

O/168/06

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No 2377781
BY MAYFAIR FOODS LIMITED
TO REGISTER A TRADE MARK
IN CLASS 29**

**AND IN THE MATTER OF OPPOSITION
THERE TO UNDER NO 93299
BY LIDL STIFTUNG & CO. KG**

BACKGROUND

1) On 11 November 2004, Mayfair Foods Limited of Brookvale, Love Lane, Betchton, Sandbach, Cheshire CW11 2TS applied under the Trade Marks Act 1994 for registration of the trade mark MAYBELLE in respect of “Dried Potato, starch, canned fruit and vegetables” in Class 29.

2) On 24 March 2005 Lidl Stiftung & Co. KG of Stiftsbergstrasse 1, D-74167 Neckassulm, Germany filed notice of opposition to the application. The ground of opposition is in summary:

a) The opponent is the proprietor of the following marks:

Mark	Number	Effective Date	Class	Specification
MARIBEL	2030400	15.08.95	5	Dietetic jellies, jams, fruit spreads, preserved fruit, canned fruit and fruit preserves, all being for medical purposes.
			29	Jellies, jams, fruit spreads, preserved fruit, canned fruit and fruit preserves; dietetic jellies, jams, fruit spreads, preserved fruit, canned fruit and fruit preserves, none being for medical purposes.

b) The mark in suit is similar to the opponent’s trade mark, and the goods applied for are identical or similar. The mark applied for therefore offends against Section 5(2)(b) of the Trade Marks Act 1994.

3) The applicant subsequently filed a counterstatement denying the opponent’s claims.

4) Both sides filed evidence in these proceedings. Both sides ask for an award of costs. Neither side wished to be heard although the opponent did provide written submissions which I shall detail in my decision as and when relevant.

OPPONENT’S EVIDENCE

5) The opponent filed a witness statement, dated 29 September 2005, by Peter Fischer, the Managing Director of Lidl Stiftung & Co. Beteiligungs-GmbH which is a general partner of the opponent company. He states that he has held his position since July 2000. Mr Fischer states that his company operates a chain of over 330 supermarkets throughout the UK and started trading in the UK in 1994. He states that his company has used the MARIBEL trade mark in the UK since November 1994 initially in respect of jams and honey, expanding to cherries in 1995 and marmalade in 1997. He provides the following figures for sales of products under the MARIBEL mark in the UK, the figures are in Euros:

Year	Jam	Marmalade	Honey	Cherries	TOTAL
1998	816,995	273,800	972,068	116,263	2,179,126
1999	937,678	340,765	1,362,007	-	2,640,540
2000	1,255,033	543,365	1,902,341	93,010	3,793,749

2001	1,233,584	560,290	2,161,131	-	3,955,005
2002	1,092,823	458,211	2,672,558	102,311	4,325,933
2003	1,174,491	520,344	2,348,997	179,155	4,222,987
2004	1,545,000	542,749	2,888,193	192,996	5,168,938

6) Mr Fischer states that the total amount spent on promoting the mark in the UK is approximately €20,000. He states that the mark MARIBEL appears on labels on the products and that advertisements for the products are usually in the form of a picture of the product which shows the mark. At exhibit PF1 he provides copies of promotional newsletters which show pictures of jars of jam, honey and marmalade from May 2004, September 2004 and April 2005.

APPLICANT'S EVIDENCE

7) The applicant filed a witness statement, dated 12 January 2005 [sic], by Mr T Nicklin, a Director of the applicant company. The statement was received in January 2006 and the statement would therefore appear to have been incorrectly dated. He states his company supplies products to food manufacturers and not retailers and so their customer bases are different. At exhibit 1 he provides a copy of a label to show that the labels that the applicant uses are totally different to those usually found on consumer products.

8) That concludes my review of the evidence. I now turn to the decision.

DECISION

9) There is only one ground of opposition which is under section 5(2)(b) which reads:

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

(a)....

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

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

10) An “earlier trade mark” is defined in section 6, the relevant part of which states:

“6.-(1) In this Act an "earlier trade mark" means -

(a) 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) The opponent is relying upon its UK Trade Mark No. 2030400 shown in paragraph 2 above. This has an effective date of 15 August 1995 and is clearly an earlier trade mark.

12) In determining the question under section 5(2)(b), I 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] E.T.M.R. 1, *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.* [2000] 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.*

13) In essence the test under section 5(2)(b) is whether there are similarities in marks and goods which would combine to create a likelihood of confusion. In my consideration of whether there are similarities sufficient to show a likelihood of

confusion I am guided by the judgements of the European Court of Justice mentioned above. The likelihood of confusion must be appreciated globally and I need to address the degree of visual, aural and conceptual similarity between the marks, evaluating the importance to be attached to those different elements taking into account the degree of similarity in the goods, the category of goods in question and how they are marketed. Furthermore, I must compare the applicant's mark and the mark relied upon by the opponent on the basis of their inherent characteristics assuming normal and fair use of the marks on a full range of the goods covered within the respective specifications.

14) The effect of reputation on the global consideration of a likelihood of confusion under Section 5(2)(b) of the Act was considered by David Kitchen Q.C. sitting as the Appointed Person in *Steelco Trade Mark* (BL O/268/04). Mr Kitchen concluded at paragraph 17 of his decision:

“The global assessment of the likelihood of confusion must therefore be based on all the circumstances. These include an assessment of the distinctive character of the earlier mark. When the mark has been used on a significant scale that distinctiveness will depend upon a combination of its inherent nature and its factual distinctiveness. I do not detect in the principles established by the European Court of Justice any intention to limit the assessment of distinctiveness acquired through use to those marks which have become household names. Accordingly, I believe the observations of Mr. Thorley Q.C in *DUONEBS* should not be seen as of general application irrespective of the circumstances of the case. The recognition of the earlier trade mark in the market is one of the factors which must be taken into account in making the overall global assessment of the likelihood of confusion. As observed recently by Jacob L.J. in *Reed Executive & Ors v Reed Business Information Ltd & Ors*, EWCA Civ 159, this may be particularly important in the case of marks which contain an element descriptive of the goods or services for which they have been registered. In the case of marks which are descriptive, the average consumer will expect others to use similar descriptive marks and thus be alert for details which would differentiate one mark from another. Where a mark has become distinctive through use then this may cease to be such an important consideration. But all must depend upon the circumstances of each individual case.”

15) I also have to consider whether the mark that the opponent is relying upon has a particularly distinctive character either arising from the inherent characteristics of the mark or because of the use made of it. The opponent's mark consists of the single word MARIBEL in capital letters. The opponent states that products under the MARIBEL brand are sold in its 330 supermarkets throughout the UK. The opponent has provided sales and advertising figures for jam, marmalade, honey and cherries. However, it has not provided figures which show the total UK market for such goods, its market share or any independent evidence of its reputation under this mark in the UK on the goods in question. In my opinion, the opponent's mark is inherently distinctive for the goods for which it is registered. However, I do not accept that the opponent has provided evidence to support its contention that it should benefit from an enhanced reputation.

16) Although the applicant has contended that the two parties are not in competition as the applicant sells to food manufacturers whilst the opponent retails directly to the general public this is not reflected in the specifications of the two parties. Neither is restricted in such a way and without both parties agreeing to such amendments to their respective specifications the situation would remain the same.

17) The opposition was filed on 24 March 2005. I must therefore consider the position under The Trade Marks (Proof of Use, etc.) Regulations 2004. Paragraph four of which states:

“4. After section 6 there shall be inserted -

6A Raising of relative grounds in opposition proceedings in case of non-use

(1) This section applies where -

- (a) an application for registration of a trade mark has been published,
- (b) there is an earlier trade mark 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 Community trade mark, any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

(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.

(7) Nothing in this section affects -

(a) the refusal of registration on the grounds mentioned in section 3 (absolute grounds for refusal) or section 5(4)(relative grounds of refusal on the basis of an earlier right), or

(b) the making of an application for a declaration of invalidity under section 47(2) (application on relative grounds where no consent to registration)."

18) As the mark that the opponent is relying upon was registered more than five years prior to the publication date of 24 December 2004 I must first consider whether the opponent has fulfilled the requirement to show that genuine use of the mark has been made.

19) The opponent's evidence of use is contained within exhibit PF1 which is detailed at paragraph 6 above. The application was published on 24 December 2004 and so the opponent must show use within the period 25 December 1999 – 24 December 2004. Although the opponent has provided turnover figures for jam, marmalade, honey and cherries the corroborative evidence only shows use on jam, marmalade and honey. For the purposes of the comparison of goods the opponent's specification will be regarded as comprising "jam, marmalade and honey".

20) It is clear that none of the goods in the specification of the mark applied for are identical to the opponent's specification as restricted in paragraph 19 above. However, the applicant's specification of "Dried Potato, starch, canned fruit and vegetables" must be regarded as similar to the opponent's specification of "jam, marmalade and honey".

21) I now turn to consider the marks of the two parties, which are MAYBELLE and MARIBEL. The opponent contends that the marks have the same beginnings in the letters MA and have the same suffix elements albeit in alternative spellings. They also contend that the marks are aurally similar and that the applicant's mark sounds like a contraction of the opponent's mark. Lastly, they contend that neither mark has any conceptual meaning, and thus there is no basis for distinguishing between the marks.

22) Visually, I agree that the marks do have the same beginning in the letters "MA". However, thereafter they vary considerably although they do both have the letters "BEL" contained within them. Phonetically, the marks are different. The mark in suit

consists of two syllables “May” and “Bell”. The opponent’s mark is a three syllable mark “Ma”, “Ri” or “Ree” and “Bell”.

23) The opponent has contended that neither mark has any conceptual meaning. Whilst this is true for the marks as wholes there are aspects which, I believe, would have resonance for the average consumer. Both marks start with what would be seen as a female name. “Mari” is a corruption of Mary, whilst May is also the name of the month. In pronouncing the applicant’s mark it could also be heard as the name Mabel.

24) Considering the marks as wholes I believe that the differences outweigh the similarities.

25) I must also consider the average consumer for the types of goods covered by the specifications outlined in paragraph 20 above. In my opinion, they would be the general public who are reasonably well informed and reasonably circumspect and observant. In my view, foodstuffs are not purchased without some consideration, not least because of the amount of media attention devoted to diet and food scares. The average consumer is nowadays far more discerning about what they consume. Although I must take into account the concept of imperfect recollection.

26) Taking account of all of the above when considering the marks globally, I believe that there is not a likelihood of consumers being confused into believing that the goods provided by the applicant are those of the opponent or provided by some undertaking linked to them. The opposition under Section 5(2)(b) therefore fails.

COSTS

27) As the opponent was unsuccessful the applicant is entitled to a contribution towards its costs. I order the opponent to pay the applicant the sum of £1,000. 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 20th day of June 2006

**George W Salthouse
For the Registrar,
the Comptroller-General**