

O/651/20

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003416221

BY AXIOM FOODS, INC

TO REGISTER:

ORYZATEIN

AS A TRADE MARK IN CLASS 30

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 418012 BY

EURYZA GMBH

BACKGROUND AND PLEADINGS

1. On 24 July 2019, Axiom Foods, Inc (“the applicant”) applied to register the trade mark shown on the cover of this decision (“the applicant’s mark”) in the UK for the following goods:

Class 30: Brown rice protein concentrate used as food.

2. The applicant’s mark was published for opposition purposes on 2 August 2019 and on 8 October 2019 it was opposed by Euryza GmbH (“the opponent”). The opposition is based on section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent relies on the following mark:



EUTM no. 2686731

Filing date 6 May 2002; registration date 2 October 2002

Relying on all goods namely:

Class 29: Ready or semi-ready meals consisting of rice, pasta, potatoes, meat, fish, vegetables; preserved, dried and cooked pulses; edible oils and fats.

Class 30: Rice, flour and preparations made from cereals, pasta, sauces, snacks consisting of rice, in particular puffed rice, in sweet and savoury form; rice biscuits, rice cakes.

Class 31: Pulses.
 (“the opponent’s mark”)

3. The opponent submits that there is a likelihood of confusion between the parties' respective marks due to the close similarity between them and the identity and/or similarity of the respective goods. The applicant filed a counterstatement denying the claims made and requested that the opponent provide proof of use of its mark. The relevant period within which proof of use must be shown is between 25 July 2014 and 24 July 2019.
4. The opponent is represented by Keltie LLP and the applicant is represented by Kilburn & Strode LLP. Both parties have filed evidence in chief and the opponent has filed evidence in reply. No hearing was requested and only the applicant has filed submissions in lieu of a hearing. I have taken these into consideration and will refer to them below where necessary. This decision is taken following a careful perusal of the papers.

EVIDENCE

The opponent's evidence

The Witness Statement of Jochen Wendt dated 9 March 2020

5. Mr Wendt is the managing director of the opponent, a position he has held for four years. The opponent is part of a group of companies that are the leading rice production companies in the world. Mr Wendt states that the opponent's ORYZA brand is Germany's recognised market leader in both packaged and loose rice and rice specialities segments. The opponent's mark was first used in 1976 and has since been used throughout the EU in Germany, Austria, Denmark, Poland, Belgium and Lithuania. For the purposes of this opposition, Mr Wendt states that he will focus on the use in respect of rice in Austria and Germany.
6. Mr Wendt refers to previous opposition proceedings between these parties at the EUIPO.¹ I note that within those proceedings, the EUIPO did not proceed with assessing the mark that the opponent now seeks to rely on. Further, while there is

¹ Exhibits JW 1 - 2

an overlap between the relevant period in those proceedings and the relevant period in these proceedings, it is limited

7. Images of the packaging for the opponent's various types of rice products that bear the ORYZA branding are included with Mr Wendt's evidence.² While I have not reproduced each example of the packaging below, I have included a sample of them below.



8. I note that these packages were produced during the years 2015 to 2017. Mr Wendt has also included an image from the opponent's ORYZA website that Mr Wendt states was printed on 17 February 2020.³ While evidence provided after the end of the relevant period may be relevant to proceedings, I note that the printout shows new products and, therefore, I do not consider that it reflects the position during the relevant period, which expired some 7 months earlier. Therefore, this evidence does not assist the opponent.

9. Marketing materials that were produced in 2019 showing the ORYZA branding on various products including rice, jars of ratatouille and other sauces are provided.⁴ The evidence of the rice packaging follows the same pattern as the examples shown at paragraph 7 above. While this evidence appears to be in German, it is clear what goods are shown. Despite Mr Wendt stating that these were produced in 2019, I note that these materials are dated 20 June 2018. Mr Wendt has provided a list of major supermarket chains that stock products bearing the ORYZA

² Exhibit JW 3

³ Exhibit JW 4

⁴ Exhibit JW 5

branding in Germany, Austria and Poland. I will not reproduce this list in full but note that these retailers include Aldi, Lidl and Amazon, amongst others. There is additional evidence provided of advertising in an Austrian publication that shows different rice products bearing the ORYZA branding.⁵ The packaging shown is the same design as the packaging shown at paragraph 7 above. While the publications are dated September 2019 and January 2020, being outside the relevant period, I consider the version dated September 2019 to be relevant as it reflects the position of the opponent's goods around the relevant period. This is because it is unlikely that the examples of goods would have changed in the few months between the end of the relevant period and September 2019.

10. Various photographs have been produced showing products bearing the ORYZA branding on sale in different supermarkets throughout Germany. Mr Wendt does not explain what goods are shown but the photographs appear to be of rice products only. I note that the packaging on a number of the rice products show the same design as shown at paragraph 7 above. I also note that the photographs were dated throughout 2018. In addition, Mr Wendt has provided copies of flyers that were distributed by supermarkets in Germany to their customers during 2018 and 2019. All of the flyers show rice products bearing the ORYZA brand. While some of the flyers are dated 2019, no exact dates are provided and, therefore, they may be dated after the relevant date.

11. Mr Wendt has provided a breakdown of sales of rice under the opponent's earlier mark between 2015 and 2019. I have reproduced this table below.

⁵ Exhibit JW 6a

EURO (000) –						
	2015	2016	2017	2018	2019	Total
Germany	20,592	21,588	26,022	29,051	31,859	129,119
Austria	124	87	388	249	381	1,230
Denmark	37	59	27	93	30	254
Belgium	23	-	-	-	-	23
Lithuania	13	-	-	-	-	13
Poland	-	-	-	-	7	7
Total	20,790	21,733	26,438	29,394	32,277	130,631

In respect of the above table, I note that some of the figures from 2019 may be dated outside the relevant period.

12.A number of invoices in relation to the sale of rice to customers including distributors and supermarkets in Germany and Austria are enclosed with Mr Wendt's evidence.⁶ So too are a number of invoices in relation to rice sold to customers in Denmark, Poland and Slovakia.⁷ Of these, I note the following:

- a. the majority of the invoices are not in the English language;
- b. the invoices are all dated throughout the entirety of the relevant period;
- c. the invoices include the word 'ORYZA' in what appears to be the product description column;
- d. they show shipment of rice goods only;
- e. there are products included that do not contain the 'ORYZA' branding. These have, therefore, been discounted;
- f. while Mr Wendt states that these invoices include goods shipped to Poland and Slovakia, there are no invoices that show this. There is, however, an invoice that relates to Lithuania;
- g. of those ORYZA goods shipped within Germany, the net value of goods is €27,087.72;
- h. of those shipped within Austria, the net value of goods is €56,414.61;
- i. of those shipped within Lithuania, the net value of goods is €375.59; and

⁶ Exhibits JW 9 - 10

⁷ Exhibit JW 11

- j. of those shipped within Denmark, the net value of goods is €9,577.44.
13. Mr Wendt states that, according to the data analytics company, Nielson, the market share of the ORYZA brand with regards to rice in Germany between 2006 and 2016 grew from 9.5% to 11.5%. Mr Wendt states that this is in relation to the opponent's share of rice sold at Aldi, Lidl and Norma. A report produced by Nielson is provided to support this.⁸
14. Mr Wendt then goes on to discuss the significant investment in relation to the promotion of the opponent's ORYZA brand. Between 2016 and 2019, the opponent's annual expenditure in relation to advertising on television, in printed publications and on social media in Germany alone was €214,000 in 2016, €42,000 in 2017, €202,000 in 2018 and €459,000 in 2019. This amounts to a total expenditure of €917,000. Further, Mr Wendt has provided invoices relating to its promotional and advertising expenditure.⁹ While the invoices are not in the English language, they do show that they relate to the ORYZA brand. They are also all dated within the relevant period. In total, there are 72 pages of invoices and I do not intend to reproduce the figures in full.
15. The social media page for the ORYZA brand is then discussed and a report dated September 2015 is enclosed.¹⁰ The evidence shows a total of 19,974 'fans' between 1 and 30 September 2015.
16. Mr Wendt encloses various copies of advertisements.¹¹ I will not go through these in detail but I do note that the majority of them are dated within the relevant period, however, I note that one advertisement¹² is only dated with a copyright date and it is not clear when the advert shown was posted. The advertisements relate to rice products and quinoa. Finally, a powerpoint presentation is shown that refers to promotion of the ORYZA brand on various social media websites. While I note the ORYZA branding throughout, these mainly show finished dishes that seemingly

⁸ Exhibit JW 12

⁹ Exhibit JW 14 - 17

¹⁰ Exhibit JW 18

¹¹ Exhibits JW 19 - 20

¹² Exhibit JW 21

use ORYZA rice products and also a few advertisements of rice products and sauces in jars.

The Witness Statement of Rose Cardas dated 13 March 2020

17. Ms Cardas is a trade mark attorney who acts on behalf of the opponent in this matter. Her witness statement is based on research she carried out on 13 March 2020. Ms Cardas states that she conducted a number of online searches to look for any third parties using the term 'ORYZA' to describe their rice product. Ms Cardas searched for the word 'oryza' on various UK supermarket's online websites. None of the searches revealed any products described as 'oryza' and an exhibit showing the print outs confirming the results are enclosed with the statement.¹³ Ms Cardas also undertook searches on the websites myvegan.com and hollandandbarret.com to find examples of rice protein products targeted at the general public. The results are exhibited to the statement and show results for rice protein powder available to purchase on each website.¹⁴ While the evidence is dated after the relevant date, I am of the view that the position regarding the availability of rice protein powders to the general public via online retailers is unlikely to have changed substantially over the period between the relevant date and the print out dates of these results.

The applicant's evidence

The Witness Statement of David Jay Janow dated 13 August 2020

18. Mr Janow is the president and CEO of the applicant. He has held the position of CEO for over 15 years and developed the first specification of rice protein between 2001 and 2002. Mr Janow states that the applicant specialises in producing goods derived from whole grain brown rice, such as protein concentrates and isolates, milks and sweeteners. Mr Janow's evidence discusses the users, purpose, method of use and distribution channels of the applicant's goods.

¹³ Exhibit RAC 1

¹⁴ Exhibit RAC 2

19. An excerpt from the applicant's website dated 19 July 2017 is also provided that states that the Oryzatein product is one that is used in food grade products as both a replacement for and in conjunction with soy protein and whey protein.
20. Mr Janow sets out that the Oryzatein product is used by a diverse range of food producers and that the final product that contains Oryzatein are food and dietary products that are of particular interest to those looking for additional protein supplements, such as people following a vegan diet and those with an interest in body building and/or health and fitness.
21. A number of goods sold by third parties that contain the applicant's Oryzatein product are shown.¹⁵ I note that all examples enclosed are dated prior to the relevant date. The goods for sale by third parties are all types of rice protein powders and all but one product sets out, within its description or the product name itself, that it contains the Oryzatein product.
22. Mr Janow explains that the applicant's customers' products will generally be sold in health food stores or sports nutrition outlets. He states that they would not be sold alongside foods such as, amongst others, wild rice, risotto rice and rice-based pasta in a general food store. He states that, even if the applicant's goods were sold in larger supermarkets, they would be sold as a supplement mixed in with other ingredient in goods such as protein shakes and bars, which would be found within health and nutrition or sport supplement sections.
23. Mr Janow goes on to discuss that they chose the name 'ORYZATEIN' because of the Latin name for Asian rice, being 'oryza sativa'. Mr Janow sets out that there are many other products that use 'oryza' as a prefix or suffix such as 'Oryza Gin' and 'Oryza Vodka'. Attached to Mr Janow's statement is a number of products that contain the word 'Oryza'. The meaning of the word 'Oryza' will be relevant to these proceedings when considering the distinctive character of the opponent's mark. I will, therefore, bear this evidence in mind at that stage.

¹⁵ Exhibit JW3

24. Mr Janow provides evidence regarding the current consumer of the applicant's goods, stating that they are wholesale food sellers and manufacturers and professionals in the food industry

25. Finally, I note that paragraph 14 of Mr Janow's statement states:

"Lastly, our ORYZATEIN product is either directly available through our company or it is sold in speciality food stores, or sports nutrition outlets rather than supermarkets or chain stores for mass consumption."

The Witness Statement of Ryan Pixton dated 14 August 2020

26. Mr Pixton is the trade mark attorney of the applicant. Mr Pixton sets out that the previous proceedings at the EUIPO between these parties are not related to the current proceedings due to the fact that, for procedural economy, the EUIPO did not proceed with an assessment of the opponent's mark.

27. The bulk of the remainder of Mr Pixton's statement relies upon the fact that the word 'ORYZA' is a type of plant species that produces rice. Several exhibits explaining this are included.¹⁶ Further, Mr Pixton relies on an EUIPO decision wherein the opponent's application for 'ORYZA' as a word only mark was rejected.¹⁷ I note that the translated decision letter states that the reasons for the rejection are listed in previous correspondence. That correspondence is not included.

28. In response to Ms Cardas' statement discussed at paragraph 17 above, Mr Pixton has provided screenshots from myvegan.com and hollandandbarrat.com.¹⁸ I note that rice is not available for sale at myvegan.com but is for hollandandbarrat.com. Mr Pixton explains that on hollandandbarrat.com, rice is found under a different category than rice protein. Also included are screenshots from online stores of large UK supermarkets that show 'rice protein' not being available for sale from

¹⁶ Exhibits REP 1 - 3

¹⁷ Exhibit REP4

¹⁸ Exhibit REP5

these retailers.¹⁹ While these printouts are dated after the relevant date, I consider them relevant to these proceedings for the same reasons I have set out at paragraph 17 above.

29. Finally, a copy of a French National Institute of Intellectual Property decision is included.²⁰ That decision found 'brown rice protein concentrate used as food' was dissimilar to 'rice' in Class 30. While I note the content of this decision, I am not bound by it.

Evidence in reply

The Second Witness Statement of Rosemary Cardas dated 30 September 2020

30. As set out above, Ms Cardas is the appointed trade mark attorney of the opponent. A copy of a decision issued by the Portuguese Trademarks and Patents' Directorate Trademarks is enclosed.²¹ This decision shows the marks 'ORYZA' and 'ORYZATEIN' are confusing similar, meaning that the 'ORYZATEIN' mark was denied registration in Portugal. Another decision is enclosed,²² being a decision issued by the OLG of Hamburg in relation to an appeal in cancellation proceedings wherein the attempt to cancel the registration for 'ORYZA' on the grounds that it lacks distinctiveness. The attempt to cancel the mark failed. Again, I note the content of these decisions, but I am not bound by them.

31. On 25 September 2020, Ms Cardas undertook further online searches to find online stores that sold rice both in grain formula and in protein powder concentrate. I note that various retailers are shown as selling both rice protein and rice.²³ Finally, Ms Cardas exhibits printouts from rice protein products²⁴ that explain that they can be consumed by adding them to various types of drinks and/or foods. While these printouts are dated after the relevant date, I consider them relevant to these proceedings for the same reasons I have set out at paragraph 17 above.

¹⁹ Exhibit REP6

²⁰ Exhibit REP7

²¹ Exhibit RAC 3

²² Exhibit RAC 4

²³ Exhibit RAC 5

²⁴ Exhibit RAC 6

DECISION

Proof of use

32. 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.”

33. Given its filing date, the opponent’s mark qualifies as an earlier trade mark under the above provisions. I note that in its counterstatement, the applicant sought to put the opponent to proof of use of its mark because its mark completed its registration process more than 5 years before the date of the application in issue. Therefore, it is subject to proof of use pursuant to section 6A of the Act.

34. The relevant statutory provisions are as follows:

“Raising of relative grounds in opposition proceedings in case of non-use

6A-(1) This section applies where –

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

(1A) In this section “the relevant period” means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier mark unless the use conditions are met.

(3) The use conditions are met if –

(a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non-use.

(4) For these purposes –

(a) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5) In relation to a Community trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

(5A) In relation to an international trade mark (EC) the reference in subsection (1)(c) to the completion of the registration procedure is to be construed as a reference to the publication by the European Union Intellectual Property Office of the matters referred to in Article 190(2) of the European Union Trade Mark Regulation.

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.”

35. Section 100 of the Act is also relevant, which reads:

“100. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

36. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J (as he then was) summarised the law relating to genuine use as follows:

“114.....The CJEU has considered what amounts to “genuine use” of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bunderversammlung Kamaradschaft ‘Feldmarschall Radetsky’* [2008] ECR I-

9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases may be summarised as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* at [29].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14] and [22]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the

latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71]; *Reber* at [29].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72] and [76]-[77]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

37. Pursuant to Section 6A of the Act, the relevant period for assessing whether there has been genuine use of the opponent's mark is the 5-year period ending with the date of the application in issue i.e. 25 July 2014 to 24 July 2019.

38. As the earlier mark is an EUTM, the opponent must show use in the EU. In *Leno Merken BV v Hagelkruis Beheer BV*, Case C-149/11, the CJEU noted that:

“It should, however, be observed that ... the territorial scope of the use is not a separate condition for genuine use but one of the factors determining genuine use, which must be included in the overall analysis and examined at the same time as other such factors. In that regard, the phrase ‘in the Community’ is intended to define the geographical market serving as the reference point for all consideration of whether a Community trade mark has been put to genuine use.”²⁵

39. Proven use of a mark which fails to establish that “the commercial exploitation of the marks is real” because the use would not be “viewed as warranted in the economic sector concerned to maintain or create a share in the mark for the goods or services protected by the mark” is, therefore, not genuine use.

Form of the Mark

40. In *Nirvana Trade Mark*, BL O/262/06, Mr Richard Arnold Q.C. (as he then was) as the Appointed Person summarised the test under s.46(2) of the Act as follows:

"33. The first question [in a case of this kind] is what sign was presented as the trade mark on the goods and in the marketing materials during the relevant period...

34. The second question is whether that sign differs from the registered trade mark in elements which do not alter the latter's distinctive character. As can be seen from the discussion above, this second question breaks down in the sub-

²⁵ Paragraph 36.

questions, (a) what is the distinctive character of the registered trade mark, (b) what are the differences between the mark used and the registered trade mark and (c) do the differences identified in (b) alter the distinctive character identified in (a)? An affirmative answer to the second question does not depend upon the average consumer not registering the differences at all."

41. Although this case was decided before the judgment of the CJEU in *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12, it remains sound law so far as the question is whether the use of a mark in a different form constitutes genuine use of the mark as registered. The later judgment of the CJEU must also be taken into account where the mark is used as registered, but as part of a composite mark.

42. In *Menelaus BV v EUIPO*, Case T-361/13, the General Court found that use of the marks shown on the left and middle below constituted use of the registered mark on the right.



43. The court held that the word VIGAR was the dominant and distinctive element of all the marks. As regards the other features, the court held that:

"73 [The first sign] sign differs from the earlier mark as registered only in the ascending orientation of its oval background, the use of standard lower-case instead of standard capital letters and the replacement of the crown element by a sequence of three dots. As the Board of Appeal rightly found, a different orientation of the same background, the use of upper-case or lower-case letters when they are standard letters which reproduce the same term, or the substitution of an ornamental element (the sequence of dots) for a laudatory element when both of those elements serve to reinforce the term 'vigar', are

minor differences that do not alter the distinctive character of the earlier Community trade mark as it was registered.

74 That finding is not called into question if the second form of use, reproduced in paragraph 63 above, is taken into account inasmuch as, even though, in that case, the basic background disappears and the word ‘spain’ is present, the latter will be understood as a merely descriptive addition.”

44. Throughout its evidence, the opponent has used its mark in a number of ways. These are shown below:



b) Oryza/ORYZA; and



45. In my view, these uses are not uses of the mark as registered. As per the case of *Nirvana* (cited above), I must consider whether they constitute acceptable variant marks by enquiring into what is the distinctive character of the mark as registered, what are the differences between the marks used and the mark as registered and do those differences alter the distinctive character of the marks.

46. Firstly, the stylisation of the word ‘ORYZA’ in the mark as registered is very slight. Further, the label element is going to be seen as a label background devoid of

distinctive character. Therefore, I find that the distinctive character of the opponent's mark lies predominantly in the word 'ORYZA' itself. I will now assess each use of the mark in turn.

Marks labelled a)

47. Registration of a trade mark in black and white covers use of the mark in colour.

This is because colour is an implicit component of a trade mark registered in black and white (as opposed to extraneous matter).²⁶ Thus a black and white mark should normally be considered on the basis that it could be used in any colour. However, it is not appropriate to notionally apply complex colour arrangements to a mark registered in black and white. I do not consider the use of the colours shown in the marks labelled a) above to be particularly complex colour arrangement. Therefore, I find that the use of colour in these examples is within the notion of fair use given that the opponent's mark is registered in black and white and provides protection in respect of all colours. Further, I find that the stylisation of the oval device and the word 'ORYZA' in the marks labelled a) are minor differences that do not alter the distinctive character of the registered mark. In respect of the additional elements on these examples, I note that they are the word 'SPITZENREIS' at the top of the marks labelled a) and the word and numbers 'seit 1976' within the oval device. Further, each mark labelled a) contains an image of different types of rice, words that state what type of rice is being sold above the image and further foreign language wording below the image of the rice that, presumably, describe the type of rice product being sold. While these additions are in a foreign language, they are presented in a way that suggests that they are descriptive in nature. I have no evidence on this point, but neither party has given me reason to believe otherwise. Despite the additions, I do not consider that the differences in the marks labelled a) alter the distinctive character of the opponent's mark as registered. Therefore, I find that use of the marks labelled a) are acceptable variant uses of the mark as registered.

²⁶ See paragraph 5 of the judgment of the Court of Appeal in *Specsavers* [2014] EWCA Civ 1294 and *J.W. Spear & Sons Ltd v Zynga, Inc.* [2015] EWCA Civ 290, at paragraph 47

Mark b)

48. The difference between the mark as registered and mark b) is that mark b) is presented as a word only mark whereas the mark as registered consists of very slight stylisation to the word element and a background label element. I do not consider that the differences between the marks alter the distinctive character of the opponent's mark as registered. Therefore, I find that use of mark a) is an acceptable variant use of the mark as registered.

Mark c)

49. Moving on to mark c), the differences between the mark as registered and mark c) is that the background devices in the marks are different in that the mark as registered consists of an oval shape and a longer rectangle whereas mark c) only consists of the oval shape (and I note it varies only in very minor respects to the oval appearing in the registered mark). Further, the stylisation of the word 'ORYZA' differs slightly with the slopping leg of the letter "R" extending below the bottom line of the rest of the word. Finally, the word and number 'seit 1976' is present in mark b) but absent in the mark as registered. As above, the distinctive character of the mark as registered lies in the word 'ORYZA' itself. I do not consider that the presentational differences in mark b) and the additional wording of 'seit 1976' will alter the distinctive character of the mark. Therefore, I find that mark c) is acceptable variant use of the mark as registered.

Sufficient Use

50. An assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself.²⁷

51. In the opponent's evidence, I note that:

²⁷ New York SHK Jeans GmbH & Co KG v OHIM, T-415/09

- a. Between 2015 and 2019, sales of ORYZA branded rice amounted to €130,631,000 across Germany, Austria, Denmark, Belgium, Lithuania and Poland. Of these figures, €129,119,000 related to sales in Germany, €1,230,000 related to sales in Austria, €254,000 related to sales in Denmark, €23,000 related to sales in Belgium, €13,000 related to sales in Lithuania and €7,000 related to sales in Poland. I have, however, acknowledged that since these figures include sales in 2019, some of those sales will fall outside the relevant period;
- b. Invoices provided show the sale of ORYZA branded rice products during the relevant period throughout Germany, Austria, Lithuania and Denmark. In total, these invoices amount to €93,455.36;
- c. Various marketing materials from within the relevant period, such as supermarket catalogues and product brochures, show a number of ORYZA branded products. Of these products, they mainly consist of different types of rice. However, I note that they also show quinoa, cous cous, dinkel and jars of ratatouille and a product called 'süss-sauer';
- d. Photographs taken from within the relevant period showing various types of rice bearing the ORYZA brand on sale in a number of supermarkets within Germany;
- e. As of 2016, the ORYZA brand held a market share of 11.5% in respect of rice sold in the German supermarkets Aldi, Lidl and Norma; and
- f. The expenditure in relation to advertising on TV, in printed publications and on social media in Germany was €214,000 in 2016, €42,000 in 2017, €202,000 in 2018 and €459,000 in 2019. I also note that there are a number of invoices relating to the promotion of the ORYZA brand.

52. I note that the applicant has submitted that:

“Since rice is the second most consumed cereal in the world, there is a reasonable expectation in terms of sales, which has not been met by the

evidence submitted. On a separate note, the Opponent has provided little to no translations for key and non-self-evident aspects of the evidence, which further hinders the assessment. It is not possible to determine the location of where the photos were taken in several of the Exhibits, and handwritten date references by the Opponent are not objective or reliable. In essence, the Opponent has tasked the Office and the Applicant to review a large amount of evidence with little to no probative value, but has failed to demonstrate actual genuine use.”

53. While I note that a number of the documents provided by the opponent are in foreign languages and have not been translated, I am of the view that the content of the foreign language documents is self-evident. For example, the information regarding products, sales figures and destination contained within the invoices provided are self-evident and, in my view, do not necessarily require translation. Further, the evidence is supported by explanations regarding sales figures by Mr Wendt within his statement. In regard to the applicant’s comments regarding handwritten dates and locations, I note that the evidence is provided by Mr Wendt and accompanied by a statement of truth. I, therefore, have no reason to be sceptical of the handwritten dates and store locations provided on the photographs that are included within Mr Wendt’s evidence.

54. While I have no evidence from either party as to the size of the market for rice in the EU, I would expect it to be a significant market amounting to hundreds of millions, if not billions, of euros per annum. The invoices provided are low in respect of the size of the relevant market. However, considering the supporting explanation of turnover figures by Mr Wendt in his statement, I am satisfied that the opponent’s use of the mark during the relevant period is quantitatively significant. While some of the evidence provided may fall outside the relevant period, the evidence is such that even if the figures from 2019 are reduced appropriately, they are still significant enough to show a market share for the relevant goods. In addition, the evidence of marketing expenditure, the opponent’s mark shown in various catalogues and its goods on sale in supermarkets makes it clear that the opponent’s use of its mark is more than merely token. Further, the evidence provided covers a number of

countries within the EU including Germany, Austria, Denmark, Belgium, Lithuania and Poland. I am, therefore, satisfied as to the territorial extent of the use shown. Taking the evidence as a whole into account, I am satisfied that the opponent has demonstrated genuine use of its mark during the relevant period.

Fair Specification

55. I must now consider whether, or the extent to which, the evidence shows use of the opponent's mark in relation to the goods relied upon.

56. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), Mr Justice Carr summed up the law relating to partial revocation as follows.

“iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria's Secret UK Ltd* [2014] EWHC 2631 (Ch) (“Thomas Pink”) at [52].

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd* (Extreme Trade Mark) [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably

be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 ("Asos") at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them; *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46."

57. I remind myself that the goods covered by the opponent's mark's specification are follows:

Class 29: Ready or semi-ready meals consisting of rice, pasta, potatoes, meat, fish, vegetables; preserved, dried and cooked pulses; edible oils and fats.

Class 30: Rice, flour and preparations made from cereals, pasta, sauces, snacks consisting of rice, in particular puffed rice, in sweet and savoury form; rice biscuits, rice cakes.

58. While the evidence includes marketing materials in relation to goods such as quinoa, cous cous, dinkel and jars of ratatouille and a product called 'süss-sauer', I am not satisfied that the opponent has shown sufficient use of these goods. The bulk of the evidence, including evidence of sales figures and annual turnover, relates to rice products only. I note that the advertising invoices are aimed generally at the 'ORYZA' brand, however, given the lack of any sufficient evidence relating to any other of the opponent's goods, I am not satisfied that this evidence covers anything other than rice. Therefore, given that genuine use has only been proven

for rice, it is necessary to limit the scope of the opponent's opposition. For the purpose of fair specification, I limited the opponent's specification to "rice".

Section 5(2)(b): legislation and case law

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

“(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 or association with the earlier trade mark.”

60. Section 5A of the Act states as follows:

“Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

61. 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 Office for Harmonization in the Internal Market (Trade Marks and Designs) (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.

Comparison of goods

62. In light of my finding above, the competing goods are as follows:

The opponent’s goods	The applicant’s goods
<u>Class 30</u> Rice	<u>Class 30</u> Brown rice protein concentrate used as food.

63. When making the comparison, all relevant factors relating to the goods in the specifications should be taken into account. In the judgment of the CJEU in *Canon*, Case C-39/97, the court stated at paragraph 23 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”.

64. 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.

65. The applicant's evidence contains detailed explanations as to the nature, purpose and users of its goods. While I do not intend to reproduce the evidence in full here, I do note that this has been summarised by the applicant in its submissions as follows:

“the products covered under the application emanate from a complex and innovative production process. Brown rice protein is a dietary hypoallergenic concentrated powder of vegetal proteins, which is a source of amino acids and protein. As explained above, these properties enable vegan and sporty consumers to stay healthy and have a reliable source of vegetal protein. On the other hand, rice is one of the most consumed cereals in the world and can be found in virtually any major channel of food distribution. In other words, contrary to simple rice, the protein concentrate of brown rice is subject to an agro-industrial process which extracts the proteins from the rice. The final product is a powder which is added to other foods in order to enrich them with a protein

intake, and which is therefore sought by a niche of consumers. The goods are different. One is rice grains; the other is a powder. The goods are therefore vastly different in nature, intended purpose, relevant consumers and method of use.”

66. Within its notice of opposition, I note that the opponent stated:

“the goods in class 30 of the Contested trademark are closely similar to the goods protected under the Opposing trademark. In this sense, the "brown rice protein concentrate used as food" is unquestionably similar to the goods covered by the Opposing trademark, as all of them contain "rice" as its main ingredient or component.

In fact, most of these goods can be found in the same supplying channels or even in the same shelves of the foodstuffs selling points and specialized shops.”

67. The goods at issue are both class 30 goods. However, I refer to Section 60A of the Act that states that goods and services are not to be regarded as similar to each other on the ground that they appear in the same class under the Nice Classification.

68. While the goods at issue relate to rice, I do not consider them to be identical. I must, therefore, consider the factors set out in the case of *Treat* (cited above) in order to determine the level of similarity (if any) between the goods.

69. Given that the applicant’s evidence and submissions set out that the users of its goods are food manufacturers who use the goods as part of their own products, I will first assess the user of the parties’ goods. The users of the opponent’s goods will be members of the general public at large. While I accept that the applicant’s goods’ users may be manufacturers of various types of health foods and drinks, I am of the view that protein concentrates in the form of powders can also be sold to the consumer directly. This is further supported by paragraph 14 of the Witness

Statement of David Janow (referred to at paragraph 25 above) wherein the applicant sets out that its goods are available through the applicant directly and through speciality food stores or sports nutrition outlet. I also note the opponent's evidence that shows rice protein available from online retailers.²⁸ While this may not be the applicant's intention, I must consider all goods that the term may cover. Therefore, I find that the users of the applicant's goods will also be members of the general public. As a result, there will be an overlap in user. However, the user base for the opponent's goods is significantly wide and I am of the view that the applicant's goods' users will be limited to those who have a keen interest in health and/or body building or have a specific nutritional need for protein supplements. Therefore, I find that any overlap in user will be limited due to the specialist nature of the applicant's goods.

70. The purpose of the opponent's goods is that it will be eaten by the user as a general food product. The purpose of the applicant's goods is that it is consumed as a dietary supplement with the aim of increasing the user's protein intake for body building or general health and well-being purposes. I do not consider there to be any overlap in purpose between the parties' goods.

71. I note the opponent's evidence²⁹ wherein it shows that a use of rice protein is that it can be added to a drink and/or food. However, I do not find that this gives rise to an overlap in method of use. The reasons for this is that the method of use for rice is that it will, commonly, be cooked and then eaten by the user whereas rice protein concentrates will be mixed with other ingredients and consumed, commonly, as a drink known as a 'protein shake'. While it may also be mixed into food and consumed, it will be as an ingredient and I do not consider that rice protein powder will be eaten on its own. Therefore, I do not consider there to be any overlap in method of use.

72. In regard to the nature of the goods, I note that the opponent stated that the applicant's goods are similar to its own as rice is a main ingredient or component

²⁸ Exhibit RAC 2 in the Witness Statement of Rosemary Cardas

²⁹ Exhibit RAC 6 in the Second Witness Statement of Rosemary Cardas

of both goods. While this may be the case, it does not automatically give rise to a finding of similarity between the goods (see *Les Éditions Albert René v OHIM*, Case T-336/03). The nature of the opponent's goods are that they are grains of different types of rice. While the applicant's goods are derived from rice, it is a concentrated protein powder. The nature of these goods is, therefore, different.

73. I do not consider that the average consumer would consider that an undertaking who produces rice, generally, to also produce rice protein concentrate. Therefore, I do not find that there is any overlap in trade channels between the goods. As for the distribution channels, I am of the view that rice will be sold in general brick and mortar stores such as supermarkets and their online equivalents. As for the applicant's goods, it will fall within the same category as other types of protein powders, such as whey, hemp and pea proteins. While they will be sold in health food stores, they may also be found in larger supermarkets. While both goods may be found in larger supermarkets, they will not be located on the same shelves or aisles as each other. Neither will they be found for sale under the same categories of supermarkets' websites. I do not consider this to be enough to find any overlap in distribution channels.

74. I appreciate that it is possible for ordinary food products (such as different types of nuts) to be chosen for their protein content and, therefore, be in competition with the applicant's goods. However, there is no evidence that rice is purchased by the average consumer as a source of protein. In my experience, as a consumer of groceries, rice is considered a source of carbohydrate. In the absence of any evidence to the contrary, I find that it is unlikely that the goods will be in competition with each other. Further, the goods do not have a close connection with each other in the sense that one is indispensable or important to each other in such a way that the average consumer may think that the responsibility of them lies with the same undertaking.³⁰ Therefore, there is no complementary relationship between them.

³⁰ *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06

75. Overall, I have found that these goods will differ in purpose, nature, method of use, trade channels and distribution channels. Also, there will be no competitive or complementary relationship between them. While I have found there to be a limited overlap in user. I do not consider it to be sufficient enough to find any similarity between the goods. Therefore, I find that these goods are dissimilar.

76. As some degree of similarity between the goods is necessary to engage the test for likelihood of confusion, my findings above mean that the opposition must fail.

77. If I am wrong in my finding that the goods are dissimilar, then they are similar to only a low degree. Based on this finding, I would still have rejected the opposition. My reasons follow.

The average consumer and the nature of the purchasing act

78. The case law, as set out earlier, requires that I determine who the average consumer is for the respective parties' goods. I must then decide the manner in which these goods are likely to be selected by the average consumer in the course of trade. 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.”

79. The applicant has submitted:

“the applied-for goods covered by the contested mark ultimately target a niche market of consumers who aim to gain a protein intake for body-building, health and fitness purposes. Additionally, rice protein powder can supply proteins for vegan consumers, and thus help them replace dairy, egg and/or meat diets which are protein-intensive. Mr Janow also explains that the actual consumers of his goods are food manufacturers that will process the goods covered under the mark into different nutritional products, and the end consumer is unlikely to see the mark ORYZATEIN at all or alone. On the other hand, the earlier mark’s goods are for mass-consumption and address the public at large. Therefore, the Applicant submits that the Opponent’s Earlier Mark’s registered goods and the contested mark’s applied-for goods target vastly different consumer groups, which has implications in the assessment below.”

80. As I have set out in paragraph 69 above, the average consumer for the applicant’s goods will be food manufacturers and members of the general public. I agree with the applicant’s submissions that the opponent’s mark’s goods address the public at large and I, therefore, find that the average consumer for the opponent’s goods are members of the general public.

81. As I have found at paragraph 73 above, the parties’ goods are most likely to be sold to members of the general public through a range of retail shops, such as supermarkets and their online equivalents. The goods will be displayed on shelves, where they will be viewed and self-selected by the consumer. A similar process will apply to websites, where the consumer will select the goods having viewed an image displayed on a webpage. The selection of the goods by members of the general public will, therefore, be primarily visual. While the visual aspect plays a greater role in the selection process, I do not discount aural consideration in the form of word of mouth recommendations and advice sought from shop assistants. The business user of the applicant’s goods is likely to purchase the goods through the applicant itself, most likely via the applicant’s online website or telephone sales. The selection of the goods by business users will, therefore, be both visual and aural depending on the method of sale used.

82. When choosing the applicant's goods, both the business users and members of the general public will bear in mind several factors such as dietary requirements, flavour, use by/best before dates and/or nutritional information. I conclude that the average consumer is likely to pay a medium degree of attention during the selection process of the applicant's goods. However, for an ordinary grocery product such as rice, the average consumer is likely to pay between a low and medium degree of attention.

Distinctive character of the opponent's mark

83. 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).”

84. Registered trade marks possess various degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, 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 made of it. In this case, the opponent has not pleaded that its mark has acquired enhanced distinctiveness through use in the UK. In any event, I do not consider the evidence filed by the opponent to be sufficient to demonstrate enhanced distinctiveness because the evidence provided does not demonstrate any use within the UK. Consequently, I have only the inherent position to consider.

85. I note that throughout its evidence and submissions, the applicant has set out that the term 'ORYZA' refers to the genus *oryza* that includes the species of plant that produces rice. The applicant has argued that the term 'ORYZA' is, therefore, descriptive and devoid of distinctive character and, as a result, the distinctiveness of the mark can only lie in its figurative elements. The assessment of likelihood of confusion I must make is in relation to the average consumer within the UK. It should not be assumed that just because a word has a meaning, the average consumer would be aware of it.³¹ When faced with the word 'ORYZA', I do not find that the average consumer in the UK would think of a plant that produces rice. Therefore, I find that the average consumer in the UK will see the word as either an invented or foreign language word with no particular meaning.

86. The device elements, being the oval shape and ribbon background will serve as background elements only and will likely be overlooked by the average consumer in the UK. While these elements may add to the overall distinctiveness of the mark, they play such a minor role that any added distinctiveness would be limited. I conclude that the distinctive character of the mark will be dominated by the word 'ORYZA'. Given that the word 'ORYZA' will be seen as invented or foreign language word with no particular meaning, I find that the opponent's mark has between a medium and high degree of inherent distinctive character.

³¹ *Chorkee Ltd v Cherokee Inc.*, Case BL O/048/08

Comparison of marks


87. It is clear from *Sabel 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.

88. 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.”

89. 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.

90. The respective trade marks are shown below:

The opponent's mark	The applicant's mark
	<p data-bbox="1007 360 1190 394">ORYZATEIN</p>

91. I have submissions from the applicant in respect of the comparison of marks that I will refer to below, as necessary.

Overall Impression

The applicant's mark

92. The applicant's mark consists of the word 'ORYZATEIN'. There are no other elements that contribute to the overall impression, which lies in the word itself.

The opponent's mark

93. The opponent's mark consists of the word 'ORYZA' with two black and white background elements. While the word 'ORYZA' is stylised very slightly, I consider that this is likely to be overlooked by the average consumer. I have found above that the device elements will simply be seen as a label background to the word element. Further, I am of the view that the eye is naturally drawn to the parts of the mark that can be read. Therefore, I find that the word 'ORYZA' will play a greater role in the overall impression of the mark with the background elements playing a lesser role.

Visual Comparison

94. Visually, the marks coincide in the letters 'O-R-Y-Z-A'. The marks differ in that the letters 'T-E-I-N' that are included at the end of the applicant's mark, are absent in the opponent's mark. Further, the device elements in the opponent's mark are not present in the applicant's mark and while I have found that they will play a lesser role in the opponent's mark, they will still constitute a visual difference. Overall, I find that the marks are visually similar to a medium degree.

Aural Comparison

95. The applicant submits that:

"64. Aurally, the contested mark "ORYZATEIN" is considerably longer and formed by 4 syllables. The two words are stressed differently i.e. O-RY-ZA / O-RY-ZA-TEIN, and in pronouncing them, the average consumer will attribute a different meaning overall for each mark. The signs are similar to a low degree at best."

96. I disagree with the applicant's submissions that the average consumer will stress certain parts of the common element differently. Aurally, the opponent's mark consists of three syllables that will either be pronounced 'OR-EE-ZA' or 'OR-IZ-AH'. The applicant's mark consists of four syllables that will be pronounced either 'OR-EE-ZA-TEEN' or 'OR-IZ-AH-TEEN'. The first three syllables of the marks are identical. However, there is a noticeable difference when pronouncing the last syllable of the applicant's mark, particularly given the presence of a hard 'T' sound which impacts the aural impression of the mark. Taking all of this into account, I find that the marks are aurally similar to a medium degree.

Conceptual Comparison

97. I note that throughout its evidence and submissions, the applicant has stated that its mark will be seen as being protein that comes from rice. I have already found that 'ORYZA' will not be perceived by the average consumer as being connected

to rice. The average consumer will see the word 'ORYZATEIN' as a made-up or foreign language word with no identifiable concept. In respect of the opponent's mark, the only element that is possible of conveying any concept is the word 'ORYZA'. I find that the average consumer will see this as an invented or foreign language word with no identifiable concept. Therefore, I find that the marks are conceptually neutral.

Likelihood of confusion

98. 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 mark, the average consumer for the goods 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.

99. I am proceeding on the basis that the respective goods are similar to a low degree. I have found the average consumer for the opponent's goods to be a member of the general public and for the applicant's goods, a member of the general public and business users. For members of the general public, the goods will be purchased primarily by visual means, although I do not discount an aural component. However, for business users, the applicant's goods will be purchased by both visual and aural means. I have concluded that a medium degree of attention is likely to be paid in the purchasing process of the applicant's goods. However, I have concluded that for the opponent's goods, this is likely to be

between a low and medium degree. I have found that marks to be visually and aurally similar to a medium degree and conceptually neutral. The opponent's mark has between a medium and high degree of inherent distinctive character. I have taken these factors into account in my assessment of the likelihood of confusion between the marks.

Direct Confusion

100. Notwithstanding the principle of imperfect recollection and taking all of the above factors into account, I consider that the presence of the letters 'T-E-I-N' in the applicant's mark and/or the device element in the opponent's mark will be sufficient to enable the consumer to differentiate between the marks. This will particularly be the case given the importance of the visual and aural components in the selection of the goods at issue and in circumstances in which the consumer will be paying a medium degree of attention when selecting the applicant's goods. Consequently, I do not consider there to be a likelihood of direct confusion between the marks, especially given that they will be used on goods that are, at best, only similar to a low degree.

Indirect Confusion

101. I will now consider whether there is a likelihood of indirect confusion. Indirect confusion was described in the following terms by Iain Purvis Q.C., sitting as the Appointed Person in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10.

"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.”

102. I must consider whether average consumers would believe that there is an economic connection between the marks or that they are variant marks from the same undertaking as a result of the shared common elements of the marks.

103. In the case of *Canon* (cited above), the CJEU stated that a lesser degree of similarity between the goods or services of marks may be offset by the greater degree of similarity between the marks, and vice versa. Whilst I have found that the marks are similar, I do not consider these similarities great enough to overcome the fact that the goods are similar to only a low degree. This is particularly the case given that the visual component will play a significant role in the selection process of the goods at issue, meaning that the visual differences between the marks will not be overlooked. Further, when encountered aurally, the aural differences between the marks will also not be overlooked. I am of the view that average consumers are more likely to consider the similarities between the marks to be a coincidence when used on goods sharing such a low degree of similarity, rather than the marks originating from the same undertaking. For these reasons, I conclude that there is no likelihood of indirect confusion between the marks.

CONCLUSION

104. The opposition fails in its entirety and the applicant’s mark can proceed to registration.

COSTS

105. As the applicant has been successful, it is entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 2/2016. In the circumstances, I award the applicant the sum of **£1,100** as a contribution towards its costs. The sum is calculated as follows:

Preparing a statement and considering the opponent's statement:	£200
Preparing evidence and considering the opponent's evidence:	£600
Preparing written submissions in lieu of a hearing:	£300
Total	£1,100

106. I therefore order Euryza GmbH to pay Axiom Foods, Inc the sum of £1,100. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 22nd day of December 2020

A COOPER
For the Registrar