

**O/393/17**

**TRADE MARKS ACT 1994**

**CONSOLIDATED PROCEEDINGS IN THE MATTER OF APPLICATION NOS**

**3169690 & 3169696**

**IN THE NAME OF LIZZIE'S FOOD FACTORY LIMITED**

**TO REGISTER THE FOLLOWING TRADE MARKS IN CLASS 30:**

**Lizzie's**

**&**

**Lizzie's Food Factory**

**AND OPPOSITION THERETO (NOS 407594 & 407596) BY**

**THE GOOD CARB FOOD COMPANY LTD**

## BACKGROUND

1) On 15 June 2016 Lizzie's Food Factory Limited ("the applicant") applied to register the following two trade marks:

**Lizzie's**

&

**Lizzie's Food Factory**

Both were published for opposition purposes on 15 July 2016 in respect of the following goods:

**Class 30:** Pastry and confectionery; bakery products; bakery goods; preparations made from pastry and confectionery; cakes; pastries; pies; savouries; cupcakes; biscuits; brownies; cookies; desserts; bakery desserts; buns; confectionery; prepared desserts; prepared savouries.

2) The Good Carb Food Company Ltd ("the opponent") claims that both applications offend under section 5(2)(b) of the Trade Marks Act 1994 ("the Act"). The relevant details of the mark relied upon by the opponent are:

**EUTM No: 15166697**

**Lizi's**

**Class 29:** Yoghurts and desserts of which yoghurt is the main component; fruit compotes and desserts of which fruit compote is the main component;

savoury snacks (vegetable or meat based); snack preparations made from shelled nuts, edible seeds, desiccated coconut, stem ginger, all being loose or in clusters, being uncoated or coated with chocolate or yoghurt.

**Class 30:** Breakfast cereals, muesli (toasted or untoasted), snack preparations made from grains, chocolate, all being loose, in bars or in clusters, being uncoated or coated with chocolate or yoghurt; cakes and pastries, chocolate brownies, fruit pies, ice cream and desserts of which the main component is ice cream, cake mixes; savoury sauces; snack preparations in bars coated with chocolate, made from shelled nuts, edible seeds, desiccated coconut, stem ginger.

**Seniority date: 12 February 2007 (UK)**

**Filing Date: 29 February 2016**

**Date of completion of registration procedure: 11 August 2016**

3) The applicant filed a counterstatement in defence of both applications. It denies, with supporting explanation, that there is a likelihood of confusion between its applications and the opponent's earlier mark. It also requests proof of use of the opponent's mark in relation to some of the goods relied upon. However, as the earlier mark had not been registered for five years or more prior to the publication date of the applicant's marks, proof of use is not applicable, as per section 6A of the Act.<sup>1</sup> The consequence of this is that the opponent is entitled to rely upon all of the goods listed in paragraph 2 above.

4) Only the applicant filed evidence. The opponent filed submissions. Neither party requested to be heard; only the applicant filed submissions in lieu. I now make this decision after considering all of the papers before me.

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<sup>1</sup> This was pointed out to the applicant in the official letter of 16 January 2017.

## **Applicant's evidence**

5) This takes the form of a witness statement in the name of Trevor Malcolm Judd, a Director of the applicant. It consists, for the most part, of submissions which I will not detail here but will bear in mind and refer to, as appropriate, in the decision which follows. In terms of factual information, Mr Judd provides the following information:

- A certificate of incorporation of the applicant dated 2 March 2004 and a copy of the registration details of the UK mark from which the opponent's EU mark claims seniority, showing that the mark was applied for and registered in 2007. This is said to show that the applicant used its mark prior to the opponent.
- Images of goods showing how the parties currently use their marks in trade which Mr Judd states shows that there is no likelihood of confusion.
- The applicant's mark is named after one of the owners and directors of the applicant, Elizabeth Mary Judd. This appears to be a statement in support of the applicant's defence made in its counterstatement that the applicant is using its own name.

## **DECISION**

6) Before I assess the ground under 5(2)(b), it is necessary to point out that the facts set out in the bullet points above do not assist the applicant. This is because any prior use that the applicant may have made of its mark before the filing/registration date of the opponent's mark is irrelevant as per 'Tribunal Practice Notice 4/2009: Trade mark opposition and invalidation proceedings – defences', the relevant part of which states:

**“The position with regard to defences based on use of the trade mark under attack which precedes the date of use or registration of the attacker's mark**

4. The viability of such a defence was considered by Ms Anna Carboni, sitting as the appointed person, in *Ion Associates Ltd v Philip Stainton and Another*, BL O-211-09. Ms Carboni rejected the defence as being wrong in law.

5. Users of the Intellectual Property Office are therefore reminded that defences to section 5(1) or (2) grounds based on the applicant for registration/registered proprietor owning another mark which is earlier still compared to the attacker's mark, or having used the trade mark before the attacker used or registered its mark are wrong in law. If the owner of the mark under attack has an earlier mark or right which could be used to oppose or invalidate the trade mark relied upon by the attacker, and the applicant for registration/registered proprietor wishes to invoke that earlier mark/right, the proper course is to oppose or apply to invalidate the attacker's mark."

7) Turning to the evidence showing how the parties currently use their marks in trade, this is also irrelevant because I am required to make the assessment of the likelihood of confusion under section 5(2)(b) notionally and objectively taking into account all of the ways in which the applied for mark might be used if it were registered<sup>2</sup>. This necessarily requires that I assess the matter solely on the basis of the marks and goods as they appear before me. The manner in which either party currently chooses to operate is irrelevant because marketing strategies are temporal and my change with the passage of time. See for instance, *Devinlec Développement Innovation Leclerc SA v OHIM*, Case C-171/06P, where the Court of Justice of the European Union stated:

"59. As regards the fact that the particular circumstances in which the goods in question were marketed were not taken into account, the Court of First Instance was fully entitled to hold that, since these may vary in time and depending on the wishes of the proprietors of the opposing marks, it is inappropriate to take those circumstances into account in the prospective analysis of the likelihood of confusion between those marks."

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<sup>2</sup> *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited*, Case C-533/06.

8) Finally, the applicant's defence that it is using its own name is also irrelevant for present purposes. Section 11(2)(a) of the Act states:

"11 (1) ...

(2) A registered trade mark is not infringed by –

(a) the use by a person of his own name or address.

(b) ...

(c) ...provided the use is in accordance with honest practices in industrial or commercial matters."

Section 11(2)(a) refers to trade mark infringement which is not the issue before me. The so-called "own name" defence does not amount to a right to registration which is what the applicant appears to be contending here.

9) For all of the reasons given above, the applicant's evidence does not assist it.

10) I now turn to assess the likelihood of confusion. Section 5(2)(b) of the Act provides:

"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,

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

## **Section 5(2)(b) – case law**

11) The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

### **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 be dominated by one or more of its components;

(f) however, it is also 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 creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

### **Comparison of goods**

12) The goods to be compared are:



Opponent's goods	Applicant's goods
<p><b>Class 29:</b> Yoghurts and desserts of which yoghurt is the main component; fruit compotes and desserts of which fruit compote is the main component; savoury snacks (vegetable or meat based); snack preparations made from shelled nuts, edible seeds, desiccated coconut, stem ginger, all being loose or in clusters, being uncoated or coated with chocolate or yoghurt.</p> <p><b>Class 30:</b> Breakfast cereals, muesli (toasted or untoasted), snack preparations made from grains, chocolate, all being loose, in bars or in clusters, being uncoated or coated with chocolate or yoghurt; cakes and pastries, chocolate brownies, fruit pies, ice cream and desserts of which the main component is ice cream, cake mixes; savoury sauces; snack preparations in bars coated with chocolate, made from shelled nuts, edible seeds, desiccated coconut, stem ginger.</p>	<p><b>Class 30:</b> Pastry and confectionery; bakery products; bakery goods; preparations made from pastry and confectionery; cakes; pastries; pies; savouries; cupcakes; biscuits; brownies; cookies; desserts; bakery desserts; buns; confectionery; prepared desserts; prepared savouries.</p>

13) In the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon*, Case C-39/97, the Court stated at paragraph 23 of its judgment that:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all

the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary”.

14) The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- a) The respective users of the respective goods or services;
- b) The physical nature of the goods or acts of services;
- c) The respective trade channels through which the goods or services reach the market;
- d) 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;
- e) 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.

15) In *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another*, [2000] F.S.R. 267, Neuberger J. (as he then was) stated that:

“I should add that I see no reason to give the word “cosmetics” and “toilet preparations”... anything other than their natural meaning, subject, of course, to the normal and necessary principle that the words must be construed by reference to their context.”

16) In *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

"... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."

17) Finally, in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05 (*'Meric'*), the General Court ('GC') stated that:

"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 trade mark application (Case T-388/00 *Institut fur Lernsysteme v OHIM- Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark".

18) The applicant's 'Pastry; bakery products; bakery goods; preparations made from pastry; cakes; pastries; savouries; cupcakes; brownies; bakery desserts; buns; prepared savouries' fall within the opponent's 'cakes and pastries' and are therefore identical on the *Meric* principle.

19) The applicant's 'pies' include the opponent's 'fruit pies'; these are also identical on the *Meric* principle.

20) The applicant's 'desserts; prepared desserts' include the opponent's 'desserts of which the main component is ice cream'; these are identical on the *Meric* principle.

21) That leaves the applicant's 'confectionery; preparations made from confectionery; biscuits; cookies; confectionery'. I find these to be highly similar to the opponent's 'cakes' and 'snack preparations in bars coated with chocolate, made from shelled nuts, edible seeds, desiccated coconut, stem ginger'. The trade channels are likely to be the same and they may be stocked in close proximity in a supermarket, the respective nature is similar, the users are the same, and there is a competitive relationship in play given that they are all types of sweet treats.

### **Average consumer and the purchasing process**

22) It is necessary to determine who the average consumer is for the respective goods and the manner in which they are likely to be selected. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

"60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words "average" denotes that the person is typical. The term typical. The term "average" does not denote some form of numerical mean, mode or median."

23) The average consumer of the relevant goods is the general public. The opponent states:

"The goods in question are not particularly costly and, overall, consumers will normally pay a reasonably low degree of attention when selecting these goods and the purchase of the goods may include impulse purchases."

I agree. The goods are likely to be selected visually from shelves, freezers, refrigerators or a bakery counter and therefore the purchase will be mainly visual. However, the goods may sometimes be requested orally such as over a bakery counter (albeit after initial selection by eye), and therefore aural considerations are also borne in mind.



### **Comparison of Marks**

24) It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

25) It would be wrong, therefore, artificially to dissect the marks, although it is necessary to take into account the distinctive and dominant components of the trade marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the trade marks.

26) The marks to be compared are:

Opponent's mark	Applicant's marks
	<p data-bbox="810 309 831 338">i)</p> <div data-bbox="922 353 1273 479" style="text-align: center;">  </div> <p data-bbox="810 562 831 591">ii)</p> <div data-bbox="810 680 1358 734" style="text-align: center;"> <p><b>Lizzie's Food Factory</b></p> </div>

27) The opponent's mark consists of Lizi's in a hand-written type font with the apostrophe replaced with the image of a heart. Although the stylised font and the heart make some contribution to the overall impression, it is the word itself, 'Lizi's', which dominates the overall impression.

28) Turning to the applicant's marks, mark i) consists of 'Lizzie's' presented in a normal font with the dot over the first 'i' replaced with the image of two leaves presented in different shades of brown. The leaves make some contribution to the overall impression but it is the word itself, Lizzie's, which is dominant. Insofar as mark ii) is concerned, there is no stylisation to this mark. The words 'Food Factory' occupy a substantial proportion of the mark as a whole; they are far from negligible. However, those words have very limited, if any, distinctive character in relation to the goods at issue for obvious reasons. Bearing that in mind, it is the distinctive word 'Lizzie's', in a prominent position at the beginning of the mark, which is the most dominant part of the mark as a whole.

29) I now turn to consider the visual, aural and conceptual similarities between the marks dealing first with mark i) of the applicant.

Mark i)

30) The applicant points out that the respective marks have different spelling, the applicant's mark has seven letters whereas the opponent's has only five and the opponent's mark has a heart in place of the apostrophe. I note these points of difference together with the different fonts and the image of leaves above the letter 'i' in the applicant's mark which is not present in the opponent's mark. However, there are also clear similarities. Both marks begin with the same three letters, 'Liz' and end with a possessive s. They also both contain the letter 'i' after the 'z'/'zz' respectively. Bearing in mind all of these factors, and not overlooking that the applicant's mark also contains the letter 'e' which is absent from the opponent's mark, I find there to be a good degree of visual similarity.

31) Aurally, the applicant contends that the first 'i' in the opponent's mark will be pronounced in a long fashion as in 'time' whereas in its mark, the first 'i' will be short as in 'stick'. I am not persuaded by this submission. In my view, both marks are likely to be vocalised in the same manner i.e. as 'LI-ZEE' where the 'i' is short as in 'stick'. They are aurally identical.

32) Conceptually, the opponent states that both marks will be perceived as diminutives of the name 'Elizabeth' and are therefore conceptually identical. The applicant, on the other hand, contends that the rarity of the use of 'Lizi' as a diminutive of Elizabeth renders the opponent's mark conceptually different to its mark which is a more common abbreviation for 'Elizabeth'. I do not agree with the applicant. It may be that the spelling 'Lizi' is less common than the spelling 'Lizzie'. However, it does not follow that the marks are conceptually different. I do not consider that the average consumer will perceive the spelling of the opponent's mark as so unusual that they will not recognise it as a diminutive of the name 'Elizabeth'. In my view, both marks will immediately be perceived as the possessive form of the same female forename (a diminutive of 'Elizabeth'). I agree with the opponent that they are conceptually identical.

Mark ii)

33) Visually, I bear in mind my earlier comments at paragraph 30 in relation to the respective 'Lizis' and 'Lizzie's' elements. However, my comments in relation to the image of leaves is not applicable here. The added words 'Food Factory' in the applicant's mark create a point of visual contrast between the respective marks. Overall, I find a medium degree of visual similarity.

34) Aurally, my comments at paragraph 31 above are equally applicable here in terms of how the respective 'Lizi's' and 'Lizzie's' are likely to be pronounced. The added words 'Food Factory' in the applicant's mark will be articulated in an entirely predictable fashion and create a point of difference. Overall, there is a medium degree of aural similarity, bearing in mind that it is the first part of marks which will tend to have the greater impact upon the ear.

35) Conceptually, my comments in paragraph 32 also apply here. Whilst mark ii) also contains the additional words 'Food Factory', I find that the respective marks are conceptually highly similar.

**Distinctive character of the earlier mark**

36) In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).



23. In making that assessment, account should be taken, in particular, 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 has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

37) There is no evidence before me to show that the opponent’s mark has acquired an enhanced level of distinctiveness through use. Accordingly, I must make the assessment on the basis of the marks inherent qualities alone. The mark does not describe or allude to the goods covered by the opponent’s registration in any way. However, neither does it have the highest degree of distinctiveness of, for example, an invented word. I find that it is possessed of an average degree of distinctiveness.

### **Likelihood of confusion**

38) I must now remind myself of all my earlier findings and feed them into the global assessment of the likelihood of confusion and, when conducting that assessment, I must also keep in mind the following established principles:

- i) the interdependency principle, whereby a lesser degree of similarity between the goods may be offset by a greater similarity between the marks, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*);
- ii) imperfect recollection i.e. that consumers rarely have the opportunity to compare marks side by side but must rather rely on the imperfect picture that they have kept in their mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V*), and;
- iii) the more distinctive the opponent’s mark is, the greater the likelihood of confusion (*Sabel BV v Puma AG*).

39) I have found that the respective goods are identical or highly similar and that the average consumer will be a member of the general public who is likely to pay a reasonably low degree of attention during a mainly visual purchase (although aural considerations are borne in mind). These factors weigh heavily in the opponent's favour owing to the principals of interdependency and imperfect recollection. This is because the identical/highly similar goods may offset a lesser degree of similarity between the marks and the reasonably low degree of attention that is likely to be paid may make the average consumer more prone to misremembering the marks. I have also found that mark i) is visually similar to a good degree and aurally and conceptually identical to the opponent's mark. Mark ii) is visually and aurally similar to a medium degree and conceptually highly similar to the opponent's mark. Weighing all relevant factors against each other in respect of each of the applicant's marks, and, in doing so, having regard for the average degree of distinctiveness of the earlier mark, I find that there is a likelihood of direct confusion in respect of both of the applicant's marks (i.e. that the respective marks are likely to be mistaken for each other because the average consumer thinks they are the same). However, even if the average consumer were to realise that the applicant's marks were not the same as the opponent's mark, the similarities that exist between them are nevertheless sufficient to lead the average consumer to believe that the respective goods emanate from the same/related source(s).

40) **The opposition succeeds.**

## **COSTS**

41) As the opponent has been successful, it is entitled to a contribution towards the costs it has incurred in these consolidated proceedings. In approaching the award, I bear in mind that, although two notices of opposition were filed, their content was brief and highly similar. Further, although the opponent has had to consider two counterstatements, their content was identical. Accordingly, using the guidance provided in Tribunal Practice Notice 2/2106, I award costs to the opponent on the following basis:

Opposition fee (x2)	£200
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Filing notices of opposition and considering the counterstatements £200

Considering the applicant's evidence  
and filing written submissions £300

**Total: £700**

42) I order Lizzie's Food Factory Limited to pay The Good Carb Food Company Ltd the sum of **£700**. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 21<sup>st</sup> day of August 2017**

**Beverley Hedley  
For the Registrar,  
the Comptroller-General**