

O-114-04

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 2278532
BY ELVEDEN FARMS LIMITED TO REGISTER THE
TRADE MARK ELVEDEN IT'S OUR NATURE
IN CLASSES 29, 30, 31, 32 AND 42**

AND

**IN THE MATTER OF OPPOSITION No. 91378
BY CAMPINA B.V.**

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Background

1. On 20 August 2001 Elveden Farms Limited applied to register the mark ELVEDEN IT'S OUR NATURE for the following specification of goods and services:

Class 29:

Meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruit and vegetables; jellies, jams, fruit sauces; eggs, milk and milk products; edible oils and fats.

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; spices; ice.

Class 31:

Agricultural, horticultural and forestry products and grains; live animals; fresh fruit and vegetables; seeds, natural plants and flowers; foodstuffs for animals; malt.

Class 32:

Beers; mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages.

Class 42:

Provision of agricultural services; provision of food and drink; provision of temporary accommodation.

The application is numbered 2278532.

2. On 2 January 2003 Campina B.V. (previously Campina Melkunie B.V.) filed notice of opposition to this application. They are the proprietors of the following registration:

Decision

8. Section 5(2) reads as follows:

“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 earlier trade mark is protected, or
- (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.”

Sub-paragraph (b) applies here.

9. The opponents' registration is an earlier trade mark within the meaning of Section 6(1)(a) of the Act.

10. I take into account the well established guidance provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] E.T.M.R. 1, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, and *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77.

11. According to these authorities the visual, aural and conceptual similarities of the marks must be assessed by reference to their overall impressions bearing in mind their distinctive and dominant components (*Sabel v Puma*, paragraph 23). Distinctive character may be either inherent or acquired (*Sabel v Puma*, paragraph 24). The matter must be judged through the eyes of the average consumer who is deemed to be reasonably well informed, circumspect and observant (*Lloyd Schuhfabrik v Klijsen*, paragraph 27).

Distinctive character of the marks

12. The opponents' mark consists of the words IT'S IN OUR NATURE. Evidence in the form of a witness statement by Michael Korthouwer, the Finance Director of Campina (UK) Ltd has this to say about use of the mark:

- “3. The Trade Mark has been used in the United Kingdom since as early as 2000.
- 4. The Trade Mark is not used in respect of any one product in the United Kingdom. It is used predominantly in advertising and promotional material.
- 5. I am attaching hereto as Exhibit “B1”, a copy of the final page of the Campina magazine dated October 2002 together with a copy of the Staff Annual Report for

2000, 2001 and 2002, also a recent advertising campaign poster and a product specification sheet given to the trade all showing use of the Trade Mark.

6. As the mark is not used in respect of any one product, but is used essentially for all products it is not possible to assign turnover or promotional expenditure figures to the Trade Mark.”

13. It is clear from the documents at Exhibit B1 that the words function as a corporate slogan and are not, it would seem, used in direct association with the products themselves. The words themselves are ordinary words of the English language and produce an expression which is, in my view, an unremarkable and natural one. The Court of First Instance emphasised in REAL PEOPLE, REAL SOLUTIONS, Case T-130/01 that “the relevant consumer is not very attentive if a sign does not immediately indicate to him the origin and/or intended use of the object of his intended purchase, but just gives him purely promotional, abstract information...”.

14. IT’S IN OUR NATURE is a registered mark so it must be assumed that it has not been found to be devoid of distinctive character. Nevertheless, given the average consumer’s approach to marks of this kind, it cannot be said to enjoy anything other than a low degree of distinctiveness.

15. The applicants say of their mark that “it consists of the initial, distinctive, registered mark of the applicants, ELVEDEN in combination with the commonly occurring non-distinctive phrase “IT’S OUR NATURE”, the combination giving use to a distinctive, registrable, whole”. ELVEDEN appears to be of geographical significance though no point has been taken in relation to its distinctiveness on that account in relation to the goods at issue and I note that it is registered under No. 2278535. The fact that the first element of the mark is separately registered does not mean that no distinctiveness/trade mark significance should be attached to the words IT’S OUR NATURE. However, it follows from my view of the opponents’ mark that I consider this latter element to have a low capacity to distinguish and hence in this case it makes but a small contribution to the overall character of the mark, the more so as the words are visually and conceptually subordinate to the word ELVEDEN.

Similarity of the marks

16. Turning to the visual, aural and conceptual similarities between the marks the opponents base their objection on the second element of the applied for mark, that is to say the words IT’S OUR NATURE. The applicants seek to discount the distinctive character of that part of their mark and focus attention on the word ELVEDEN. The opponents comment on this in their written submissions:

“The Applicant appears to be arguing in paragraph 5 of their counter statement that the fact that it is registered is an argument as to why ELVEDEN IT’S OUR NATURE is not similar to IT’S IN OUR NATURE. There is a fallacy in that argument. If the argument is to be considered valid then it is saying that Elveden Farms Limited would be able to register, with impunity, marks such as ELVEDEN COCA-COLA. Clearly that is not so. It is admitted that Elveden Farms Limited have not, in the second element of their marks,

taken the identical Registered Trade Mark of the Opponent, but it is so similar for that point to be unimportant.”

17. There is force in the submission that an objection cannot be circumvented by adding an independently registrable word to a word or element that is the distinctive trade mark of another party (the ELVEDEN COCA-COLA example). On the other hand, no such problem would be likely to exist if the element common to the parties’ respective marks was, for instance, the name of the goods or a highly descriptive word. Difficult issues may arise where, as here, the common element is of low but not negligible distinctive character.

18. I remind myself at this point that the earlier trade mark is IT’S IN OUR NATURE whereas the second element of the applied for mark is IT’S OUR NATURE. However, the absence of the preposition is not of particular consequence. The two phrases are visually, aurally and conceptually similar to a high degree, particularly when allowance is made for imperfect recollection.

19. Overall consideration of the respective marks must, of course, take into account that the applied for mark is not IT’S OUR NATURE but ELVEDEN IT’S OUR NATURE. ELVEDEN may be seen as a house mark or another mark of which the consumer was previously unaware which is now being used with the words IT’S OUR NATURE. The circumstances can be compared with those pertaining in *BULOVA ACCUTRON* 1969 RPC 102 where it was said:

“Particularly having regard to the fact that BULOVA is the house name of the applicants and has a significance other than as a trade mark, its addition before the word ACCUTRON does not in my judgment serve to prevent the deception or confusion which would in the view of the Court of Appeal have been caused but for that adoption. As the Assistant Registrar remarks in his decision: “As BULOVA and ACCUTRON do not hold together as a phrase or present a wholly different meaning to the separate components, I think that their combination will be taken by many persons on first impression as an indication that the manufacturer of the watches is using two separate trade marks in connection with his products”. I would add that the combination of the two words is likely to be taken by other persons on first impression as an indication that the part of the trade mark which consists of BULOVA is a house name of the marketers of the watches, that the trade mark is ACCUTRON and that they will confuse them with watches marketed under the trade mark ACCURIST simpliciter”.

20. I do not consider that ELVEDEN IT’S OUR NATURE hangs together as a phrase save that the OUR may be taken as referring back to ELVEDEN. But certainly the totality does not create a different meaning. In summary the respective marks are distinguishable by virtue of the element ELVEDEN but the latter may be taken as a previously unobserved housemark. In substance the element IT’S OUR NATURE is very closely similar to IT’S IN OUR NATURE but neither makes a strong claim on consumers’ attention.

Similarity of goods and services

21. The full specifications of the application in suit and the earlier trade mark are set out at the start of this decision. The principles to be applied in considering similarity of goods are to be found in the *Canon case* where the ECJ stated at paragraph 23:

“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 end users and their method of use and whether they are in competition with each other or are complementary.”

22. In *British Sugar Plc v James Robertson & Sons Ltd* (TREAT) [1996] RPC 281 the judge considered that channels of trade should also be brought into the reckoning. The opponents’ statement of grounds claims that the respective goods and services are identical or similar but offers no further explanation or elaboration. Their written submissions (referring also to the applicants’ position) go a little further and say that:

“It is also noted that the Applicant has argued in their counterstatement that there is no similarity or identity of goods between the Opponent’s mark and those of the Applicant’s mark. To take just a few examples, in Class 29 of both the Opponent’s and the Applicant’s marks there is the term “milk and milk products” in Class 30, both marks contain the term “flour”. It has also been submitted that there is a similarity between the remaining goods and services of the Applicant’s mark and the goods of the Opponent’s mark. The fact that the issue has to be considered in these written submissions should be born in mind when costs are awarded in the opposition, regardless of the outcome.”

23. Given the number of Classes and the extensive range of goods and services involved, it is not helpful to have submissions pitched at such a general level. It was held in *Harding v Smilecare Ltd* [2002] FSR 37 that, in relation to Section 10(2)(b) (the infringement provision equating to Section 5(2)(b)), there is a threshold that has to be crossed, namely that goods or services must be similar. A case under Section 5(2)(b) does not get off the ground if there is no similarity. Furthermore, likelihood of confusion is a matter of global appreciation (*Sabel v Puma*, paragraph 22) and the assessment under Section 5(2) must take account of the net effect of the similarities and differences between the marks and the goods and services (*Raleigh International Trade Mark* [2001] RPC 202). It follows that even if similarity has been established the degree of similarity may also be relevant. The onus is on the opponents to make out their case. Applying the principles from *Canon* and *Treat I* make the following findings in relation to identical goods (by Class):

Applicants’ goods

Meat extracts
Milk and milk products
Edible oils and fats

Opponents’ goods

Meat extracts
Milk and milk products
Edible oils and fats

Flour
Yeast and baking powder

Sauces
Ices

Rice, tapioca, sago

Jellies

Flour
Ingredients used in preparing bread
Sauces
Ice cream, sorbet (on the basis that a sorbet is a water ice)
Puddings, other desserts in this Class, rice, porridge
Meat extracts (aspic, for instance, being a savoury jelly based on meat stock).

24. The position in relation to similar goods is less easily determined.

25. 'Coffee, cocoa and artificial coffee' may have some similarities to 'chocolate milk and milk drinks added with cocoa, chocolate or coffee' but the degree of similarity is not clear. In particular, I do not know whether such goods appear in close proximity in retail outlets (milk products would be likely to be placed in a chilled cabinet), whether they are made by the same manufacturers or whether they are considered to be complementary or competitive such that consumers may have expectations as to common trade origin.

26. 'Preparations made from cereals' is a term of somewhat uncertain scope. I would take it to include breakfast cereals and to have a high degree of similarity to the term 'cereals'. The applicants' Class 30 specification also contains 'sugar', 'bread' and 'confectionery'. No submissions have been made as to whether such goods are similar to 'ingredients used in preparing bread and confectionery'. Ingredients are not necessarily similar to the finished product. If there is similarity it is at a low level.

27. The opponents have remained silent on the issue of similarity between their goods and the applicants' goods and services in Classes 31, 32 and 42. The opponents' registration does not cover those Classes but that is not determinative of whether there is similarity. There may be scope for argument as to whether certain 'non-alcoholic drinks', 'fruit drinks' and 'fruit juices' in Class 32 may be similar to 'dietetic products for medical use' etc in Class 5 of the opponents' registration. Evidence as to the position in trade might have helped to resolve the position. In the absence of evidence or argument directed to the point I am unable to reach a concluded view. The remaining goods and services are in my view not similar.

Likelihood of confusion

28. As noted above the likelihood of confusion is a matter of global appreciation taking all relevant factors into account. The main factors in this case are the low level of distinctive character attaching to the mark/element that gives rise to the opponents' objection; consumers' general inattentiveness to slogan type marks particularly where they consist of a relatively common expression; the near identity of the common elements when imperfect recollection is allowed for; the diluting effect of the presence of the word ELVEDEN; goods and services

which range from the identical to the dissimilar and various shadings in between; and the fact that low cost consumer goods may not be purchased with the same degree of care as more expensive items.

29. Making the best I can of the matter I am of the view that confusion can only be said to be likely where the goods are identical or very closely similar such that they can be expected to appear in close proximity in a retail trading environment. The opponents' mark is not sufficiently memorable that consumers can be expected to make any association or assumption as to common trade origin where the applied for mark is used on goods or services which share a lesser degree of similarity.

30. Accordingly, the application will be allowed to proceed if, within 28 days of the expiry of the appeal period for this decision, the applicants file a Form TM21 amending their specification as follows:

Class 29 - meat, fish, poultry and game; preserved, dried and cooked fruit and vegetables; jams, fruit sauces; eggs.

Class 30 - coffee, tea, cocoa, sugar, artificial coffee, bread, pastry and confectionery; honey, treacle; salt, mustard; vinegar, condiments; spices; ice.

Class 31 - Agricultural, horticultural and forestry products and grains; live animals; fresh fruit and vegetables; seeds, natural plants and flowers; foodstuffs for animals; malt.

Class 32 - Beers; mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages.

Class 42 - Provision of agricultural services; provision of food and drink; provision of temporary accommodation.

31. If no Form TM21 is filed within the period set the application will be refused in its entirety. If an appeal is filed the period for filing the Form TM21 will be 28 days from the final determination of the case.

Costs

32. In the passage referred to above from the opponents' written submissions it is suggested that any costs award should take account of the fact that the applicants' counterstatement denied any similarity or identity of goods. As I read the counterstatement, the applicants were not necessarily saying that there was no identity or similarity but suggesting that it was not such (when considered in conjunction with the marks) as to give rise to a likelihood of confusion. In the light of the lack of particularisation of the opponents' own claims in relation to identity/similarity of goods and services I do not think the applicants' position calls for criticism.

In the circumstances of this case, as both sides have achieved a measure of success, I do not propose to favour either side with an award of costs.

Dated this 27th day of April 2004

**M REYNOLDS
For the Registrar
the Comptroller-General**