

O/301/13

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NOS. 2570515, 2570516 & 2570517
BY MRS BRENDA ROBINSON & MR MARK ROBINSON
TO REGISTER THE TRADE MARKS:**

OMEGASMART

OMEGAMAYO

&

OMEGABEE

IN CLASS 30

AND:

**CONSOLIDATED OPPOSITIONS THERETO UNDER NOS. 102059, 102060 & 102061
BY MARKANT HANDELS UND SERVICE GMBH**

BACKGROUND

1. On 28 January 2011, Mrs Brenda Robinson and Mr Mark Robinson (“the applicants”) applied to register the trade marks shown on the cover page of this decision. The applications were accepted and published for opposition purposes on 18 March 2011 for a range of goods in class 30. Following the filing of a form TM21 on 29 March 2012, the specifications now read as follows:

No. 2570515 – OMEGASMART – Peanut butter, dressings, spreads, breakfast spreads; sauces (condiments); all containing or fortified with omega fatty acids.

No. 2570516 – OMEGAMAYO – Flour and preparations made from flour, cereals and preparations made from cereals, bread, pastry and confectionery including jellies and chocolates, ices; honey, treacle, jams, peanut butter, dressings, spreads, mayonnaise, breakfast spreads; sauces (condiments); all containing or fortified with omega fatty acids.

No. 2570517 – OMEGABEE - Flour and preparations made from flour, cereals and preparations made from cereals, bread, pastry and confectionery including jellies and chocolates, ices; honey, treacle, jams, peanut butter, dressings, spreads, breakfast spreads; sauces (condiments); all containing or fortified with omega fatty acids.

2. On 16 June 2011, MARKANT Handels und Service GmbH (“the opponent”) filed notices of opposition directed against each application and against all of the goods for which they were originally published. The oppositions are based upon a single ground under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”) for which the opponent relies upon all of the goods in the following trade mark registration:

CTM no. 6685614 for the trade mark **OMEGA** applied for on 21 February 2008 and which completed its registration procedure on 5 July 2010. It stands registered for:

Class 29 - Meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies, jams, fruit sauces; eggs, edible oils and fats.

Class 30 - Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, except bread mixes and prepared baking mixes (not included in other classes), for making bread; pastry and confectionery, ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice.

Class 32 - Beers; non-alcoholic drinks except for waters and lemonades; fruit drinks and fruit juices; syrups and other preparations for making beverages.

3. On 23 March 2012, the applicants filed counterstatements in which they deny the opponent’s claims. The applicants state:

“d) There is (and at the date of application was) wide spread/established use in the United Kingdom of the term OMEGA and terms and trade marks including the word OMEGA in the food classes to refer to particular fatty acids and goods which include or are fortified with these fatty acids. Omega fatty acids are widely promoted and there is a high awareness of them as a result of claims of them having health benefits in boosting brain power, reducing cholesterol, boosting the immune system etc. In these circumstances, the average consumer would take the OMEGA prefix in the mark[s] applied for as indicating that the goods contain/are fortified with omega fatty acids.

e) The applicants deny that the application[s] cover identical/similar goods to those covered by the opponent’s mark.

f) The applicants are the proprietors of a UK trade mark registration for the mark OMEGAHONEY – the registration of which (UK no. 2468268) predates the mark upon which the opposition is based and have used/promoted this and the mark[s] applied for in the United Kingdom prior to the date of the mark upon which the opposition is based.

g) The applicants make no admission and indeed deny the validity/level of distinctiveness of the mark upon which the opposition is based.”

4. Whilst only the applicants filed evidence, the opponent filed two sets of written submissions (dated 27 September 2012 and 29 January 2013) during the evidential rounds. Neither party asked to be heard; I will refer to the submissions filed as necessary below.

EVIDENCE

5. This consists of a witness statement from Jill Matchett a trade mark attorney at Barker Brettell LLP, the applicants’ representatives. Attached to Ms Matchett’s statement are six exhibits. The majority of these exhibits have been provided to demonstrate (to use the applicants’ words) that:

“6...the average consumer will take the OMEGA prefix in the applied for marks as indicating the products contain/are fortified with omega fatty acids.”

6. Exhibit JM1 consists of pages taken from the applicants’ website www.naturesblend.com showing the type of food products of interest to the applicants i.e. those which contain or are fortified with omega fatty acids.

7. Exhibit JM2 is described by Ms Matchett as:

“7...copies of various articles and materials which...illustrate the meaning of the term omega in relation to diet/foods and awareness thereof. These include articles/items from the online versions of national newspapers, the website of the

BBC as well as charities, government organisations and from amazon.co.uk showing the availability of recipe books etc. on the subject.”

In its submissions, the opponent comments upon this evidence in the following terms:

“8. ...It is also clear after reviewing the documents...that the term omega is not used alone in relation to foodstuffs as it is not a recognised term in this field. Indeed, the terms omega-3, omega-6, omega-9 and omega-3 fatty acids are referred to in the documents submitted..(not OMEGA) as it these terms that are recognised in the food sector...”

8. Exhibit JM3 consists of extracts taken from various trade publications which Ms Matchett explains shows:

“8...use, promotion and availability of omega inclusive/enhanced food products by major food manufacturers/in major retailers in the UK.”

9. Exhibit JM4 consists of copies of packaging which, states Ms Matchett, shows: “use of the term OMEGA on food products.” The opponent criticises this evidence on the same basis as above.

Ms Matchett states:

“9. There are also numerous coexisting marks already registered on the UK and CTM registers in the food classes for marks which contain the element OMEGA...While I accept that entries on the register do not necessarily reflect the situation in the marketplace, it seems to me that given the numerous coexisting entries these results must reflect the fact that in the food classes, the term is one which the trade considers to be descriptive/common.”

10. Exhibit JM5 consists of the results of a search showing “some of these marks.” In its submissions, the opponent argues that this state of the register evidence is irrelevant to these proceedings, adding:

“10...other than to point out that the applicant provides a number of examples of marks containing the term OMEGA 3/OMEGA 6/OMEGA 7, rather than just OMEGA...”

11. That concludes my summary of the evidence filed to the extent that I consider it necessary.

DECISION

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

“5 (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, or

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

13. An earlier trade mark is defined in section 6 of the Act, 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 or international trade mark (EC) 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,

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

14. In these proceedings the opponent is relying upon the trade mark shown in paragraph 2 above, which constitutes an earlier trade mark under the above provisions. Given the interplay between the date on which the application was published and the date on which the opponent’s registration completed its registration procedure, the earlier trade mark is not subject to proof of use, as per section 6A of the Act.

Section 5(2)(b) – case law

15. 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 Court of Justice of the European Union (CJEU) cases mentioned) on the basis indicated below:

The CJEU cases

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.

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 process

16. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties’ goods and then to determine the manner in which these goods will be selected by the average consumer in the course of trade. The goods at issue in these proceedings are, broadly speaking, foodstuffs. The average consumer for such goods will be the general public who will, for the most part, self-select the goods from a range of retail outlets such as supermarkets, convenience stores and on-line. While aural considerations must not be overlooked, it is the visual aspect of the competing trade marks that is likely to dominate the selection process. As the goods at issue are low cost items which will be bought on a fairly regular basis, the degree of attention paid to their selection is likely to be (at best) moderate.

Comparison of goods

The opponent’s goods	The applicants’ goods
<p>Although in its notice of opposition the opponent relied upon all of the goods in its earlier trade mark, in its submissions it relied only upon those goods in classes 29 and 30 i.e.</p> <p>Class 29 - Meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies, jams, fruit sauces; eggs, edible oils and fats.</p> <p>Class 30 - Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, except bread mixes and prepared baking mixes (not included in other classes), for making</p>	<p>As the specification of trade mark no. 2570516 – OMEGAMAYO contains all of the goods of the two other applications (as well as mayonnaise), it is this specification which I will use for the purpose of comparison i.e.</p> <p>Flour and preparations made from flour, cereals and preparations made from cereals, bread, pastry and confectionery including jellies and chocolates, ices; honey, treacle, jams, peanut butter, dressings, spreads, mayonnaise, breakfast spreads; sauces (condiments); all containing or fortified with omega fatty acids.</p>

bread; pastry and confectionery, ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice.	
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17. The leading authorities on how to determine similarity between goods and services are considered to be *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 117 and *British Sugar Plc v James Robertson & Sons Ltd (Treat)* [1996] R.P.C. 281. In the first of these cases the CJEU accepted that all relevant factors should be taken into account including the nature of the goods/services, their intended purpose, their method of use and whether they are in competition with each other or are complementary. The criteria identified in the *Treat* case were:

- (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 respectively 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. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

18. In reaching a conclusion, I will also keep in mind the decision of the General Court in *Gérard Meric v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* case T-133/05 i.e.

“29 In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 *Oberhauser v OHIM – Petit Liberto (Fifties)* [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 *Vedial v OHIM – France Distribution (HUBERT)* [2002] ECR II-5275, paragraphs 43 and 44; and Case T- 10/03 *Koubi v OHIM – Flabesa (CONFORFLEX)* [2004] ECR II-719, paragraphs 41 and 42).”

19. In *Les Editions Albert René v OHIM* Case T-336/03 the GC considered the relationship between a finished article and component parts. The court said:

“The mere fact that a particular good is used as a part, element or component of another does not suffice in itself to show that the finished goods containing those components are similar since, in particular their nature, intended purpose and the customers for those goods may be completely different.”

20. In its first round of submissions the opponent provided a detailed explanation of why it considered the competing goods to be identical or similar. In its evidence the applicants did not specifically respond to these submissions other than to say that its goods are “functional foods”, explaining that this means foods where an additional ingredient is added. The applicants went on to state:

“5...These are a specific type of product and arguably not the same or similar as the more general products covered by the opponent’s mark.”

21. Although the applicants have limited their goods to: “all containing or fortified with omega fatty acids”, as the opponent points out, its goods are not limited in any way. Consequently, the fact that the applicants’ goods are limited in the manner indicated does not assist them.

22. A number of terms in the applicants’ specification either find identically worded terms in the opponent’s specifications or are identical on the principle outlined in *Gérard Meric*. The goods which fall into this category are: “flour” (identically worded), “preparations made from cereals” (identically worded), “bread” (identical as it would be included in “preparations made from cereals”), “pastry and confectionery including jellies and chocolates” (identical as all the named goods would be included in “pastry and confectionery”), “ices” (identical), “honey” (identical), “treacle” (identical), “dressings” (identical as it would be included in “sauces (condiments)”, “spreads” and “breakfast spreads” (identical as both terms would include “honey”), “mayonnaise” (identical as it would be included in “sauces and condiments”) and “sauces (condiments)” (identical). Although the applicants have applied for “jams” in class 30, “jams” are (as per the opponent’s earlier trade mark) proper to class 29. Notwithstanding this error of classification, the goods are identical. That leaves “preparations made from flour”, “cereals” and “peanut butter” to consider. In its submissions the opponent states:

“11...peanut butter, spreads and breakfast spreads are similar to...jams, honey and mustard in that they all can be used as spreads.

17... flour and preparations made from flour are similar to...flour and preparations made from cereals in that flour is made from grinding cereal grains.

19...cereals are similar to...preparations made from cereals.”

23. In reaching a conclusion on the similarity or otherwise of the goods that remain, my starting point is that whilst at a high level of generality the users (i.e. the general public) and intended purpose of the competing goods (i.e. for consumption) are the same, this is the case for all food products and tells one little; one needs to dig deeper. Although “preparations made from flour” in the application will include a range of goods where flour is only a constituent part, as the term would include, for example biscuits, and “preparations made from cereals” (in the earlier trade mark) would include, for example, cereal bars (see below), in addition to the more general areas of similarity I highlighted above, such goods are likely to have a similar physical nature and similar trade channels i.e. they will be sold in the same aisle of, for example, a supermarket. In addition, as one product may be chosen as an alternative to the other, there is an element of competition between them. Considered overall, the competing goods are, in my view, similar to a high degree. Although “preparations made from cereals” in the earlier trade mark will also include a range of goods where cereals are only a constituent part, as the term includes, for example, cereal bars (which may be no more than cereals formed into a particular shape), “cereals” in the applicants’ specification are, in my view, similar to “preparations made from cereals” to a high degree. That leaves “peanut butter”. This is likely to have the same physical nature and method of use as both “honey” and “jam” i.e. they may all be provided as spreads and, insofar as channels of trade are concerned, all are likely to be found in the same aisle of a supermarket. As one may be selected as an alternative to the other, there is an element of competition between them. Considered overall, I think that although the basic ingredient of the competing goods is different, there is at least a reasonable degree of similarity between them.

Conclusion on the similarity of goods

24. With the exception of “peanut butter” which I have found to be similar to at least a reasonable degree, all of the goods at issue are either identical or highly similar.

Comparison of trade marks

25. The competing trade marks are as follows:

The opponent’s trade mark	The applicants’ trade marks
OMEGA	OMEGASMART OMEGAMAYO OMEGABEE

26. It is well established that the average consumer is considered to be reasonably well informed, circumspect and observant but perceives trade marks as a whole and does not pause to analyse their various details. In addition, he/she rarely has the chance to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he/she has kept in his or her mind. In reaching a conclusion on similarity I must compare the respective trade marks from the visual, aural and conceptual perspectives identifying, where appropriate, what I consider to be the

distinctive and dominant elements of the respective trade marks. In its submissions the opponent states:

“5. All of the applicants’ marks incorporate the whole of the opponent’s mark OMEGA in full and begin with this word element...

6. In addition, the suffixes of MAYO and BEE in the applicant’s marks are descriptive of the applicant’s marks in that they inform the consumer that they provide mayonnaise and honey containing omega fatty acids. Furthermore, the suffix SMART merely suggests that if the consumer eats the goods produced under the applicant’s mark that they are smart.

7. Since the suffixes of the applicant’s marks are descriptive and non-distinctive they will go unnoticed by the relevant consumer who will instead focus on the prefix to the applicant’s marks...”

In her statement Ms Matchett states:

“6...There are clearly visual and phonetic differences between [the competing trade marks] in terms of their length, appearance and pronunciation.” Also...the average consumer will not attribute the same meaning to the word OMEGA on its own as to it in combination with other matter in the marks applied for where OMEGA is subsumed into what appear to be invented words.”

The opponent responded to these submissions in the following terms:

“3...Although the applicant argues that their marks are neologisms, the relevant consumer would naturally split the applicant’s marks into two because they recognise the prefix OMEGA and [the various suffixes]. Indeed, the human mind is logical and focuses on what it recognises in terms of words. It therefore recognises words within words and splits them accordingly. As such, the applicant’s marks will be seen and heard by the relevant consumer as OMEGA – MAYO, OMEGA – BEE and OMEGA – SMART.

4...The suffixes to the applicant’s marks therefore add no distinctive character and the prefix OMEGA has an independent and distinctive character in the applicant’s marks as the eye naturally segregates it from the above suffixes.

5. The term OMEGA means “the 24th and last letter of the Greek alphabet; the ending or last of a series” according to Collins English Dictionary. OMEGA has no other meaning in the dictionary as it is written above. As such, the applicant’s argument that the “use of the term omega in the food classes to refer to omega fatty acids and goods which include omega fatty acids” is firmly rejected. The words OMEGA and omega fatty acids have different meanings. Indeed if you refer to the Collins English Dictionary the term OMEGA stands on its own. However, there are three other entries that begin with OMEGA but are followed

with a separate word/number thereafter being: Omega minus: “an unstable negatively charged elementary particle, classified as a baryon, that has a mass 3276 times that of the electron”, Omega 3: “a type of unsaturated fatty acid present in some foodstuffs, especially fish oils, the consumption of which may reduce the risk of heart disease” and Omega 3 fatty acid: “an unsaturated fatty acid that occurs naturally in fish oil and is valuable in reducing blood cholesterol levels”.

27. As the opponent’s trade mark consists exclusively of the word OMEGA presented in upper case, its distinctiveness can lie only in its totality. The same word, also presented in upper case, constitutes the first five letters of the applicants’ trade marks. Although the applicants’ trade marks also contain the suffixes SMART, MAYO and BEE presented in upper case and which together with the word OMEGA form part of a unified whole, as all four words will be well known to the average consumer, I agree with the opponent that the average consumer is likely to notice that they form part of the applicants’ trade marks.

28. As to the distinctiveness of the word OMEGA, on the basis of the evidence provided, in particular the evidence in exhibits JM2 and JM3 and, to a lesser extent, the evidence in exhibit JM5 (in relation to which the comments of Mr Daniel Alexander QC, sitting as a deputy judge of the High Court in *Digipos Store Solutions Group Ltd v Digi International Inc* [2008] RPC 24 are relevant), there can, in my view, be little doubt that at the material date in these proceedings (i.e. 28 January 2011), the average consumer of the goods at issue had been educated to the perception that (at the very least) Omega 3 is added to a wide range of products and that this fatty acid may have beneficial health related properties (the applicants’ trade marks have of course been limited to reflect the fact they contain or are fortified with omega fatty acids). Whilst there are some examples in exhibits JM2 to JM4 of the word OMEGA being used alone, I agree with the opponent that the vast majority of the use in the exhibits mentioned refers to OMEGA in combination with other indications e.g. a numeral, a numeral and letter or together with words such as fatty acid(s), oils etc.

29. However, I think it most unlikely that the average consumer will remember and understand the differing forms of omega fatty acids and their related numbers/properties. Rather, at the material date, I think the word OMEGA alone would have communicated to the average consumer that the product concerned contained omega fatty acids of one sort or another. As a consequence, while the word OMEGA may, by virtue of its positioning, be a dominant element of the applicants’ trade marks, it is not, in my view, a distinctive element. As to the words which accompany this word, I am prepared to accept on judicial notice that the word MAYO in the OMEGAMAYO trade mark would be understood by the average consumer to mean mayonnaise and would lack distinctive character for such goods, as would the trade mark as a whole when considered in relation to such goods. As to the words BEE and SMART, I have reproduced above the opponent’s arguments as to why it considers these words to be descriptive. Whilst I accept that honey may be supplemented with omega fatty acids, that honey is produced by bees and that the evidence also shows that one of the

reported benefits of the use of omega fatty acids is to improve mental ability, when considered as totalities, the meanings of OMEGABEE and OMEGASMART are, in my view, difficult to penetrate. As a consequence, the distinctive character of these trade marks lies, in my view, in the totalities they create rather than the elements of which they are made up.

30. Notwithstanding that the suffixes in the applicants' trade marks are alien to the opponent's trade mark, the fact that the competing trade marks consist or of contain as their first five letters the word OMEGA, and as the applicants' trade marks would be articulated as the words OMEGA (space) SMART etc. results, in my view, in a reasonable degree of both visual and aural similarity between them. The fact that both parties' trade marks are likely to create in the average consumer's mind the concept of omega fatty acids, the OMEGASMART and OMEGABEE trade marks are conceptually similar to a reasonable degree, and the OMEGAMAYO trade mark is conceptually similar to a higher degree to the opponent's trade mark.

Distinctive character of the opponent's earlier trade mark

31. I must now assess the distinctive character of the opponent's earlier trade mark. The distinctive character of a trade mark can be appraised only, first, by reference to the goods for which it is registered and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. 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 registered as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585. 37. As the opponent has not filed any evidence in these proceedings, I have only the inherent characteristics of its trade mark to consider. As I have already concluded that, at the material date in these proceedings, the word OMEGA is likely to have been understood by the average consumer as a reference to products containing omega fatty acids, any distinctive character the opponent's trade mark possesses must, in my view, be at a very low level.

Likelihood of confusion

32. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is 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. As I mentioned above, it is also necessary for me to factor in the distinctive character of the opponent's earlier trade mark as the more distinctive this trade mark is the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods, the nature of the purchasing process and that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he/she has retained in his/her mind. Earlier in this decision I concluded

that: (i) the average consumer of the goods at issue was a member of the public who would select the goods by primarily visual means and who would pay at best a moderate degree of attention when doing so, (ii) the majority of the goods at issue were either identical or similar to a high degree and the goods which did not fall into these categories i.e. peanut butter were similar to at least a reasonable degree, (iii) the competing trade marks were visually, aurally and conceptually similar to at least a reasonable degree, and (iv) any inherent distinctive character the opponent's earlier trade mark possesses, must be at a very low level.

33. In relation to my conclusion at (iv) above, it is clear from the decision of the CJEU in Case C-196/11 P, *Formula One Licensing BV v OHIM, Global Sports Media Ltd*, that it is not permissible for me to regard the opponent's earlier trade mark as having no distinctive character. However, given what I consider must be the very low level of distinctiveness the opponent's earlier trade mark possesses, the inclusion in the applicants' trade marks of the suffixes SMART and BEE as part of a unified whole and the meaning of which is difficult to discern, are, in circumstances where the only element in common is of such low distinctive character, sufficient, in my view to avoid a likelihood of either direct or indirect confusion. As to the OMEGAMAYO trade mark, notwithstanding the low level of distinctive character the earlier trade mark possesses, as the suffix MAYO is purely descriptive of the goods upon which the trade mark will be used i.e. egg mayonnaise (exhibit JM1 page 10 refers), there is nothing in the OMEGAMAYO trade mark which would allow the average consumer to distinguish between the competing trade marks; as a consequence, the opposition to the OMEGAMAYO trade mark succeeds.

34. In reaching the above conclusion in relation to the OMEGAMAYO trade mark, I have borne in mind the terms in the applicants' specification, and I have, as per the guidance in TPN 1/12 – "Partial Refusal", considered whether it is appropriate to give the applicants an opportunity to offer a limited specification which might avoid the above conclusion. Paragraph 3.2.2(d) of that notice reads in part:

"...Generally speaking, the narrower the scope of the objection is to the broad term(s), compared to the range of goods/services covered by it, the more necessary it will be for the Hearing Officer to propose a revised specification of goods/services. Conversely, where an opposition or invalidation action is successful against a range of goods/services covered by a broad term or terms, it may be considered disproportionate to embark on formulating proposals which are unlikely to result in a narrower specification of any substance or cover the goods or services provided by the owner's business, as indicated by the evidence. In these circumstances, the trade mark will simply be refused or invalidated for the broad term(s) caught by the ground(s) for refusal",

35. However, given the applicants' own evidence showing the goods upon which this trade mark is used, I have concluded that it is not appropriate to offer the applicants this opportunity.

36. Finally, in reaching the above conclusions I have not overlooked the applicants' comments to the effect that: (i) they have a similar trade mark already registered for similar goods and that this trade mark predates the opponent's earlier trade mark, and (ii) that this trade mark and the trade marks the subject of the applications have been "used/promoted" in the United Kingdom prior to the date of the opponent's earlier trade mark. As the applicants have provided no evidence of the extent to which their trade marks have been used in the UK prior to the material date, I need say no more about point (ii). As for point (i), the presence of the earlier trade mark does not assist the applicants for the reasons outlined in Tribunal Practice Notice ("TPN") 4/2009 the relevant part of which reads as follows:

"1. A number of counterstatements in opposition and invalidation actions have sought to introduce as a defence that the applicant for registration/registered proprietor has a registered trade mark (or trade mark application) for the same or a highly similar trade mark to that which is the subject of the proceedings that predates the earlier mark upon which the attacker relies.

2. Sections 5(1) and 5(2) of the Act turn upon whether the attacker has an earlier trade mark compared to the mark under attack, as defined by section 6 of the Act. Whether the applicant for registration/registered proprietor has another registered trade mark (or trade mark application) that predates the earlier mark upon which the attacker relies cannot affect the outcome of the case in relation to these grounds.

3. The position was explained by the Court of First Instance in *PepsiCo, Inc v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) T-269/02*:

"24 Nor did the applicant claim, and even less prove, that it had used its earlier German mark to obtain cancellation of the intervener's mark before the competent national authorities, or even that it had commenced proceedings for that purpose.

25 In those circumstances, the Court notes that, quite irrespective of the question whether the applicant had adduced evidence of the existence of its earlier German mark before OHIM, the existence of that mark alone would not in any event have been sufficient reason for rejecting the opposition. The applicant would still have had to prove that it had been successful in having the intervener's mark cancelled by the competent national authorities.

26 The validity of a national trade mark, in this case the intervener's, may not be called in question in proceedings for registration of a Community trade mark, but only in cancellation proceedings brought in the Member State concerned (*Case T 6/01 Matratzen Concord v OHIM -Hukla Germany (MATRATZEN) [2002] ECR II 4335, paragraph 55*). Moreover,

although it is for OHIM to ascertain, on the basis of evidence which it is up to the opponent to produce, the existence of the national mark relied on in support of the opposition, it is not for it to rule on a conflict between that mark and another mark at national level, such a conflict falling within the competence of the national authorities.””

Overall conclusion

37. The oppositions to the OMEGASMART and OMEGABEE applications have failed; the opposition to the OMEGAMAYO trade mark has succeeded.

Costs

38. As the applicants have been successful in relation to two of their three applications, they are entitled to a contribution towards their costs. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 4 of 2007. In a letter to the TMR dated 29 May 2013, the applicants sought costs above the scale for their attendance at an interlocutory hearing held on 27 June 2012 concerning the TMR’s preliminary view that the opponent’s seniority claims were ineffective and should be struck out. That interlocutory hearing took place before me and I have consulted the notes I made when the hearing concluded. In my notes I recorded that:

“AW [i.e. Ms Wilson who represented the opponent] did not seek costs. Although JM [Ms Matchett who represented the applicants] mentioned that some research had been done by the A [the applicants’] to address the point, she confirmed that the A was not seeking costs”.

39. Consequently, I do not intend to make any award in respect of the interlocutory hearing. Using the TPN mentioned as a guide but keeping in mind, inter alia, (i) the similarity in the pleadings, (ii) the proceedings were consolidated, (iii) the relevance of the majority of the applicants’ evidence, and (iv) the opponent achieved a measure of success, I award costs to the applicants in the amount of **£800**.

40. I order MARKANT Handels und Service GmbH to pay to Mrs Brenda Robinson and Mr Mark Robinson the sum of **£800**. 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 30 day of July 2013

C J BOWEN
For the Registrar
The Comptroller-General