

O-073-04

**TRADE MARKS ACT 1994
IN THE MATTER OF APPLICATION NO. 2185792 IN THE NAME OF
ORANGE PERSONAL COMMUNICATIONS SERVICES LIMITED**

AND

**IN THE MATTER OF
OPPOSITION THERETO UNDER NO. 90356
IN THE NAME OF MARS UK LIMITED**

Trade Marks Act 1994
In the matter of application No. 2185792
in the name of Orange Personal Communications Services Limited

And

In the matter of opposition thereto
under No. 90356 in the name of Mars UK Limited

Background

1. On 7 January 1999, Orange Personal Communications Services Limited applied to register a trade mark in Classes 3, 5, 29 and 30, however, the opposition stands only against Classes 29 and 30, the specifications of these Classes being as follows:

Class 29: Meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies, jams, fruit, sauces; dairy products; eggs, milk and milk products; edible oils and fats; potato and potato products; vegetable products; prepared meals; snacks; chips; crisps; but not including any such goods consisting of or containing oranges.

Class 30: Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery, ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); biscuits, cakes, pastry; prepared meals and snacks; chocolate and chocolate based foodstuffs; ice-cream; sauces and dips; desserts; honey; but not including any such goods containing oranges.

3. The trade mark applied for is as follows:



The applicant claims the element of the mark.

colour orange as an

4. On 16 August 2001, Mars UK Limited filed notice of opposition based on the following ground:

Under Section 5(2)(b) because the mark applied for is a similar mark to the opponents=earlier trade marks and is sought to be registered for identical or similar goods to those covered by the earlier marks such that there exists a likelihood of confusion.

5. The earlier mark relied upon by the opponents can be found as an annex to this decision.

6. The applicants filed a counterstatement in which they deny the grounds on which the opposition is based.

7. Both sides ask that an award of costs be made in their favour.

8. Neither side filed evidence in these proceedings. The matter came to be heard on 26 January 2004, when the applicants were represented by Ms Buckley of R G C Jenkins, their trade mark attorneys. The opponents were represented by Ms Carboni of Counsel, instructed by Clifford Chance, their trade mark attorneys.

Decision

9. The opposition is founded on Section 5(2)(b) of the Act, which reads as follows:

A5.-(2) A trade mark shall not be registered if because**B**

- (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.@

10. An earlier trade mark is defined in Section 6 of the Act as follows:

A6.- (1) In this Act an Aearlier trade mark@means**B**

- (b) a registered trade mark, international trade mark (UK) or Community trade mark which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,@

11. In a consideration of a likelihood of confusion or deception I must take into account the guidance provided by 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] 45 F.S.R. 77 and *Marca Mode CV v Adidas AG* [2000] E.T.M.R. 723. 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 goods/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 therefore 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*,
- (e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,
- (f) 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*,
- (g) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v Puma AG*,
- (h) further, the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense; *Marca Mode CV v Adidas AG*,
- (i) but 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*.

12. At the hearing Ms Buckley helpfully conceded that some of the goods covered by Classes 29 and 30 of the application are goods identical or similar to those covered by the opponents' earlier marks, and that the point at issue revolved around a mark-for-mark comparison. There being no qualification or limitation to any of the specifications, such as to their nature, purpose, uses etc, I must notionally assume that these goods share the same channels of trade, from manufacture to retail, and also the same consumer.

13. Foodstuffs are in general ordinary everyday goods that consumers from most walks of life will come into contact with and at some time buy. Although not ordinarily high price items food is likely to be selected with a degree of care, probably with more attention being paid to

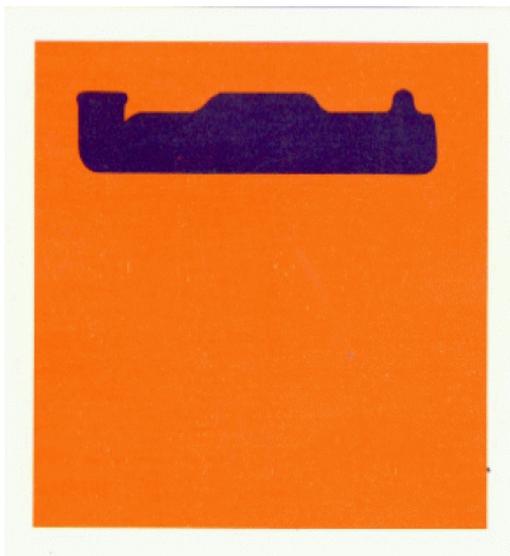
their description of the foodstuff to ensure that the correct product is obtained than to the trade name. That said, food products can, and in my experience, quite often do attract brand loyalty with consumers choosing an item because they have previously bought and been satisfied with that specific product, or another product from the same trader.

14. In my experience traders display all of the different branded goods of the same type that they hold in stock in close proximity, so this is one of the rare areas of commerce where the consumer may have the opportunity to see marks along side one another. However, not all traders stock all of the available brands, and it may well be that a consumer will see a brand in one shop, but not in another. This leaves open the possibility of the applicants' and the opponents' goods being displayed side-by-side affording a direct comparison, or in different retail outlets where the consumer will have to rely on their potentially imperfect recollection.

15. In their Statement of Grounds, the opponents provide a list of the trade marks that they rely upon. In her submissions Ms Carboni stated that the opponents relied on two marks in particular, Nos. 2013046 and 2013040, accepting that if the opponents are not able to succeed in their action based on these marks, they will be in no better position in respect of any of the other marks.

16. The two marks primarily relied upon by the opponents are as follows:

2013046



2013040



17. Both marks are defined by the statement 'The mark consists of the colours orange and blue as in the representation shown below in heraldic shading' with the second mark also stated to consist of the character as shown in the representation.

18. Ms Buckley sought to draw a distinction between the wording that qualified or defined the respective marks. The applicants claim the colour ORANGE as an element of their mark whereas the opponents say that their mark consists of, inter alia the colours ORANGE and BLUE. Ms Carboni took the view that differentiating between the words 'consists of' and 'claims' is just playing with words. In the appeal to the Appointed Person in respect of Case

No. 0/392/02, Mr Geoffrey Hobbs QC made the following observation:

18. An application for registration can be made subject to: (i) a colour claim confirming that a specified colour or colour scheme forms part of the trade mark to which the claim relates; or more restrictively: (ii) a colour limitation confirming that a specified colour or colour scheme is indispensable to the identity of the trade mark to which the limitation applies. Both possibilities involve the voluntary adoption of a 'limitation' within the meaning of that expression as used in Section 13 of the Act.

19. On my reading Mr Hobbs is saying that there may be a difference in the *raison d'être* for a 'claim' and a 'limitation' (the expression 'consists of' would in my view most likely come under the latter), but at the end of the day the effect is that both result in a limitation to whatever element is claimed or the mark is said to consist of. Accordingly, in any comparison the element or feature to which the limitation applies must be attributed some significance, the degree depending on the distinctiveness that it contributes to the mark as a whole.

20. Both Ms Carboni and Ms Buckley made reference to the individual features of the respective marks. Given that each mark has a number of component parts, and the claimed similarity exists in respect of one, this approach is almost inevitable and not at odds with the guidance in the *Sabel* case which indicated that where an element is particularly distinctive and dominant that the focus of attention should be on that element. Ms Carboni submitted that the dominant feature of the respective marks, and the most distinctive in the mark applied for is the colour ORANGE, and that it is the colour that would be the key to the overall impression left in the mind of the average consumer. She considered the significance of the shape to depend upon how the mark is used, saying that if it was used so that it covered the entirety of a square packaging the consumer would not regard the shape as having any significance, but would remember the colour.

21. Ms Buckley submitted that the applicants' mark 'A...has a boundary of white space around it demonstrating very clearly that the mark is a square device'. That may well be the case, but as Ms Carboni rightly stated, the same could be said of the opponents' marks; it is hard to see any difference. As none of the respective marks have claimed shape to be a feature, I must assume that they are all capable of being used in the same way, be it square and bordered, or covering the entire surface of the packaging.

22. All three marks have an orange quadrilateral-shaped background, and if only to that extent there must be a visual similarity. The opponents' marks also have an irregular, blue coloured shape in the upper portion, and in one case, also a depiction of a man's head. The applicants' mark has the word ORANGE in white lettering placed on the background. Although as Ms Carboni states, the most prominent feature of these marks is the colour ORANGE, these additional elements move the marks some way apart in terms of visual similarity.

23. With the ORANGE colour background and the word ORANGE placed on it, there is no doubt in my mind that the applicants' marks will be referred to as the 'ORANGE' mark. In the opponents' marks there is no single feature that seems to be an obvious descriptor, and whilst it is possible that they could be referred to as 'ORANGE' marks, it seems more likely to me that the consumer will resort to a description based on all of the elements. I do not, therefore see that there is much in the way of oral or aural similarity.

24. Ms Carboni placed a good deal of reliance on the assertion that it is the colour that would be the key to the overall impression left in the mind of the average consumer. Again, there is no doubt in my mind that the applicants' mark will be seen and remembered as an **ORANGE** mark. The word appearing in the applicants' mark may serve to emphasise that the mark is **ORANGE** in colour, but its use is unusual and in my view sticks in the mind. Even though the colour **ORANGE** is a major part of the opponents' marks, with the additional features I am not convinced that the consumer will see the marks as Ms Carboni suggests. The overall impression I get from the opponents' marks is that of the colour **ORANGE** used as a background, and subordinate to other matter placed upon it.

25. Much of Ms Carboni's case relies upon the consumer fixing the colour **ORANGE** from the opponents' marks in their mind, so that when they see the applicants' mark they will be confused through imperfect recollection. I do not consider the colour **ORANGE** to be an unusual colour likely to be used by one or two traders in foodstuffs. There must be many that use it to varying degrees of significance, if not in their trade marks then on their packaging. Whilst my view is based on personal knowledge, in the absence of evidence I do not place any reliance on this point. Having determined that any conceptual similarity in the respective marks is at best marginal, I do not see confusion through imperfect recollection as a real likelihood.

26. In *Henkel's application*, Case T337/99, a decision of the Court of First Instance of the European Communities, it was stated that the distinctive character of a trade mark must be assessed in relation to the goods or services in respect of which registration of the mark is sought. But this does not mean that if the colour or colours have no relevance for the goods or services that the trade mark must possess a distinctive character. Because of their common usage on packaging, etc, applications to register single or combinations of two (or more colours depending on how they are represented) are generally regarded as being possessed of a low level of distinctiveness.

27. The opponents define their earlier marks as being composed of two colours. Although they do not make any specific claim to the shapes or manner in which the colours are represented, the claim mentions that the colours (and the device of the character) are as shown in the representation. If, as in the case of the opponents' earlier marks, a two-colour mark is found to be acceptable *prima facie*, then its distinctiveness must rest in something unusual in the combination of colours, or the manner in which they are represented. But whichever is the case, such a mark must be considered to possess a low level of distinctiveness and deserving a correspondingly narrow boundary of protection.

28. Taking all of the above into account and adopting the *global* approach advocated, I have little difficulty in reaching the view that whilst there is some commonality in the use of the colour **ORANGE**, the best that can be said is that the later mark might bring the earlier mark to mind. I do not consider this will lead the consumer into believing the respective goods come from the same or an economically linked undertaking, or that there is a likelihood of confusion.

29. The opposition having failed, the applicants are entitled to an award of costs. I order the opponents to pay the applicants the sum of £1,550 as a contribution towards their costs. This

sum to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 22nd day of March 2004

**Mike Foley
for the Registrar
the Comptroller-General**