

O-185-13

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO 2602310
BY
ST KEW PRODUCTS LIMITED
TO REGISTER THE TRADE MARK

KEEP CALM AND CARRY ON

IN CLASS 30

AND

THE OPPOSITION THERETO
UNDER NO 103409
BY
KEEP CALM AND CARRY ON BEVERAGE COMPANY LIMITED

BACKGROUND

1. On 23 November 2011, St Kew Products Limited (hereafter the applicant), applied to register the above trade mark in class 30 of the Nice Classification system, as follows:¹

Bakery Products; Biscuits; Fudge

2. Following publication of the application on 9 March 2012, KEEP CALM AND CARRY ON BEVERAGE COMPANY LIMITED (the opponent) filed notice of opposition against the application.

3. The grounds of opposition were brought under sections 5(2)(a) and 5(3) of the Trade Marks Act 1994 (the Act). The 5(3) ground was subsequently removed.

4. The opposition is directed at some of the applicant's goods in class 30, namely biscuits and fudge. The opponent relies upon the mark shown below:

MARK DETAILS AND RELEVANT DATES	RELEVANT GOODS
<p>TM: 2581816</p> <p>MARK: KEEP CALM AND CARRY ON</p> <p>Filing date: 19 May 2011</p> <p>Registration date: 30 December 2011</p>	<p>Boiled sweets, chewing sweets (non-medicated), chewing sweets (non-medicated having liquid fruit fillings, chocolate sweets, foamed sugar sweets, gum sweets (non-medicated), non-medicated sweets, panned sweets (non-medicated), sal ammoniac liquorice sweets (non-medicated), sweets (non-medicated), sweets (non-medicated) being acidulated, sweets (non-medicated) being acidulated caramel sweets, sweets (non-medicated) being alcohol based, sweets (non-medicated) being honey based, sweets (non-medicated) containing herbal flavourings, sweets (non-medicated) in compressed form, sweets (non-medicated) in the form of robins, sweets (non-medicated) in the nature of caramels, sweets (non-medicated) in the nature of chocolate eclairs, sweets (non-medicated) in the nature of nougat, sweets (non-medicated) in the nature of sugar confectionery, sweets (peppermint), chewing gum, not for medical purposes, gum (chewing), not for medical purposes, gum for chewing (other than for medicinal purposes), mint flavoured chewing gum (other than for medical use), non-medicated chewing gum, sugar free chewing gum (not for medical purposes), chocolate confectionery, chocolate sweets; but not including sweets (non-medicated) in the nature of fudge; sweets (non-medicated) in the nature of toffees.</p>

¹ *International Classification of Goods and Services for the Purposes of the Registration of Marks under the Nice Agreement (15 June 1957, as revised and amended).*

5. In its statement of grounds the opponent submits:

“4. The Applicant’s proposed use of the mark on [biscuits and fudge] will because of the very nature of the products cause confusion to the public due to a lack of distinctiveness – especially since it is market practice for the goods covered by this companys [sic] registered trade mark to be sold by retailers side by side with the goods [biscuits and fudge].”

6. On 12 September 2012, the applicant filed a counter statement. It denies the grounds on which the opposition is based.

7. The opponent’s marks are earlier marks not subject to proof of use because, at the date of publication of the applications, neither of them had been registered for five years.²

8. Neither of the parties filed evidence or submissions in lieu of attendance at a hearing. Neither party requested a hearing, both content for a decision to be made from the papers on file.

DECISION

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

“5. - (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,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

Relevant case law

10. In his decision in *La Chemise Lacoste SA v Baker Street clothing Ltd* - BL O/330/10 (approved by Arnold J in *Och-Ziff Management Europe Ltd v Och Capital LLP* [2011] FSR 11), the Appointed Person, Mr Geoffrey Hobbs QC, expressed the test under this section (by reference to the CJEU cases mentioned) on the basis indicated below:

The CJEU cases

11. *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; *Matratzen Concord GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-6/01; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04; *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* C-334/05 P.

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.

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, in certain circumstances, be dominated by one or more of its components;

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite 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 causes the public to wrongly believe that the respective goods [or services] come from the same or economically-linked undertakings, there is a likelihood of confusion.”

The average consumer and the nature of the purchasing act

12. In accordance with the above cited case law, I must determine who the average consumer is and consider the nature of the purchasing process. The average consumer is reasonably well informed and reasonably circumspect and observant, but with a level of attention likely to vary according to the category of goods at issue.

The attention paid is likely to vary depending on price and, to some extent, the nature of the goods and the frequency of the purchase.

13. The respective goods are foodstuffs. The average consumer of these goods will be a member of the general public. The purchase is likely to be primarily visual as it is likely to be made directly from a shelf or from a website. These are relatively low value fairly frequent purchases; the average consumer may pay attention, to the extent that they will consider, inter alia, ingredients, calories and taste. However, the level of attention paid to the purchase of such goods will be low.

Comparison of goods

14. The goods to be compared are as follows:

Opponent's goods	Applicant's goods
<p>Class 30 Boiled sweets, chewing sweets (non-medicated), chewing sweets (non-medicated) having liquid fruit fillings, chocolate sweets, foamed sugar sweets, gum sweets (non-medicated), non-medicated sweets, panned sweets (non-medicated), sal ammoniac liquorice sweets (non-medicated), sweets (non-medicated), sweets (non-medicated) being acidulated, sweets (non-medicated) being acidulated caramel sweets, sweets (non-medicated) being alcohol based, sweets (non-medicated) being honey based, sweets (non-medicated) containing herbal flavourings, sweets (non-medicated) in compressed form, sweets (non-medicated) in the form of robins, sweets (non-medicated) in the nature of caramels, sweets (non-medicated) in the nature of chocolate eclairs, sweets (non-medicated) in the nature of nougat, sweets (non-medicated) in the nature of sugar confectionery, sweets (peppermint), chewing gum, not for medical purposes, gum (chewing), not for medical purposes, gum for chewing (other than for medicinal purposes), mint flavoured chewing gum (other than for medical use), non-medicated chewing gum, sugar free chewing gum (not for medical purposes), chocolate confectionery, chocolate sweets; but not including sweets (non-medicated) in the nature of fudge; sweets (non-medicated) in the nature of toffees.</p>	<p>Class 30 Biscuits; Fudge</p>

15. In comparing the goods, I bear in mind the following guidance provided by the General Court (GC) in *Gérard Meric v OHIM*, Case T-133/05:

“29. ...goods can be considered identical when the goods designated by the earlier mark are included in a more general category, designated by the trade

mark application or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark.”

16. Other factors which may be considered include the criteria identified in *British Sugar Plc v James Robertson & Sons Limited (Treat)* [1996] R.P.C. 281 (hereafter *Treat*) for assessing similarity between goods and services:

- (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 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, taking into account how goods/services are classified in trade.

17. In its counterstatement the applicant submits:

“5...as a consequence of action by Applicant, Opponent [sic] has expressly excluded from their registered rights all of the specific Goods of Applicant's Application. Their Opposition is therefore without merit. It is submitted that an Opponent cannot oppose Registration of Goods it has expressly excluded from its registered rights.”

18. The concluding line of the opponent's specification states:

“but not including sweets (non medicated) in the nature of fudge; sweets (non medicated) in the nature of toffees”.

19. In making a comparison of goods in order to determine whether or not there is a likelihood of confusion it is necessary to consider a broader category of goods than just those which are strictly identical.

20. The application includes fudge, the opponent's specification includes, inter alia, caramel sweets, nougat sweets and honey based sweets as well as chocolate sweets. The users of both parties' goods are members of the general public. Such products will be bought as a sweet treat. The goods may be individually wrapped and could be sold in packets, tubes or in the form of a bar. The goods are available in many retail establishments including supermarkets, smaller stores and from websites. The products will be presented side by side on the same shelves. The goods are not complementary in the sense that one is indispensable for the use of the other. They are in competition; one could buy fudge in place of a chocolate, caramel etc. Taking these factors into account I find these goods to be highly similar.

21. The contested 'biscuits' in the application include a range of products which are normally baked, may be presented in a range of sizes and shapes and may include a wide variety of ingredients, toppings and fillings. The goods of the earlier mark are sweets and items of confectionery. The goods will be bought by members of the general public. Both types of goods will be purchased as a sweet treat or snack. They are likely to be available in the same stores, in similar areas of the store if not on the same shelves. The term 'biscuits', at large, includes any number of baked biscuits and/or wafers which may be filled with and/or covered in chocolate. These goods are clearly in competition with chocolate confectionary, especially when one considers that some chocolate confectionary may also include a baked or wafer element. Furthermore, the goods at large are in competition with each other to the extent that a consumer intending to purchase a sweet snack may choose any one of these goods. Consequently, I find these goods to have at least a reasonable degree of similarity.

Comparison of marks

22. The marks to be compared are as follows:

The opponent's mark	The applicant's mark
KEEP CALM AND CARRY ON	KEEP CALM AND CARRY ON

Visual, aural and conceptual similarities

23. The parties' marks consist of the five words 'KEEP CALM AND CARRY ON' which hang together as a single phrase and are visually, aurally and conceptually identical.

Distinctive character of the earlier mark

24. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods for which it has been used as coming from a particular undertaking and thus to distinguish those goods and services from those of other undertakings - *Windsurfing Chiemsee v Huber* and *Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

25. The opponent's mark consists of the ordinary words 'KEEP CALM AND CARRY ON'. The mark in its totality does not serve to describe the goods at issue, nor is it non-distinctive for those goods. Consequently, the mark possesses a normal degree of inherent distinctive character.

Likelihood of confusion

26. In assessing the likelihood of confusion, I must adopt the global approach advocated by case law and take into account the fact that marks are rarely recalled perfectly, the consumer relying instead on the imperfect picture of them he has kept

in his mind.³ I must also keep in mind the average consumer for the goods, the nature of the purchasing process and have regard to the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa.

27. I have found the marks to be visually, aurally and conceptually identical. I have found a reasonably high level of inherent distinctive character in the earlier mark and have found the goods to be highly similar in the case of fudge and at least reasonably similar in the case of biscuits. I have identified the average consumer, namely a member of the general public and have concluded that a low degree of attention will be paid to the purchase of such goods though the average consumer may take consider particular ingredients, calories, and so on.

28. Taking all of these factors into account the identical nature of the marks means that in the context of goods which possess a reasonable degree of similarity there will, in my view, be direct confusion (where one mark is mistaken for the other). Even if I am wrong in this, there will be indirect confusion (where the average consumer believes the respective goods originate from the same or a linked undertaking).

Conclusion

29. The opposition succeeds.

Costs

30. The opposition having succeeded, the opponent, is entitled to a contribution towards its costs. I have taken into account that no hearing has taken place and that no evidence or written submissions in lieu of a hearing were filed. I make the award on the following basis:

Preparing a statement and considering the other side's statement:	£300
Official fee:	£200
Total	£500

31. I order St Kew Products Limited to pay KEEP CALM AND CARRY ON BEVERAGE COMPANY LIMITED the sum of £500. 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 8th day of May 2013

**Ms Al Skilton
For the Registrar,
The Comptroller General**

³ *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27.