

O/685/19

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION NO 3228438: ALWAYS
SAKURA IN CLASS 30 BY TWG TEA COMPANY PTE LTD**

AND

**IN THE MATTER OF THE OPPOSITION THERETO UNDER NO 411235 BY
MARIAGE FRERES SOCIETE ANONYME**

Background and pleadings

1. TWG Tea Company PTE Ltd (the applicant) applied to register the trade mark ALWAYS SAKURA in the UK on 3rd May 2017. It was accepted and published in the Trade Marks Journal on 20th October 2017 in respect of the following goods in Class 30:

Tea, tea bags, tea extracts, tea essence, tea for infusions, and beverages made of tea, all the aforesaid flavoured with or containing cherry blossom; foods flavoured with tea containing or flavoured with cherry blossom, namely, sugar, chocolates, chocolate bars, pralines, edible ices, ice cream, sorbets (ices), ice desserts, confectionery, cakes, pastry, macaroons (pastry), pastries, biscuits, cookies; aromatic preparations for imparting a cherry blossom tea flavour to pastries.

2. Mariage Freres, Societe anonyme (the opponent) partially oppose the trade mark on the basis of Section 5(2)(b) of the Trade Marks Act 1994 (the Act). The goods opposed are *foods flavoured with tea containing or flavoured with cherry blossom, namely, sugar, chocolates, chocolate bars, pralines, edible ices, ice cream, sorbets (ices), ice desserts, confectionery, cakes, pastry, macaroons (pastry), pastries, biscuits, cookies; aromatic preparations for imparting a cherry blossom tea flavour to pastries.* This is on the basis of, its earlier UK No 3 052 394: SAKURA SAKURA! The following goods are relied upon in this opposition:

Class 29:

Jellies ; jams ; compotes ; preserved, dried and cooked fruits.

Class 30:

Cocoa; chocolate; pastry, biscuits and confectionery; edible ices; salt, mustard; spices; seasonings, condiments; seeds other than essential oils, and mixtures of the aforesaid goods, for preparing non-medicinal beverages.

3. The opponent argues that the respective goods are identical or similar and that the marks are similar.
4. The applicant filed a counterstatement denying the claims made. In particular the applicant argues that SAKURA lacks distinctiveness as it will be understood as meaning cherry blossom.
5. Both sides filed evidence. This will be summarised to the extent that it is considered necessary.
6. A Hearing took place on 5th June 2019, with the opponent represented by Mr Tom St Quintin of Counsel, instructed by Potter Clarkson and the applicant by Mr Ian Bartlett of Beck Greener, the applicant's representatives in these proceedings.

Evidence

Opponent's Evidence

7. This is a witness statement, dated 4th July 2018, from Mr Sanjay Kapure, a Trade Mark Attorney and the Opponent's representatives in these proceedings. Much of the witness statement is comprised of submissions, which will not be summarised but they have been perused.
8. It is noted that Mr Kapure includes as Exhibit SK2 a Dictionary reference (from the Concise Oxford English Dictionary). This defines "Always" as

meaning “on all occasions”, “throughout a long period of the past”, “forever”, “repeatedly”, “failing all else”.

Applicant’s Evidence

9. This is a Witness Statement, dated 24th September 2018, from Mr Ian Bartlett, a Trade Mark Attorney and the applicant’s representative in these proceedings. Exhibit IB1 is a previous decision of the Trade Mark Registry, O/556/18. Herein, the Hearing Officer concluded, as a result of the evidence filed, that sakura is “an apt word to describe tea and tea products flavoured or containing cherry blossom and it would be appropriate that such a term is kept free for other traders who may wish to use it to designate a characteristic of their goods”.

10. Exhibit IB2 and Exhibit IB3 contain the evidence of the earlier proceedings to which the aforementioned decision refers. The summary that follows focusses upon material considered to be directly relevant to the current proceedings.

11. Exhibit IB2 is a witness statement, dated 1st March 2014 from Taha Bouqdib, the Chief Executive Officer of the applicant. Much of this witness statement refers to ancillary disputes which do not form part of these proceedings. However, there is evidence in relation to the word SAKURA and its meaning (and specifically as a flavour/type of tea). Here, Mr Bouqdib asserts that sakura means cherry blossom and that this is well known as being the national flower of Japan. Attached to the witness statement is Exhibit TB13 which is a copy of a Wikipedia entry concerning sakura as indicating an infusion made from sakura, that is cherry blossom. Further Exhibit TB14 are articles from national newspapers and magazines, including The Daily Telegraph, The Guardian, The Observer and Time Out. Upon perusal of these articles, it is noted that they all describe the season whereby cherry blossom appears on the particular tree. All entries provide an explanation that sakura means cherry blossom or blossom. Mr Bouqdib goes on to explain that sakura has a specific meaning in relation to tea in that it has long been a Japanese tradition to drink tea flavoured with cherry blossom. This is known as “sakura tea”. Exhibit TB15 contains examples of tea products from UK-

based suppliers. It is noted that there is more than one producer of tea using “sakura” to indicate flavour. It is also noted that the exhibit contains evidence from the website Amazon.co.uk. The website offers chocolate bars, namely Kit Kats, flavoured with particular teas, including sakura. These products are described as a “Japanese Kit Kat”. It is noted that one entry indicates a multi pack within which there are different flavours (green tea, sakura, strawberry and dark chocolate). There is no further detail provided in this regard and so it is difficult to gauge the impact of this evidence, particularly in respect the meaning of sakura and flavouring of products beyond tea.

12. Exhibit IB3 contains a second Witness Statement, dated 4th January 2018, from the same Taha Bouqdib. The relevant information is contained within Exhibit TB22 to this witness statement which consists of further examples of press articles regarding sakura and the cherry blossom season. They include articles from The Sun, The Times, The Guardian, The BBC, Conde Nast Traveller, The Daily Mail and Time Out. Upon inspection of these articles, it is again noted that references to sakura are explained as cherry blossom. This evidence also shows that there are also special editions of foodstuffs (doughnuts and chocolates) flavoured in this manner. However, these appear in the context of a narrative around the cherry blossom season as a whole and are available in Japan. As such, they are directed towards the Japanese market and their availability appears to be limited to the cherry blossom season.

Opponent’s Evidence in Reply

13. This is a further witness statement, from the same Mr Sanjay Kapur as has already filed a witness statement in these proceedings. It is dated 22nd November 2018. In this, Mr Kapur disputes that SAKURA has a meaning for the average consumer in the UK. Further he attaches evidence demonstrating the long standing use of the term in the UK by the opponent. I will not summarise this evidence but have noted its contents.

Conclusions on the evidence

Earlier decision BL O/556/18

14. It is noted that the earlier Tribunal decision found sakura to be descriptive and non-distinctive in respect of teas. Though the decision went on to find that the repetition of sakura was sufficient to overcome an objection on the basis of Section 3(1)(b) and (c). On appeal¹, The Appointed Person found that sakura did offend the provisions of Section 3(1)(b) and (c) in respect of teas (and that the repetition made no difference). This decision is binding upon me. Having said that, the offending goods in the earlier case are not in issue here and so I must decide the position of distinctiveness in respect of the earlier goods relied upon in these proceedings. None of which are tea. To this end, I note that the Appointed Person made specific comments in respect of the remaining goods (which are relied on here). The sum of the comments is that the evidence filed (which coincides with that filed in the current proceedings) did not justify an objection on Section 3(1)(b) in relation to these other goods (other than tea and tea infusions). I will consider this point further below.

Evidence relating to meaning of SAKURA

15. There are several examples (already described) of press coverage of sakura, the cherry blossom season in Japan. However, though each article uses the word sakura, it also explains what this means, namely cherry blossom. It is considered that this is persuasive evidence to suggest that the UK public is assumed not to widely know what sakura means and so this is the reason for the explanation of the term being included across the board. It is possible that these articles have had the effect of educating the public as to the meaning of sakura. However, there is no direct evidence in support of this. There is other evidence which appear to show special editions of products such as drinks

¹ BL O/146/19

containing cherry blossom and even chocolates. However, these are clearly focussed at the Japanese market and do not shine any light on the position in the UK. It is noted that there is an example of Japanese Kit Kats from the UK website of Amazon. However, only two listings are provided and there is no other corroborative evidence. In short, I am not persuaded from the evidence filed that a) the meaning of sakura is widely known to the average UK consumer and b) that it will be understood to be a characteristic (that is, a flavour) in respect of the goods relied upon (unlike with tea and tea infusions).

DECISION

Section 5(2)(b)

16. Section 5(2)(b) of the Act is 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”.

Comparison of goods and services

17. In the judgment of the Court of Justice of the European Union (“the 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”.

18. 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 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.

19. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, the General Court 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 für 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”.

The opponent's goods are:

Class 29:

Jellies ; jams ; compotes ; preserved, dried and cooked fruits.

Class 30:

Cocoa; chocolate; pastry, biscuits and confectionery; edible ices; salt, mustard; spices; seasonings, condiments; seeds other than essential oils, and mixtures of the aforesaid goods, for preparing non-medicinal beverages.

The contested goods are:

Class 30:

Foods flavoured with tea containing or flavoured with cherry blossom, namely, sugar, chocolates, chocolate bars, pralines, edible ices, ice cream, sorbets (ices), ice desserts, confectionery, cakes, pastry, macaroons (pastry), pastries, biscuits, cookies; aromatic preparations for imparting a cherry blossom tea flavour to pastries.

20. It is noted that the earlier trade mark contains *confectionery*. This is also present within the contested trade mark (albeit limited to being flavoured with tea containing or flavoured with cherry blossom) and is identical. Further, the earlier term is a wide term encompassing all manner of chocolates and sweets. As such, it includes the following contested items: chocolates, chocolate bars, pralines (all flavoured with tea containing or flavoured with cherry blossom).

21. The contested goods contain pastry and biscuits at large. They therefore include the following contested items: pastry, macaroons (pastry), pastries, biscuits, cookies (all flavoured with tea containing or flavoured with cherry blossom). Further, the contested cakes (flavoured with tea containing or

flavoured with cherry blossom) are highly similar. They can be alternatives to one another and share a highly similar purpose. They can also coincide in trade channels and producers.

22. The opponent's goods also includes the term edible ices. This also appears in the contested goods. They are identical. Further, the earlier term will also, self-evidently, include the contested ice cream, sorbets (ices), ice desserts (flavoured with tea containing or flavoured with cherry blossom).

23. The opponent's goods also includes the term condiments. These are items added to food to provide flavour. Sugar performs a similar purpose for example, when added to coffee or tea, in that it alters the flavour by adding sweetness. They may be similar in nature as for example, both salt (condiment) and sugar are available in granulated form. They may also coincide in terms of trade channels. They are similar, to a medium degree. Further, the remaining contested term is aromatic preparations for imparting a cherry blossom tea flavour to pastries. I understand this to mean that its purpose is to add flavour. It has a purpose in common with the earlier condiments and I cannot see why the respective trade channels will not coincide. As such, it is also considered similar, to a medium degree.

Comparison of marks

24. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a 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 marks must be assessed by reference to the overall impressions created by the 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, to artificially dissect the trade marks, although, it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

26. The respective trade marks are shown below:

SAKURA SAKURA !	ALWAYS SAKURA
Earlier trade mark	Contested trade mark

27. Both trade marks are word marks as shown. In terms of visual dominance, there is no stand out element in either. In terms of distinctiveness, it is noted that SAKURA is repeated twice in the earlier trade mark and also appears as the second element of the contested trade mark. The remaining element ALWAYS in the contested trade mark is clearly less distinctive than SAKURA as it has a meaning that will be readily understood by the UK consumer. The marks therefore coincide in terms of an identical distinctive element (though it is accepted that the earlier trade mark also employs repetition).

28. Visually, the marks coincide in terms of SAKURA and differ as to the repetition of that element. They also differ in that the contested trade mark includes ALWAYS which has no counterpart in the earlier trade mark. Further,

the exclamation mark in the earlier trade mark does not appear in the contested trade mark. It is concluded that they are visually similar to a medium degree.

29. Aurally, it is noted that the exclamation mark will not be pronounced. The earlier trade mark repeats the same element twice while the contested trade mark lacks the repetition and also includes a differing element. This difference would also be articulated first and does have an impact. That said, the coincidental element is identical and so the marks are aurally similar overall. This is pitched as being medium.
30. Conceptually, I have already found (at paragraph 15, above) that the word SAKURA will not be widely understood by the English speaking public of the UK. It is more likely therefore to be viewed as an invented word or as a non English word of no known meaning. In the earlier trade mark, this is merely repeated. In the later trade mark, the word ALWAYS will be understood as meaning every time (in any particular situation). For those who will understand the meaning of sakura, the element ALWAYS merely serves to qualify SAKURA and doesn't create a conceptual gap. That said, it is considered that SAKURA will in any case, not be widely understood. The overall conceptual impact therefore, is neutral.

Average consumer and the purchasing act

31. 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 or services in question: *Lloyd Schuhfabrik Meyer, Case C-342/97*.
32. 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.”

33. The goods in question are a variety of foodstuffs. These will be overwhelmingly purchased via self selection, whether it be a bricks and mortar store or via a grocery website. They are consumables, relatively cheap and will be purchased frequently. The level of attention one would expect to be displayed, therefore, is fairly low.

Distinctive character of the earlier trade mark

34. 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).”

35. The opponent makes no claim to enhanced distinctiveness through use. As such, I am only required to assess the inherent distinctiveness of the earlier trade mark. I accept that sakura is descriptive in respect of tea and tea infusions. However, these are not the relevant goods here. I have assessed the evidence of the applicant in this regard (see paragraph 15, above) and concluded that SAKURA is not descriptive (and non-distinctive) in respect of the goods relied upon here. There is no evidence to the contrary, nor is it obvious on a prima facie basis. Further, it is a registered trade mark and so there is a presumption of validity². It is considered that the goods to which the trade mark relates and which are relied upon are a clear step removed from teas and there is no evidence these are also routinely flavoured with cherry blossom. Any evidence on this point is sparse and in any case limited to the Japanese market to coincide with the cherry blossom season. As such, the earlier trade mark as a whole is considered therefore to have at least an average degree of distinctiveness.

GLOBAL ASSESSMENT – Conclusions on Likelihood of Confusion.

36. 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-*

² *Formula One Licensing BV v OHIM*, Case C-196/11P

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:

(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 might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

37. Most of the goods have been found to be identical and/or similar. The one exception is the contested "sugar" where I have found to be similar to a medium degree to the opponent's "condiments". They are consumables, purchased mainly via self selection. There is likely to be a lower than average degree of attention displayed. The earlier trade mark is distinctive to at least an average degree and the marks have been found to be similar both visually and aurally to a medium degree. It is considered that sakura will not be widely known and so many will view this as an invented word or one of non-English origin with no known meaning. In which case, the conceptual impact is neutral. I also take into account that trade marks can be imperfectly recalled. That said, despite the degree of similarity between the respective trade marks and the closeness of the goods, the differences between the marks are noticeable, particularly in terms of the repetition employed in the earlier trade mark. I consider these differences are unlikely to go unnoticed. As such, the marks will not be mistaken for one another and so there is no likelihood of direct confusion.

38. That however is not the end of the matter and so I go on to consider whether or not confusion is likely to occur indirectly. In doing so, I take into account the guidance in *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, where Mr Iain Purvis Q.C., as the Appointed Person, explained that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

39. I have already found that there is insufficient evidence that sakura is widely known. It is therefore distinctive (to at least an average degree) and because it has the look and feel of an invented or non-English word with no known meaning, it has an unusual quality. The earlier trade mark places its entire identity upon sakura (emphasised by its repetition). The same is true of the later trade mark where the element “always” merely serves to qualify and emphasise sakura. The focus of each is clearly sakura. Bearing this in mind, I am persuaded a consumer, familiar with the earlier trade mark, will conclude that the later trade mark has emanated from the same source and is a later brand of the opponent. There is a likelihood of indirect confusion.

40. As such, the opposition succeeds in its entirety.

COSTS

41. The opponent has been successful and is entitled to a contribution towards its costs. In the circumstances I award the opponent the sum of £2000 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Notice of opposition and accompanying statement plus official fee - £500

Preparing and filing evidence and considering evidence - £750

Preparation for and attendance at a Hearing - £750

TOTAL - £2000

42. I therefore order TWG Tea Company PTE Ltd to pay Mariage Frerer, Societe anonyme the sum of £2000. The above sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 8th day of November 2019

Louise White

For the Registrar