

O-367-09

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO 2422996

BY GILLIAN RAMSAY

TO REGISTER IN CLASS 30 THE TRADE MARK:

Puffin Poo

AND

IN THE MATTER OF OPPOSITION NO 96251 BY

ASDA STORES LIMITED

TRADE MARKS ACT 1994

**In the matter of application No 2422996
by Gillian Ramsay
to register in class 30 the trade mark Puffin Poo**

and

**In the matter of opposition No 96251 by
Asda Stores Limited**

Background

1. Ms Gillian Ramsay applied for the above trade mark on 27 May 2006. She seeks registration for confectionery in class 30 of the Nice Classification system¹.

2. On 13 February 2008 Asda Stores Limited (“Asda”) opposed the registration of Ms Ramsay’s application. Asda’s grounds of opposition are under sections 5(2)(b) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”) relying on its earlier trade mark for the word PUFFIN (UK registration 2107974a) and its goodwill associated with that sign.

3. It should be noted that Asda’s earlier mark was registered before the period of five years ending on the date of publication of Ms Ramsey’s application². Therefore, the proof of use provisions contained in section 6A of the Act apply to Asda’s mark³. Asda claim to have used its mark in relation to all of the goods covered by its registration, namely “confectionery; biscuits”.

4. Ms Ramsay filed a counterstatement denying the grounds of opposition. Ms Ramsay also put Asda to proof on its claim to have used its mark on “all goods and services”; I will return to Ms Ramsay’s counterstatement on this point shortly.

5. Both sides then filed evidence, a summary of the evidence is provided below. Neither side requested a hearing. Asda did, however, file written submissions in lieu of a hearing. Ms Ramsay did not file any written submissions, but I will take into account the arguments she made in her counterstatement and evidence.

¹ International Classification of Goods and Services for the Purposes of the Registration of Marks under the Nice Agreement (15 June 1957, as revised and amended).

² Ms Ramsay’s application was published on 16 November 2007 and Asda’s earlier mark completed its registration procedure on 4 July 1997.

³ Section 6A of the Act was added to the Act by virtue of the Trade Marks (Proof of Use, etc.) Regulations) 2004 (SI 2004/946) which came into force on 5th May 2004.

Asda's evidence

6. Asda's evidence is given by Mr Varinder Rehal, a solicitor in its legal department. Mr Rehal states that the mark PUFFIN has been used by Asda since about 1997 in relation to a chocolate biscuit bar and that it has been continuously used since then. Examples of packaging are shown in Exhibit VR1. They show the name PUFFIN or PUFFINS. He states that such products have been sold for a period of time in excess of 10 years.

7. Reference is made to Exhibit VR2 which consists of an extract from Asda's Internet home shopping website. The product uses the name PUFFINS. The print is not dated, but Mr Rehal states that such products have been available online for at least two years. He concludes his evidence by stating that the mark PUFFIN is clearly in use by Asda for an item of confectionery, namely a chocolate biscuit.

Ms Ramsay's evidence

8. The evidence comes from Ms Ramsay herself. She states that the mark PUFFIN POO has been used since 2000 by herself (as a sole trader) but, since 2006, it has been used by her company. She states that the product is a handmade confectionery product, which consists of a white chocolate nugget containing Belgian chocolate, toasted rice, marshmallow and coconut. Ms Ramsay highlights that her product is sold in 100g and 300g clear bags and 300g boxes that feature the name (PUFFIN POO) and an artist's illustration of a puffin (examples of the packaging can be seen in Exhibits GR 1 and GR 2).

9. Ms Ramsay states that the two products are sufficiently different so that the registration of PUFFIN POO will not cause confusion. She states that they [the products] have nothing in common other than that they have a chocolate element. Ms Ramsay refers to a test for confusion that she undertook in 2008 whereby she asked her tourist visitors [presumably those visiting her establishment] to identify the unnamed and unpackaged products. She states that without exception all identified the PUFFIN biscuit as a PENGUIN biscuit sold by McVities. When these visitors were then shown the PUFFIN packaging they all confirmed that they would not confuse the two as the products were entirely different. She states that this test was not conducted on local customers because there is no Asda in Shetland and so they would only be familiar with the PUFFIN POO products and, as such, this would give an unfair bias.

10. Ms Ramsay states that the PUFFIN POO trade mark is also used on a range of clothing, ties, hats and t-shirts. The mark is also used on ice cream which contains the same main ingredients as the main product. She states that the trade mark will protect her product from those passing themselves off and therefore confusing customers. Ms Ramsay concludes her evidence by referring to another mark (OSCAR PUFFIN) within this classification which, to her

knowledge, was not objected to. She believes that this means that PUFFIN POO should not be objected to.

The proof of use provisions

11. As stated in paragraph 3 above, the proof of use provisions apply to Asda's earlier mark. However, as I also identified, Ms Ramsay's statement when requesting proof of use refers to "all goods and services". This is despite there being no services at all in Asda's specification. I also note from her counterstatement that she says:

"We deny that our application is identical to the one in use by the opponent" (emphasis added).

12. Despite Ms Ramsay putting Asda to proof on its claim, she nevertheless refers to Asda's product as being in use. She also addresses Asda's own use in her evidence as she obtained Asda's product and undertook a test for confusion with her tourist visitors. She did not undertake this test on local people because there is no Asda store in the Shetlands. Her counterstatement also refers to the lack of confusion with her use since 2000, presumably against the use of Asda. Taking the above into account, it seems to me that Ms Ramsay cannot be regarded as challenging Asda's use of its mark on its chocolate covered biscuit bar referred to in both sides evidence. The proof of use challenge will, therefore, only be considered against any wider form of goods and services (although the service element is irrelevant because services are not covered by Asda's specification).

13. In terms of use, I have to say that Asda's evidence lacks depth and detail. It strikes me as perfunctory. It does, however, clearly demonstrate that Asda have not sold any other product (under its PUFFIN mark) apart from its chocolate covered biscuit bar. In view of my comments in the preceding paragraphs, I do not intend to consider the matter further as there are no further types of goods to consider.

14. I must consider what a fair specification is for the goods on which Asda have used its mark. The relevant case-law⁴ informs me that the resulting specification should be fair – it should not be overly broad but neither should it be pernickety. Asda have used its mark on one product, namely, a biscuit covered in chocolate that is bar shaped. However to adopt a specification worded in this way would be pernickety, being bar like and being chocolate covered the pernickety characteristics. One of the terms in its specification is biscuits. This seems to me to be an appropriate designation that is neither too wide nor too pernickety. The

⁴ See, for example *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32, *Reckitt Benckiser (España), SL v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Case T-126/03 & *Animal Trade Mark* [2004] FSR 19.

other term, confectionery, even if a biscuit could be regarded as an item of confectionery, is much wider and I consider this to be too broad a designation.

15. For the purposes of this opposition, the specification of Asda's earlier mark will be taken as "biscuits".

The section 5(2)(b) ground of opposition

Legislation and the relevant authorities

16. Section 5(2)(b) of the Act states:

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

(a)

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

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

17. In my consideration of whether there exists a likelihood of confusion, I take into account the guidance from the case-law of the European Court of Justice ("ECJ") in *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77, *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723, *Matratzen Concord v OHIM C-3/03* [2004] ECR I-3657, and *Shaker di L. Laudato & C. Sas v OHIM C-334/05 P* (LIMONCELLO). It is clear from these cases that:

(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*;

(b) the matter must be judged through the eyes of the average consumer of the services in question; *Sabel BV v Puma AG*, 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; *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v Puma AG*;

(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; *Sabel BV v Puma AG*, 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; *Shaker di L. Laudato & C. Sas v OHIM*;

(e) nevertheless, the overall impression conveyed to the relevant public by a composite trade mark may, in certain circumstances, be dominated by one or more of its components; *Matratzen Concord v OHIM*;

(f) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the respective services, and vice versa; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*;

(g) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either *per se* or because of the use that has been made of it; *Sabel BV v Puma AG*;

(h) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of s.5(2); *Sabel BV v Puma AG*;

(i) if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*

The average consumer and the purchasing act

18. As matters must be judged through the eyes of the average consumer (*Sabel BV v. Puma AG*, paragraph 23) it is important that I assess who this is. The goods are not specialist goods aimed at a particular section of the public. They are general consumer items purchased to be eaten, so the average consumer is the public at large.

19. The case-law informs me that the average consumer is to be regarded as reasonably observant and circumspect (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27). However, this general presumption (or at least the average consumer's level of attention during purchase) can change depending on the particular goods in question (see, for example, the decision of the CFI⁵ in *Inter-Ikea Systems BV v OHIM* (Case T-112/06)). There is nothing, though, in the case before me to suggest that the average consumer will pay a significantly higher or lower degree of attention than the norm. Whilst the goods

⁵ The Court of First Instance of the European Communities

may be purchased relatively frequently, and whilst they may be relatively inexpensive (these factors combine to mean that the purchase of the goods will not amount to the most important of choices), personal taste and preference still play a part. The average consumer will, therefore, be reasonably observant and circumspect during the purchasing act, although not highly so.

20. The goods are most likely to be purchased from a shelf or from an online shopping equivalent, so the visual impression is more important than aural impressions; however, that does not mean that aural similarity should be ignored completely.

Comparison of the goods

21. Before making any comparisons, I should highlight that prior to writing this decision I wrote to Mr Ramsay (Asda were, of course, copied in) to ask whether she wished to restrict her specification. I did so because it was clear from both her counterstatement and from her evidence that she placed great significance on the nature of her actual product and that of Asda. I highlighted to Ms Ramsey that her goods, from her evidence, appeared to be a “chocolate nugget” (albeit containing other ingredients such as toasted rice, marshmallow and coconut). Ms Ramsay responded stating that she wished to restrict her specification to “chocolate nuggets”. I will, therefore, consider this as the goods of the application from this point on. Asda were invited to provide submissions on the impact of such a restriction on its opposition; I will return to this shortly.

22. Ms Ramsay’s restricted specification reads:

“Chocolate nuggets”

23. Asda’s specification (following proof of use) reads:

“Biscuits”

24. All relevant factors relating to the goods in the respective specifications should be taken into account in determining this issue. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the ECJ 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.”

25. In *British Sugar Plc v James Robertson & Sons Limited* [1996] R.P.C. 281, Jacob J also gave guidance on how this should be assessed. The factors he highlighted 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.”

26. In its written submissions in relation to the restricted specification, Asda submit that because its specification includes confectionary and biscuits then it makes no difference whether the applicant restricts her specification or not. This submission is, though, now irrelevant given the proof of use considerations. Asda also submit that the term biscuits includes chocolate nuggets. In support of this proposition Asda submit that chocolate nuggets (although it also found this term to be vague) could be biscuit like products as they could have added ingredients to give a biscuit like texture and bite. It provided some Internet hits to support this proposition, however, this goes beyond submission and leave to file this information as evidence has not been sought. Nevertheless, I am at least prepared to accept that chocolate nuggets could contain added ingredients to give bite, indeed, Ms Ramsay’s product does have added ingredients which may well do so.

27. Despite Asda’s submission, I do not consider the goods to be identical. Chocolate nuggets are small pieces or lumps of chocolate (see the definition of “nugget” in the Collins English Dictionary). They may contain other ingredients, but the basic composition means that they are not the same as biscuits, even chocolate covered biscuits which would represent Asda’s best case. There is, though, a degree of similarity in that chocolate may be one of the primary ingredients in both. One will be biscuit shaped (most biscuits being rectangular or circular and of a fairly flat profile) whereas the other is likely to be spherical in shape (although irregularly so) and this creates a point of difference.

28. The end user is the same, although, this cannot be a particularly significant factor because the end user of all products aimed at the general public, no matter how different they may be, will always be the same. The method of use is the same because they are both eaten, but, again, this can be said of anything that is eaten.

29. In terms of the distribution channels, biscuits will all be located together and, from my experience, there is a diverse range of biscuit type products. This means that it is unlikely that other forms of confectionery will be intermingled with them. The goods are, therefore, unlikely to be sold next to each other. However, other types of confectionery are unlikely to be too far removed in proximity and will be sold much closer than other types of less similar foodstuffs.

30. In terms of competition/complementary relationships, there may be a degree of competition, but this should not be regarded as being of the highest degree of competition. This is because the diversity of product range means that competition will be focused more on competition with very close products (e.g. competition between various different biscuit type products) rather than with other forms of confectionery (such as Ms Ramsay's goods). Having said that, balancing the respective factors, it seems to me that there is still a reasonable degree of similarity, although, not of the highest degree.

Comparison of the marks

31. When assessing this factor I must do so with reference to the visual, aural and conceptual similarities between the respective marks bearing in mind their distinctive and dominant components (*Sabel BV v. Puma AG*, paragraph 23). The marks to be compared are:

Ms Ramsay's mark: Puffin Poo

Asda's mark: PUFFIN

32. In terms of the dominant and distinctive components, Asda's mark has only one component so the answer is self evident. In relation to Ms Ramsay's mark, neither of the words PUFFIN or POO are presented in a way so as to give either of them dominance over the other. In note in my analysis the judgments of the ECJ in *Case C-3/03P, Matratzen Concord v OHIM, para 32* where it was stated:

“The Court rightly pointed out, in paragraph 34 of the contested judgment, that the assessment of the similarity between two marks does not amount to taking into consideration only one component of a complex trade mark and comparing it with another mark. On the contrary, such a comparison must be made by examining the marks in question, each considered as a whole. It also held that that does not mean that the overall impression created in

the mind of the relevant public by a complex trade mark may not, in certain circumstances, be dominated by one or more of its components.”

33. And in *Case C- 120/04 Medion* where it was stated:

“28 The global appreciation of the likelihood of confusion, in relation to the visual, aural or conceptual similarity of the marks in question, must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components. The perception of the marks by the average consumer of the goods or services in question plays a decisive role in the global appreciation of that likelihood of confusion. In this regard, the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (see, in particular, *SABEL*, paragraph 23, *Lloyd Schuhfabrik Meyer*, paragraph 25, and *Matratzen Concord*, paragraph 29).

29 In the context of consideration of the likelihood of confusion, assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark. On the contrary, the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components (see *Matratzen Concord*, paragraph 32).

30 However, beyond the usual case where the average consumer perceives a mark as a whole, and notwithstanding that the overall impression may be dominated by one or more components of a composite mark, it is quite possible that in a particular case an earlier mark used by a third party in a composite sign including the name of the company of the third party still has an independent distinctive role in the composite sign, without necessarily constituting the dominant element.”

34. Applying the above guidance, the word PUFFIN does not play an independent and distinctive role in the PUFFIN POO mark. The word PUFFIN qualifies the word POO. Therefore, neither of the words constitute a dominant and distinctive element alone, let alone the most dominant and distinctive element. The dominant and distinctive element of Ms Ramsay’s mark is the word combination PUFFIN POO.

35. Despite the word PUFFIN not being a dominant and distinctive element in Ms Ramsay’s mark, the presence of the word still creates an obvious point of visual and aural similarity. The similarity is reduced, though, by the presence of the word POO which will not go unnoticed either when looking at the mark or hearing/speaking it.

36. In terms of conceptual similarity, Asda argue that there is similarity because both marks, to some extent, refer to Puffins. In *Case T-292/01 Phillips-Van Heusen v OHIM – Pash Textilvertrieb und Einzelhandel (BASS)* [2003] ECR the CFI stated:

“Next, it must be held that the conceptual differences which distinguish the marks at issue are such as to counteract to a large extent the visual and aural similarities pointed out in paragraphs 49 and 51 above. For there to be such a counteraction, at least one of the marks at issue must have, from the point of view of the relevant public, a clear and specific meaning so that the public is capable of grasping it immediately. In this case that is the position in relation to the word mark BASS, as has just been pointed out in the previous paragraph. Contrary to the findings of the Board of Appeal in paragraph 25 of the contested decision, that view is not invalidated by the fact that that word mark does not refer to any characteristic of the goods in respect of which the registration of the marks in question has been made. That fact does not prevent the relevant public from immediately grasping the meaning of that word mark. It is also irrelevant that, since the dice game Pasch is not generally known, it is not certain that the word mark PASH has, from the point of view of the relevant public, a clear and specific meaning in the sense referred to above.

The fact that one of the marks at issue has such a meaning is sufficient – where the other mark does not have such a meaning or only a totally different meaning - to counteract to a large extent the visual and aural similarities between the two marks.”

37. I regard the concepts of both marks to be clear and specific, capable of immediate grasp by the average consumer. Asda’s mark refers simply to a puffin (being a sea bird) whereas Ms Ramsay’s mark refers to the faeces of such a bird. I note Asda’s submission that both marks relate to PUFFINS. Whilst this is true, any similarity on this point alone strikes me as a fairly superficial one. This is because the actual meanings of both marks are quite different and distinct. The concept of a particular bird is quite different from the concept of a particular bird’s poo (even if the particular bird is the same). This creates a quite different overall message and a strong conceptual difference that is likely to be noticed by the average consumer which, in turn, will cause a counteraction in terms of overall similarity.

38. Overall, I consider there to be some similarity between the marks, but based on my assessments in the preceding paragraphs, this cannot be said to be high.

Distinctive character of the earlier trade mark

39. The distinctiveness of the earlier mark is another factor to consider because the more distinctive it is (based either on inherent qualities or because of the use made of it), the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24). From an inherent point of view, I have already identified that the word PUFFIN relates to a sea bird. A biscuit is not a PUFFIN nor do such goods have subject matters to which such a word could relate. However, the average consumer may perceive some form of suggestive or allusive quality based on the fact that the goods could bear representations of puffins perhaps because they are aimed at children. In view of this, I do not regard the earlier mark as being of the highest degree of distinctiveness. It has, though, an average degree of inherent distinctiveness.

40. In terms of the use made of the earlier mark, I have already described the evidence as perfunctory. No sales figures are provided nor the amount spent on promotion. The goods may have been sold for 10 years, but without knowing to what extent I cannot infer that it has been used to such a degree that the mark has taken on an enhanced distinctive character.

Likelihood of confusion

41. Before considering whether confusion is likely, I must deal with two specific points that Ms Ramsay has made. Firstly, she states that her product is only sold in her shop and that Asda's product is only sold in Asda's stores, in other words, never the twain shall meet. This is proven, it is argued, by no confusion having arisen so far. Whilst I understand the argument, it can play no part in my determination. Marketing strategies can be temporary and a proprietor who adopts a particular strategy at one point in time has the freedom to choose another strategy at a different point. I am re-enforced in this view by the judgment in *Devinlec Développement Innovation Leclerc SA v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T- 147/03* where it was stated:

“104 Consideration of the objective circumstances in which the goods covered by the marks are marketed is fully justified. The examination of the likelihood of confusion which the OHIM authorities are called on to carry out is a prospective examination. Since the particular circumstances in which the goods covered by the marks are marketed may vary in time and depending on the wishes of the proprietors of the trade marks, the prospective analysis of the likelihood of confusion between two marks, which pursues an aim in the general interest, that is, the aim that the relevant public may not be exposed to the risk of being misled as to the commercial origin of the goods in question, cannot be dependent on the commercial intentions, whether carried out or not, and naturally subjective, of the trade mark proprietors.

.....

107 It follows that by taking into consideration in the assessment of the likelihood of confusion between the marks the particular circumstances in which the goods covered by the earlier mark are marketed, the temporal effect of which is bound to be limited and necessarily dependent solely on the business strategy of the proprietor of the mark, the Board of Appeal erred in law.”

42. Furthermore, the marketing strategies that have been adopted so far may be the factor which has led to no confusion taking place so far. This is because the degree to which the marks have encountered each other in the marketplace is very limited (if at all). This, therefore, does not assist me in determining whether there will be a likelihood of confusion based on the objective and notional use of both marks, which is what I must consider. The “test” for confusion that Ms Ramsay undertook does not take matters further forward because so little information is provided about the numbers of people “tested” and the methodology used.

43. The second point I must refer to is Ms Ramsay’s argument that the non-objection to another PUFFIN based mark (OSCAR PUFFIN) means that there should be no objection here. This, again, is not relevant. Whether and why Asda did not object to this other mark has no bearing. It is up to Asda which marks it opposes and which it does not. I must determine matters on the basis of the marks before me and the merits of the case.

44. In relation to whether there exists a likelihood of confusion, it is clear that the relevant factors have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17) and that a global assessment of the factors must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). There is, though, no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused.

45. The earlier mark has an average level of distinctiveness. I have found the respective goods to be similar but not highly so. The respective marks are similar but, again, not highly so. Although both marks refer, in some way, to puffins, one refers to the bird itself whereas the other refers to its faeces. The concept of Ms Ramsay’s mark is important for three reasons. Firstly, the conceptual difference itself creates a significant recollection point which will, in my view, mitigate strongly against the significance of imperfect recollection⁶. It creates a marked and noticeable difference between the marks in the mind of the average

⁶ A concept relating to the fact that consumers rarely have the chance to make direct comparisons between trade marks and must instead rely on the imperfect picture of them he or she may have kept in mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.*)

consumer. It is unlikely that the concept of a puffin's faeces will be forgotten as this is a memorable concept.

46. Secondly, the concept is important because the words combine to create a coupled whole rather than two separate un-associated words. If this had not been the case then the word PUFFIN would have retained an independent and distinctive role within the mark. This is not, however, the case here.

47. Thirdly, the mark's concept creates a suggestive link to the product itself and there may be an understanding by the average consumer that the words evoke a reference that the goods are novelty faeces shaped goods because of their shape and perhaps colour (chocolate being brown or white). In other words, the mark makes a fanciful suggestion to the consumer that the goods are edible "puffin poo".

48. After bearing in mind the relevant factors, my first finding is that there is no likelihood of direct confusion. Direct confusion requires, effectively, that the average consumer mistakes one mark for the other. The strong and memorable concept given by Ms Ramsay's mark results in it being highly unlikely that the average consumer will mistake PUFFIN for PUFFIN POO. Whilst only an average (and not high) degree of care and attention will be utilised at the point of purchase, the average consumer will be able to distinguish between the marks (and their goods).

49. That, however, is not the end of the matter because confusion does not need to be direct and can, instead, occur when the average consumer, even though he or she can distinguish between the marks, nevertheless believes that the goods sold under the respective marks are the responsibility of the same or an economically linked undertaking. This is often referred to as indirect confusion. I should stress, though, that if the average consumer merely brings the earlier mark to mind (or vice versa) this alone is not enough (*Sabel BV v Puma AG*). It is only if such an association informs the average consumer that the undertakings responsible are the same or are related that there is a likelihood of confusion (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*).

50. In determining this issue there are two alternate propositions, namely:

i) The average consumer may see the trade mark PUFFIN POO, when used on chocolate nuggets, as a trade mark suggestive that the chocolate nuggets are intended to represent a humorous or novelty product and even if they had already encountered (or encountered later) Asda's PUFFIN branded biscuit, this will not be put down to an economic connection but simply to the use (in relation to the PUFFIN POO mark) of a known bird's name in order to create the humorous suggestive association that I have described;

ii) That the average consumer either does not see the suggestive reference or, even if they did see it, PUFFIN POO chocolate nuggets would be perceived as an extension of the PUFFIN brand of chocolate biscuit into a new product line under a quirky but related sub-brand.

51. Considering the two propositions, I am mindful that Asda's earlier mark does not have the highest degree of inherent distinctiveness and that there has been no enhancement of distinctiveness through use. Neither is there any evidence of brand extension. All of the relevant factors create a finely balanced determination. However, in my view, the average consumer is likely to see the suggestive reference to the nature of the chocolate nuggets rather than extracting the word PUFFIN from Ms Ramsay's mark and, based on this inclusion, to economically connect it to Asda's product. The proposition outlined in i) above is, therefore, to be preferred. There is no likelihood of confusion.

The section 5(4)(a) ground of opposition

52. Section 5(4)(a) of the Act reads:

"A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented –

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

(b)

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an "earlier right" in relation to the trade mark."

53. There are three elements (often referred to as "the classic trinity") to consider in a claim for passing-off, namely: 1) goodwill, 2) misrepresentation and 3) damage. In *Reckitt & Colman Products Ltd v Borden Inc* [1990] R.P.C.341, Lord Oliver summarised the position quite succinctly when he stated:

"The law of passing off can be summarised in one short general proposition--no man may pass off his goods as those of another. More specifically, it may be expressed in terms of the elements which the plaintiff in such an action has to prove in order to succeed. These are three in number. First he must establish a goodwill or reputation attached to the goods or services which he supplies in the mind of the purchasing public by association with the identifying 'get-up' (whether it consists simply of a brand name or trade description, or the individual features of labelling or packaging) under which his particular goods or services are offered to the public, such that the get-up is recognised by the public as

distinctive specifically of the plaintiff's goods or services. Secondly, he must demonstrate a misrepresentation by the defendant to the public (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by him are the goods or services of the plaintiff...Thirdly he must demonstrate that he suffers, or in a *quia timet* action that he is likely to suffer, damage by reason of the erroneous belief engendered by the defendant's misrepresentation that the source of the defendant's goods or services is the same as the source of those offered by the plaintiff.”

54. Although this ground is completely separate from that under section 5(2)(b) and, as such, it requires separate analysis, I fail to see how Asda can be in any better position. This is because even if I accepted that Asda have a goodwill associated with the sign PUFFIN, I have already found, given the nature of the respective marks (which are the same in this analysis) and given the nature of the goods (which are, again, the same, Asda's goodwill associated with Puffin not extending beyond the goods assessed under section 5(2)), that there will be no likelihood of confusion. Therefore, I do not see why a member of the public, let alone a substantial number of them⁷, will believe that Ms Ramsay's goods are the responsibility of Asda. Although shortly stated, this ground of opposition fails.

Conclusion

55. In view of the above, the opposition fails in relation to the restricted specification of “chocolate nuggets” and it should proceed to registration accordingly.

Costs

56. As Ms Ramsay's success relates only to a specification put forward at a late stage, I do not consider it appropriate to make an award of costs in her favour. Both sides shall bear their own costs.

Dated this 23rd day of November 2009

**Oliver Morris
For the Registrar
The Comptroller-General**

⁷ See the findings of the Court of Appeal in *Neutrogena Corporation and Ant. V. Golden Limited and Anr.* [1996] R.P.C. 473