O/291/12

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO 2587744
IN THE NAME OF IRISH POTATO MARKETING LIMITED

AND

OPPOSITION THERETO UNDER NO 102506 BY STAR FRUITS

Background

1. Application No 2587744 seeks registration of the trade mark PINK KISS. It has an application date of 13 July 2011 and stands in the name of Irish Potato Marketing Limited ("Irish"). Following an amendment, which had the effect of reducing the coverage of goods (and services) from that originally filed, registration is sought in respect of *Potatoes.*

2. Following publication of the application in the *Trade Marks Journal* on 12 August 2011, notice of opposition was filed against it by Star Fruits ("Star"). The opposition is brought on grounds under section 5(2)(a) of the Act. Star relies on the following trade marks:

No	Mark	Application/ registration date	Specification of goods relied upon
CTM 677583	PINK KISS	10.11.1997/ 6.3.2000	Fruit, fruit trees; apples; apple trees and cuttings thereof
CTM 5475207	PINK KISS	16.11.2006/ 4.9.2007	Preserved, dried, cooked and crystalised fruits; preparations made from preserved, dried, cooked and crystallised fruits; jams; fruit sauces; fruit jellies; fruit salads; fruit yoghurt; fruit chips Fruit drinks and fruit juices, syrups; preparations for making fruit drinks; sodas; Apple juice

3. Irish filed a counterstatement in which it accepts that the marks relied on by Star are earlier marks within the meaning of Section 6 of the Act and further admits the respective marks are identical. It denies that there is any similarity in the parties' respective goods or that there is any likelihood of confusion. It puts Star to proof of the use of its mark in relation to ""Apples" and any other goods on which [Star] claims [CTM 677583] has been used in the relevant period".

4. Only Star filed evidence but both parties filed written submissions. Neither requested to be heard. I therefore give this decision from all of the papers now before me.

Decision

5. The relevant section of the Act states:

> "**5.**-(1) ...
>
> (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...

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

6. An "earlier trade mark" is defined in section 6 of the Act. It 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,

(b) a Community trade mark which has a valid claim to seniority from an earlier registered trade mark or international trade mark (UK), or

(c) a trade mark which, at the date of application for registration of the trade mark in question or (where appropriate) of the priority claimed in respect of the application, was entitled to protection under the Paris Convention or the WTO agreement as a well known trade mark.

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.

(3) A trade mark within subsection (1)(a) or (b) whose registration expires shall continue to be taken into account in determining the registrability of a later mark for a period of one year after the expiry unless the registrar is satisfied that there was no *bona fide* use of the mark during the two years immediately preceding the expiry."

7. Star's trade marks are both earlier trade marks within the meaning of section 6(1) of the Act. Irish's application was published on 12 August 2011. Only earlier mark CTM 677583 was registered more than five years prior to this date and Irish has put Star to proof of use of it in respect of certain goods, thus the requirements of Section 6A of the Act are relevant to this mark. Section 6A of the Act reads:

"6A (1) This section applies where-

an application for registration of a trade mark has been published,

there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

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-

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) ……

(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)…."

8. Also of relevance is section 100 of the Act which states:

> "100. 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."

9. It is not entirely clear on which goods Star is claiming to have used its mark, and consequently neither is it entirely clear which goods Irish seeks to require it to prove use, however, for reasons which will become clear, I have not found it necessary to seek further clarification from the parties. The relevant period in which Star is required to prove use of its mark is 13 January 2006 to 12 August 2011. The guiding principles to be applied in determining whether there has been genuine use of a mark are set out in *Ansul BV v Ajax Brandbeveiliging BV* [2003] RPC 40 and *Laboratoire de la Mer Trade Mark* [2006] FSR 5. From these cases it is clear that:

-genuine use entails use that is not merely token. It must also be consistent with the essential function of a trade mark, that is to say to guarantee the identity of the origin of goods or services to consumers or end users (*Ansul*, paragraph 36);

- the use must be 'on the market' and not just internal to the undertaking concerned (*Ansul*,paragraph 37);

- it must be with a view to creating or preserving an outlet for the goods or services (*Ansul*,paragraph 37);

- the use must relate to goods or services already marketed or about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns (*Ansul*, paragraph 37);

- all the facts and circumstances relevant to determining whether the commercial exploitation of the mark is real must be taken into account (*Ansul*, paragraph 38);

- the assessment must have regard to the nature of the goods or services, the characteristics of the market concerned and the scale and frequency of use (*Ansul*, paragraph 39);

-but the use need not be quantitatively significant for it to be deemed genuine (*Ansul*, paragraph 39);

- an act of importation could constitute putting goods on the market (*Laboratoire de la Mer*, paragraph 25 referring to the earlier reasoned order of the ECJ);

- there is no requirement that the mark must have come to the attention of the end user or consumer (*Laboratoire de la Mer*, paragraphs 32 and 48);

- what matters are the objective circumstances of each case and not just what the proprietor planned to do (*Laboratoire de la Mer*, paragraph 34);

- the need to show that the use is sufficient to create or preserve a market share should not be construed as imposing a requirement that a significant market share has to be achieved (*Laboratoire de la Mer*, paragraph 44).

10. I must also keep in mind the guidance in *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32, in relation to determining what constitutes a fair specification, namely:

> "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 the 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".

11. In *Animal Trade Mark* [2004] FSR 19, Jacob J held:

> "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 pernickety 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."

12. Also of relevance are the comments of the Court of First Instance in *Reckitt Benckiser (España) SL v OHIM*, Case T-126/03 where it said:

> "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 to which the goods or services for which the trade mark has actually been used 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.
>
> 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."

The evidence

13. Star's evidence consists of a single witness statement by Renaud Pierson, who states he is the General Manager of Star, a position he has held since May 2005. At Exhibit 4, he provides what he refers to as "examples of the Products on sale under the Trade Mark". The pages appear to be pages downloaded from the internet and which contain pictures of various fruits, vegetables and a bottle of what appears to be juice. The pages are in a number of differing languages, none of them English and no translation of them has been provided. The only dates appearing on the vast majority of the pages are what appear to me to be download dates, all in 2012 though two pages show dates within the relevant period. Page 121 shows a picture of what appears to be a box of apples. The box bears a sticker with the date 13.01.2011. Page 122 shows a date in 2010 and appears to be some sort of list. On none of the pages within this exhibit can I see any reference to Star and no evidence is given on any relationship Star might have (or have had) with any other particular businesses.

14. Whilst Mr Pierson states the mark has been used in respect of apples since at least 2005, he gives no details of any sales made under the mark in relation to these or, indeed, any other of the goods for which it is registered. He does, however, provide at Exhibit 1 what he says is "a presentation prepared by [Star] for business partners [which] shows the nature and extent of the use [of the mark] and steps taken to protect [it] from misuse". Neither the identities of the 'business partners' nor the nature of the relationship are explained.

15. Mr Pierson does not say when this material was prepared and, as far as I can see, there is no indication given in the document itself. Again, many of the pages are not in English and no translation is provided. Some of the pages show boxes of apples. There is one reference to the sale of apples which appears at page 5 of the exhibit, where the following is stated:

> "The presence of apples sold under (sic) mark PINK KISS has been notoced (sic) in most of (sic) main Wholesale market (sic) in Europe and in particular in franec (sic) during the last three seasons."

16. At Exhibit 3, Mr Pierson has provided examples of various publications which he states have referred to the products. Again, the vast majority are not in English (with no translation provided) and show they were downloaded on dates in 2012. There is one article in English which is from something called 'FJP Supplement' and dated September 2005. Mr Pierson says this is a UK based publication with readers across the world though no details of the number of UK readers have been provided. The article refers to apple growing in northern Spain and the person being interviewed

states no more that Pink Kiss is one of the varieties grown by him and his (unnamed) neighbour. There is no reference to Star in the article.

17. The evidence does not, in any way, show genuine use of mark CTM 677583 in the relevant period in relation to any of the goods for which it is registered. That being the case, Star is not able to rely on this mark in these proceedings.

18. The remaining mark relied on by Star, is CTM 5475207 as detailed above at paragraph 2, which is not subject to proof of use.

19. In determining the question under section 5(2)(a), I take into account the guidance provided by the European Court of Justice (CJEU) 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, *Marca Mode CV* v *Adidas AG* [2000] E.T.M.R.723, *Medion AG v Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di Laudato & C. Sas v OHIM* C-334/05 (Limoncello), as cited with approval in *Och-Ziff Management Europe Ltd and Oz Management LP v Och Capital LLP, Union Investment Management Ltd and Ochoki* [2010] EWCH 2599 (Ch). It is clear from these cases that:

(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, 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 and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may, in certain circumstances, be dominated by one or more of its components;

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) 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;

(k) if the association between the marks causes the public to wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of marks

20. There is no dispute that the respective trade marks are identical.

Comparison of goods

21. The goods to be compared are as follows:

Irish's goods	Star's goods
Potatoes	Preserved, dried, cooked and crystalised fruits; preparations made from preserved, dried, cooked and crystallised fruits; jams; fruit sauces; fruit jellies; fruit salads; fruit yoghurt; fruit chips Fruit drinks and fruit juices, syrups; preparations for making fruit drinks; sodas; Apple juice

22. Irish's application originally sought registration in respect of a wider range of goods than is now sought. Both the pleadings and the submissions of both parties make reference to the specification of goods and services of the application for which registration was originally applied but the parties have not sought to amend or update them. For that reason, many of the submissions which have been made are no longer of any relevance to the issues to be decided in these proceedings.

23. Irish state:

> "[We deny] that "potatoes" are similar to the goods of the earlier mark....potatoes are vegetables and are fundamentally different from apples and other fruit, whether fresh or processed, and from fruit drinks and fruit juices."

24. It goes on to submit:

> "Fresh potatoes also have different origins from preserved, dried, cooked or crystallised fruit drinks and fruit juices: the former reach the market as fresh produce from the grower, whereas the latter require processing and packaging and are sold through different outlets or in different parts of a supermarket from fresh produce. The different production methods mean that fresh potatoes and processed fruit, fruit drinks and fruit juices are unlikely to originate from the same undertaking because of the different expertise and economics involved. Consumers are aware of the different qualities and uses of fresh potatoes and preserved, dried, cooked and crystallised fruits and fruit drinks and fruit juices and are used to distinguishing between them.
> ...
>
> Fresh potatoes are not similar to fruit drinks and fruit juices. The one is a raw staple, solid foodstuff requiring preparation and cooking prior to consumption for nourishment, whereas the others are prepared drinks in liquid form or requiring dilution for slaking a thirst. They have different natures and purposes and there can be no confusion between them."

25. For its part, Star points out that its registration includes fruit chips and says that "chips or crisps are generally made from potatoes, but there are also crisps made from other vegetables and some fruits such as apples". It goes on say:

> "...regardless of the fact that apples are bought for their sweet qualities and potatoes are bought as a savoury staple carbohydrate, they are <u>all</u> foodstuffs which are sold as: fresh produce, either loosely or pre-packaged; as pre-prepared or processed products with a short shelf life in the refrigerated section, or prepared in a way that gives then a longer shelf life either in jars or tins. Therefore, consumers seeing the identical trade mark on both apple and potato produce in their shopping trolley would undoubtedly expect the products to have the same trade origin."

26. It goes on to repeat what it said in its notice of opposition, namely:

> "We reiterate our point that in the French language, the word for apple is "pomme" and the word for potato is "pomme de terre" which literally means apple of the earth. The British public have sufficient knowledge of the French language to be aware of this link and it serves to remind us that the respective products are staple foodstuffs".

27. The average consumer visits a supermarket in order to buy what (s)he needs to provide e.g. meals for him/herself or a family-(s)he is not in the habit of thinking of what speakers of other languages would call those products and, even less, whether any such words are similar or not to that of another product. Whether or not the British public is aware of the French words for apples and potatoes, I cannot see how this submission is of any relevance to the issues to be decided in this case.

28. In *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 28, Jacob J gave advice as to how similarity should be assessed. He identified the following factors to be taken into account:

> (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."

29. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-325/06 the General Court stated:

> "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] ECRII-685, paragraph 60, upheld on appeal in Case C-214/05P *Rossi v OHIM* [2006] ECR I-7057; Case T-364/05, *Saint-Gobain Pam v OHIM –Promamsa (PAM PLUVIAL)* [2007] ECRII-757, paragraph 94; and Case T-443/05 *El Corte Inglés v OHIM –Bolaños Sabri (PiraŇam diseño original Juan Bolañs)* [2007] ECR-1-0000, paragraph 48)."

30. Potatoes are earth grown tubers and are a raw product which will require some sort of preparation and cooking before being eaten. Most of Star's goods are made from fruit which will have been through some form of process of manufacturer to create them. 'Syrups' and 'sodas' may or may not have fruit content but will still have been manufactured having been produced from other ingredients.

31. I have no evidence before me to show that potatoes are an ingredient in any of the goods within Star's earlier registration, however, even it they were, I am mindful of the decision in *Les Éditions Albert René V Office for Harmonisation in the Internal Market (Trade Marks & Designs) (OHIM)* T-336/03, where it was held:

> "The mere fact that a particular good is used as a part, element or component of another does not suffice in itself to show that the finished goods containing

those components are similar since, in particular, their nature, intended purpose and the customers for those goods may be completely different."

32. There is no dispute that each of the respective goods is a foodstuff, whether to be eaten or drunk, but even if they share the same purpose, as an item to be ingested, their natures differ as do their method of use. The respective goods are not in competition with each other, do not come from the same source, reach the store by different routes and will be displayed in very different areas of that store. They are not complementary and one will not be used as a substitute for the other. The respective goods are not similar.

33. In order for a positive finding under section 5(2)(a), there has to be some similarity of goods. As I have found the respective goods to be dissimilar, the ground of opposition under section 5(2)(a) fails.

34. The opposition having failed and subject to any appeal against my decision, the application is free to proceed to registration.

Costs

35. Irish having succeeded is entitled to an award of costs in its favour. I make the award on the following basis:

For reviewing the Notice of Opposition and filing a counterstatement	£300
For filing submissions and reviewing submissions/evidence	£500
Total	**£800**

36. I order Star Fruits to pay Irish Potato Marketing Limited the sum of £800 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 these proceedings if any appeal against my decision is unsuccessful.

Dated the 1st of August 2012

Ann Corbett
For the Registrar
The Comptroller-General