

O-171-11

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO 2493640**

**BY**

**MKS LIMITED**

**TO REGISTER THE TRADE MARK:**



**IN CLASS 30**

**AND**

**THE OPPOSITION THERETO**

**UNDER NO 98827**

**BY**

**TATA GLOBAL BEVERAGES GB LIMITED**

**Trade Marks Act 1994**

**In the matter of application no 2493640  
by MKS Limited  
to register the trade mark:**



**in class 30  
and the opposition thereto  
under no 98827  
by Tata Global Beverages GB Limited**

1) On 23 July 2008 MKS Limited (MKS) filed an application to register the above trade mark (the trade mark). The trade mark was published in the *Trade Marks Journal*, for opposition purposes, on 5 December 2008. Subsequent to the publication, the specification was amended to:

*coffee, tea, cocoa, sugar, tapioca, artificial coffee; ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice; aromatic preparations for food; allspice; aniseed; baking soda [bicarbonate of soda for cooking purposes]; bee glue [propolis] for human consumption; beer vinegar; binding agents for ice cream; capers; celery salt; chewing gum, not for medical purposes; chicory [coffee substitute]; chocolate beverages with milk; chocolate-based beverages; chow-chow [condiment]; chutneys [condiments]; cinnamon [spice]; cloves [spice]; cocoa beverages with milk; cocoa-based beverages; coffee beverages with milk; coffee flavorings [flavourings]; coffee-based beverages; condiments; cooking salt; curry [spice]; custard; dressings for salad; essences for foodstuffs, except etheric essences and essential oils; ferments for pastes; flavorings [flavourings], other than essential oils; flavorings [flavourings], other than essential oils, for beverages; flavorings [flavourings], other than essential oils, for cakes; garden herbs, preserved [seasonings]; ginger [spice]; glucose for food; gluten for food; golden syrup; gruel, with a milk base, for food; hominy; ice for refreshment; ice, natural or artificial; iced tea; infusions, not medicinal; ketchup [sauce]; leaven; malt extract for food; malt for human consumption; maltose; mayonnaise; meat gravies; meat tenderizers, for household purposes; molasses for food; natural sweeteners; nutmegs; pasta; pepper; peppers [seasonings]; powders for ice cream; preparations for stiffening whipped cream; quiches; relish [condiment]; royal jelly for human consumption, not for medical purposes; saffron [seasoning]; salt for preserving foodstuffs;*

*sausage binding materials; sea water for cooking; seasonings; soya bean paste [condiment]; soya sauce; spring rolls; star aniseed; starch for food; starch products for food; sushi; tabbouleh; tacos; tea- based beverages; thickening agents for cooking foodstuffs; tomato sauce; tortillas; turmeric for food; unroasted coffee; vanilla [flavoring] [flavouring]; vanillin [vanilla substitute]; vegetal preparations for use as coffee substitutes; weeds [condiment]; yeast in pill form, not for medical use.*

The above goods are in class 30 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

2) On 5 March 2009 Tetley GB Limited filed a notice of opposition to the registration of the trade mark. Subsequent to the filing of the opposition, Tetley GB Limited changed its name to Tata Global Beverages GB Limited (Tata). Tata relies upon sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (the Act).

3) Section 5(2)(b) of the Act states:

“(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 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.”

Section 5(3) of the Act 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 Community trade mark or international trade mark (EC) in the European Community) 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.”

Section 5(4)(a) of the Act states:

“(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented——

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade”.

The principles of the law of passing-off were summarised by Lord Oliver in *Reckitt & Colman Products Ltd v. Borden Inc* [1990] RPC 341 at page 406:

“The law of passing off can be summarised in one short, general proposition: no man may pass off his goods as those of another. More specifically, it may be expressed in terms of the elements which the plaintiff in such an action has to prove in order to succeed. These are three in number. First he must establish a goodwill or reputation attached to the goods or services which he supplies in the mind of the purchasing public by association with the identifying 'get-up' (whether it consists simply of a brand name or trade description, or the individual features of labelling or packaging) under which his particular goods or services are offered to the public, such that the get-up is recognised by the public as distinctive specifically of the plaintiff's goods or services. Secondly, he must demonstrate a misrepresentation by the defendant to the public (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by him are the goods or services of the plaintiff. ... Thirdly he must demonstrate that he suffers, or in a *quia timet* action that he is likely to suffer, damage by reason of the erroneous belief engendered by the defendant's misrepresentation that the source of the defendant's goods or services is the same as the source of those offered by the plaintiff.”

4) In relation to the grounds of opposition under sections 5(2)(b) and 5(3) of the Act, Tata relies upon United Kingdom registration no 752364 of the trade mark **TETLEY**. The application for registration of the trade mark was made on 28 March 1956. The registration is subject to proof of genuine use<sup>i</sup> for the period from 6 December 2003 to 5 December 2008. Tata states that during this period the trade mark was used in respect of tea. It states that its trade mark has a reputation in respect of tea.

5) Tata states that its goods are identical to those of the application insofar as they include tea, tea-based beverages, iced tea and infusions. It states that the remainder of the goods of the application are similar to tea “as they include non-alcoholic beverages such as coffee and cocoa which are sold in the same parts of the supermarket as tea, have similar uses and the same users and include other foodstuffs which are aimed at the consumer and are sold in food shops and supermarkets”. Tata states that the trade mark is formed with the first three letters of its trade mark. It states that as consumers pay more attention to the beginning of trade marks, “the marks are clearly similar”. Tata states that its trade mark has acquired a substantial reputation in relation to teas and because of this it enjoys an above average distinctiveness. Consequently, there is a

likelihood of confusion and registration of the trade mark would be contrary to section 5(2)(b) of the Act.

6) Tata states that use of the trade mark by MKS on any goods would take advantage of, and be detrimental to, the reputation in its trade mark because “it is “free-riding” on the investment in this reputation to capture consumers’ attention, and harms the reputation for quality enjoyed by the Opponent’s mark”. Consequently, registration of the trade mark would be contrary to section 5(3) of the Act.

7) Under section 5(4)(a) of the Act Tata relies upon the signs **TETLEY** and:



Tata states that it has used the first sign in the United Kingdom since 1953 in respect of teas and the second sign since the 1980s in respect of teas. Tata states that in relation to the sign TETLEY, use of a “highly similar mark in relation to tea-based beverages would constitute a misrepresentation liable to cause damage to the Opponent”. Tata states that, in relation to the second sign, the trade mark of MKS “uses a serif font which is identical or at least highly similar to the serif font in the Applicant’s mark, and appears in an oblong border which is similar to the oval border in the Applicant’s mark”. Tata states that use by MKS “of a highly similar mark in relation to tea and tea-based beverages would constitute a misrepresentation liable to cause damage to the Opponent, and is therefore liable to be prevented under Section 5(4) of the Act”.

8) MKS filed a counterstatement. MKS denies that any of the respective goods are identical or similar. MKS denies that the trade mark and sign of Tata is similar to its trade mark. It puts Tata to proof of use of its trade mark, of its claim to reputation and its claim to goodwill in relation to the trade mark and sign upon which Tata relies.

9) Both parties filed evidence. They also filed written submissions.

***First evidence of Tata***

10) This consists of a witness statement by Daniel Barlow. Mr Barlow is the company secretary of Tata.

11) Tata and its predecessors in title have been selling tea in the United Kingdom since 1837 when the Tetley brothers first established themselves as tea merchants in Huddersfield. Tata, and associated companies, now sell tea in over

40 countries. The first TETLEY tea bag was launched on the British market in 1953 and tea bags have been sold under the TETLEY brand in the United Kingdom continuously since then. Exhibited at DB1 is a copy of a document entitled *The Story of Tetley*. The document includes details of the introduction of black teas blended with herbs in 2002. In 2002 in the M25 area two varieties of energising ice teas were introduced. In 2003 four speciality and three fruit and herbal teas were introduced into Tesco. In March 2004 six fruit and herbal teas, two green teas and four speciality teas were introduced.

12) TETLEY is the market leader in the United Kingdom with a 29.2% share of the market. TETLEY is the third biggest brand in the black tea market in the United States of America. In Canada TETLEY is the market leading brand of black tea, with a 44.1% share of the market. TETLEY is the second biggest brand of tea in Australia with a 20.8% share of the market (excluding fruit and herbal tea) and the third biggest brand of tea in France, with a 10.5% share of the market. TETLEY is sold in other countries, including Poland, Saudi Arabia, Pakistan, Russia, South Africa and India. TETLEY is the number two tea bag brand in the world. Tata produces over 18 billion tea bags each year and owns the largest tea production facility in the world. In the United Kingdom Tata sells a range of herbal and fruit teas as well as traditional tea. As well as carrying the TETLEY word trade mark, United Kingdom products generally carry the TETLEY roundel (as per paragraph 7). The turnover and advertising expenditure for products bearing the trade marks TETLEY and the TETLEY roundel were as follows:

Year	Turnover millions	Advertising expenditure millions
2005	£187.2	£33.4
2006	£197.8	£37.6
2007	£196.6	£37.7
2008	£205.7	£44.1
2009	£201.2	£37.9

13) TETLEY and TETLEY roundel tea products are sold nationwide. They are sold in all major supermarkets and a large number of grocery stores. Exhibited at DB3 are the results of a brand awareness exercise where members of the public were asked the question “What brands of tea have you seen or heard of?”. The source is the Millward Brown weekly tracking of 50 respondents per week. The results cover (on a four weekly basis) the period from 11 February 2007 to 28 February 2010. The rubric above the results states:

“This is the first question about tea, and is totally unprompted (i.e. respondents type in their answer).”

Over this period the arithmetic mean of responses naming TETLEY was 63.28%, being 50% at the lowest (25 November 2007) and 72% at the highest (24 May 2009). At 20 July 2008 the response was 64%.

14) Exhibited at DB4 are copies of photographs showing packets of TETLEY tea. DB4.1 shows packets from the 1950s to 1986. DB4.2 shows packets used in 1998 and DB4.3 show packets used in 2005. TETLEY appears prominently upon all of the packets; in the case of the last two exhibits, in an oval. All of the packets are for tea bags. Exhibited at DB5.1 are advertisements from 2004 for four of a set of twelve new teas: English breakfast, camomile, Earl Grey and vanilla and green tea with lemon. All are for tea bags. In all of the advertisements TETLEY and the TETLEY roundel appear prominently. Exhibited at DB5.2 are two advertisements from 2005. All are for tea bags. In all of the advertisements TETLEY and the TETLEY roundel appear prominently. The products shown are: decaffeinated tea, camomile tea, green tea with lemon, Earl Grey tea, ordinary tea, organic tea and extra strong tea. Exhibited at DB5.3 are four advertisements from 2006. They are for extra strong tea, decaffeinated tea, four types of green tea and four types of herb tea. All are for tea bags. In all of the advertisements TETLEY and the TETLEY roundel appear prominently. Exhibited at DB5.4 is an advertisement from 2007, in which TETLEY and the TETLEY roundel appear prominently.

15) Exhibited at DB6 is a CD-ROM which contains advertisements that were broadcast nationwide on television from 2004 to 2008. From 2004 there are four "Auntea" advertisements, one featuring David Dickinson and four featuring Kim Cattrall. From 2005 there are six "Auntea" advertisements, for organic, extra strong, decaffeinated, green tea range, redbush vanilla and Summer Berry Merry. From 2007 there is an advertisement for extra strong tea and the "Tetley Chorus" advertisement. From 2008 there is an advertisement for redbush tea. The advertisements show the TETLEY roundel and make oral and sometimes visual reference to TETLEY on its own. Exhibited at DB7 are screenshots from a range of TETLEY television advertisements from the 1960s to 2000. TETLEY and the TETLEY roundel appear in the advertisements.

16) Mr Barlow states:

"I am not aware of any other significant TET-prefixed brand used in the UK in relation to tea."

### ***Evidence of MKS***

17) This consists of a witness statement made by Dmytro Aslanov. Mr Aslanov is an attorney at MKS.

18) Mr Aslanov states that MKS has used its trade mark in relation to a wide range of tea products outside of the United Kingdom. Exhibited at DA1 are photographs of shelves of tea products in retail premises. These include TET products. There is no indication as to when and where the photographs were taken. However, certain of the photographs show Russian script.

19) The rest of the statement of Mr Aslanov consists of a critique of the evidence of Tata rather than evidence of fact. Consequently, it is not appropriate to summarise it here. However, the comments have been kept in mind in the writing of the decision.

***Further evidence of Tata***

20) This consists of a statutory declaration by Mr Barlow.

21) Mr Barlow exhibits at DB-SD1 a change of name certificate from Companies House which shows that Tetley GB Limited changed its name to Tata on 30 July 2010.

22) In response to a comment by Mr Aslanov in his witness statement that no invoices had been exhibited with Mr Barlow's witness statement, exhibited at DB-SD2 are copies of invoices. They are from Tetley GB Limited and cover the period from 22 October 1998 to 23 July 2008. They are for a variety of TETLEY products. The invoices are, inter alia, to J Sainsbury Ltd, Asda PLC, Wm Morrison Supermarkets Plc, Tesco Stores Ltd, Booker Foodservice, Booker Cash & Carry Ltd, Somerfield Stores Ltd, Plymouth & South West Co-op Soc Ltd, Makro S/Service Wholesalers Ltd, Safeway Stores Plc, CWS Purchase Matching Dept, Nisa Today's Ltd, Costco UK Limited, Waitrose Ltd and 3663 First for Foodservice. They are for various TETLEY tea products. (The invoices also include some Quickbrew products.)

23) In response to a comment by Mr Aslanov in his witness statement in relation to a brand awareness survey exhibited at DB3, Mr Barlow states that the survey is continuous and 50 different individuals take part each week. Participants are aged between 16 and 70 are nationally representative of age, gender, region and socio demographic. Participants are recruited by Lightspeed, a sister company to Millward Brown. The survey is conducted online and takes about twenty minutes to complete.

24) In response to a comment by Mr Aslanov in his witness statement re exhibit BD4.1, the picture of TETLEY products is reproduced with annotations showing the periods from when the packaging emanates.

25) In response to a comment by Mr Aslanov in his witness statement, Mr Barlow states that advertisements exhibited at DB5.1 were used as posters in the United Kingdom and appeared mainly outside grocery stores; the advertisements exhibited at DB5.2 and the first advertisement exhibited at DB5.3 featured in the United Kingdom trade press, including *The Grocer*. The subsequent advertisements exhibited at DB5.3 featured in United Kingdom consumer magazines including *Times Magazine*, *Hello*, *Good Housekeeping*, *She*, *Red*, *BBC Good Food* and *Olive*. The advertisement exhibited at DB5.4 featured in United Kingdom national daily newspapers.

26. In response to a comment by Mr Aslanov in his witness statement, Mr Barlow confirms that the television advertisements were broadcast in the United Kingdom on national television. Exhibited at DB-SD4 are details of the television advertising expenditure for TETLEY tea products. This was £4,355,466, £1,076,901, £2,401,122 and £2,332,039 for the years 2005, 2006, 2007 and 2008 respectively. In 2006 there was also an expenditure of £693,663 for cinema advertising for TETLEY ice tea range. The figures were compiled by the independent media audit company, Nielsen Ad Dynamix.

27. In response to a comment by Mr Aslanov in his witness statement, exhibit DB7 is reproduced as DB-SD5 annotated with the years of the screen shots; which are 1960, 1980, 1989, 1995, 1996, 1999 and 2000.

### ***Material dates***

28) In relation to the claim to reputation under section 5(3) of the Act the material date is the date of the application for registration.

29) A similar provision to section 5(4)(a) of the Act is to be found in Article 8(4) of Council Regulation 40/94 of December 20, 1993. This was the subject of consideration by the General Court (GC) in *Last Minute Network Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Joined Cases T-114/07 and T-115/07, in which the GC stated:

“50 First, there was goodwill or reputation attached to the services offered by LMN in the mind of the relevant public by association with their get-up. In an action for passing off, that reputation must be established at the date on which the defendant began to offer his goods or services (*Cadbury Schweppes v Pub Squash* (1981) R.P.C. 429).

51 However, according to Article 8(4) of Regulation No 40/94 the relevant date is not that date, but the date on which the application for a Community trade mark was filed, since it requires that an applicant seeking a declaration of invalidity has acquired rights over its non-registered national mark before the date of filing, in this case 11 March 2000.”

The reasoning of the GC, *mutatis mutandis*, is followed in relation to the Act; so Tata must establish a protectable goodwill as of the date of application.

30) In relation to proof of use Tata must establish genuine use of the trade mark TETLEY for tea during the period 6 December 2003 to 5 December 2008.

### **Findings of fact**

31) Tata has claimed that it has used the trade mark TETLEY for tea and has a reputation in relation to this use, for the purposes of section 5(3) of the Act. In relation to section 5(4)(a) of the Act, Tata has claimed that it has goodwill in relation to the two signs upon which it relies in relation to teas. The claims are extremely limited, there is nothing covetous in them.

32) MKS put Tata to proof of use in relation to TETLEY for tea. In its written submissions it appears to have forgotten that it did so, no mention is made of this. It also refers to the complete specification of Tata's earlier trade mark, despite Tata only relying upon tea in relation to this earlier trade mark. The evidence of Tata primarily shows use for tea bags, however, there is also limited evidence of use of TETLEY in relation to iced tea drinks. It is necessary to decide upon a fair description for the goods for which genuine use has been shown and which fall within the parameters of the specification. The description must not be over pernickety<sup>ii</sup>. It is necessary to consider how the relevant public, which for these goods is the public at large, describe the goods<sup>iii</sup>. The GC in *Reckitt Benckiser (España), SL v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-126/03* held:

“42 The Court observes that the purpose of the requirement that the earlier mark must have been put to genuine use is to limit the likelihood of conflict between two marks by protecting only trade marks which have actually been used, in so far as there is no sound economic reason for them not having been used. That interpretation is borne out by the ninth recital in the preamble to Regulation No 40/94, which expressly refers to that objective (see, to that effect, *Silk Cocoon*, cited at paragraph 27 above, paragraph 38). However, the purpose of Article 43(2) and (3) of Regulation No 40/94 is not to assess commercial success or to review the economic strategy of an undertaking, nor is it to restrict trade-mark protection to the case where large-scale commercial use has been made of the marks (Case T-334/01 *MFE Marienfelde v OHIM – Vétoquinol (HIPOVITON)* [2004] ECR II-0000, paragraph 32, and Case T-203/02 *Sunrider v OHIM – Espadafor Caba (VITAFRUIT)* [2004] ECR II-0000, paragraph 38).

43 Therefore, the objective pursued by the requirement is not so much to determine precisely the extent of the protection afforded to the earlier trade mark by reference to the actual goods or services using the mark at a given time as to ensure more generally that the earlier mark was actually used for the goods or services in respect of which it was registered.

44 With that in mind, it is necessary to interpret the last sentence of Article 43(2) of Regulation No 40/94 and Article 43(3), which applies Article 43(2) to earlier national marks, as seeking to prevent a trade mark which has

been used in relation to part of the goods or services for which it is registered being afforded extensive protection merely because it has been registered for a wide range of goods or services. Thus, when those provisions are applied, it is necessary to take account of the breadth of the categories of goods or services for which the earlier mark was registered, in particular the extent to which the categories concerned are described in general terms for registration purposes, and to do this in the light of the goods or services in respect of which genuine use has, of necessity, actually been established.

45 It follows from the provisions cited above that, if a trade mark has been registered for a category of goods or services which is sufficiently broad for it to be possible to identify within it a number of sub-categories capable of being viewed independently, proof that the mark has been put to genuine use in relation to a part of those goods or services affords protection, in opposition proceedings, only for the sub-category or sub-categories relating to which the goods or services for which the trade mark has actually been used actually belong. However, if a trade mark has been registered for goods or services defined so precisely and narrowly that it is not possible to make any significant sub-divisions within the category concerned, then the proof of genuine use of the mark for the goods or services necessarily covers the entire category for the purposes of the opposition.

46 Although the principle of partial use operates to ensure that trade marks which have not been used for a given category of goods are not rendered unavailable, it must not, however, result in the proprietor of the earlier trade mark being stripped of all protection for goods which, although not strictly identical to those in respect of which he has succeeded in proving genuine use, are not in essence different from them and belong to a single group which cannot be divided other than in an arbitrary manner. The Court observes in that regard that in practice it is impossible for the proprietor of a trade mark to prove that the mark has been used for all conceivable variations of the goods concerned by the registration. Consequently, the concept of 'part of the goods or services' cannot be taken to mean all the commercial variations of similar goods or services but merely goods or services which are sufficiently distinct to constitute coherent categories or sub-categories.

53 First, although the last sentence of Article 43(2) of Regulation No 40/94 is indeed intended to prevent artificial conflicts between an earlier trade mark and a mark for which registration is sought, it must also be observed that the pursuit of that legitimate objective must not result in an unjustified limitation on the scope of the protection conferred by the earlier trade mark where the goods or services to which the registration relates represent, as in this instance, a sufficiently restricted category."

In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited* BL O/345/10 Mr Geoffrey Hobbs QC, sitting as the appointed person, stated:

“However, that does not appear to me to alter the basic nature of the required approach. As to that, I adhere to the view that I have expressed in a number of previous decisions. 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.”

The average consumer would categorise the use of the trade mark of Tata as being for tea; this is the extent of use that Tata claims. The specification tea includes fruit and herbal teas and the like.

33) MKS has continued to deny that Tata has established that it has a reputation for the purposes of section 5(3) and a goodwill for the purposes of section 5(4)(a). It is a notorious fact that TETLEY is a famous trade mark for tea. MKS not only refused to accept this but also put Tata to proof of use of the trade mark in relation to tea. Having put Tata to the trouble of filing evidence to establish what would have been known to MKS, it then criticised the evidence. Evidence that clearly proved what would have been obvious to MKS. So Tata filed a statutory declaration to answer the criticisms of MKS. Still, however, MKS denies that the reputation and goodwill have been established; whilst making no comment as to the proof of use. MKS states, inter alia, “the goodwill the Opponent claims attaches to its TETLEY marks is simply not borne out by the evidence”. So the market share, the enormous turnover, the television advertising, the enormous advertising budget, the length of use, according to MKS, does not even establish a goodwill in relation to teas. It is to be wondered what MKS would consider necessary to establish the requisite goodwill.

34) There is no doubt that TETLEY has been used in relation to tea in the material period for proof of use. There is no doubt that TETLEY was known for tea by a significant part of the public concerned by the products covered<sup>IV</sup> at the date of application. There is no doubt that at the date of application Tata enjoyed an enormous goodwill in relation to tea and that this goodwill was related to the signs upon which it relies in this opposition.

35) A party has a right to put another party to proof of its claims. However, when it will have clearly known that those claims were fully justified, it must expect that its behaviour may be considered unreasonable and will be dealt with as such in relation to costs. MKS could not have not known that TETLEY had been used for tea in the material period. MKS could not have not known that TETLEY had an enormous reputation for tea. MKS could not have not known that Tata had a

goodwill in relation to teas and that this goodwill was related to the signs upon which it relies in this opposition. MKS could not have not known that in relation to tea TETLEY is a famous trade mark in the United Kingdom; a fact underlined by the evidence which has been filed by Tata.

***Average consumer, nature of purchasing decision and standard for likelihood of confusion***

36) The average consumer “is deemed to be reasonably well informed and reasonably circumspect and observant”<sup>vi</sup>. The average consumer of teas is the public at large. The average consumer of the goods of the application will also for the most part be the public at large. The purchasing process will not, normally be particularly careful and researched. Consequently, the effects of imperfect recollection are increased. The goods will normally be purchased from the supermarket shelf; so visual similarity is of greater importance than aural similarity. However, the following goods would appear to be for the food industry rather than the public at large: *bee glue [propolis] for human consumption, binding agents for ice cream, ferments for pastes, glucose for food; gluten for food; preparations for stiffening whipped cream; sausage binding materials, thickening agents for cooking foodstuffs and yeast in pill form*. These goods are likely to be purchased by professionals who will make careful and educated decisions in buying the goods; consequently, the effects of imperfect recollection are decreased.

***Section 5(2)(b) of the Act – likelihood of confusion***

***Comparison of trade marks***

37) The trade marks to be compared are:

**TETLEY** and



The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details<sup>vi</sup>. 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<sup>vii</sup>. Consequently, there cannot be an artificial dissection of the trade

marks, although it is necessary to take into account any distinctive and dominant components. The average consumer rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he/she has kept in his/her mind and he/she is deemed to be reasonably well informed and reasonably circumspect and observant<sup>viii</sup>. The assessment of the similarity of the trade marks must be made by reference to the perception of the relevant public<sup>ix</sup>.

38) The font in which the letters TET are presented is not particularly striking. The letters are presented in an oval, which is unlikely to have a major effect upon the perception of the average consumer for the goods of the application. For the average consumer the letters TET will form an invented word; it is not considered, and there is no evidence to the matter, that the average consumer would identify TET with the Tet Offensive in the Vietnam War. Consequently, the distinctive and dominant component of the trade mark of MKS is the invented, for the average consumer, word TET. Tata's trade mark does not lend itself to division, its distinctiveness lies in the trade mark in its entirety. In *Les Editions Albert René v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Case T-336/03 the GC stated:

“75 It should be noted in this regard that the attention of the consumer is usually directed to the beginning of the word (Joined Cases T-183/02 and T-184/02 *El Corte Inglés v OHIM – González Cabello and Iberia Líneas Aéreas de España*(MUNDICOR) [2004] ECR II-0000, paragraph 83).”

There is no reason that TETLEY breaks this rule of thumb. So in terms of the comparison of the trade marks the beginning of TETLEY may be of more importance than the end.

39) The history of the TETLEY brand shows that TETLEY is a surname. However, there is nothing to suggest that the average consumer will be aware of this. There is no indication that TETLEY is known as a surname or will be perceived as such by the average relevant consumer; in the absence of any indication, such as being preceded by a forename. Consequently, TETLEY and TET will both be perceived as invented words and so the position, in relation to conceptual similarity, is neutral.

40) TETLEY consists of two syllables; the emphasis will fall upon the first syllable but the second syllable will still be clearly and definitely pronounced and heard. The word element of the trade mark of MKS consists of a single syllable, this will be pronounced in the same fashion as the first syllable of TETLEY. There is a similarity in the coincidence of the first syllable, however, there is a dissimilarity arising from the alien second syllable of Tata's trade mark. A second syllable that significantly changes the sound and the perception of the hearer, this difference means that the respective trade marks cannot be considered similar, even if they have a similarity.

41) The non-verbal elements of the trade mark of MKS are such that they will have little effect upon the perception of the average, relevant consumer. The stylisation of the letters is unlikely to have any great impact on the average, relevant consumer. Primarily, the trade mark of MKS will be remembered as a TET trade mark. The trade marks coincide in the presence of the letters TET, however, the trade mark of Tata is twice as long and the final three letters can be clearly seen. In *Inter-Ikea Systems BV v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-112/06* the GC held:

“54 As regards the visual comparison between the verbal element of the contested mark and the earlier word marks, the applicant claims that the only difference between them is the presence of the letter ‘d’ in the contested mark and the letter ‘k’ in the earlier word marks. However, the Court has already held in Case T-185/02 *Ruiz-Picasso and Others v OHIM – DaimlerChrysler(PICARO)* [2004] ECR II-1739, paragraph 54) that, in the case of word marks which are relatively short, even if two marks differ by no more than a single consonant, it cannot be found that there is a high degree of visual similarity between them.”

In this case three of the six letters are different, there is a great deal of visual difference between them. Considering the trade marks in their entireties, and taking into account the dominant and distinctive components, it is considered that they are not visually similar.

42) The presence of TET in TETLEY gives rise to a similarity. However, having a similarity does not make trade marks similar. **In this case the differences between the respective trade marks are such that they cannot be considered overall to be similar.** TETLEY has a reputation for tea but this cannot affect the issue of similarity of the trade marks, as the GC stated in *Ravensburger AG v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-243/08*:

“27 It is appropriate at the outset to reject that complaint as unfounded. The reputation of an earlier mark or its particular distinctive character must be taken into consideration for the purposes of assessing the likelihood of confusion, and not for the purposes of assessing the similarity of the marks in question, which is an assessment made prior to that of the likelihood of confusion (see, to that effect, judgment of 27 November 2007 in Case T-434/05 *Gateway v OHIM – Fujitsu Siemens Computers (ACTIVY Media Gateway)*, not published in the ECR, paragraphs 50 and 51).”

A finding that can also be found in *Accenture Global Services GmbH v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-244/09*, *Lan Airlines, SA v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-194/09* and *Ferrero SpA v Office for*

*Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-140/08.*

### **Comparison of goods**

43) In “construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of trade<sup>xv</sup>. Words should be given their natural meaning within the context in which they are used, they cannot be given an unnaturally narrow meaning<sup>xi</sup>. Consideration should be given as to how the average consumer would view the goods<sup>xii</sup>. The class of the goods in which they are placed may be relevant in determining the nature of the goods<sup>xiii</sup>. In assessing the similarity of goods it is necessary to take into account, inter alia, their nature, their intended purpose, their method of use and whether they are in competition with each other or are complementary<sup>xiv</sup>. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T- 325/06* the General Court (GC) explained when goods were complementary:

“82 It is true that goods are complementary if 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 (see, to that effect, *Case T-169/03 Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI)* [2005] ECR II-685, paragraph 60, upheld on appeal in *Case C-214/05 P Rossi v OHIM* [2006] ECR I-7057; *Case T-364/05 Saint-Gobain Pam v OHIM – Propamsa (PAM PLUVIAL)* [2007] ECR II-757, paragraph 94; and *Case T-443/05 El Corte Inglés v OHIM – Bolaños Sabri (PiraÑAM diseño original Juan Bolaños)* [2007] ECR I-0000, paragraph 48).”

In *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281, Jacob J also gave guidance as to how similarity should be assessed<sup>xv</sup>.

44) *Tea* is included in both specifications and so must be identical. *Tea* will include *tea-based beverages* and *iced tea* and so these goods are identical. Goods can be considered as identical when the goods and services designated by the earlier trade mark are included in a more general category, designated by the trade mark application<sup>xvi</sup>. *Infusions, not medicinal* will include *tea* and so be considered to be identical.

45) In its written submissions Tata provide a little more reasoning as to why it considers the other goods of the application are similar to tea. It states:

“The Applicant’s specification includes a number of other hot beverages, namely ‘coffee’, ‘cocoa’, ‘artificial coffee’, chicory [coffee substitute], ‘chocolate beverages with milk’, ‘chocolate based beverages’, ‘cocoa beverages with milk’, ‘cocoa-based beverages’, ‘coffee beverages with

milk', 'coffee based beverages', 'vegetal preparations for use as coffee substitutes', all of which are of the same nature as tea (i.e. hot drinks), are in competition with tea (as they are alternatives), and are bought by the same users. In addition, these goods are all found in the same supermarket aisle as tea. 'Sugar' and 'honey' for which coverage is also sought by the Applicant, are clearly complementary to tea as many consumers take their tea with milk and sugar or honey and lemon. The additional foodstuffs for which coverage is also sought by the Applicant, are also similar to tea. All of these goods are common household food items that are sold in supermarkets and grocery stores, as is tea, and are bought by the same customers i.e. the public at large".

46) The claims to the similarity of the "additional foodstuffs" are vague to the extreme. As referred to in paragraph 36, certain of the goods are unlikely to be purchased by the public at large: *bee glue [propolis] for human consumption, binding agents for ice cream, ferments for pastes, glucose for food; gluten for food; preparations for stiffening whipped cream; sausage binding materials, thickening agents for cooking foodstuffs and yeast in pill form*. There is nothing to suggest that these products will be ordinarily found in any supermarket. The argument that the consumers of the "additional foodstuffs" are the same, as they are all public at large, lacks rigour. The public at large also purchases computers and mobile telephones; this for the purposes of similarity of goods does not make them the same public as the purchaser of tea. The "additional foodstuffs" are, with the exception of *unroasted coffee*, primarily ingredients or condiments or basic foodstuffs, such as pasta. They are not bought for drinking and so have a different purpose to tea. The purpose defines the nature of the user, a user who for the purposes of the similarity of the goods, is different to the user of tea; who wishes to imbibe a beverage. They do not have the same nature as tea. They will, if found in a supermarket, be found in different areas of such an establishment. They have no symbiotic or dependent relationship with tea; they are not complementary. They are not fungible with tea, they are not in competition. It is not likely that the respective goods will reach the retailer through the same channels of trade. **Putting *unroasted coffee* to one side, the "additional foodstuffs" are not similar to tea.**

47) *Unroasted coffee* must be included in what Tata categorises as "other hot beverages". All of these goods are for drinking, they have the same purpose. They will normally be drunk hot. Although not on the same shelves in supermarkets as tea, they are normally in the same aisle and in proximity to tea. They are often substituted for one another; consequently, they are in competition. All of these goods will be bought by someone who wants some form of infusion and so the end user is the same. There is a good deal of similarity between "the other hot beverages" and *unroasted coffee* and tea.

48) Tata claims that *sugar* and *honey* are similar to tea as they may be added to tea. There is no mutually dependent or symbiotic relationship between sugar and

honey and tea. The respective goods are not 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. They are not complementary to *tea*. Neither *sugar* nor *honey* are beverages. They are both sweeteners, although honey can also be used to give flavour or as a spread. Their natures are different to tea. They will normally be found in their own discrete areas in supermarkets. *Honey* is likely to be found in proximity to the preserves in the aisle of a supermarket. They will normally reach retail establishments by a different means of distribution to tea. It is not considered that *sugar* and *honey* are similar to tea.

### **Conclusion**

49) In considering whether there is a likelihood of confusion various factors have to be taken into account. There is the interdependency principle – a lesser degree of similarity between trade marks may be offset by a greater degree of similarity between goods, and vice versa<sup>xvii</sup>. In this case certain of the goods are identical. However, for the interdependency principle to come into play the respective trade marks must be similar. As it has been decided that they are not, the grounds of opposition under section 5(2)(b) of the Act must fail. The identity of certain of the goods, the enhanced distinctiveness of the earlier trade mark; these cannot get over the barrier of an absence of similarity. Quite simply, the average, relevant consumer, although relying on his or her imperfect recollection, and taking into account TETLEY's reputation for tea, is still not going to be confused owing to the differences between the trade marks. Tata in its submissions argues that TET will be seen as an abbreviation for TETLEY. There is no evidence as to this and no reason as to why this should be the case. In *New Look Ltd v Office for the Harmonization in the Internal Market (Trade Marks and Designs)* GC stated:

“49 However, it should be noted that in the global assessment of the likelihood of confusion, the visual, aural or conceptual aspects of the opposing signs do not always have the same weight. It is appropriate to examine the objective conditions under which the marks may be present on the market (*BUDMEN*, paragraph 57). The extent of the similarity or difference between the signs may depend, in particular, on the inherent qualities of the signs or the conditions under which the goods or services covered by the opposing signs are marketed. If the goods covered by the mark in question are usually sold in self-service stores where consumer choose the product themselves and must therefore rely primarily on the image of the trade mark applied to the product, the visual similarity between the signs will as a general rule be more important. If on the other hand the product covered is primarily sold orally, greater weight will usually be attributed to any aural similarity between the signs.”

This is a case where visual similarity, owing to the nature of the goods, is more important than aural similarity. The visual distance between the trade marks is marked. **There is not a likelihood of confusion.**

***Sections 5(3) and 5(4)(a) of the Act***

50) To be successful under section 5(3) of the Act the respective trade marks have to be similar. As it has been decided that they are not, the opposition fails under this ground. It is not considered that the trade mark of MKS will even bring to mind the TETLEY trade mark.

51) The absence of similarity of the trade marks under consideration means that there will be no misrepresentation and so the grounds of opposition under section 5(4)(a) of the Act fail. Tata also relies upon the trade mark in an oblong border. Despite the claims of Tata, it is not considered that the trade mark of MKS is in a similar font. The oblong border trade mark is no more similar to the trade mark of MKS than the word only trade mark.

***Costs***

52) In normal circumstances MKS as the successful party would receive a contribution towards its costs. However, as indicated above, its challenging of the use, reputation and goodwill of Tata in the trade marks upon which it relies, was clearly untenable and it is not possible to believe that MKS did not realise that it was untenable. It put Tata to needless expense, not once, but twice. The behaviour of MKS was unreasonable. Consequently, it is considered appropriate to make an award of costs in respect of the evidence filed by Tata. The witness statement filed by MKS, where it could be judged as evidence, was not relevant to the proceedings in the United Kingdom.

**53) MKS Limited is to pay Tata Global Beverages GB Limited the sum of £1,500. This sum is 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 19 day of May 2011**

**David Landau  
For the Registrar  
the Comptroller-General**

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<sup>i</sup> Section 6A of the Act reads:

“(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 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).”

Under Section 100 of the Act the onus is upon the proprietor of the earlier trade mark(s) to show genuine use:

“If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

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ii *Animal Trade Mark* [2004] FSR 19:

“20 The reason for bringing the public perception in this way is because it is the public which uses and relies upon trade marks. I do not think there is anything technical about this: the consumer is not expected to think in a pernicky way because the average consumer does not do so. In coming to a fair description the notional average consumer must, I think, be taken to know the purpose of the description. Otherwise they might choose something too narrow or too wide. Thus, for instance, if there has only been use for three-holed razor blades imported from Venezuela (Mr T.A. Blanco White's brilliant and memorable example of a narrow specification) "three-holed razor blades imported from Venezuela" is an accurate description of the goods. But it is not one which an average consumer would pick for trade mark purposes. He would surely say "razor blades" or just "razors". Thus the "fair description" is one which would be given in the context of trade mark protection. So one must assume that the average consumer is told that the mark will get absolute protection ("the umbra") for use of the identical mark for any goods coming within his description and protection depending on confusability for a similar mark or the same mark on similar goods ("the penumbra"). A lot depends on the nature of the goods--are they specialist or of a more general, everyday nature? Has there been use for just one specific item or for a range of goods? Are the goods on the High Street? And so on. The whole exercise consists in the end of forming a value judgment as to the appropriate specification having regard to the use which has been made.”

iii *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32:

“29 I have no doubt that Pumfrey J. was correct to reject the approach advocated in the Premier Brands case. His reasoning in paras [22] and [24] of his judgment is correct. Because of s.10(2), fairness to the proprietor does not require a wide specification of goods or services nor the incentive to apply for a general description of goods and services. As Mr Bloch pointed out, to continue to allow a wide specification can impinge unfairly upon the rights of the public. Take, for instance, a registration for "motor vehicles" only used by the proprietor for motor cars. The registration would provide a right against a user of the trade mark for motor bikes under s.10(1). That might be understandable having regard to the similarity of goods. However, the vice of allowing such a wide specification becomes apparent when it is envisaged that the proprietor seeks to enforce his trade mark against use in relation to pedal cycles. His chances of success under s.10(2) would be considerably increased if the specification of goods included both motor cars and motor bicycles. That would be unfair when the only use was in relation to motor cars. In my view the court is required in the words of Jacob J. to "dig deeper". But the crucial question is--how deep?

30 Pumfrey J. was, I believe, correct that the starting point must be for the court to find as a fact what use has been made of the trade mark. The next task is to decide how the goods or services should be described. For example, if the trade mark has only been used in relation to a specific variety of apples, say Cox's Orange Pippins, should the registration be for fruit, apples, eating apples, or Cox's Orange Pippins?

31 Pumfrey J. in *Decon* suggested that the court's task was to arrive at a fair specification of goods having regard to the use made. I agree, but the court still has the difficult task of deciding what is fair. In my view that task should be carried out so as to limit the specification so that it reflects the circumstances of the particular trade and the way that the public would perceive the use. The court, when deciding whether there is confusion under s.10(2), adopts the attitude of the average reasonably informed consumer of the products. If the test of infringement is to be applied by the court having adopted the attitude of such a person, then I believe it appropriate that the court should do the same when deciding what is the fair way to describe the use that a proprietor has made of his mark. Thus, the court should inform itself of the nature of trade and then decide how the notional consumer would describe such use.”

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<sup>iv</sup> *General Motors Corporation v Yplon SA* Case C-375/97.

<sup>v</sup> *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* Case C-342/97.

<sup>vi</sup> *Sabel BV v Puma AG* Case C-251/95.

<sup>vii</sup> *Sabel BV v Puma AG* Case C-251/95.

<sup>viii</sup> *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV* Case C-342/97.

<sup>ix</sup> *Succession Picasso v OHIM - DaimlerChrysler (PICARO)* Case T-185/02.

<sup>x</sup> *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281.

<sup>xi</sup> *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267.

<sup>xii</sup> *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32 dealt with a non-use issue but are still pertinent to the consideration of the meaning and effect of specifications:

“In my view that task should be carried out so as to limit the specification so that it reflects the circumstances of the particular trade and the way that the public would perceive the use. The court, when deciding whether there is confusion under section 10(2), adopts the attitude of the average reasonably informed consumer of the products. If the test of infringement is to be applied by the court having adopted the attitude of such a person, then I believe it appropriate that the court should do the same when deciding what is the fair way to describe the use that a proprietor has made of his mark. Thus, the court should inform itself of the nature of trade and then decide how the notional consumer would describe such use”

<sup>xiii</sup> *Altecnic Ltd's Trade Mark Application* [2002] RPC 34.

<sup>xiv</sup> *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* Case C-39/97.

<sup>xv</sup> He considered that the following should be taken into account when assessing the similarity of goods and/or services:

(a) The respective uses of the respective goods or services;  
(b) The respective users of the respective goods or services;  
(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;  
(f) 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.”

<sup>xvi</sup> See *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-133/05 paragraph 29:

“In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301,

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paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 *Oberhauser v OHIM – Petit Liberto (Fitties)* [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 *Vedial v OHIM – France Distribution (HUBERT)* [2002] ECR II-5275, paragraphs 43 and 44; and Case T-10/03 *Koubi v OHIM – Flabesa (CONFORFLEX)* [2004] ECR II-719, paragraphs 41 and 42).”

<sup>xvii</sup> *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* Case C-39/97.