics Japan Ltd v. Able C&C Co Ltd*, O-246-08, Mr Geoffrey Hobbs QC, sitting as the appointed person, and the recent judgment of Mr Justice Mann in *Specsavers International Healthcare Limited & Others v Asda Stores Limited* [2010] EWHC 2035 (Ch). That being the case, what the holder refers to as background is to be assessed as a device (this is the alternative expression used by the holder), partitioned by a very wavy line with the numeral 4 and the word MOVE across the centre of the device. The starkly contrasting halves of the device are striking to the eye, but are relatively subordinate to the 4 MOVE elements as these are large, span the width of the device and are superimposed upon the device. Although 4 appears at the beginning of the mark and 4 is the element that will be read first, MOVE is longer than 4, giving it a degree of more dominance than the 4.

15. The similarity between the marks centres on the MOOVE and MOVE elements, although the comparison cannot be made solely on this basis because the other elements of the IR are not negligible. There are visual similarities between MOOVE and MOVE as they differ only by one letter; however, factoring the other elements of the IR into the overall visual comparison, I consider the level of visual similarity to be moderate.

16. There is more in the way of aural similarity between MOOVE and MOVE than there is visually, despite the holder's submission that MOOVE will be pronounced MOO-VE, with emphasis on the OO, taking longer to pronounce than MOVE. In my view, MOOVE and MOVE will be pronounced in an identical, or near-identical way. This supposition goes somewhat to the conceptual significance of MOVE, which I will come to below. The numeral 4 is pronounceable and, I consider, would be pronounced; being positioned in front of MOVE, it is the 4 ('for') sound which will be heard first in the holder's mark. (The device, of course, is not relevant to aural consideration of the mark). Weighing the different element at the beginning of the holder's mark (the 4) with the close proximity of the sound of MOOVE and MOVE, there is a reasonable degree of aural similarity between the marks.

17. MOVE is a common English word, the primary meaning of which (to change position or location) will be clear to the average UK consumer (and thus its pronunciation). MOOVE, on the other hand, is not a dictionary word: when perceived visually it is an invention without meaning. The device in the holder's mark has no concept. The opponent claims that the numeral 4 is a descriptor suggesting four ingredients or four flavours. The holder submits that the numeral 4 will either be seen as FOUR or FOR, the latter being commonly substituted in modern marketing by the numeral 4. The argument that it will be seen as the numeral version of the word FOUR is to be preferred because FOR MOVE makes no grammatical sense. The substitution of FOR by 4 will not occur to the average consumer because it is not a natural linguistic construction. Although the element 4 and the element MOVE have their own concepts, the combination of 4 MOVE has no concept. The opponent's mark has not concept when seen, but when heard it will sound the same as MOVE so, aurally, there is potential for a similarity in concept between MOOVE and MOVE. Comparing the two marks in totality and factoring in the different visual and aural conceptual considerations, there is either no conceptual similarity or a moderate degree of conceptual similarity. The level of overall similarity between the marks is low.

Distinctiveness of the opponent's mark

18. It is necessary to consider the distinctive character of MOOVE because the more distinctive it is, either by inherent nature or by use (nurture) the greater the likelihood of confusion⁵. The distinctive character of a trade mark must be assessed by reference to the goods or services in respect of which registration is sought and by reference to the way it is perceived by the relevant public⁶. The opponent has not filed evidence of use of the mark so cannot claim the benefit of enhanced distinctive character through use. Nevertheless, MOOVE is likely to be seen in the UK as an invented word, so its inherent distinctive character is high; if it is heard as MOVE, then it will still be reasonably high as it will not describe or allude to drinks.

Likelihood of confusion

19. Both sides have pointed to decisions from other jurisdictions. The opponent has cited a French decision, but MOVE is not a French word, so the considerations in comparison to MOOVE are substantially different compared to the perception of the words in the UK. The holder refers to the acceptance of the IR in Ireland and Portugal: this has no bearing on the assessment I must make, the reasons for a lack of ex parte relative grounds objections and/or opposition in those territories being irrelevant to the opposition in the UK jurisdiction.

⁵ *Sabel BV v Puma AG* [1998] RPC 199.

⁶ *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91.

20. In deciding whether there is a likelihood of confusion between the marks, I must weigh the various factors I have identified and also bear in mind the principle of interdependency, whereby a lesser degree of similarity between the goods may be offset by a greater degree of similarity between the trade marks, and vice versa (*Canon*). The goods of the parties are identical. I keep in mind the whole mark comparison and the effect which the predominantly visual and reasonably, but not particularly, attentive purchasing process has upon the weight of these elements. Although the high point in terms of similarity of the marks is the aural aspect, more weight falls on the visual comparison⁷; aural similarity is not necessarily determinative, as per the judgment of the GC in *Mülhens GmbH & Co KG v OHIM* Case C-206/04 P:

“21 It is conceivable that the marks’ phonetic similarity alone could create a likelihood of confusion within the meaning of Article 8(1)(b) of Regulation No 40/94 (see, in respect of Directive 89/104, *Lloyd Schuhfabrik Meyer*, paragraph 28). However, it must be noted that the existence of such a likelihood must be established as part of a global assessment as regards the conceptual, visual and aural similarities between the signs at issue. In that regard, the assessment of any aural similarity is but one of the relevant factors for the purpose of that global assessment.

22 Therefore, one cannot deduce from paragraph 28 of the judgment in *Lloyd Schuhfabrik Meyer* that there is necessarily a likelihood of confusion each time that mere phonetic similarity between two signs is established.”

Visual perception of the mark includes the device element which forms part of the overall perception of the IR, as per *Shaker*⁸. The average consumer rarely has the opportunity to compare marks side by side, relying instead upon the imperfect picture he has of them in his mind; in the case of the IR, this picture will be of the composite mark rather than a dissected recollection of it. The visual recollection will not be one of a shared conceptual hook or evocation. Although

⁷ *New Look Ltd v OHIM* Joined cases T-117/03 to T-119/03 and T-171/03.

⁸ “41 It is important to note that, according to the case-law of the Court, in the context of consideration of the likelihood of confusion, assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark. On the contrary, the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components (see order in *Matratzen Concord v OHIM*, paragraph 32; *Medion*, paragraph 29).

As the Advocate General pointed out in point 21 of her Opinion, it is only if all the other components of the mark are negligible that the assessment of the similarity can be carried out solely on the basis of the dominant element.”

lack of conceptual similarity does not always offset visual or aural similarity⁹, the factors in this case in terms of overall visual perception and lack of conceptual visual similarity in what is primarily a visual purchase combine to militate against a likelihood of direct confusion. There is also no common theme, no natural brand extension nor a variation in the marks which would cause the average consumer to expect the undertaking responsible for each mark to be economically connected so as to cause indirect confusion. The opposition fails.

Costs

21. The holder has been successful and is entitled to an award of costs on the following basis¹⁰:

| | |
|---|-------------|
| Considering the other side's statement and preparing a counterstatement: | £400 |
| Preparing evidence and considering and commenting on the other side's evidence: | £500 |
| Total: | £900 |

22. I order to pay Sumol + Compas Marcas, S.A. to pay to Foodcare Spolka Z.O.O. the sum of £900. 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 6 day of June 2011

**Judi Pike
For the Registrar,
the Comptroller-General**

⁹ As per the GC in *Nokia Oyj v OHIM* Case T-460/07: "Furthermore, it must be recalled that, in this case, although there is a real conceptual difference between the signs, it cannot be regarded as making it possible to neutralise the visual and aural similarities previously established (see, to that effect, Case C-16/06 P *Éditions Albert René* [2008] ECR I-0000, paragraph 98)."

¹⁰ As per the scale in Tribunal Practice Notice 4/2007.