

O/0114/23

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 3624006
IN THE NAME OF
NATURALİ GIDA SANAYİ VE DIŞ TİCARET ANONİM ŞİRKETİ

TO REGISTER THE FOLLOWING TRADE
MARK:



IN CLASS 30

AND

IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 429018
BY NATURLİ' FOODS A/S

Background and pleadings


1. On 9 April 2021, NATURALİ GIDA SANAYİ VE DIŞ TİCARET ANONİM ŞİRKETİ (the “applicant”) applied to register the trade mark shown on the front page of this decision in the UK. The application, was published for opposition purposes on 10 September 2021 and registration is sought for the following goods:

Class 30: Coffee, cocoa; coffee or cocoa based beverages, chocolate based beverages; pasta, stuffed dumplings, noodles; pastries and bakery products based on flour; desserts based on flour and chocolate; bread, pasties, pita, sandwiches, pies, cakes; desserts based on dough coated with syrup; puddings, custard, rice pudding; honey, bee glue for human consumption, propolis for food purposes; condiments for foodstuff, vanilla (flavoring), spices, sauces (condiments), tomato sauce; yeast, baking powder; flour, semolina, starch for food; sugar, cube sugar, powdered sugar; tea, iced tea; confectionery, chocolate, biscuits, crackers, wafers; chewing gums; ice-cream, edible ices; salt; cereal-based snack food, popcorn, crushed oats, corn chips, breakfast cereals, processed wheat for human consumption, crushed barley for human consumption, processed oats for human consumption, processed rye for human consumption, rice; molasses for food.

2. The application was opposed by NATURLI' FOODS A/S (“the opponent”) on 1 December 2021. The opposition is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”) with the opponent relying upon the following marks:

Earlier Mark	Registration no.	Filing and registration date
NATURLI'	UK00003695102 (“The first earlier mark”)	Priority date: 6 February 2019 ¹ Date of entry in register: 21 January 2022

¹ On 1 January 2021, the UK left the EU after the expiry of the transition period. Under Article 59 of the Withdrawal Agreement between the UK and EU, applications for EUTMs made before the end of the transition period that had received a filing date can form the basis of a UK application with the same filing date as the

	WO0000001450909	International registration date: 03 December 2018
	("The second earlier mark")	Date of protection of the international registration in UK 02 May 2019

3. The opponent relies upon some of its goods in classes 29, 30 and 32 as shown in paragraph 17 of this decision.

4. By virtue of their earlier priority date and international protection date respectively, the above registrations constitute as earlier marks within the meaning of section 6 of the Act.

5. The opponent submits that there is a likelihood of confusion because the applicant's registration is similar to the opponent's and the respective goods and services are identical or similar.

6. The applicant filed a counterstatement admitting that some of the goods covered by the earlier marks were either identical or similar to some of their applied for goods however they denied that all of the goods were similar. They also admitted the first earlier mark and their applied for mark were similar to a low degree, but that confusion was not likely between the same. They admitted that the second earlier mark was aurally similar to the applied for mark to a low degree but denied that the marks were visually or conceptually similar and submitted that overall, the marks were dissimilar.

7. Both parties are professionally represented in these proceedings; the opponent by Patrade AS and the applicant by Forresters IP LLP. Neither party filed evidence in these proceedings although the opponent did file written submissions. These will not be summarised but have been fully considered and will be referred to where appropriate throughout this decision. No hearing was requested so this decision is taken following a careful perusal of the papers.

corresponding EUTM, provided they were filed within 9 months of the end of the transition period. The opponent's EUTM number 018019833 was filed at the EUIPO on 6 February 2019, whereas its UK application was filed on 15 September 2021. Accordingly, the UK registration retains a priority date of 6 February 2019.

8. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts.

Proof of Use

9. As the opponent's marks had not completed their registration or designation processes more than 5 years before the filing 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 it has identified for both earlier marks.

Decision

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

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

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark”.

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

The principles:

- (a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;
- (b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
- (d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;
- (e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components; (f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;
- (g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;
- (h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

- (i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;
- (j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;
- (k) if the association between the marks creates a risk that the public 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 and services

12. When making the comparison, all relevant factors relating to the goods in the specification should be taken into account. In *Canon*, the Court of Justice of the European Union (“CJEU”) stated at paragraph 23 of its judgment:

“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”.

13. Guidance on this issue has also come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

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

d) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;

e) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

14. The General Court (“GC”) confirmed in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, that, even if goods are not worded identically, they can still be considered identical if one term falls within the scope of another (or vice versa):

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM- Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

15. For the purposes of considering the issue of similarity of goods and services, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way and for the same reasons (see *Separode Trade Mark* (BL O/399/10) and *BVBA Management, Training en Consultancy v. Benelux- Merkenbureau* [2007] ETMR 35 at paragraphs 30 to 38).

16. In *Sky v Skykick* [2020] EWHC 990 (Ch), Lord Justice Arnold considered the validity of trade marks registered for, amongst many other things, the general term ‘computer software’. In the course of his judgment, he set out the following summary of the correct approach to interpreting broad and/or vague terms:

“...the applicable principles of interpretation are as follows:

(1) General terms are to be interpreted as covering the goods or services clearly covered by the literal meaning of the terms, and not other goods or services.

(2) In the case of services, the terms used should not be interpreted widely, but confined to the core of the possible meanings attributable to the terms.

(3) An unclear or imprecise term should be narrowly interpreted as extending only to such goods or services as it clearly covers.

(4) A term which cannot be interpreted is to be disregarded.”

17. The goods to be compared are as follows:

The opponent's goods	The applicant's goods
<p>("The first earlier mark")</p> <p>30: Desserts based on soya milk or rice milk (confectionery); Coated nuts [confectionery]; Snack bars containing a mixture of grains; Ices based on soya milk or rice milk; Foodstuffs made of rice; Cocoa-based beverages; Extracts of cocoa for use as flavours in beverages; Processed grains, starches, and goods made thereof, baking preparations and yeasts.</p> <p>32: Rice-based beverages, other than milk substitutes; Nut and soy based beverages.</p>	<p>30: Coffee, cocoa; coffee or cocoa based beverages, chocolate based beverages; pasta, stuffed dumplings, noodles; pastries and bakery products based on flour; desserts based on flour and chocolate; bread, pasties, pita, sandwiches, pies, cakes; desserts based on dough coated with syrup; puddings, custard, rice pudding; honey, bee glue for human consumption, propolis for food purposes; condiments for foodstuff, vanilla (flavoring), spices, sauces (condiments), tomato sauce; yeast, baking powder; flour, semolina, starch for food; sugar, cube sugar, powdered sugar; tea, iced tea; confectionery, chocolate, biscuits, crackers, wafers; chewing gums; ice-cream, edible ices; salt; cereal-based snack food, popcorn, crushed oats, corn chips, breakfast cereals, processed wheat for human consumption, crushed barley for human consumption, processed oats for human consumption, processed rye for human consumption, rice; molasses for food.</p>
<p>("The second earlier mark")</p> <p>29: Soya milk (milk substitute), rice milk (milk substitute), milk beverages based on soya milk or rice milk; nut milk (milk substitute); oat milk (milk substitute); coconut milk for culinary purposes; sour cream substitutes; soya yoghurt; soy-based snack foods; soybean oil for cooking; nut oils; coconut oil; beans; tofu; tofu-based snacks; falafel; vegetable-based meat substitutes, ready meals consisting primarily of meat substitutes.</p> <p>30: Desserts based on soya milk or rice milk (confectionery); coated nuts [confectionery]; snack bars containing a mixture of grains, nuts and dried fruit [confectionery]; ices based on soya milk or rice milk; foodstuffs made of rice; cocoa-based beverages; extracts of cocoa for use as flavours in beverages.</p>	

The first earlier mark

18. In their counterstatement, the applicant has highlighted the goods that they admit are identical to that of the opponent's. I agree and find the following goods in the applicant's specification are either self-evidently identical to the opponent's goods or otherwise identical on the principle outlined in *Meric*.

Cocoa based beverages; rice pudding; yeast, baking powder; flour, semolina, starch for food; confectionery; ice-cream, edible ices; cereal-based snack food, popcorn, crushed oats, corn chips, breakfast cereals, processed wheat for human consumption, crushed barley for human consumption, processed oats for human consumption, processed rye for human consumption, rice.

19. I consider the opponent's *cocoa-based beverages* would encompass *cocoa* and *chocolate based beverages* in the applicant's specification. On that basis, they are identical in line with *Meric*.

20. *Processed grains, starches, and goods made thereof, baking preparations and yeasts* would include food items made from various flours and I find that this would include the applicant's *pasta, stuffed dumplings, noodles; pastries and bakery products based on flour; desserts based on flour and chocolate; bread, pasties, pita, sandwiches, pies, cakes; biscuits, crackers, wafers*. I therefore consider these terms to be identical in line with *Meric*.

21. There is an overlap in terms of nature and purpose with the applicant's *coffee; coffee based beverages; tea, iced tea* and the opponent's *cocoa based beverages* insofar as they are non-alcoholic beverages for the purpose of human consumption. The goods would be found within close proximity of one another in the same aisle of a supermarket and I find there would also be a degree of competition between the same. I do not consider there to be a complementary relationship between the goods, and I do not find that these goods would be derived from the same manufacturer. Weighing up these factors, I find there is a medium degree of similarity between these goods.

22. The applicant's *desserts based on dough coated with syrup* and the opponent's *desserts based on soya milk or rice milk (confectionery)* overlap in terms of nature and purpose insofar as they are both desserts intended to be eaten after a main meal, however I acknowledge that they are made from different key ingredients. These goods would be sold close to each other in a supermarket and there would also be an overlap in users and a degree of competition between the same. The goods may also be derived from the same manufacturer however, I do not find there to be a complementary relationship. Consequently, I consider these goods to be similar to a high degree.

23. I consider the applicant's *pudding* and to be a type of dessert intended to be eaten after a main meal and on that basis, I consider there to be an overlap in terms of nature, purpose and user with the opponent's *desserts based on soya milk or rice milk (confectionery)*. There would be an overlap in trade channels with the respective goods being sold within close proximity to one another and the same manufacturer may be responsible for the same goods. There is, however, no complementary relationship to be found. Considering these factors, I find there is a high degree of similarity between these goods.

24. I consider the applicant's *custard* and the opponent's *desserts based on soya milk or rice milk (confectionery)* to both be sweet items to be consumed after a main meal however I acknowledge that *custard* is a dessert accompaniment rather than a dessert itself. There would be an overlap in users and trade channels, and I would expect the goods would be sold next to one another in the chilled aisle of a supermarket. Although *custard* would sometimes be consumed alongside *desserts based on soya milk or rice milk (confectionery)*, I do not take this to mean that the respective goods are important or indispensable to one another to the extent that consumers would believe that the goods are derived from the same undertaking² and as such, there is no complementary relationship to be found. Further, I do not consider there to be a degree of competition between the goods. Weighing up these factors, I consider there to be medium degree of similarity between these goods.

² *Boston Scientific Ltd v OHIM*, Case T-325/06

25. The applicant's *sugar, cube sugar, powdered sugar; vanilla (flavoring); molasses for food* would be found alongside the opponent's *baking preparations* in a supermarket. Although their nature differs, I consider there would be an overlap in purpose and method of use as these goods are used to make sweet baked goods. I also find there would be an overlap in users however, I do not consider there to be a competitive or complementary relationship between these goods. Overall, I consider there to be a medium degree of similarity between these goods.

26. *Condiments for foodstuff, sauces (condiments) and tomato sauce* are all preparations intended to be added to food typically after cooking, to enhance the flavour of a dish. They would be eaten alongside the opponent's *processed grains, starches, and goods made thereof* for example with bread, crackers or noodles however, I do not consider this to be a complementary relationship to the extent that the average consumer would believe that the goods are derived from the same undertaking. Although the respective goods are all foodstuffs, I find they differ in terms of nature and method of use and would be sold in different parts of a supermarket. I do not consider there to be a competitive relationship between the goods. Balancing these factors, I do not consider there to be any similarity between these goods.

27. *Salt and spices* in the applicant's specification are typically used during the cooking process or used after cooking to enhance the flavour of a dish. They would certainly be found in many of the opponent's goods such as *foodstuffs made of rice* however, their nature and intended purpose differ. I do not consider there to be a competitive or a complementary relationship between these goods either. Although, these goods would all be found in a supermarket, they would be sold in completely different areas. There would be an overlap in users but only insofar as they are the general public. At this point I also acknowledge that salt and spices may also be used in baking however I do not find any similarity compared to the opponent's *baking preparations* as the goods differ in nature and purpose, they do not compete nor are they complementary and they would be sold in different areas of a supermarket. Overall, I do not consider there to be any similarity between these goods.

28. I now compare the applicant's *chocolate* to the opponent's *snack bars containing a mixture of grains*. There is a slight overlap in nature especially when the opponent's snack bars are coated in or contain chocolate. The respective goods are

usually intended to be consumed as a snack or treat and on that basis, I find there is also an overlap in terms of purpose and method of use. The goods would typically be found within close proximity to one another in a supermarket and I also find there would be a degree of competition between these goods as well as an overlap in user. There is, however, no complementary relationship to be found. Overall, I consider these goods to have a medium degree of similarity.

29. *Honey, bee glue for human consumption and propolis for food purposes* are all sweet products that may be used as ingredients in the opponent's goods such as *desserts based on soya milk or rice milk (confectionery)*. Though it may be the case that these goods are found in desserts, I do not consider this to be a complementary relationship where the goods are indispensable to one another to the extent that consumers believe they are derived from the same undertaking. The goods also differ in nature and method of use as I find that *honey, bee glue for human consumption and propolis for food purposes* is generally added to food and drink as a sweetener. There would be a broad overlap in users, namely the general public but the goods would be found in different areas of a supermarket and do not enjoy competitive relationship. I also acknowledge that honey may be used in baking however, I do not find any similarity compared to the opponent's *baking preparations* as the goods differ in nature and purpose, they do not compete nor are they complementary and they would be sold in different areas of a supermarket and be derived from different undertakings. Consequently, I do not find any similarity between these goods.

30. I find that applicant's *chewing gums* and the opponent's *coated nuts [confectionery]* are sometimes found in similar areas of a supermarket near tills or in the confectionery aisle. I consider that the nature and purpose of the respective goods differ as coated nuts are eaten as a snack to satiate hunger whereas chewing gum is typically consumed after eating to freshen ones breath. Broadly speaking, there would be an overlap in consumers, being the general public however, I do not consider the respective goods to enjoy a complementary or competitive relationship. Weighing up these factors, I consider these goods to be dissimilar.

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

the first earlier mark must fail against the goods of the application that I have found to be dissimilar³, namely:

Class 30: Condiments for foodstuff; sauces (condiments) tomato sauce; salt; spices; honey, bee glue for human consumption and propolis for food purposes; chewing gums.

The second earlier mark

32. For the second earlier mark, the applicant has again highlighted in their counterstatement the goods that they admit are identical to that of the opponent's. I agree and find the following goods in the applicant's specification are either self-evidently identical to the opponent's goods or otherwise identical on the principle outlined in *Meric*.

Cocoa; Cocoa based beverages; rice pudding; confectionery; ice-cream, edible ices.

33. I consider that the opponent's *cocoa-based beverages* would encompass the applicant's *chocolate based beverages*. On that basis, they are identical in line with *Meric*.

34. The applicant's specification includes the term *rice*. I find that this would encompass the opponent's *foodstuffs made of rice* and on that basis, I consider them to be identical on the principle outlined in *Meric*. If I am wrong on this, I consider the goods to be highly similar due to their overlap in nature and purpose. The goods may originate from the same producer and be found within close proximity to one another in a supermarket. I also find that there would be an overlap in users and a degree of competition between the goods.

35. I now consider the terms *pasta* and *noodles to foodstuffs made of rice*. It is not uncommon for, pasta and noodles to be made from rice flour and I therefore find these

³ *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, paragraph 49

goods to be identical on the principle outlined in *Meric*. If I am wrong on this, then I consider the goods to be similar to a high degree as they have an overlap in nature and purpose. The goods would also be found close to one another in a supermarket and have an overlap in users. There would also be a degree of competition between the respective goods.

36. I consider that the applicant's *stuffed dumplings* are savoury foodstuffs usually made from flour and typically consumed as an accompaniment to a main meal. Although they may be eaten alongside the opponent's *foodstuffs made from rice*, I find that they differ in terms of nature. There may be a broad overlap in purpose insofar as they are savoury food items intended to satiate hunger. There would also be an overlap in users and trade channels, though I do not find it likely that the respective goods would be found close to one another in a supermarket. Although stuffed dumplings may be eaten alongside foodstuffs made from rice, I do not consider this to be an important or indispensable relationship to the extent that consumers would believe that the goods are derived from the same undertakings. There may be some degree of competition though, when consumers are faced with the choice of savoury foodstuffs. Overall, I consider these goods to have a low to medium degree of similarity.

37. For the same reasons as outlined in paragraph 21 in this decision, I find there to be a medium degree of similarity between the applicant's *coffee; coffee based beverages; tea, iced tea* and the opponent's *cocoa based beverages*.

38. The applicant's *desserts based on dough coated with syrup; desserts based on flour and chocolate* and the opponent's *desserts based on soya milk or rice milk (confectionery)* overlap in terms of nature, purpose and method of use insofar as they are all sweet desserts typically intended to be eaten after a main meal. I acknowledge however that they are made from different key ingredients. These goods would be sold close to each other in a supermarket and there would also be an overlap in users and a degree of competition between the same. The goods may also be derived from the same manufacturer however, I do not find there to be a complementary relationship. I consider these goods to be similar to a high degree.

39. As previously outlined in paragraph 23 of this decision, I consider the applicant's *puddings* be similar to a high degree compared to the opponent's *desserts based on soya milk or rice milk (confectionery)*.

40. Again, I previously outlined my findings of similarity between the applicant's *custard* and the opponent's *desserts based on soya milk or rice milk (confectionery)* in paragraph 24 of this decision. I find these goods to be similar to a medium degree

41. *Cereal-based snack food, popcorn* and *corn chips* would be found in a supermarket within close proximity to *coated nuts [confectionery]*. I consider the respective goods to be different types of sweet or savoury goods intended to be eaten as a snack and to that extent, I consider there to be an overlap in terms of nature and purpose. There would also be an overlap in users and a degree of competition however, there is no complementary relationship to be found. Weighing up these factors, I find the goods to be similar to a medium to high degree.

42. Turning to *crushed oats, breakfast cereals, processed wheat for human consumption, crushed barley for human consumption, processed oats for human consumption* and *processed rye for human consumption*, I consider these to be various cereals and grains intended to be eaten typically at breakfast. These goods differ in nature to the opponent's *snack bars containing a mixture of grains, nuts and dried fruit [confectionery]* though I note the respective goods all include some type of grain. From this, I consider that the goods may originate from the same manufacturer as it is not uncommon for companies who make various grains and cereals to make snack bars consisting of grains and cereals. Further, there would be an overlap in users and there may be some degree of competition between the goods if a consumer is faced with the choice of purchasing opponent's snack bars as a convenient alternative to the applicant's goods. The goods may be found within close proximity to one another in the breakfast/cereal aisle in a supermarket and I also consider there to be a broad overlap in respect of purpose as the goods are intended to satiate hunger. I do not consider there to be a complementary relationship between the goods. Overall, I find there is a medium degree of similarity between these goods.

43. I now compare the applicant's *chocolate, biscuits, crackers* and *wafers* to the opponent's *snack bars containing a mixture of grains*. There is a difference in nature

however, the respective goods are usually intended to be consumed as a snack or treat and on that basis, I find there is an overlap in terms of purpose. The goods would typically be found within close proximity to one another in a supermarket and I also find there would be a degree of competition between these goods as well as an overlap in user. I do not consider there to be a complementary relationship between these goods. Overall, I consider these goods to have a medium degree of similarity.

44. The opponent's *soybean oil for cooking; nut oils and coconut oil* and the applicant's *condiments for foodstuff, sauces (condiments), tomato sauce; salt and spices* may all be used during cooking and as such, I consider there to be a general overlap in users however, I find it unlikely that these respective goods would be found next to one another on supermarket shelves. Differences also lie in the physical nature and method of use of these goods and there does not appear to be any competitive or complementary relationship between the same. As such, I do not consider there to be any similarity between these goods.

45. For the same reasons as outlined in paragraph 29, I do not consider there to be any similarity between the applicant's *honey, bee glue for human consumption, propolis for food purposes* and the opponent's *desserts based on soya milk or rice milk (confectionery) or baking preparations*.

46. Again, I previously outlined in paragraph 30 my reasoning for there being no similarity between the applicant's *chewing gum* and the *opponent's coated nuts [confectionery]*. I also find this to be the case here and there is no similarity between the same.

47. The applicant's *yeast, baking powder; flour, semolina, starch for food; sugar, cube sugar, powdered sugar; vanilla (flavoring)* and *molasses for food* are all products typically used for baking. Whilst they may be found near the opponent's *extracts of cocoa for use as flavours in beverages* in a supermarket, their respective nature and purposes differ. There is a broad overlap in users however, I do not consider these goods to have any complementary or competitive relationship. Consequently, I do not consider these goods to be similar.

48. I consider *pastries and bakery products based on flour; bread, pasties, pita, sandwiches, pies, and cakes* to all be baked goods which would predominantly be found in the bakery section of a supermarket (though I acknowledge that this would not usually be the case in respect of sandwiches). They would not be found within close proximity to any of the opponent's goods and their nature and purposes differ. The users would generally overlap insofar as they would be the general public at large however, there is no competitive or complementary relationship to be found. Overall, I do not find these goods to have any similarity with the opponent's goods.

49. As some degree of similarity between goods is necessary to engage the test for likelihood of confusion, my findings above mean that the opposition in respect of the second earlier mark must fail against the goods of the application that I have found to be dissimilar,⁴ namely:

Class 30: Condiments for foodstuff; sauces (condiments) tomato sauce; salt; spices; honey, bee glue for human consumption and propolis for food purposes; chewing gums; pastries and bakery products based on flour; bread, pasties, pita, sandwiches, pies, cakes; vanilla (flavoring); yeast, baking powder; flour, semolina, starch for food; sugar, cube sugar, powdered sugar; molasses for food.

The average consumer and the nature of the purchasing act

50. 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 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:

“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

⁴ *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, paragraph 49

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.”

51. The goods at issue are, broadly speaking, day-to-day products being foodstuffs and beverages. The average consumer for these goods will primarily comprise members of the general public however, there will also be some business users purchasing on behalf of a commercial undertaking. The goods will be purchased fairly frequently and be relatively inexpensive and I would therefore expect the general public to pay a fairly low degree of attention during their selection.

52. The goods are likely to be self-selected by the general public from a supermarket or their online equivalents. Visual considerations are, therefore, likely to dominate the selection process. However, given that advice may be sought from sale assistants, and orders may be placed over the phone, I do not discount an aural component to the purchase.

53. In respect of the business user the goods will be available via wholesale websites, catalogues, and stores. They will likely pay a medium degree of attention when purchasing goods on behalf of a business. Whilst the visual considerations are also likely to dominate in these circumstances the goods may be ordered over the phone, and so I cannot completely discount the aural considerations in this respect either.

Comparison of marks



54. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant

components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“...it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relevant 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.”

55. 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 trade marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

56. The marks to be compared are as follows:

Opponent's marks	Applicant's mark
<p data-bbox="411 1223 560 1256">NATURLI'</p>	
	

Overall impression

57. The opponent's first earlier mark is in word-only format and consists of the word "NATURLI" presented in an upper-case font followed by an apostrophe. Generally, as a rule, the beginning of marks are considered to have more impact than their endings⁵ and as a result I find the "NATURLI" wording plays the dominant role. The apostrophe plays a much lesser role, although it is not negligible.

⁵ *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

58. The second earlier mark consists of the word “NATURLI” in an upper case blue font followed by an apostrophe. Above the letters U and R sits a small figurative device of two blue leaves overlapping. I am of the view that the wording dominates the overall impression of the mark. Whilst it will not be overlooked, the leaf device plays a lesser role in the overall impression. Again, I consider that the apostrophe plays a much lesser role although it is not negligible.

59. The applicant’s mark consists of the word “NATURALI” presented in a black font. The lettering is presented in a mixture of upper and lower case however, the sizing of the lettering is consistent throughout. Two figurative leaf devices stem from the top of the letter “T”. The wording is presented on a lime green background. The word element dominates the overall impression, followed by the leaf device. Whilst the background plays a far lesser role, I do not consider it to be negligible.

Visual comparison

The first earlier mark

60. Visually, both marks coincide through use of the letters “NATUR_LI”, however, the applicant’s mark includes the letter “A” between the letters “R” and “L” and the wording in the opponent’s mark is followed by an apostrophe. The discrepancy in letter case does not create a point of significant difference between the marks, since the registration of word-only marks provides protection for the words themselves, irrespective of whether they are presented in upper, lower or title case.⁶ I also acknowledge that fair and normal use of the earlier word mark would permit the use of black font on a lime green background. The applicant’s mark contains a figurative leaf device stemming from the letter “T”, an element which is not present in the opponent’s mark. Weighing up these factors, I find the marks to be visually similar to a high degree.

The second earlier mark

⁶ *Migros-Genossenschafts-Bund v EUIPO*, Case T-189/16

61. Again, the second earlier mark and the applicant's mark coincide through use of the letters "NATUR_LI", however, the applicant's mark includes the letter "A" between the letters "R" and "L" and the wording in the opponent's mark is followed by an apostrophe. Both marks also contain a figurative device showing two leaves above the lettering however, the device in the opponent's mark sits atop the letters "UR" whereas they stem from the letter "T" in the applicant's device. I also note the slight difference in presentation of upper case and lower case lettering between the marks and the fact that the opponent's mark is presented in a blue font on a white background whereas the applicant's mark is presented in a black font on a lime green background. Overall, I find there is a high degree of visual similarity between these marks.

Aural comparison

62. In respect of both earlier marks, I find that they will be pronounced by some consumers in three syllables as "NAT-EARL-EE", but I accept that other consumers will pronounce the mark as "NATE-EARL-EE". The applicant's mark will be pronounced in four syllables as "NAT-ER-A-LEE". When both the earlier marks and the applicant's marks are pronounced as "NAT-EARL-EE" and "NAT-ER-A-LEE" respectively, I find them to be similar to a high degree. If the opponent's marks are pronounced as "NATE-EARL-EE" and the applicant's pronounced "NAT-ER-A-LEE", I find there is a medium to degree of similarity.

Conceptual comparison

63. In its counterstatement, the applicant submits that their mark will bring to mind soil and greenery whereas their second earlier mark will bring to mind water. I am not convinced by this argument as I remind myself that for a conceptual message to be relevant it must be capable of immediate grasp by the average consumer. This is highlighted in numerous judgments of the General Court ("GC") and the CJEU including *Ruiz Picasso v OHIM*⁷. The assessment must be made from the point of view of the average consumer.

⁷ [2006] e.c.r.-I-643; [2006] E.T.M.R. 29

64. I am of the view that consumers will regard the competing marks as invented words. I do find however, that consumers will perceive the “NATUR” element in all three marks as relating to nature, even though the words “NATURLI” and “NATURALI” are not dictionary-defined words in the English Language. The figurative elements in the second earlier mark and the applicant’s mark will further reinforce this idea. I do not consider that the apostrophe in both earlier marks will convey any message to the average consumer. I also consider that to some consumers; the applicant’s mark may be perceived as a deliberate misspelling of “naturally”. Overall, I find there is a high degree of conceptual similarity between both earlier marks and the applicant’s mark.

Distinctive character of the earlier mark

65. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods for which it has been registered as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585. In *Lloyd Schuhfabrik*, 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).”

66. 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.

67. The opponent has not filed any evidence to support the earlier marks’ distinctive character have been enhanced through use. Consequently, I have only the inherent position to consider.

The first earlier mark

68. As previously outlined in the conceptual comparison, the average consumer will see the word “NATURLI” as an invented word however, this wording is likely to be suggestive of nature. This is not directly descriptive of the goods at issue however, it does allude to a characteristic of the goods, that is that they are in some way natural or derived from natural processes. Bearing that in mind, I consider this mark possesses a medium degree of distinctive character.

The second earlier mark

69. In relation to the second earlier mark, I make the same findings as above in relation to the “NATURLI” word element. In this case, the stylisation of the wording is minimal and as such, I do not find it elevates the mark’s distinctiveness. Further, the fact that I found the word “NATURLI” to be somewhat allusive of the goods at issue

will no doubt be emphasised by the mark's figurative leaf device. Again, I find this mark holds a medium degree of distinctive character.

Likelihood of confusion

70. There is no simple formula for determining whether there is a likelihood of confusion. I must make a global assessment of the competing factors (*Sabel* at [22]), keeping in mind the interdependency between them (*Canon* at [17]) and considering the various factors from the perspective of the average consumer. In making my assessment, I must bear in mind 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 he has retained in his mind (*Lloyd Schuhfabrik* at [26]).

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

72. Earlier in this decision, I concluded that:

- Some of the applicant's goods are identical to the goods of the earlier marks while others are similar to a low degree;
- The average consumer is a member of the general public who will pay a fairly low degree of attention during the purchasing process or a business user purchasing on behalf of a business who will pay no more than a medium degree of attention;
- In respect of both consumer groups, the purchasing process will be predominantly visual, though aural considerations have not been excluded;
- Both earlier marks possess a medium degree of inherent distinctive character;

- Compared to the applicant's mark, both earlier marks are visually and conceptually similar to a high degree;
- In circumstances where the earlier marks are pronounced as "NAT-EARL-EE", they have a high degree of similarity to the applicant's mark but if the earlier marks are pronounced as "NATE-EARL-EE", they have a medium degree of similarity to the applicant's mark.

73. I begin by considering the first earlier mark. The competing marks overlap in respect of the first five letters and the last letter. I recognise there are several points of difference being the presence of the letter "A" towards the end of the applicant's mark and the inclusion of an apostrophe at the end of both earlier marks. The first earlier mark is also in word format only however, I remind myself that I found the figurative elements in the applied for mark to be mainly decorative and would be perceived as reinforcing the conceptual message shared by the marks. It is also well established that the word elements of a composite mark must generally be regarded as more distinctive than the figurative elements since the relevant public will keep in mind the word elements to identify the mark concerned, the figurative elements being perceived more as decorative.⁸ Taking this into account along with the imperfect recollection of the consumer and the similarity of the goods, I am of the view that consumers may not recall the respective marks with sufficient accuracy to differentiate between them. Rather, I find that the initial "NATUR" element of the competing marks will be retained in the consumers' minds and the shared concept of "nature" will help this element to be recalled in the marks. Considering these factors, alongside the interdependency principle, I consider there to be a likelihood of direct confusion.

74. Regarding the second earlier mark, I make the same findings as above and consider that consumers will be first drawn to the word element of the competing marks, of which I have found to be highly similar. The concept evoked by this element will help it to stick in the consumer's mind and be remembered. Consumers may also notice the shared leaf elements between the marks, and I am of the view that their exact placement and stylisation may be easily misremembered, though the conceptual message will be shared. On the contrary, the additional elements such as the

⁸ see *Migros-Genossenschafts-Bund v EUIPO – Luigi Lavazza (CReMESPRESSO)*, Case T-189/16, paragraph 52

apostrophe at the end of the mark and the stylisation of the lettering are mainly decorative and are therefore unlikely to stick in the consumer's mind. I acknowledge again, that the average consumer will pay a fairly low degree of attention during the purchasing process. Taking these factors into account alongside the interdependency principle, I find that the average consumer may not recall the differences between the marks and as such, there is a likelihood of direct confusion.

75. I now go on to consider indirect confusion.

76. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis K.C., as the Appointed Person, explained that:

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

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

77. These examples are not exhaustive but provide helpful focus.

78. I note that the respective marks do not appear to fall directly into one of the categories highlighted in *L.A. Sugar*. However, I note that these categories are not exhaustive. For a finding of indirect confusion, I would need to conclude that consumers will notice the common “NATUR” and “LI” elements and recall the differences between the marks and assume that the marks are from the same or related undertakings. I am not convinced that the differences between the competing marks (in particular, the addition of the letter “a” in the applicant’s mark) are a signifier of a brand extension or a sub-brand and, as such, I do not see a logical step which would cause consumers to be indirectly confused. Instead, I find the average consumer would put the presence of the common “NATUR” and “ALI” elements down to coincidence rather than an economic connection⁹ and consequently, I do not find there to be any likelihood of indirect confusion.

CONCLUSION

79. The opposition under section 5(2)(b) of the Act has been partly successful. Subject to any successful appeal against my decision, the application will be refused in respect of the following goods:

Coffee, cocoa; coffee or cocoa based beverages, chocolate based beverages; pasta, stuffed dumplings, noodles; pastries and bakery products based on flour; desserts based on flour and chocolate; bread, pasties, pita, sandwiches, pies, cakes; desserts based on dough coated with syrup; puddings, custard, rice

⁹ See *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17

pudding; vanilla (flavoring); yeast, baking powder; flour, semolina, starch for food; sugar, cube sugar, powdered sugar; tea, iced tea; confectionery, chocolate, biscuits, crackers, wafers; ice-cream, edible ices; cereal-based snack food, popcorn, crushed oats, corn chips, breakfast cereals, processed wheat for human consumption, crushed barley for human consumption, processed oats for human consumption, processed rye for human consumption, rice; molasses for food.

COSTS

80. Both parties have enjoyed a measure of success, though the opponent has been more successful in this case.

81. Awards of costs in proceedings commenced after 1 July 2016 are governed by Annex A of Tribunal Practice Notice ('TPN') 2 of 2016. Using that TPN as a guide, I award costs to the opponent including a 10% reduction on costs to account for the applicant's partial success.

Official TM7 fee:	£100
Filing a notice of opposition and considering the holder's counterstatement:	£200
Filing submissions:	£300
Total:	£600
Total (including 10% reduction):	£540

Dated this 3rd day of February 2023

Catrin Williams
For the Registrar