

O-064-17

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO 3132844
IN THE NAME OF VEG & CITY DRINKS LIMITED
FOR THE TRADE MARK

SUPER GREEN

AND

OPPOSITION THERETO UNDER NO 406209
BY V A WHITLEY & CO LIMITED

Background

1. Application No 3132844 seeks registration of the trade mark **SUPER GREEN**, has a filing date of 22 October 2015 and stands in the name of Veg & City Drinks Limited (“the applicant”).

2. Following publication of the application in the *Trade Marks Journal* on 8 January 2016, notice of opposition was filed by V.A. Whitley & Co Limited (“the opponent”). The applicant subsequently requested an amendment to the specification of its application and it now seeks registration in respect of the following goods:

Class 29

Meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables (excluding peas); jellies, jams, compotes; eggs, milk and milk products; edible oils and fats; prepared meals (excluding meals made predominantly with peas); soups (not made with peas) and potato crisps.

Class 31

Agricultural, horticultural and forestry products; live animals; fresh fruits and vegetables (excluding peas), seeds, natural plants and flowers; foodstuffs for animals; malt; food and beverages for animals.

Class 32

Beers; mineral and aerated waters; non-alcoholic drinks; smoothies; fruit drinks and fruit juices; syrups for making beverages; shandy, de-alcoholised drinks, non-alcoholic beers and wines.

3. The opponent opposes the application insofar as it seeks registration in respect of the goods shown above in classes 29 and 31 only. It bases its opposition on grounds under the provisions of sections 5(2)(a), 5(2)(b) and 5(3) of the Trade Marks Act 1994 (“the Act”) relying on its registration no 2543480 for a series of two trade marks **SUPER GREEN** and **SUPERGREEN** registered in class 29 in respect of *peas*. A further ground of opposition under section 5(4)(a) of the Act was also raised.

4. The applicant filed a counterstatement in which it admits the respective marks **SUPER GREEN** and **SUPER GREEN** are identical. It denies the respective goods are identical or similar and puts the opponent to proof of use of the earlier mark relied upon and to proof of its claimed reputation and goodwill.

5. Only the opponent filed evidence. The matter came before me for a hearing on 25 January 2017 where the opponent was represented by Ms Ashton Chantrielle of Counsel instructed by Mathys & Squire LLP. The applicant did not attend and was not represented though written submissions in lieu of attendance were filed by its representatives, Novagraaf UK.

6. In her skeleton arguments dated 23 January 2017 and filed in advance of the hearing, Ms Chantrielle withdrew the ground of opposition under section 5(4) of the Act. She also indicated that she intended to file late evidence. This late evidence did not accompany her skeleton argument but was filed the afternoon prior to the hearing. I dealt with the late evidence as a preliminary issue at the hearing.

The late evidence

7. I admitted the late evidence into the proceedings. In doing so, I took into account the factors identified in *Property Renaissance Ltd t/a Titanic Spa v Stanley Dock Hotel Ltd t/a Titanic Hotel Liverpool and Ors* [2016] EWHC 3103(Ch) and the submissions of both parties.

8. The applicant submitted that the late evidence should not be admitted. It submitted that no proper reasons had been given as to why its admittance was sought at such a late stage. It referred to Ms Chantrielle's skeleton argument and the comment therein that the late evidence stemmed from issues raised by the applicant in its submissions in lieu of attendance at a hearing. It submitted that the opponent is professionally represented as it was at the time the earlier evidence was filed and that they would have been "well aware of the requirements on evidence" and the "numerous cases and guidelines" which set out the types of evidence needed to support the claims made. It queried whether sufficient attention was paid to the initial

identification of evidence and submitted that it would be inherently unjust and unfair to the applicant to allow its admittance, particularly as the applicant had had “no time to consider any such evidence or properly respond”.

9. At the hearing, Ms Chantrielle submitted that following the filing of the opponent’s evidence in chief, which took the form of a witness statement of Christopher Rogers, the applicant had not filed any evidence in response nor had it made any submissions on that evidence during the normal evidence stages. Instead, it had waited until its written submissions, filed in lieu of attendance at a hearing, to make a number of criticisms of that earlier evidence. Ms Chantrielle conceded that the late evidence now sought to be filed had been available to the opponent when it was collating its earlier-filed evidence but submitted that it was only in light of the criticisms made by the applicant that the opponent had reviewed matters and had identified the further evidence it now wished to file. She submitted that the evidence is material to the issues to be determined and that the opponent would be prejudiced if it was not admitted.

10. Parties should make every effort to identify, collate and file its strongest evidence at the earliest opportunity. The applicant’s criticism of the timing of the filing of the late evidence is not, therefore, without merit. However, challenging the sufficiency of (earlier-filed) evidence not when it was filed, but instead by way of submissions in lieu of a hearing, could also be said to be contrary to that party’s duty to help achieve the overriding objective to deal with cases expeditiously and fairly.

11. In terms of the content of the late-filed evidence, it consists of a second, very brief, witness statement by Mr Rogers along with two exhibits. Those exhibits consist of copies of delivery notes showing the supply, by the opponent, of relevant goods to named customers along with printouts from the opponent’s website. Given that it goes directly to the use of the opponent’s earlier mark and bearing in mind the grounds of opposition, I consider the evidence is material to the issues to be decided.

12. I was not persuaded that it would be “inherently unjust and unfair” to the applicant to allow the admittance of the late evidence nor did I consider it had had

“no time to consider any such evidence or properly respond”. I accept that the applicant had only a very short period of time available to it to consider that evidence before the appointed hearing time. As set out above, however, the late witness statement is very brief and the exhibits are but a few sample delivery notes and website printouts. There is no suggestion that any evidence could be filed in response to it and, given that it filed fairly extensive submissions on the content of that evidence, in writing, on the same day it received it (albeit very late into the evening and well after normal office hours), I do not consider the applicant would suffer any prejudice that could not be compensated for in costs. In contrast, the opponent would be likely to be prejudiced by its exclusion.

13. Balancing all relevant factors, I admitted the late evidence.

Decision

The opposition under section 5(2)(a) and (b) of the Act

14. The relevant parts of the Act state:

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

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

(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”.

15. It is convenient to consider, first, the respective marks. For ease of reference, I set these out below.

Opponent's marks	Applicant's mark
SUPER GREEN SUPERGREEN	SUPER GREEN

16. As set out above, in its counterstatement, the applicant concedes that the respective marks **SUPER GREEN** and **SUPER GREEN** are identical but is silent as regards the opponent's second mark in the series. In *S.A. Société LTJ Diffusion v. Sadas Vertbaudet SA*, Case C-291/00, the Court of Justice of the European Union ("CJEU") held:

"54... a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer."

17. The opponent's mark **SUPERGREEN** differs from the applicant's mark only insofar as it is presented as a single word without a visual break between its two component words. This is a difference which is so insignificant that it would be highly likely to go unnoticed by the average consumer and I consider the applicant's mark to be identical to each of the opponent's marks. That being so, the objection under section 5(2)(b) of the Act which is based on the marks being not identical but similar, will not be considered further.

18. In support of its ground of opposition under section 5(2)(a) of the Act, the opponent relies on its registration no 2543480. As indicated above, the applicant has put the opponent to proof of use of its mark. Given it has a filing date of 31 March 2010 and was entered in the register on 3 September 2010, it is an earlier mark within the meaning of section 6(1) of the Act and is subject to the provisions of section 6A of the Act which states:

"6A. - (1) This section applies where -

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

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

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

(3) The use conditions are met if -

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

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

(4) For these purposes -

(a) use of a trade mark includes use in a form differing in elements
which do not alter the distinctive character of the mark in the form in
which it was registered, and

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

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

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

19. The relevant period within which genuine use must be shown is 9 January 2011 to 8 January 2016. The case law on genuine use of trade marks was summarised by Arnold J. in *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*, [2016] EWHC 52, as follows:

“I would now summarise the principles for the assessment of whether there has been genuine use of a trade mark established by the case law of the Court of Justice, which also includes Case C-442/07 *Verein Radetsky-Order v Bunderversvereinigung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223 and Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR 7, as follows:

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

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

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

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

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

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor.

Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

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

20. The opponent’s evidence takes the form of two brief witness statements of Christopher Rogers, its Company Secretary, a position he has held for some twenty three years.

First witness statement

21. Mr Rogers states that the opponent adopted the trade mark SUPER GREEN in around 1979. He states that the mark has been used continuously since then and in a variety of formats, namely:

- 1) SUPER GREEN
- 2) SuperGreen
- 3) Supergreen
- 4) SUPERGREEN
- 5) SUPER
GREEN

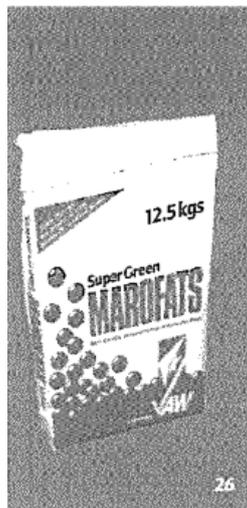
22. Mr Rogers states the mark is used to promote and sell marrowfat peas.

23. There are a number of exhibits attached to Mr Rogers’ witness statement. These are as follows:

- CR1: a single page said to be a copy of a promotional flyer sent to “customers and potential customers towards the back end of 1979”. The flyer bears the heading “Introducing the ‘Super Green Marofat!’” which it states will be an end product that is “larger...of a superior even colour and of higher quality than that generally available to the trade.” The flyer is not dated but I note that underneath the opponent’s name and address, the contact telephone number

given on it, is one that pre-dates the changes made to areas codes which saw them change to "01" numbers and so is likely to be of some age. No details are given as to whom this may have been issued or how many were issued;

- CR2: a single page containing two tables said to show "sales information from 2000 to 2016" and "purchase information referencing the amount of peas bought from our supplier". The former table lists an increasing number of sales units each trading year. They range from a low of 16,201 units in 2000, to 31,306 units in 2008 and 44,782 in 2015 (figures are also given for 2016 but much of this is likely accrue to after the relevant period). Sales values relating to each year are also given for each of the years 1998 to 2015 with those for the specific years I refer to above amounting to £78,581.73, £221,141.63 and £443,845.53 respectively. The latter table shows purchases from a single supplier for the years 1998 to 2015 (with the exception of 2001). Those for the specific years mentioned above are given as 207, 392 and 560 tonnes respectively;
- CR3: said to be a representative sample of promotional material. Mr Rogers states the mark has been promoted constantly in a variety of ways since it was first used. The exhibit consists of some twenty-eight pages. At page 6 is a price list which shows the opponent's name along with a telephone number. It bears the typewritten date October 1983 and lists various products including "SUPERGREENS". Pages 7 to 12 are headed "Buyers Guide" (editions 1 to 6 respectively) and cover the period 1998 to 2016. Each lists "Supergreen" peas (some listed as Supergreen Marrowfat peas). Edition 3 onwards show a picture of a 12.5kg pack of peas which look like this:



The newsletters at pages 13 to 21 date from November 1994 to November/December 2014. All make reference to SUPER GREEN peas (albeit presented in various formats) though some only in the context of them being free with the purchase of something else. Page 22 is headed “Generic V A Whitley Exhibition Stand” and shows two images marked ‘previous’ and ‘current’ respectively though neither image bears any specific date. The quality of the images is poor and I am unable to see the mark on the first of those images. On the second, I can see an arrow bearing the words ‘Catering Provisions’ which is pointing towards a small inset picture. Whilst I cannot make out much of what might be on that picture, I can see it contains the words Super Green. Page 23 is headed “Exhibition Information-Innovations” and shows an image underneath which is written “We have a dedicated Stand at our Bi-Annual Trade Exhibition, Innovations.” The image shows a stand on which is displayed the image of a packet of peas and on which the words Super Green (one word above the other) appear. Underneath this is shown what is said to be a copy of an order form given out on the day. It is dated 2011 and appears to be a price list rather than order form and the size and quality of the image is such that I cannot see any reference to the mark on it. Copies of order forms dated 2013 and 2015 are shown at page 24. Again, the quality of the print is poor but I can see that they are headed “innovations” and appear to list a number of products which are available at various stands. The 2013 form shows the opponent as being on stand 67 and offers a free 5th 12.5kg bag of Supergreen Peas with every four purchased. I cannot see the mark on the 2015 form.

Pages 25 to 27 are said to be point of sale examples. Each shows a 12.5kg bag of dried Super Green marrowfat peas with page 26 referring to “Supergreen Marofat Peas” being recently awarded the Champion Prize for dried peas and pulses by the British Edible Pulse Association 2010. Pages 28 to 30 are taken from the opponent’s website. Pages 29 and 30 show the 12.5kg packets of dried Super Green peas. None of these pages are dated.

The remaining three pages within the exhibit are said to be “miscellaneous scans”. Whilst each refers to Supergreen peas, no information is given of what these scanned documents might be. That said, the first page appears to be the text of promotional articles. No information is given to indicate that it was ever published (and, if so, where) and indeed the handwritten note which appears on it (“Mike, Would something like this be any use? James”) would suggest it was something that was prepared for internal use. The second of the pages has a short article entitled “Super pea is “top of the pods”” but no indication is given of when it may have been published or who may have seen it. Also on this page is a copy of a fax message dated 1999 which appears to be an internal document which dates from well before the relevant period. The last of the pages is an article entitled “VAW Supergreen Marofats” It is not dated and no information is given as to where the article may have been published.

As regards all of the material within this exhibit, no information is given which allows me to establish how any of the promotional material e.g. was distributed and to whom or where it may have appeared or when. There is no information to establish where and when any point of sale material was displayed. There is no evidence which establishes where the “Innovations” exhibitions took place or who or how many people may have attended any of them.

- CR4: this consists of a single page said to show “packaging designs for the years 2001 to 2016 and the new 2016 redesign”. Whilst the latter image is likely to date from after the relevant period, the words “Super Green Marofats” can be seen on both packets which are labelled as being 12.5kgs of dried peas.

Second witness statement

24. As indicated above, Mr Rogers’ second witness statement is very brief. He states that the SUPER GREEN product has “been promoted and exhibited at every “Innovations” trade exhibition which we have hosted in the period ie 2011, 2013,

2015 and soon in February 2017". Again, he gives no indication of where these exhibitions may have taken place or who and how many people may have attended each or any of them. He exhibits the following:

- CR1: this consists of what Mr Rogers states are samples of signed delivery notes. There are 18 such notes (the latter one consisting of two pages) each on headed paper and bearing the opponent's company name. They are dated at regular intervals between 19 January 2011 and 11 October 2016, the latter two delivery notes postdating the relevant period. The 16 from within the relevant period are addressed to 14 different businesses in the Greater Manchester and neighbouring areas, most of them identified as being fish and chip shop-type businesses. Each lists a range of goods supplied and each includes "SUPERGREEN PEAS – DRIED MARROWFAT 12.5kg" totalling some 20 packets during the relevant period.
- CR2: these are 5 printouts of the opponent's website each downloaded from the Internet Archive (waybackmachine). They show pages as they appeared between May 2012 and 4 January 2016. Each is a "how to" guide on preparing dried peas. The only reference to the mark is that each bears an image like this:



25. That completes my summary of the evidence filed.

26. The applicant submits that the evidence filed is insufficient to show genuine use in relation to peas. It submits that:

“peas are a common consumer product (not specialist products aimed at only a small section of society). Fish and chip shops and restaurants operate (and are popular) throughout the United Kingdom. Therefore the market for peas is exceptionally large. The volumes shown in the evidence are insignificant in comparison. In particular, the territorial scope of the use shown by the evidence is very narrow (North West England only).”

27. In its written submissions filed in relation to the late-filed evidence it submits:

“the late evidence shows, at best, use of the sign...in relation to dried marrowfat peas in packages of 12.5kg. These dried marrowfat peas are sold only to restaurants and fish and chip shops (and similar establishments). Therefore, as stated in the Applicant’s previous submissions, these goods cannot be considered similar to the goods for which the Application is made.”

28. I have no evidence of the size of the market for peas or the opponent’s place within it. I accept that the delivery notes themselves show a very limited volume of sales and that most of those are shown to be to fish and chips shops and the like but, as Mr Rogers has indicated, these are merely examples of sales made. Mr Rogers has provided details of the volume of unit sales made under the mark over a lengthy period of time and which are fairly accurately commensurate with the tonnage figures of supplies bought in, if each unit is taken to be a 12.5kg pack. He has provided details of the value of those sales with those values increasing almost every year. They are not insignificant. The delivery notes show the mark in use in relation to the supply of dried peas and other material show images of packages of dried peas on which the mark is shown. None of this material has been challenged. Whilst the evidence does have a number of flaws as set out above, I am satisfied that, when taken as a whole, it is sufficient, just, to show genuine use of the mark.

29. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law as being:

“In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there

has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”

30. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), Mr Justice Carr summed up the law relating to genuine use and fair specifications (albeit in relation to revocation proceedings) as follows:

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

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

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

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 ("Asos") at [56] and [60].

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

31. Whilst the evidence shows it to have been used only in respect of dried marrowfat peas, with the above case law in mind, I consider that *peas* is a fair specification for the use shown.

Comparison of the respective goods

32. As set out above, in its notice of opposition, the opponent objected to the application insofar as it seeks registration for each of the goods set out in classes 29 and 31. In her skeleton argument, Ms Chantrielle directed her submissions under this ground only to *preserved, dried and cooked fruits and vegetables*, however, at the hearing, she made submissions in line with the wide claim as set out in the notice of opposition. Given that there were a number of clear errors within the skeleton argument, it is the wider claim I will consider. For ease of reference, the goods to be compared are:

Opponent’s goods	Applicant’s goods
Class 29 Peas	Class 29 Meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables (excluding peas); jellies, jams, compotes; eggs, milk and milk products; edible oils and fats; prepared meals (excluding meals made predominantly with peas); soups (not made with peas) and potato crisps.

	Class 31 Agricultural, horticultural and forestry products; live animals; fresh fruits and vegetables (excluding peas), seeds, natural plants and flowers; foodstuffs for animals; malt; food and beverages for animals.
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33. In *Canon*, Case C-39/97, the CJEU stated at paragraph 23 of its judgment that:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary”.

34. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- a) The respective 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.

35. In *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

"... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."

36. In *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another*, [2000] F.S.R. 267 (HC), Neuberger J. (as he then was) stated that:

"I should add that I see no reason to give the word "cosmetics" and "toilet preparations"... anything other than their natural meaning, subject, of course, to the normal and necessary principle that the words must be construed by reference to their context."

37. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criteria capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the General Court stated that "complementary" means:

“...there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking”.

38. At the hearing, Ms Chantrielle submitted that each of the applicant’s goods in class 29 are foodstuffs and therefore identical or similar to those of the opponent. Whilst I agree that these respective goods are each foodstuffs, that fact of itself is not determinative. As set out in the above case law, I have to take all relevant factors into account in making my comparison.

39. *Meat, fish, poultry and game* are the flesh of various animals. *Meat extracts* are also derived from animals. They are therefore different in their source and nature to *peas* which are of plant origin. The respective goods do not reach the market through the same trade channels and they are not in competition. Whilst they may be eaten together, they are not complementary in the sense that one is indispensable or important for the use of the other (see: *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL-0-255-13). They are dissimilar goods.

40. *Preserved, dried and cooked fruits* are, self-evidently, fruits. Whilst, like *peas*, they are products derived from plants, their nature is different from them. I have no evidence they reach the market through the same trade channels and they are not in competition or complementary. They are dissimilar goods.

41. *Jellies, jams and compotes* are prepared foodstuffs, generally fruit based. Used as a dessert, topping, spread or sweet accompaniment, they are different in nature to *peas*. The respective goods have different trade channels and are not in competition or complementary. They are dissimilar goods.

42. *Eggs, milk and milk products* are also products which come from animals though would include plant-based milk and milk products such as those made from soya. Again, the respective goods have different natures, uses and trade channels and are not in competition or complementary. They are dissimilar goods.

43. *Edible oils and fats* may be animal or plant based, however again, they differ in nature, uses and trade channels from the opponent's *peas* and they are not in competition or complementary goods. They are dissimilar goods.

44. The applicant has amended its specification so as to exclude *peas* from the term *preserved, dried and cooked vegetables*. Despite this exclusion, each of the respective goods are vegetables and will overlap in nature, users, use and channels of trade. They are in competition in the sense that the person cooking with or eating vegetables may substitute one vegetable for the other. I consider the respective goods to be similar to at least a medium degree.

45. *Prepared meals (excluding meals made predominantly with peas)* and *soups (not made with peas)* may incorporate vegetables as an ingredient, however, their nature as a meal are different to that of *peas*. They will not reach the market through the same trade channels and they are not in competition or complementary. They are dissimilar goods.

46. *Potato crisps* are derived from a plant but the respective goods differ in their natures and uses, do not reach the market through the same trade channels and are not in competition or complementary. They are dissimilar goods.

47. I go on to consider the applicant's specification in class 31. The term *agricultural, horticultural and forestry products* is a very wide one. Agriculture relates, inter alia, to farming and the raising of crops, horticulture to the raising of plants and forestry to trees. Bearing in mind the relevant factors set out above, I can see no way in which *peas* are similar to *forestry products*. *Horticultural products* would include pea plants but I consider these to be dissimilar to *peas* as they differ in their nature, they reach the market through different trade channels, have different uses and users and are not complementary or in competition. *Agricultural products* will include vegetables which in turn will include *peas*. Whilst those vegetables within class 31 will be fresh and those in class 29 will be preserved, frozen, dried and/or cooked, they have the same users and uses and are alternatives for each other and, not least because of

the prevalence of farm shops, could reach the market through the same trade channels. These respective goods are similar to at least a medium degree.

48. *Seeds and natural plants* could include *peas* whether e.g. as a seed for growing into a plant or as a seedling or plug plant for growing on. As such, they are different in nature from the end product that is grown from them and they reach the market through different trade channels, have different uses and users and are not complementary or in competition. The respective goods are dissimilar.

49. Again, the applicant has amended its specification to exclude *peas* from the term *fresh vegetables*. Despite this exclusion, each of the respective goods are vegetables. Further, despite the fact that the applicant's vegetables are fresh whereas those in class 29 are not, they have the same users and uses and are alternatives for each other. For the reasons set out above, the respective goods are similar to at least a medium degree.

50. I can see no way in which *live animals, flowers or malt* are in any way similar to *peas* and Ms Chantrielle's rather vague submissions to the contrary at the hearing did not persuade me otherwise.

51. *Fresh fruits* are different in nature to vegetables in general and *peas* in particular. Whilst they each are foodstuffs, their particular uses and channels of trade differ and they are not in competition or complementary. They are dissimilar goods.

52. *Foodstuffs for animals and food and beverages for animals* will reach the market through different trade channels than will goods for human consumption. Their users differ and I do not consider that the respective goods are in competition or complementary. I consider them to be dissimilar goods.

53. In *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, Lady Justice Arden stated:

"49..... I do not find any threshold condition in the jurisprudence of the Court of Justice cited to us. Moreover I consider that no useful purpose is

served by holding that there is some minimum threshold level of similarity that has to be shown. If there is no similarity at all, there is no likelihood of confusion to be considered. If there is some similarity, then the likelihood of confusion has to be considered but it is unnecessary to interpose a need to find a minimum level of similarity.

54. In view of the above, the opposition under this ground therefore fails in respect of the following, which I have found to be dissimilar goods to those of the opponent:

Class 29

Meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits; jellies, jams, compotes; eggs, milk and milk products; edible oils and fats; prepared meals (excluding meals made predominantly with peas); soups (not made with peas) and potato crisps.

Class 31

Horticultural and forestry products; live animals; fresh fruits, seeds, natural plants and flowers; foodstuffs for animals; malt; food and beverages for animals.

55. As I have found (and it is not disputed) the competing trade marks to be identical, it is not necessary for me to consider the average consumer for the goods I have found to be similar nor is there any necessity for me to consider the distinctive character of the earlier trade mark. I pause to note the applicant has made submissions to the effect that the opponent's goods have been shown only to have been sold to businesses such as chip shops which is not the intended customer of its own goods, however, I cannot reach a determination on the likelihood of confusion on the basis of marketing considerations. As the CJEU stated in *Devinlec Développement Innovation Leclerc SA v OHIM*, Case C-171/06P:

“59. As regards the fact that the particular circumstances in which the goods in question were marketed were not taken into account, the Court of First Instance was fully entitled to hold that, since these may vary in time and depending on the wishes of the proprietors of the opposing marks, it is

inappropriate to take those circumstances into account in the prospective analysis of the likelihood of confusion between those marks.”

56. In determining whether there is a likelihood of confusion, I take into account the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. I have found the respective trade marks to be identical and have found some of the respective goods to be similar to at least a medium degree. Having regard to the interdependency principle, I find that there is a likelihood of direct confusion and the opposition under section 5(2)(a) succeeds in respect of the following goods:

Class 29

Preserved, dried and cooked vegetables (excluding peas)

Class 31

Agricultural products, fresh vegetables (excluding peas)

The objection under section 5(3)

57. Section 5(3) states:

“(3) A trade mark which-
(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a European Union trade mark or international trade mark (EC), in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

58. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, [1999] ETMR 950, Case 252/07, *Intel*, [2009] ETMR 13, Case C-408/01, *Adidas-Salomon*, [2004] ETMR 10 and C-487/07, *L’Oreal v Bellure* [2009] ETMR 55 and Case C-323/09, *Marks and Spencer v Interflora*. I

have this in mind but there is no need for me to set out the case law in detail because the opposition under this ground has no prospect of success.

59. In order to succeed under this ground, the opponent first has to show that the reputation of its trade mark is established in relation to the relevant section of the public and that it must be known by a significant part of that relevant public. It has failed to do so. I set out above a summary of the opponent's evidence of use of its mark and identified a number of flaws. Whilst I have found that evidence to be sufficient, just, to show genuine use of the mark, it is not sufficient to establish the required reputation. Whilst it appears the opponent has undertaken some promotional activities, (in the form of point of sale material, other promotional material and biannual exhibitions) the evidence is silent as to e.g. where, specifically, the point of sale material was displayed, when and how many people may have seen it, how the other promotional material was distributed, in what numbers and to whom and where the exhibitions took place and who and how many may have attended. I have no evidence of the size of the relevant market or the opponent's place within it. I have no evidence from the relevant public or the trade. The objection on this ground therefore fails.

Summary

60. The opposition brought under section 5(2)(a) succeeds in respect of:

Class 29

Preserved, dried and cooked vegetables (excluding peas)

Class 31

Agricultural products, fresh vegetables (excluding peas)

Costs

61. The opposition was originally brought under the provisions of section 5(2)(a), 5(2)(b), 5(3) and 5(4)(a) of the Act. The latter ground was withdrawn only in the skeleton argument. The objections under 5(2)(b) and 5(3) have failed in their entirety and the objection under 5(2)(a) has succeeded only in respect of a very small

number of goods. The applicant has therefore had the greatest measure of success and is entitled to an award of costs in its favour.

62. I make the award on the following basis:

For filing a counterstatement and reviewing the other side's notice of opposition:	£300
For reviewing evidence:	£750
Written submissions:	£500
Total:	£1,550

63. I order V A Whitley & Co Limited to pay Veg & City Drinks Limited the sum of £1,550 within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 15th day of February 2017



**Ann Corbett
For the Registrar
The Comptroller-General**