

O-421-17

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 3219640

BY LAWRENCE HILL TO REGISTER:



AND



AS A SERIES OF TRADE MARKS IN CLASSES 5, 29, 30, 32 AND 35

AND IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 60000639

BY NATURE WORKS BRANDS LIMITED

Background and pleadings

1. On 19 March 2017, Lawrence Hill (“the applicant”) applied to register the following trade marks as a series of two for goods and services in classes 5, 29, 30, 32 and 35:



As nothing turns on the colour of these marks, I will refer to them in the singular but my comments can be taken as applying equally to both marks in the series.

2. The application was published for opposition purposes on 31 March 2017. It is opposed by Nature Works Brands Limited (“the opponent”) under the fast-track opposition procedure. The opposition, which is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”), is directed against the following goods in the application:

Class 29 Dried and cooked fruits and vegetables; nuts; jellies, jams, compotes; prepared meals; snack food; soups; edible oils and fats; peanut butter; almond butter; protein shakes; energy bars; protein based drinks and

foodstuffs; drinks and foodstuffs for use during exercise; drinks and foodstuffs fortified with vitamins; drinks and foodstuffs fortified with minerals; drinks and foodstuffs fortified with carbohydrate; drinks and foodstuffs fortified with fibre.

Class 30 Coffee, tea, cocoa, sugar, rice, preparations made from cereals; cereal bars; snack bars; energy bars; bread, pastry confectionery; food and drink flavourings; sandwiches; prepared meals; pizzas, pies and pasta dishes.

Class 32 Mineral and aerated drinks; non-alcoholic drinks; energy gels and drinks; sports gels and drinks; fruit drinks and fruit juices; preparations for making energy drinks and sports drinks; drinks fortified with protein; drinks fortified with vitamins; drinks fortified with minerals; drinks fortified with carbohydrate; drinks fortified with fibre; drinks fortified with dietary supplements.

3. The opponent relies upon its UK trade mark registration number 3151309 for the trade mark **POWER PLANT**. The opponent's trade mark was applied for on 23 February 2016 and its registration procedure was completed on 6 May 2016. The opponent relies upon all of the goods in its registration, namely:

Class 29 Milk substitutes.

Class 30 Cereal bars; cereals; snacks manufactured from cereals; tea; infusions, not medicinal; coffee; coffee substitutes (vegetal preparations for use as-); coffee substitutes [artificial coffee or vegetable preparations for use as coffee]; coffee substitutes [grain or chicory based].

Class 32 Juice (fruit-), soft drinks, water, energy drinks.¹

4. The opponent claims that “the mark we are opposing uses the same two words, thus –PLANT POWER – POWER PLANT this is clearly intended to cause confusion”.

5. The applicant filed a counterstatement denying the grounds of opposition. He claims that:

“‘Plant Power’ is a joint symbolic/word logo to differentiate and therefore cause no conflict with the already registered ‘Power Plant’. I would like to see ‘Power Plant’ in use and where the ‘confusion’ lies”.

6. Rules 20(1)-(3) of the Trade Marks Rules (“TMR”) (the provisions which provide for the filing of evidence) do not apply to fast track oppositions but Rule 20(4) does. It reads:

“(4) The registrar may, at any time, give leave to either party to file evidence upon such terms as the registrar thinks fit”.

7. The effect of the above is to require parties to seek leave in order to file evidence (other than the proof of use evidence which is filed with the notice of opposition) in fast track oppositions. No leave was sought in respect of these proceedings.

8. Rule 62(5) (as amended) states that arguments in fast track proceedings shall be heard orally only if (i) the Office requests it or (ii) either party to the proceedings requests it and the Registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost. Otherwise, written arguments will be taken. A hearing was neither requested nor considered necessary. Only the applicant filed written submissions, which I will bear in mind.

¹ The opponent’s form TM7F does not record some of the goods relied upon (infusions and coffee substitutes) exactly as set out in the mark’s specification. However, the registered specification is, if anything, more limited than the goods claimed in the form TM7F, and I proceed on that basis.

9. Neither party is professionally represented.

10. This decision is taken following a careful reading of the papers.

Section 5(2)(b)

11. The opposition is based upon section 5(2)(b) of the Act, which 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,

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

12. 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”.

13. In these proceedings, the opponent is relying upon the trade mark shown at paragraph 3, above, which qualifies as an earlier trade mark under the above provisions. As the opponent's earlier mark had not been registered for five years or more at the publication date of the opposed application, it is not subject to the proof of use provisions under section 6A of the Act. The opponent can, as a consequence, rely upon all of the goods it has identified. I note that the applicant has indicated that he "would like to see "power plant" in use". As I have explained, because the mark has not yet been registered for the required period, the opponent is not obliged to show any evidence of its use of the mark. Consequently, this decision will take into account only the mark applied for (and its specification) and any potential conflict with the earlier trade mark and its specification as relied upon.

14. 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.

The average consumer and the nature of the purchasing act

15. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods in question: *Lloyd*. 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 “average” does not denote some form of numerical mean, mode or median”.

16. The parties have not commented on the average consumer, nor on the purchasing process.

17. The goods at issue are foodstuffs and non-alcoholic beverages. The average consumer for these goods will be a member of the general public. The goods are most likely to be self-selected from the shelves of retail premises, primarily supermarkets, and from their online equivalents. The purchase is, therefore, predominantly visual. Although there may be some variation in the level of attention paid to the purchase, the

goods are relatively inexpensive, everyday purchases and are likely to be bought with a fairly low level of attention.

Comparison of goods

18. Some of the contested goods are identical to the goods on which the opposition is based (e.g. in class 32, non-alcoholic drinks and soft drinks). For reasons of procedural economy, I will not undertake a full comparison of the goods listed above. The examination of the opposition will proceed on the basis that the contested goods are identical to those covered by the earlier trade mark. If the opposition fails even where the goods are identical, it follows that the opposition will also fail where the goods are only similar.



Comparison of trade marks

19. It is clear from *Sabel* (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 Court of Justice of the European Union (“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”.

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

21. The trade marks to be compared are as follows:

Opponent's trade mark	Applicant's trade mark (series of two)
<p>POWER PLANT</p>	<p>(i)</p>  <p>(ii)</p> 

22. The applicant's marks consist of a number of elements. In the first mark in the series, there is a stylised representation of a leaf, in outline form, presented in green. The ® symbol appears in a very small font at the top right of the leaf. These elements

are presented on a circular grey background, which is not uniform in colour and which has a ragged edge. Beneath the leaf and the circular background are the words “PLANT POWER”, presented one above the other in a bold green typeface. There is a second ® symbol after the word “POWER”, again in a small typeface. All of these elements are presented on a rectangular black background.

23. The second mark in the series features the same leaf device and a similar circular background. The colour of the circle is paler but it, too, is not uniform and has a ragged edge. In this mark, the ® device appears in a small font, not next to the leaf but to the right of the circle. The words “PLANT POWER” appear in capitals, one above the other, underneath the leaf and circle. There is also a second ® symbol, in a small font, after the word “POWER”. All of these elements are presented on a black rectangular background.

24. Given their relative size, I consider that the device of the leaf and circle on the one hand and the words “PLANT POWER” on the other play a roughly equal role in the overall impression of the applicant’s marks. The black rectangular background has very little, if any, distinctive character. The ® symbol is likely to be given no trade mark significance (other than to indicate registration).

25. The opponent’s mark consists of the words “POWER PLANT”, presented in capital letters. The overall impression is of the unit “POWER PLANT”, with neither word dominating the other.

26. Although both marks contain the words “PLANT” and “POWER”, the order is reversed. This reduces the visual similarity between the marks. In addition, there is a significant device element in the applicant’s mark, which is absent from the opponent’s mark. The marks have only a low degree of visual similarity.

27. The figurative elements of the applicant's mark will not be articulated. Both words in the marks, "PLANT POWER" and "POWER PLANT", will be verbalised. Despite identical words appearing in each mark, the reversal of the order will be noticed. I consider that there is a medium degree of aural similarity.

28. Conceptually, the opponent's mark has the distinct conceptual meaning of a power plant (i.e. a facility for generating power). The applicant's mark is likely to be perceived as relating to the beneficial or energising qualities of plants. The marks are conceptually different.

Distinctive character of the earlier trade mark

29. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought 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. In *Lloyd*, 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-2779, 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)".

30. The opponent has not claimed that its mark has an enhanced level of distinctive character. Invented words usually have the highest degree of inherent distinctive character; words which are descriptive of the goods relied upon normally have the lowest. The mark contains two ordinary dictionary words. It is neither descriptive nor allusive in relation to the goods. I consider that the mark as a whole has an average level of inherent distinctive character.

Likelihood of confusion

31. 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 necessary for me to keep in mind the distinctive character of the opponent's trade mark, as the more distinctive this trade mark is, the greater the likelihood of confusion. I must also bear in mind the average consumer for the goods, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks but relies instead upon the imperfect picture of them he has retained in his mind.

32. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks/goods down to the responsible undertakings being the same or related.

33. I have proceeded on the basis that the goods are identical (i.e. the position most favourable to the opponent). Also in favour of the opponent is the average level of distinctive character enjoyed by the earlier mark and what I have found to be the fairly low degree of attention paid by the consumer to the purchase, as the lower the degree of attention, the more likely it is that the average consumer will be confused. However, there is a low level of visual similarity between the marks, in respect of a purchase which will be made primarily by eye. There is a conceptual difference between the marks but I must bear in mind that a conceptual difference may not always overcome higher levels of visual and aural similarity. In *The Picasso Estate v OHIM*, Case C-361/04 P, the CJEU found that:

“20. By stating in paragraph 56 of the judgment under appeal that, where the meaning of at least one of the two signs at issue is clear and specific so that it can be grasped immediately by the relevant public, the conceptual differences observed between those signs may counteract the visual and phonetic similarities between them, and by subsequently holding that that applies in the present case, the Court of First Instance did not in any way err in law”,

while in *Nokia Oyj v OHIM*, Case T-460/07, the General Court (“GC”) stated that:

“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)".

34. Taking into account all of the competing factors, and in doing so balancing the higher level of aural similarity against the lower degree of visual similarity and conceptual dissonance, I come to the view that there is no likelihood of confusion, whether direct or indirect. In this case, the conceptual dissimilarity, when coupled with a low degree of visual similarity, affords sufficiently distinct hooks for the average consumer to be able to distinguish between the marks, notwithstanding the fairly low level of care taken in the purchase and even when the concept of imperfect recollection is taken into account. The opposition is dismissed.

Conclusion

35. The opposition has failed and, subject to appeal, the application will proceed to registration.

Costs

36. The applicant has been successful and is entitled to a contribution towards its costs. Awards of costs in proceedings commenced after 1 July 2016 are governed by Annex A of Tribunal Practice Notice ("TPN") 2 of 2016. This being a fast-track opposition, TPN 2/2015 also applies. The applicant's written submissions were extremely brief (amounting to less than a page) and I make no award in respect of them. Bearing in mind that the applicant was not professionally represented, I award costs to the applicant on the following basis:

Considering the notice of opposition and filing a counterstatement	£100
Total:	£100

37. I order Nature Works Brands Limited to pay Lawrence Hill the sum of **£100**. 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 8th day of September 2017

Heather Harrison

For the Registrar

The Comptroller-General