

TRADE MARKS 1994
IN THE MATTER OF APPLICATION No 2068388
BY BRAKE BROS LIMITED
TO REGISTER THE MARK
WALLY WHALE AND DEVICE
IN CLASS 29

AND IN THE MATTER OF OPPOSITION THERETO
BY S.A. BLUE WHALE

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION No 2069388

by BRAKE BROS PLC

5 TO REGISTER A TRADE MARK IN CLASS 29 & 30

AND IN THE MATTER OF OPPOSITION THERETO

by S.A. BLUE WHALE

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BACKGROUND

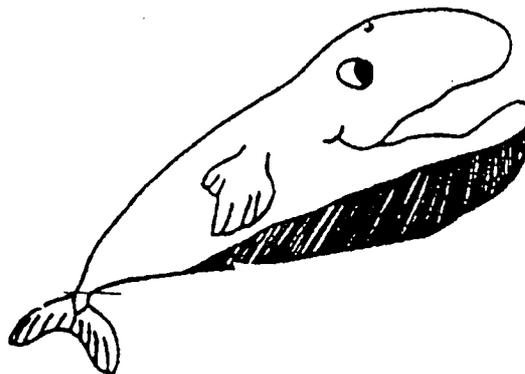
15 On 23 April 1996, Brake Bros Plc of Enterprise House, Godinton Road, Ashford, Kent, TN23 1EU applied under the Trade Marks Act 1994 for registration of the trade mark WALLY WHALE & Device (reproduced below for ease of reference) in respect of the following goods:

20 Class 29: "Meat; meat products; fish; poultry and game; frozen and / or chilled food products made from meat, fish, poultry or game; prepared meals; fruits and vegetables, all being preserved, dried, cooked or frozen; vegetarian prepared meals; potato chips; eggs".

And

25 Class 30: "Rice; pasta; pasta products, snack foods, prepared meals, dumplings; sauces, pastries, cakes and pastry mixes; confectionery; frozen confectionary; ices and sweets; puddings; milk based desserts, dessert products; ice creams; sorbet."

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WALLY WHALE

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On 3 December 1996 S.A. Blue Whale of MIN, BP417, 82004, Montauban, France, filed notice of opposition. The opponents did not file any evidence within the authorised period despite the

granting of three extensions of time, adding nine months to the statutory three month period. The absence of evidence would normally lead to the opposition being deemed withdrawn. However, in this case the Registrar decided, after an interlocutory hearing, that the opposition should continue. However, the grounds of opposition in the original statement of opposition were modified. The amended grounds of opposition are:

“The opponent is the registered proprietor of the following UK trade mark registration;

MARK	NUMBER	CLASS	JOURNAL	PAGE
WHALE DEVICE	988637	31	4912	2091

As a result of the use which the opponent has made of WHALE DEVICE in conjunction with the aforementioned trade mark registrations since at least 1972 it is contended that the applicants are not the true proprietors of the mark WALLY WHALE and DEVICE as applied for under application number 2069388 and accordingly the application should be refused under the Trade Marks Act 1994 and in particular Section 5(2)”.

The applicants filed a counterstatement denying the grounds of opposition, stating that they were the owners of the copyright in the logo embodied in their trade mark application. Both sides ask for an award of costs.

Neither side filed evidence in these proceedings and neither wished to be heard on the matter. My decision will therefore be based on the statement of opposition and the counterstatement.

DECISION

The ground of opposition under Section 5(2) 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 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.”*

I must first determine whether the goods of the applicants are identical with or similar to those for which the opponents are registered.

The applicants seek to be registered for:

Class 29: “Meat; meat products; fish; poultry and game; frozen and / or chilled food products made from meat, fish, poultry or game; prepared meals; fruits and vegetables, all being preserved, dried, cooked or frozen; vegetarian prepared meals; potato chips; eggs”.

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And

Class 30: “Rice; pasta; pasta products, snack foods, prepared meals, dumplings; sauces, pastries, cakes and pastry mixes; confectionery; frozen confectionary; ices and sweets; puddings; milk based desserts, dessert products; ice creams; sorbet.”

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Whilst the opponents are registered for:

Class 31: “Fresh fruits and fresh vegetables”.

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In considering the degree of similarity between the goods I rely on the decision by Jacob.J. in the British Sugar Plc v James Robertson & Sons [“TREAT” 1996 RPC 281]. In that case the court stated that:

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“The following factors must be relevant in considering whether there is or is not similarity:

a) The respective uses of the respective goods or services;

b) The respective users of the respective goods or services;

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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;

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f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in the 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”.

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Whilst I acknowledge that in view of the CANON - MGM judgement by the European Court of Justice (C-39/97) the TREAT case may no longer be wholly relied upon, the ECJ said that the factors identified by the UK government in its submissions, which are the factors listed in TREAT, are still relevant.

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In utilising this approach and applying it to this case it is clear that the opponents goods in Class 31 ‘Fresh fruit and vegetables’ are similar to the applicants goods ‘fruits and vegetables, all being preserved, dried, cooked or frozen’ in class 29 as the respective uses, users and physical nature are broadly similar. However, the trade channels may differ and the goods are likely to be found on different shelves, although they could be said to compete. This small range of the applicants’ goods are similar to the opponents’ goods.

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In considering the rest of the applicants' goods it is clear that there is no similarity as the uses, users, physical nature of the goods and the trade channels are likely to be different. Overall, whilst accepting that all foodstuffs are similar to an extent, the degree of similarity of the goods is very low.

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I therefore have to determine whether, bearing in mind the degree of similarity that exists between some of the goods, the marks are so similar that there exists a likelihood of confusion on the part of the relevant public. In deciding whether the two marks are similar I rely on the decision of the Court of Justice of the European Communities (ECJ) in the Sabel v Puma case C251/95 - ETMR [1998] 1-84. In that case the court stated that:

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“Article 4(1)(b) of the directive does not apply where there is no likelihood of confusion on the part of the public. In that respect, it is clear from the tenth recital in the preamble to the Directive that the appreciation of the likelihood of confusion ‘depends on numerous elements and, in particular, on the recognition of the trade mark on the market, of the association which can be made with the used or registered sign, of the degree of similarity between the trade mark and the sign and between the goods or services identified’. The likelihood of confusion must therefore be appreciated globally, taking into account all factors relevant to the circumstances of the case.

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Global appreciation of 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 wording of Article 4(1)(b) of the Directive - “there exists a likelihood of confusion on the part of the public” - shows that the perception of the marks in the mind of the average consumer of the type of goods or services in question plays a decisive role in the global appreciation of the likelihood of confusion. The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details.

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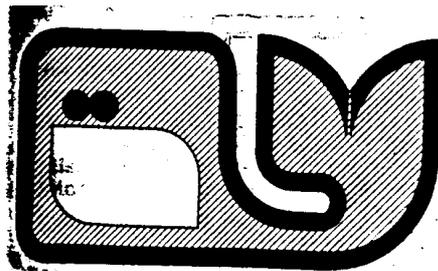
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In that perspective, the more distinctive the earlier mark, the greater will be the likelihood of confusion. It is therefore not impossible that the conceptual similarity resulting from the fact that two marks use images with analogous semantic content may give rise to a likelihood of confusion where the earlier mark has a particularly distinctive character, either per se or because of the reputation it enjoys with the public.”

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For ease of reference the opponents' trade mark is reproduced below:

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5 As the ECJ stated in Sabel v Puma, the public normally perceive trade marks as wholes and do
not proceed to analyse the various details. In this instance the opponents have a heavily stylised
logo which they state represents a whale, although I am not convinced that the average consumer
would immediately realise that this is what it represents. In contrast the applicants have a logo
which is a more realistic representation of a whale, albeit one with a friendly face. Even without
10 the word mark WALLY WHALE, the average consumer would identify the logo as a whale. With
the word mark in place then the identification of the mark as a cetacean mammal is certain.

15 It is my view that even if the products were identical (which they are not) the differences in the
marks is such that no confusion would be likely to arise. The opposition under Section 5(2)
therefore fails.

20 The opposition having failed, the applicants are entitled to a contribution towards their costs. I
order the opponents to pay to the applicants the sum of £135.

25 Dated this 3 Day of March 1999

30 George W Salthouse
For the Registrar
The Comptroller General