

O-238-06

TRADE MARKS ACT 1994

**IN THE MATTER OF AN APPLICATION FOR THE REGISTRATION OF A
TRADE MARK UNDER NO. 2341128 BY C.P. RETAILING AND
MARKETING CO. LTD**

AND

**IN THE MATTER OF AN OPPOSITION THERETO UNDER NO. 92214 BY
B.E.INTERNATIONAL FOODS LTD**

**IN THE MATTER OF an application
for the registration of a trade mark
under No. 2341128 by C.P. Retailing and
Marketing Co Ltd and in the matter of
opposition thereto under No. 92214 by
B.E. International Foods Ltd**

Background

1. On 19 August 2003, Hallmark IP Ltd, on behalf of C. P. Retailing and Marketing Co Ltd (“the applicant”) applied, under application No. 2341128 to register the following trade mark:



in respect of the following specification of goods:

Class 29

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

Class 30

All kinds of dim sum and snack foods.

2. On 24 December 2003, B.E. International Foods Ltd (“the opponent”) filed notice of opposition. Now represented by A.A Thornton & Co, the opponent requests refusal of the application for registration. The grounds of opposition are, in summary:

- Under section 5(2)(b) based on the opponent’s earlier community trade mark No. 62737
- Under section 5(4)(a) based on the law of passing off. The opponent says it has used its earlier trade mark since at least as early as 1996.

3. The applicant filed a counter-statement essentially denying the opponent’s claims. Both parties filed evidence and both request an award of costs.

4. A hearing was arranged however both parties later indicated they wished a decision to be taken from the papers. Both parties filed written submissions. After a careful consideration of all the papers, I give this decision.

Opponent's evidence

5. This consists of two witness statements. The first is by Aubrey de Souza and is dated 13 April 2005.

6. Mr de Souza is the Company Secretary of the opponent company, a position he says he has held since December 2001. Mr de Souza states that the facts in his witness statement come either from his own knowledge or from the records of his company. I do not intend to summarise Mr de Souza's evidence insofar as it is a record of his opinion though I do take it into account.

7. Mr de Souza gives details of the earlier mark relied on by the opponent. He explains that the mark was acquired from another company in 1994 and has been used continuously by his company since that date. At ADS1 he exhibits copies of printouts from the UK Trade Marks Register showing other, now lapsed, registrations which, along with the goodwill, were also acquired at that time. He goes on to say that his company's trade mark appears on products in green. He exhibits at ADS2 a printout of a webpage said to have been downloaded from the applicant's website which shows the mark in suit to be in green.

8. Mr de Souza claims the earlier mark has acquired a significant reputation because of the use made of it. He says that use has been "in respect of goods in connection with which registered protection has been granted". I am not entirely sure what he means by this but he goes on to say that since his company began using the trade mark it has been used consistently in relation to varieties of flour, starch and rice and prawn crackers. At ADS3 he exhibits photocopies of examples of his company's goods said to show the trade mark. He says the packaging shown is typical of that used since 1994. The copies show self raising, plain and corn flour as well as potato starch.

9. Mr de Souza gives details of sales made by his company under the trade mark as follows:

Year	Approx. turnover (£)
1997	3m
1998	3.5m
1999	3.5m
2000	3.9m
2001	4m
2002	4.5m

10. A figure is also provided for 2003 but I cannot be certain how much of it relates to a period before the relevant date. Figures given for 2004 and 2005 are all after the relevant date.

11. Mr de Souza says his company's goods bearing the trade mark are supplied and sold throughout the UK. At ADS4 he exhibits what he says is a list of his company's

direct customers and stockists. The list is said to have been compiled from current records but built up over a considerable period of time. Mr de Souza says a substantial number of the customers appearing on the list are what he calls specialist ethnic supermarkets. Whilst the list is headed “Green Dragon customers” no customers are in fact listed- the exhibit has been redacted to such an extent that it merely shows a list of place names or localities (several duplicated) throughout the UK and Channel Islands along with a list of numbers. There is no explanation given of what the numbers mean, although the relevant column is headed “Net cases April 02 to April 05”, a period extending to well after the relevant date.

12. The second witness statement is that of David Edward Powell and is dated 5 April 2005. Again, much of Mr Powell’s statement is commentary and opinion which I do not intend to summarise although I do take it into account as appropriate.

13. Mr Powell is a trade mark attorney employed by the firm originally acting for the opponent in these proceedings. He comments that the trade mark in suit includes the words JADE DRAGON. At DEP1 he exhibits an extract from Collins English Dictionary (2001, ed.). The extract shows the word Jade to have a number of alternate meanings:

1. a semiprecious stone consisting of either jadeite or nephrite. It varies in colour from white to green and is used for making ornaments and jewellery
2. the green colour of jade
3. an old overworked horse, nag, hack
4. a woman considered to be ill-tempered or disreputable
5. to exhaust or make exhausted from work or use.

14. At DEP2 Mr Powell exhibits a printout said to have been taken from the applicant’s internet website. He comments on the use of the colour green within the mark as it appears on the printout. At DEP3 he exhibits a copy of the case details of the opponent’s earlier mark as taken from the OAMI website. It shows the mark to be registered in the colour green.

Applicant’s evidence

15. This consists of a witness statement dated 13 July 2005 by Jennifer Hitchcock, an employee of Hallmark IP Ltd, the applicant’s trade mark attorney. Again much of Ms Hitchcock’s statement is either opinion or commentary and I do not intend to summarise it in full but do take it into account as appropriate.

16. Ms Hitchcock comments on the differences between the respective marks. She refers to a number of trade marks on the UK and OAMI registers which consist of or contain a device of a dragon or the words DRAGON or GREEN and at JH1-3 exhibits a selection of these marks. She indicates that some of the marks show other “dragon” marks are combined with colours such as blue or gold and that consumers would therefore be used to seeing such words and devices and be able to distinguish them on the basis of even small differences. I take all of this to be “state of the register” evidence- whilst it might tell me what is on the various registers it does not tell me whether the trade marks are in use in the relevant market.

17. In respect of the evidence filed by the opponent Ms Hitchcock disputes the opponent's claim to have shown a substantial reputation in its earlier mark. She contends there to be no need to keep the names of customers confidential.

18. Ms Hitchcock says that the client's products bearing the mark are served to customers on Thai Airways international flights. She goes on to say the applicant is not aware of any instances of actual confusion between the respective marks but gives no indication that the applicant has used its mark in the UK or even on flights to/from the UK.

Opponent's evidence in reply

19. This consists of two further witness statements by Messrs de Souza and Powell.

20. Mr de Souza's second witness statement is dated 13 October 2005. He says that the device of a dragon within each mark merely reinforces the words appearing in the mark. He says he is unaware of any products ever having been ordered or asked for in the food industry by reference to a device rather than a name or word.

21. He goes on to reiterate that his company sells goods bearing the GREEN DRAGON trade mark to customers throughout the UK and through long use it has built up a substantial goodwill. Again, he says that many of its customers are ethnic supermarkets and goes on to say that this is a niche market which makes it inappropriate to use mainstream advertising via national television and press. He doesn't say why this should be, nor does he give any explanation of who the remainder of his company's customers might be. He says that both the applicant and opponent have the same trade sector. He explains that no invoices of sales made or details of his company's customers have been filed because this is considered to be commercially sensitive information.

22. Mr Powell's second witness statement is dated 2 October 2005. He exhibits at DEP5 what he says are the results of a survey carried out by his firm and which is intended to show what, if anything, the word JADE signifies to people. There are any number of flaws with this survey. Other than saying the survey was carried out by employees of his company in a Bristol street, there is no explanation given of, for example, how the survey was put together or carried out, how the respondents were chosen or how many people were approached for interview. I also note that the response sheets have been completed in type which makes it highly unlikely that those submitted were those actually prepared in the street.

23. Mr Powell goes on to comment on Ms Hitchcock's evidence of the UK and OAMI registers and exhibits at DEP6-9 results of searches he himself made. I make the same criticism of these as I do of those submitted by Ms Hitchcock.

24. In reply to Ms Hitchcock's claim that the applicant is unaware of any instances of confusion between the respective marks, Mr Powell claims that the applicant has not used its mark in the UK. He goes on to explain that the opponent instructed Cerberus Investigation Ltd to carry out an investigation into the applicant's use of its mark. He says the investigation concluded that no use had been made of it in the UK by the

applicant. The investigator's report is exhibited at DEP10. The report consists of a brief letter dated 4 July 2005.

25. That concludes my summary of the evidence.

Decision

26. The opposition is based on grounds under sections 5(2)(b) and 5(4)(a). Section 5(2) of the Act reads:

- “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.”

27. The term “earlier trade mark” is defined in section 6 of the Act as follows:

- “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,”

28. There is no dispute that the opponent's mark is an earlier trade mark within the definition of Section 6 of the Act.

29. In determining the question under Section 5(2), I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel v Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] R.P.C. 117, *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*, paragraph 22;
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question: *Sabel BV v Puma AG*, paragraph 23, 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 he has kept in his mind; *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen B. V.* paragraph 27;

- (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*, paragraph 23;
- (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*, paragraph 23;
- (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 v Metro-Goldwyn-Mayer Inc*, paragraph 17;
- (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*, paragraph 24;
- (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*, paragraph 26;
- (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*, paragraph 41;
- (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*, paragraph 29.

30. In essence the test under Section 5(2) is whether there are similarities in marks and goods which would combine to create a likelihood of confusion. 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 and taking into account the degree of similarity in the goods, the category of goods in question and how they are marketed.

31. For ease of reference I set out below the respective trade marks:

Applicant's trade mark	Opponent's trade mark
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<p>Class 29: Meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs, milk and milk products; edible oils and fats.</p> <p>Class 30: All kinds of dim sum and snack foods</p>	<p>Class 29: Meat, fish, poultry and game; and foods produced therefrom; soups; meat preserves; preserved, dried, cooked and canned fruits and vegetables; jellies; jams; pickles; preserves; edible oils and fats; fruit sauces.</p> <p>Class 30: Rice; tapioca; sago; flour, and preparations made from cereals; bread, pastry and confectionery; poppadums; egg and rice noodles; vinegar; sauces; spices; curry powder; salt; mustard; pepper; fortune cookies; chutney; salad dressings.</p>

32. It is clear that both specifications of goods in class 29 include identical goods. In respect of the class 30 specifications, the applicant's specification includes goods which are at least similar to those covered by the opponent's earlier mark.

33. The evidence of use filed by the opponent has a number of deficiencies. Whilst approximate turnover figures are given, they are not said to relate to all goods covered by the specifications of goods as registered. In any event, no indication is given of how big a market share these figures might represent. There is no supporting evidence in the form of invoices etc to show to whom and when any goods may have been supplied. There is no evidence of any promotional or advertising activities having ever been carried out. On the basis of the evidence filed, I cannot say that the earlier trade mark has a reputation because of the use made of it. That said, it seems to me that the mark is of a relatively high inherent distinctive character.

34. The applicant's mark consists of two concentric circles, the outer one being thicker and darker than the inner one. Within the inner circle is a line drawing said to be a device of a dragon. Above the device, within the outer circle, are seven characters which have the appearance of those of an oriental language. Under the device, again within the outer circle, are the words JADE DRAGON in slightly stylised font, with the first letters of each word in upper case and the remainder in lower case. The opponent's mark consists of what is again said to be a dragon. Below this device the word GREEN appears above the word DRAGON all in upper case.

Though of roughly equal width, the words are approximately one quarter of the height of the device.

35. Both marks contain a device of a dragon and they also have the word DRAGON in common. The applicant's dragon device is presented in what could be described as "dragon rampant" style and, whilst it is somewhat "curlicued", it is a relatively simple line drawing. The opponent's dragon is presented face-on and is highly detailed with clear scaling, claws and other bodily features. The applicant's mark contains non-English characters which do not appear in the opponent's mark. The applicant's mark has the word Jade, the opponent's Green. The applicant's mark is essentially circular, the opponent's oblong. Whilst there are some visual similarities between the respective marks, there are also strong visual differences.

36. Aurally similar considerations apply. It has long been held that in relation to aural comparisons, words speak louder than devices. It seems to me that whilst the words appearing in the marks emphasise the devices of dragons, the significance of any other elements is reduced. The marks are likely to be referred to, as they were in the evidence filed in these proceedings, as "jade dragon" and "green dragon". Whilst the words "jade" and "green" are aurally distinct, the word "dragon" is identical in each of the marks.

37. Conceptually, whilst the devices of dragons are not identical, the inclusion in both marks of the word dragon reinforces the respective device and indicates to me that unless subjected to cryptozoological analysis, highly unlikely in the marketplace, both devices will simply be referred to as dragons. As for the words jade and green, jade clearly has a number of alternate meanings. But one of those meanings is the green colour associated with a semiprecious stone. I consider there to be a high degree of conceptual similarity particularly if the marks are presented in green.

38. Given that the respective goods are foodstuffs, they are likely to be bought with some care though not necessarily the highest degree of care. They are everyday items and the evidence does not show the average consumer to be anyone other than the ordinary member of the general public. Certainly the respective specifications are not limited in any way. Taking all matters into account, particularly the fact that the average consumer rarely has the opportunity to compare marks together but has to rely on the imperfect picture he has of them, I consider that there is a likelihood of confusion. The opposition under section 5(2)(b) succeeds.

39. In view of my decision in relation to the ground of opposition under section 5(2)(b), I do not intend to go on to consider the objection under section 5(4)(a).

Costs

40. The opposition having succeeded the opponent is entitled to an award of costs. Much of what was filed as evidence was, in fact opinion and commentary or was material which could be accorded little weight. The decision has been reached without a hearing taking place. In all the circumstances I order the applicant to pay the opponent the sum of £1100 as a contribution towards its costs. 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 18th day of August 2006

**Ann Corbett
For the Registrar
The Comptroller-General**