

O/157/20

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003295221

BY S&P SYNDICATE PUBLIC COMPANY LIMITED

TO REGISTER THE TRADE MARK:

SUDA

IN CLASSES 21, 29, 30 AND 43

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 412978 BY

BRF SINGAPORE FOODS PTE LTD

BACKGROUND AND PLEADINGS

1. On 8 March 2018, S&P Syndicate Public Company Limited (“the applicant”) applied to register the trade mark **SUDA** in the UK. The application was published for opposition purposes on 30 March 2018 and registration is sought for the following goods and services:

Class 21 Household or kitchen utensils and containers; articles made of ceramics, glass, porcelain or earthenware; plates, serving dishes, condiment dishes, bowls, serving bowls, salad bowls, soup bowls, sugar bowls; tableware; dinnerware (other than knives, forks and spoons); chinaware; drinking glasses, wine glasses; plastic plates, plastic bowls, plastic glasses, plastic tablecovers, cutlery holders, cutlery rests, cutlery trays; paper and cardboard plates.

Class 29 Meat, fish, poultry, game and seafood; meat, fish, poultry, game and seafood products; meat extracts; prepared, preserved, frozen, dried, tinned or cooked fruits or vegetables and foodstuffs made from these goods; prepared meals; jellies, jams; compotes; dairy products; eggs, milk and milk products; edible oils and fats; dips; snackfoods; salads; soups and potato crisps.

Class 30 Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee, flour and preparations made from cereals, bread, pastry and confectionery, pasta, bread, pastry, biscuits, wraps, sandwiches, prepared meals, snackfoods, confectionery, ice cream; seasonings, honey, treacle, yeast, baking-powder, salt, mustard, vinegar, sauces (condiments), spices, fruit sauces, edible ices, ice cubes, natural or artificial ice, ice (frozen water).

Class 43 Restaurant services; services for providing food and drink; restaurant, bar and catering services; takeaway services; booking and reservation services for restaurants.

2. On 2 July 2018, BRF Singapore Foods Pte Ltd (“the opponent”) partially opposed the application based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent relies on the following trade marks:

SADIA

EUTM no. 12084273

Filing date 22 August 2013; not yet registered

(“the First Earlier Mark”)



EUTM no. 13336359

Filing date 7 October 2014; registration date 18 February 2015

(“the Second Earlier Mark”)

3. The opponent relies upon all goods and services for which the earlier marks are registered, as set out in paragraph **13** below.

4. The opposition is directed against the following goods and services in the applicant’s specification only:

Class 29 Meat, fish, poultry, game and seafood; meat, fish, poultry, game and seafood products; meat extracts; prepared, preserved, frozen, dried, tinned or cooked fruits or vegetables and foodstuffs made from these goods; prepared meals; jellies, jams; compotes; dairy products; eggs, milk and milk products; edible oils and fats; dips; snackfoods; salads; soups and potato crisps.

Class 30 Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee, flour and preparations made from cereals, bread, pastry and confectionery, pasta, bread, pastry, biscuits, wraps, sandwiches, prepared meals,

snackfoods, confectionery, ice cream; seasonings, honey, treacle, yeast, baking-powder, salt, mustard, vinegar, sauces (condiments), spices, fruit sauces, edible ices, ice cubes, natural or artificial ice, ice (frozen water).

Class 43 Restaurant services; services for providing food and drink; restaurant, bar and catering services; takeaway services; booking and reservation services for restaurants.

5. The opponent claims that there is a likelihood of confusion because the trade marks are similar, and the goods and services are identical or similar.

6. The applicant filed a counterstatement denying the claims made.

7. The opponent is represented by Finnegan Europe LLP and the applicant is represented by Shipley IP Ltd. The opponent filed written submissions during the evidence rounds and the applicant filed evidence and written submissions. The opponent filed written submissions in reply. Neither party requested a hearing and neither party filed written submissions in lieu of attendance. This decision is taken following a careful perusal of the papers.

EVIDENCE AND SUBMISSIONS

8. The applicant filed evidence in the form of the witness statement of Benjamin Prangell dated 17 September 2019. Mr Prangell is the solicitor acting for the applicant in these proceedings. Mr Prangell's evidence relates entirely to the relative proportions of the word and device elements of the Second Earlier Mark. I will, therefore, return to this when I carry out my comparison of the marks.

9. As noted above, both the applicant and the opponent filed written submissions. I have read all of these in their entirety and have taken them into consideration in reaching my decision. Whilst I do not propose to summarise those here, I will refer to them below where necessary.

DECISION

10. Section 5(2)(b) of the Act states as follows:

“5(2) A trade mark shall not be registered if because –

(a)...

(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.”

11. By virtue of their earlier filing dates, the trade marks upon which the opponent relies qualify as earlier trade marks pursuant to section 6 of the Act. As the opponent's marks had not completed their registration process (or, in the case of the First Earlier Mark, still has not completed its registration process) more than 5 years before the date of the application in issue, they are not subject to proof of use pursuant to section 6A of the Act. The opponent can, therefore, rely upon all of the goods and services it has identified.

Section 5(2)(b) – case law

12. 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:

(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 greater 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 to mind the earlier mark, 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 and services

13. The competing goods and services are as follows:

Opponent's goods and services	Applicant's goods and services
<p>First Earlier Mark</p> <p><u>Class 29</u></p> <p>Meat, fish, poultry and game; meat extracts; preserved, frozen, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs, milk and milk products; edible oils and fats; prepared meals, snacks and desserts; prepared soya; ready meals primarily with meat, fish, seafood or vegetables; soups and preparations therefore; snack and side dishes of potatoes; potato crisps; confectionary with fruit, nuts and berries; canned beans, fish, fruits, meat, pulses, soups and vegetables; tinned fish, meats, vegetables; charcuterie; dairy products and dairy substitutes; seafood and molluscs; processed fruits, fungi and vegetables (including nuts and pulses); stocks and broth.</p>	<p><u>Class 29</u></p> <p>Meat, fish, poultry, game and seafood; meat, fish, poultry, game and seafood products; meat extracts; prepared, preserved, frozen, dried, tinned or cooked fruits or vegetables and foodstuffs made from these goods; prepared meals; jellies, jams; compotes; dairy products; eggs, milk and milk products; edible oils and fats; dips; snackfoods; salads; soups and potato crisps.</p> <p><u>Class 30</u></p> <p>Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee, flour and preparations made from cereals, bread, pastry and confectionery, pasta, bread, pastry, biscuits, wraps, sandwiches, prepared meals, snackfoods,</p>

Class 30

Coffee, tea, cocoa, coffee substitutes and artificial coffee; rice; flour; pastry and confectionery; ices; sugar; honey, treacle; yeast, baking-powder; salt; mustard; vinegar, sauces (condiments); spices; ice; ice cream; frozen yogurts and sorbets; sandwiches; prepared meals excluding meals which contain couscous; pizzas, pies, pastry dishes and pasta dishes excluding couscous; convenience food (excluding couscous) and savoury snacks; coulis (fruit-)(sauces), fruit sauces; canned sauces; canned pasta foods (excluding couscous); salad dressings; baked foodstuffs; desserts; sweet coatings, glazes and fillings; sweets.

Class 35

Food retail services; retail services relating to foodstuffs and beverages; promotional services in the form of tasting food and drink samples; advertising and promotional services; Information, advisory and consultancy services in relation to the aforesaid.

Second Earlier Mark

Class 29

Meat, fish, poultry and game; meat extracts; preserved, frozen, dried and

confectionery, ice cream; seasonings, honey, treacle, yeast, baking-powder, salt, mustard, vinegar, sauces (condiments), spices, fruit sauces, edible ices, ice cubes, natural or artificial ice, ice (frozen water).

Class 43

Restaurant services; services for providing food and drink; restaurant, bar and catering services; takeaway services; booking and reservation services for restaurants.

cooked fruits and vegetables; jellies, jams, compotes; eggs, milk and milk products; edible oils and fats; prepared meals, snacks and desserts; prepared soya; ready meals primarily with meat, fish, seafood or vegetables; soups and preparations therefore; snack and side dishes of potatoes; potato crisps; canned beans, fish, fruits, meat, pulses, soups and vegetables; tinned fish, meats, vegetables; charcuterie; dairy products and dairy substitutes; seafood and molluscs; processed fruits, fungi and vegetables (including nuts and pulses); stocks and broth.	
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14. In the *Treat* case, [1996] R.P.C. 281, Jacob J. (as he then was) identified the following factors for assessing similarity:

- (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.

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

16. In its counterstatement, the applicant states:

“24. The Opponent has been, and is, an exporter on a significant scale of meat from South America. The Opponent has dealt, and deals, at the level of a wholesaler, that is, its operations are business-to-business and the average consumer of its goods and services is in trade as a professional wholesaler.

25. The Applicant has been, and is, a restaurateur operating in the United Kingdom. The Applicant has dealt, and deals, at the retail level, that is, its operations are business-to-consumer.”

17. I recognise that the parties may very well, in practice, be operating different types of businesses. However, for the avoidance of doubt, the assessment that I must undertake is a notional one, based upon all the circumstances in which the marks could be used in relation to the goods and services for which they are applied for/registered. The differences between the parties’ respective businesses in practice are not, therefore, relevant to my decision.

Class 29

18. “Meat, fish, poultry, game and seafood” in the applicant’s specification is self-evidently identical to “Meat, fish, poultry and game” and “seafood and molluscs” in the opponent’s specification.

19. “Ready meals primarily with meat, fish, seafood [...]” in the opponent’s specification falls within the broader category of “meat, fish, poultry, game and seafood products” in the applicant’s specification. These goods can, therefore, be considered identical on the principle outlined in *Meric*.

20. “Meat extracts” appears identically in both the applicant’s and opponent’s specifications.

21. “Prepared, preserved, frozen, dried, tinned or cooked fruits or vegetables and foodstuffs made from these goods” in the applicant’s specification is either self-evidently or *Meric* identical to “preserved, frozen, dried and cooked fruits and vegetables” and “ready meals primarily with meat, fish, seafood or vegetables” in the opponent’s specification.

22. “Prepared meals” in the applicant’s specification falls within the broader category of “prepared meals, snacks and desserts” in the opponent’s specification.

23. “Jellies”, “jams”, “compotes”, “dairy products”, “eggs, milk and milk products” and “edible oils and fats” all appear identically in both the applicant’s specification and the opponent’s specification.

24. “Dips” and “snackfoods” in the applicant’s specification all fall within the broader category of “prepared meals, snacks and desserts” in the opponent’s specification. As salads can be provided as a ready prepared meal, I also consider “salads” in the applicant’s specification to fall within this broader category. These goods can, therefore, be considered identical on the principle outlined in *Meric*.

25. "Soups" and "potato crisps" appear identically in both the applicant's specification and the opponent's specification.

Class 30

26. "Coffee", "tea", "cocoa", "sugar" and "rice" appear identically in both the applicant's specification and the opponent's specification.

27. "Tapioca" and "sago" are products typically used as alternatives to rice and flour. There will, therefore, be overlap in user, use and method of use with "rice" and "flour" in the opponent's specification. There will also be a degree of competition between them and there may be an overlap in trade channels. I consider these goods to be highly similar.

28. "Artificial coffee" and "flour" appear identically in both the applicant's specification and the opponent's specification.

29. "Savoury snacks" in the opponent's specification could fall within the broader category of "preparations made from cereals" in the applicant's specification. "Savoury snacks" could include products made from cereals such as popcorn or cereal based crisps. I consider these goods to be identical on the principle outlined in *Meric*. If I am wrong in this finding then there will be overlap in user, method of use, purpose and nature. There will also be overlap in trade channels and there will be a degree of competition. The goods will, therefore, be highly similar.

30. "Breads, pastry and confectionery", "bread" and "pastry" in the applicant's specification are either self-evidently or *Meric* identical to "pastry and confectionery" and "baked foodstuffs" in the opponent's specification.

31. "Canned pasta foods (excluding couscous)" in the opponent's specification falls within the broader category of "pasta" in the applicant's specification. These goods can, therefore, be considered identical on the principle outlined in *Meric*.

32. "Biscuits" in the applicant's specification is likely to overlap in use and user with "confectionery" in the opponent's specification. They are likely to overlap in trade channels and are often sold in the same aisle of a supermarket. There will be a degree of competition between them. I consider these goods to be highly similar.

33. "Wraps" in the applicant's specification will include filled wraps in the form of ready-prepared meals. Consequently, this term falls within the broader category of "prepared meals excluding meals which contain couscous" in the opponent's specification. These goods can, therefore be considered identical on the principle outlined in *Meric*. Even if I am wrong in this finding, there will be an overlap in use, purpose and method of use with both these goods and "sandwiches" in the opponent's specification. There will also be competition between them. These goods will, therefore, be highly similar.

34. "Sandwiches" appears identically in both the applicant's specification and the opponent's specification.

35. "Prepared meals excluding meals which contain couscous" in the opponent's specification falls within the broader category of "prepared meals" in the applicant's specification. These goods can, therefore, be considered identical on the principle outlined in *Meric*.

36. "Savoury snacks" in the opponent's specification falls within the broader category of "snackfoods" in the applicant's specification. These goods can, therefore, be considered identical on the principle outlined in *Meric*.

37. "Confectionery" and "ice cream" appear identically in both the applicant's specification and the opponent's specification.

38. "Salt" in the opponent's specification falls within the broader category of "seasonings" in the applicant's specification. These goods can, therefore, be considered identical on the principle outlined in *Meric*.

39. “Honey”, “treacle”, “yeast”, “baking-powder”, “salt”, “mustard”, “vinegar”, “sauces (condiments)”, “spices” and “fruit sauces” all appear identically in both the applicant’s specification and the opponent’s specification.

40. “Edible ices”, “ice cubes”, “natural or artificial ice” and “ice (frozen water)” in the applicant’s specification all fall within the broader category of “ices” in the opponent’s specification. These goods can, therefore, be considered identical on the principle outlined in *Meric*.

41. “Restaurant services”, “services for providing food and drink”, “restaurant, bar and catering services” and “takeaway services” in the applicant’s specification all fall within the broader category of “food retail services” in the opponent’s specification. These goods can, therefore, be considered identical on the principle outlined in *Meric*. Even if the applicant’s ‘bar’ services cannot be considered identical, there would be overlap in user and trade channels. The services would be both complementary¹ and in competition. The services would, therefore, be highly similar.

42. “Booking and reservation services for restaurants” in the applicant’s specification may overlap in user and trade channels with “Information, advisory and consultancy services in relation to the aforesaid” in the opponent’s specification. I recognise that the specific purpose and nature of the services may differ. I consider the services to be similar to a medium degree.

The average consumer and the nature of the purchasing act

43. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties’ goods and services. I must then determine the manner in which the goods and services are likely to be selected by the average consumer. 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:

¹ *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06

“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.”

44. The average consumer for both the goods and services will be members of the general public and business users. The cost of the purchase of the goods and services is not likely to be particularly expensive, but various factors will still be taken into account (such as nutritional content and dietary requirements for the goods and aesthetic presentation and type of food offered for the services). Consequently, I consider that a medium degree of attention will be paid during the purchasing process for the goods and services.

45. The goods are normally purchased by self-selection from the shelves of a retail outlet. Visual considerations will, therefore, dominate the selection process for the goods. However, given that advice may be sought from a sales assistant, I do not discount that aural components will also play a role. The services are normally purchased following selection of the premises frontage, or following perusal of adverts (either online or in the form of flyers and posters etc.). However, I recognise that word-of-mouth recommendations will also play a part. Consequently, visual considerations will dominate the selection process for the goods, but there may also be an aural component.

Comparison of trade marks


46. 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 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.”

47. 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.

48. The respective trade marks are shown below:

Opponent’s trade marks	Applicant’s trade mark
<p data-bbox="336 1240 655 1330">SADIA (the First Earlier Mark)</p>  <p data-bbox="312 1659 679 1697">(the Second Earlier Mark)</p>	<p data-bbox="1051 1240 1142 1272">SUDA</p>

49. The applicant’s mark consists of the word SUDA. There are no other elements to contribute to the overall impression of the mark, which lies in the word itself. The First Earlier Mark consists of the word SADIA. Again, there are no other elements to contribute to the overall impression which lies in the word itself. As noted above, Mr

Prangell's evidence focuses entirely upon the contribution of the word and device elements of the Second Earlier Mark to the overall impression of the mark. He states:

"5. I printed 1 copy of the 359EUTM mark by replicating the representation on the register (as available from the EUIPO register at <https://euipo.europa/eu/eSearch/#details/trademarks/013336359>) on an a4 page (proportionately enlarged to fit whilst retaining ratio lock and original proportions).

6. I printed the copy of 359EUTM on 150gsm white paper using an inkjet printer.

7. I drew a rectangle around the entire representation of the 359EUTM large enough to capture the ogee in its entirety, and extending to the left of the word element, as it appears on the EUIPO register as linked to above. I cut this rectangle out with scissors.

8. I drew a rectangle around the word element of 359 EUTM large enough to capture the word element at its greatest dimensions. I cut this out with scissors.

9. I zero'd scales (capacity 0.05g – 200g with accuracy of 0.01g) and weighed the entire representation of 359EUTM including the word and ogee element, and then weighed the rectangle including the word element on its own. The results are that the entire device weighed 3.96g and the word element weight 0.40g.

10. The ratio of the word element to the entire representation is 1:9.9 [appears here]".

50. The approach to the assessment suggested by Mr Prangell's evidence is entirely artificial and not in line with the case law. The comparison that I must undertake is based upon the perception of the average consumer who will not dissect the marks in the way suggested by the applicant. I recognise that the device element of the Second Earlier Mark is bigger than the word element. However, it appears below the word element and, in any event, the eye is naturally drawn to the element that can be read.

Consequently, I consider that the word SADIA plays the greater role in the overall impression of the mark, with the device element playing a lesser role.

Visual Comparison

51. Visually, the opponent states that the marks are “of similar length (4 and 5 letters) and both start with the letter S and end with the letter A, and have the letter D in the middle”. This is, of course, true and these are the points of visual similarity between the marks. However, the letters D and A are next to each other in the applicant’s mark and are separate by the letter I in the First Earlier Mark. Further, the letter immediately following the letter S in the applicant’s mark is the letter U and the letter immediately following the letter S in the First Earlier Mark is the letter A. These represent the points of visual difference between the marks. I consider the marks to be visually similar to no more than a medium degree.

52. Visually, the same points apply to the Second Earlier Mark and the applicant’s mark. However, there is the additional point of visual difference created by the device element. I consider these marks to be visually similar to between a low and medium degree.

Aural Comparison

53. Aurally, the applicant’s mark will be pronounced SUE-DAA. Both the First and Second Earlier Marks will be pronounced SAY-DEE-AHH or SAA-DEE-AHH. I consider the marks to be aurally similar to a low degree.

Conceptual Comparison

54. Conceptually, the parties agree that both the words SADIA and SUDA have no particular meaning to enable a conceptual comparison. The applicant suggests that the device element will be recognised as a Spanish/Iberian or Moorish motif. I consider this unlikely. In my view, the device element of the Second Earlier Mark will not convey any particular meaning to the average consumer and does not, therefore, impact upon the conceptual message conveyed. The conceptual position will, therefore, be neutral.

Distinctive character of the earlier trade marks

55. 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-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).”

56. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use that has been made of it.

57. The opponent has not pleaded that its marks have acquired enhanced distinctive character through use and has filed no evidence to support such a claim. Consequently, I have only the inherent position to consider. The word SADIA is likely to be viewed as an invented word with no particular meaning. Consequently, I consider the First Earlier Mark to be inherently distinctive to a high degree. The same will, of course, also apply to the Second Earlier Mark. I do not consider that the device element will contribute significantly to the distinctiveness of the Second Earlier Mark.

Likelihood of confusion

58. 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 and the goods and services down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where 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 services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier marks, the average consumer for the goods and services and the nature of the purchasing process. In doing so, I must be alive to the fact 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 that he has retained in his mind.

59. I have found the First Earlier Mark and the applicant's mark to be visually similar to no more than a medium degree and aurally similar to a low degree. I have found the Second Earlier Mark and the applicant's mark to be visually similar to between a low and medium degree and aurally similar to a low degree. I have found the conceptual position in respect of both earlier marks to be neutral. I have found the earlier marks to have a high degree of inherent distinctive character. I have identified the average consumer to be a member of the general public or a business user who will select the goods and services primarily by visual means (although I do not discount

an aural component). I have concluded that a medium degree of attention will be paid during the purchasing process. I have found the parties' goods and services to vary from being identical to similar to a medium degree.

60. Taking all of the above factors into account, I consider that the visual and aural differences will be sufficient to avoid the marks being mistakenly recalled or misremembered as each other, notwithstanding the principle of imperfect recollection. Differences between these marks, which are relatively short in length, will be more apparent to the average consumer. I consider this to be the case even where the marks are used on identical goods and notwithstanding the fact that the earlier marks are inherently distinctive to a high degree. In my view, these factors will be offset by the clear aural and visual differences between them. I do not consider there to be a likelihood of direct confusion.

61. Having identified the differences between the marks, I can see no reason why the average consumer would conclude that they originate from the same or economically linked undertakings. They are not natural variants or brand extensions of each other. I do not consider there to be a likelihood of indirect confusion.

CONCLUSION

62. The opposition is unsuccessful, and the application can proceed to registration.

COSTS

63. The applicant has been successful and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 2/2016. I have not made an award in respect of the applicant's evidence, because it did not assist me in reaching my decision for the reason given above. In the circumstances, I award the applicant the sum of **£500** calculated as follows:

Considering the Notice of opposition and preparing a counterstatement	£200
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Preparing written submissions £300

Total £500

64. I therefore order BRF Singapore Foods Pte Ltd to pay S&P Syndicate Public Company Limited the sum of £500. This 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 11th day of March 2020

S WILSON

For the Registrar