

O-296-10

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 2462510
BY NEW FOREST ICE CREAM LIMITED TO REGISTER A
TRADE MARK IN CLASS 30**

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 95878 BY KAUFLAND WARENHANDEL GMBH & CO.KG**

BACKGROUND

1. On 27 July 2007, New Forest Ice Cream Limited (NF) applied to register the trade mark **MAXICHOC** for the following goods in class 30:

Ice cream; edible ice; water ices; frozen confectionery; preparations for making said goods not included in other classes.

Following examination, the application was accepted and published for opposition purposes on 19 October 2007 in Trade Marks Journal No.6706.

2. On 18 January 2008, Kaufland Warenhandel GmbH & Co. KG (KW) filed a notice of opposition. This consisted of grounds based upon sections 3(1)(b), 3(1)(c), 3(3)(b) and 5(2)(b) of the Trade Marks Act 1994 (as amended) (the Act), directed, I note, against all of the goods contained in the application. However, in their written submissions dated 24 June 2010, KW withdrew the ground of opposition based upon section 3(3)(b) of the Act. In their Notice of Opposition KW say in relation to the ground based upon section 3(1)(c) of the Act:

“1. The mark applied for comprises the conjoined elements MAXI and CHOC, which are either commonly used or immediately comprehensible abbreviations for the words “maximum” and “chocolate”, respectively.

2. When used in relation to a foodstuff of any kind, the consumer will draw the immediate conclusion that the product contains a large quantity of chocolate. Chocolate is, to many consumers, a desirable ingredient, and many would purchase a product in the belief that it contains the “maximum level of chocolate”, which is the clear message communicated by the mark MAXICHOC. The mark applied for is therefore directly descriptive of ice creams, frozen confectionery and so on that contain chocolate.

3. The descriptive nature of the mark means that it is a phrase that should remain free for other traders to use to describe their products.”

3. In relation to the ground based upon section 3(1)(b) of the Act they say:

“5. Furthermore, the mark applied for, being a simple joining together of two common words, possesses no distinctive character....”

4. KW’s opposition under section 5(2)(b) of the Act is based upon the following trade mark:

Trade Mark	No.	Application Date	Protection conferred	Goods
MaxX	858022 International trade mark designating the Community	25.02.2005 IC date of 01.09.2004 claimed from Germany	26.11.07	30 - Edible ices.

5. Insofar as the comparison of the trade marks are concerned KW say:

“8. The common letters MAX confer a phonetic and [sic] similarity onto the respective marks.

9. Products such as ice creams and the like are purchased following the visual inspection of the products available and/or by requesting the product by name. The visual and phonetic characteristics of trade marks are therefore the most important considerations when assessing the likelihood of confusion arising between them. In this instance, the phonetic and visual similarity between the two marks is such as to be likely to give rise to confusion on the part of the public.

6. In relation to the similarity in the competing goods KW say:

11. The opponent’s earlier mark covers “edible ices” in Class 30. These goods are identical or at least very similar to those [in NF’s application].

- a. Edible ices are defined by the European Ice Cream Association as “food products into the composition of which all food ingredients as well as all additives...may enter, the solid or pasty texture of which is obtained by freezing, and which are stored, transported, sold and consumed in a frozen state”;
- b. It is therefore clear that the term “edible ices” includes all of the goods listed in the application. To the extent that the goods covered by the earlier mark are not identical to the goods in the application, they must be considered similar thereto;
- c. The purpose of the goods covered by the earlier registration and the mark applied for is identical, namely, for consumption as a snack, a treat or a dessert item;
- d. The products will be available through the same channels of trade;
- e. The consumers of the respective products will be identical;
- f. The goods are directly competitive.”

7. On 22 April 2009, NF filed a counterstatement. In relation to the ground based on section 3(1)(b) of the Act, they say inter alia:

“..Being an invented word, devised by the applicant, the mark is immediately striking, not least because neither the elements of the mark nor the mark as a whole are commonly used or hitherto known words. The average consumer would immediately perceive that the purpose of such a word is to serve as a trade mark to distinguish in the marketplace the goods of the applicant and those of third parties.”

8. In relation to the ground based on section 3(1)(c) of the Act, NF say inter alia:

“Rather, proper assessment requires consideration of whether third parties would use the trade mark to describe the goods during the normal course of trade. It is submitted that they would not. No specific, concrete meaning can be derived from the mark. At most, only arguable allusions of meaning can be inferred. Such a word does not have a specific, precise meaning and so would not be used by third parties since it is not apt to serve the purpose of providing a meaningful designation in the context of describing goods.”

9. Finally, in relation to the ground based on section 5(2)(b) of the Act, NF say inter alia:

“The marks are visually, phonetically and conceptually dissimilar. The opponent’s mark is in a stylised form in which the first and last letters are in uppercase and the second and third letters are in lower case. Furthermore, the opponent’s mark ends in two letters X. Those aspects of the opponent’s mark give it a very different impact from that created by the applicant’s mark. The fact that both marks include MAX- is insufficient for the two marks to be deemed to be confusingly similar. It is noted that the opponent implies in its earlier argumentation that MAX is non-distinctive, and so is attempting to argue for confusing similarity on the basis of an element which it asserts is non-distinctive....less distinctive elements dilute the likelihood of confusion. In any event, the commonality of MAX- is insufficient to outweigh the phonetic and visual differences between the marks, which when viewed in their respective entireties are dissimilar. The average consumer would have no difficulty in distinguishing between the marks.”

10. In responding to the above grounds of opposition, I note that nowhere in their counterstatement do NF comment on KW’s assessment of the degree of similarity between the respective parties’ goods. Paragraph 24 of Tribunal Practice Notice 1 of 2000 reads:

“The purpose of the counterstatement is to narrow down the field of dispute, because the claimant will not need to prove any allegations which the defendant admits. Whilst in the past counterstatements have sometimes been very sketchy,

that is no longer acceptable. If a counterstatement leaves uncertainty about what is and is not in dispute, it is inadequate. Thus, the counterstatement must deal specifically with every allegation in the statement. **(Indeed, any allegation not dealt with is generally deemed to be admitted by the defendant.)** Again, costs need not be specifically claimed, though they usually are.” (my emphasis).

11. In those circumstances, I intend to proceed on the basis that NF agree with KW’s assessment of the degree of similarity between the competing goods.

12. Both parties filed evidence in the proceedings and both provided written submissions in lieu of attendance at a hearing. I will refer to these written submissions as necessary later in this decision. After a careful consideration of all the material before me, I give this decision.

EVIDENCE

KW’s evidence

13. This consists of a witness statement, dated 8 October 2009, from Elizabeth Lowe who is a Trade Mark Attorney at Haseltine Lake LLP, KW’s professional representatives in these proceedings. Attached to her witness statement are seven exhibits; these are as follows:

Exhibit EL1 – consists of copies of pages 11 & 12 taken from the Trade Marks Registry’s Manual of Examination Practice, which indicates the general approach to be adopted under sections 3(1)(b) and (c) of the Act;

Exhibit EL2 – consists of an extract taken from the website of the Intellectual Property Office concerning the relevance of decisions of the European Court of Justice (ECJ) to examination practice in the United Kingdom, in which the following words have been underlined:

“..the decisions of the ECJ do have implications for our examination practices.”

Exhibit EL3 – consists of a copy of the ECJ’s Judgment in Case C-191/01-P, *Wm. Wrigley Jr. Company v. Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case C-191/01 P (the “Doublemint” case);

Exhibit EL4 – consists of an extract downloaded from the website <http://en.wiktionary.org/wiki/maxi> on 6 August 2009 in which “maxi” is shown as an adjective meaning “having a hemline at ankle length”, as a noun meaning “a coat or skirt having such a hemline” and as an abbreviation of the word “maximum”;

Exhibit EL5 – consists of an extract downloaded from www.merriam-webster.com on 29 July 2009 in which MAXI is described as a “combining form” the etymology of which is

identified as “maximum” and in which the following examples are given: “1: extra long <maxiskirt> and 2: extra large <maxi-problems>”:

Exhibit EL6 – consists of an extract taken from The Oxford Dictionary of Abbreviations downloaded from www.encyclopedia.com on 29 July 2009 in which “choc” is identified as an abbreviation of “chocolate” and examples of the abbreviation in use are shown;

Exhibit EL7 – consists of what Ms Lowe describes as “example of descriptive commercial use of the words “MAXI” and “CHOC”. This exhibit consists of the following:

Page 25 - consists of a Google® search conducted on 7 August 2009 in which the words maxi taste were entered into the search engine. The search, which was limited to the United Kingdom, produced over 24k hits. The first six hits (only five of which appear to be relevant) are provided. The relevant headings appear to be: “Cadbury’s Mini Rolls – Review – Mini Chocolates Maxi Taste”, “McVities Mini Cheddars – Review – Mini cheddar, maxi taste”, “Kinder Maxi – Review – Kinder maxi! Maxi taste and fabulous!” (2 entries) and “Maxi Twist...It’s good honest daily pleasure food with the Maxi Taste”;

Page 26 – consists of what appears to be an undated page downloaded from www.loveicecream.com in relation to the Maxi Twist product mentioned above;

Page 27 – consists of a page downloaded from www.moodiereport.com on 7 August 2009 . The page which is headed “Mars grows its range with Maxi Packs – 17/4/08” appears to be referring to the Asia Pacific region;

Page 28 – consists of a page downloaded from what appears to be www.mysupermarket.co.uk on 7 August 2009 in which reference is made to what appears to be a “Cadbury’s Treatsize Maxi Mix Bag”;

Page 29 – consists of a page downloaded from www.thisiswhyyourefat.com on 13 July 2009 in which, inter alia, the following words appear: “The Gastronomic Surprise Maxi Rainbow 24 Scoop Ice Cream Sundae”;

Page 30 – consists of a page downloaded from www.sugarmouse.net on 13 July 2009 (which refers to a business in the United Kingdom) and which under the heading Ice Cream refers to, inter alia, “Plain Chocolate Maximum” and “White Chocolate Maximum”;

Page 31 – consists of a page downloaded from www.encyclo.co.uk on 29 July 2009 in which (under the heading “Look up: choc-ice”) the words are described as “British abbreviation for chocolate ice cream”;

Page 32 – appears to be an undated page downloaded from www.chaffinsfoodservice.co.uk which under the heading “ICE CREAM CONES” the following entries have been highlighted: “SUGAR CONE MAXI CHOC DIPPED” and “SUGAR CONES – MAXI”;

Page 33 – consist of a copy of a page downloaded from www.shopwiki.co.uk on 5 October 2009 which refers to “Maximuscle Maxi Milk 8 x 330ml Choc”.

NF’s evidence

14. This consists of a witness statement, dated 22 December 2009, from Simon Robinson who is, inter alia, a Trade Mark Attorney at Barker Brettell LLP, NF’s professional representatives in these proceedings. Attached to his witness statement are 10 exhibits all of which relate to previous trade marks accepted by either the Intellectual Property Office or the Office for Harmonization in the Internal Market (OHIM) which contain the letters MAXI as an element. While I note this evidence, I am also aware of the comments of Mr Justice Jacob (as he then was) in *British Sugar plc v James Robertson & Sons Ltd* [1996] RPC 281 when he said:

“Both sides invite me to have regard to the state of the register. Some traders have registered marks consisting of or incorporating the word “Treat”. I do not think this assists the factual inquiry one way or the other, save perhaps to confirm that this is the sort of word in which traders would like a monopoly. In particular the state of the register does not tell you what the circumstances were which led the Registrar to put the marks concerned on the register. It has long been held under the old Act that comparison with other marks on the register is in principle irrelevant when considering a particular mark tendered for registration, eg MADAM Trade Mark and the same must be true under the 1994 Act. I disregard the state of the register evidence.”

15. In *GfK AG v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Case T-135/04 the General Court (GC) said:

“68. As regards the search of the Cedex database, the mere fact that a number of trade marks relating to Class 35 contain the word ‘bus’ is not enough to establish that the distinctive character of that element has been weakened because of its frequent use in the field concerned. Firstly, the search in question does not provide any information on the trade marks actually used in relation to the services concerned. Secondly, it includes a number of trade marks in which the word ‘bus’ is used descriptively by public transport businesses.”

16. This was a view re-iterated by the GC in *Zero Industry Srl v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Case T-400/06. While I am also aware of the judgment of Mr Daniel Alexander QC, sitting as a deputy judge of the High Court, in *Digipos Store Solutions Group Ltd v Digi International Inc* [2008] RPC 24, in that case Mr Alexander was not referred to the judgment of the GC in *GfK AG*. In addition, in his judgment Mr Alexander referred to the decision in *British Sugar* as an absolute grounds case and appeared to consider this of some significance. The GC cases referred to above are relative grounds cases; clearly the GC considers that the principle of not giving weight to state-of-the register evidence also applies in cases

involving relative grounds issues. As in the GfK case mentioned above, no evidence has been provided by NF to show that the trade marks identified by them are actually being used in relation to the goods concerned. In light of the above authorities, this sort of evidence does nothing to assist me in relation to either the absolute (section 3) or relative (section 5) grounds of opposition and as such I see no need to summarise its contents here.

17. That concludes my summary of the evidence filed to the extent that I consider it necessary.

DECISION

The objections under section 3(1) of the Act

18. I will deal with the grounds based on sections 3(1)(b) and (c) first. These sections read:

“3. - (1) The following shall not be registered -

(a)...

(b) trade marks which are devoid of any distinctive character,

(c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,

(d)...

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.”

19. No evidence has been filed by NF to indicate what use, if any, they may have made of their MAXICHOC trade mark; I have therefore only the trade mark’s inherent characteristics to consider.

The objection under section 3(1)(c) - case law

20. The comments of the ECJ in Case C-363/99 - *Koninklijke KPN Nederland NV and Benelux-Merkenbureau* (the “Postkantoor” case) in relation to section 3(1)(c) are of assistance. The Court said:

“54. As the Court has already held (*Windsurfing Chiemsee*, paragraph 25, *Linde*, paragraph 73, and *Libertel*, paragraph 52), Article 3(1)(c) of the Directive pursues

an aim which is in the public interest, namely that such signs or indications may be freely used by all. Article 3(1)(c) therefore prevents such signs and indications from being reserved to one undertaking alone because they have been registered as trade marks.

55. That public interest requires that all signs or indications which may serve to designate characteristics of the goods or services in respect of which registration is sought remain freely available to all undertakings in order that they may use them when describing the same characteristics of their own goods. Therefore, marks consisting exclusively of such signs or indications are not eligible for registration unless Article 3(3) of the Directive applies.

56. In those circumstances, the competent authority must, under Article 3(1)(c) of the Directive, determine whether a trade mark for which registration is sought currently represents, in the mind of the relevant class of persons, a description of the characteristics of the goods or services concerned or whether it is reasonable to assume that that might be the case in the future (see to that effect *Windsurfing Chiemsee*, paragraph 31). If, at the end of that assessment, the competent authority reaches the conclusion that that is the case, it must refuse, on the basis of that provision, to register the mark.”

21. In their evidence and written submissions KW have drawn my attention to the comments of the ECJ in the “*Doublemint*” case and to the manner in which this decision has been interpreted by the Trade Marks Registry in its Manual of Examination Practice (exhibits EL1, 2 and 3 refer). In *Doublemint* the court said:

“32. In order for OHIM to refuse to register a trade mark under Article 7(1)(c) of Regulation No 40/94, it is not necessary that the signs and indications composing the mark that are referred to in that article actually be in use at the time of the application for registration in a way that is descriptive of goods or services such as those in relation to which the application is filed, or of characteristics of those goods or services. It is sufficient, as the wording of that provision itself indicates, that such signs and indications could be used for such purposes. A sign must therefore be refused registration under that provision if at least one of its possible meanings designates a characteristic of the goods or services concerned.”

22. I also note that in *Matratzen Concord AG v Hukla Germany SA*, (Case C-421/04) (“*Matratzan*”) the ECJ said:

“In fact, to assess whether a national trade mark is devoid of distinctive character or is descriptive of the goods or services in respect of which its registration is sought, it is necessary to take into account the perception of the relevant parties, that is to say in trade and or amongst average consumers of the said goods or services, reasonably well-informed and reasonably observant and circumspect, in the territory in respect of which

registration is applied for (see Joined Cases C-108/97 and C-109/97 Windsurfing Chiemsee [1999] ECR I-2779, paragraph 29; Case C-363/99 Koninklijke KPNNederland [2004] ECR I-1619, paragraph 77; and Case C-218/01 Henkel [2004] ECR I-1725, paragraph 50).”

23. KW’s evidence indicates that MAXI is, inter alia, an abbreviation for “maximum” and that CHOC is an abbreviation for chocolate. Insofar as the CHOC element is concerned I would have been prepared to accept that it was an abbreviation for chocolate on the basis of judicial notice. However, as KW’s evidence shows (see exhibits EL4 and 5), the position is not, I think, quite so clear cut in relation to the word MAXI.

24. While not mentioned by NF in either their evidence or written submissions, I am aware of the Trade Marks Registry’s published practice in relation to the ex-parte approach to be adopted in relation to trade marks which contain MAXI as an element. This reads:

“MAXI

A mark consisting of the prefix MAXI (meaning large, great or much) together with a word which is meaningful for the goods/services concerned is not usually open to objection. The word has a more limited trade usage than MINI. Therefore, the following examples are acceptable:

MAXI INSURANCE — for insurance
MAXICOVER — for paint
MAXICOVER — for insurance
MAXICRUISE — for travel services
MAXITOOl — for tools.”

25. Of course the Addendum to the Examination and Practice Guide is just that, only a guide and I place no reliance on it. However, what is, I think interesting, is that the Practice Guide refers to MAXI as a prefix meaning large, great or much, it does not refer to it as an abbreviation for maximum. Consistent with those definitions (particularly the reference to large) many of the examples of use provided by KW in their evidence points to the use of MAXI as a reference to size rather than as an abbreviation for maximum; the examples mentioned in exhibit EL5 and the following references in exhibit EL7: “Maxi Packs (page 27), “Cadbury’s Treatsize Maxi Mix Bag” (page 28), “SUGAR CONES MAXI” (page 32) refer.

26. In their counterstatement (see paragraphs 7 and 8 above) NF say, inter alia, that their application consists of an invented word, that neither of the elements nor the mark as a whole are commonly used in trade, that no specific concrete meaning can be derived from the trade mark and that third parties would not wish to use the trade mark to describe their own goods.

27. In their evidence (exhibit EL1) KW drew my attention to the following extract appearing in the Manual of Examination Practice:

“When examining marks consisting of unusually juxtaposed words and marks which consist of only part of a natural description for the goods/services, the court’s judgement in *Baby-Dry* (C-383/99 P) provides guidance. *Baby-Dry* also assists in an assessment of whether a trade mark consisting of two or more words consists exclusively of a descriptive term, when the words in question are juxtaposed in a manner which renders the mark resistant to natural descriptive uses. Although the court stated in *Doublemint* that it is sufficient if the sign in question is “capable” of being used as a description of the goods/services, this must be taken as applying only where there is a reasonable likelihood that the sign in question will serve a descriptive purpose in the ordinary course of trade. What must be considered is whether third parties are likely to use signs corresponding to the trade mark applied for in order to describe characteristics of the goods/services covered by the application.”

28. In their written submissions KW say:

“17. While it is possible for the conjoining of descriptive words to create a new word and distinctive term, it is submitted that where the conjoined term is no less descriptive than the individual words, the term cannot claim to have distinctive character...”

29. In my view NF’s trade mark consists of the conjoining of two known elements. While the CHOC element would be well being known as a reference to chocolate, I am not convinced that the MAXI element would necessarily be seen as a reference to maximum; in practice, it may be seen as a reference to either maximum or to a particular size. Insofar as the latter is concerned, the examples highlighted by KW on page 32 of exhibit EL7 appear to support this conclusion i.e. MAXI would be seen as a reference to the size of the cone i.e. SUGAR CONE MAXI CHOC DIPPED would be understood (given the reference to SUGAR CONES MAXI in the same listing) as a reference to a MAXI size sugar cone that was dipped in chocolate.

30. So the combination MAXICHOC may be understood as meaning either “maximumchocolate” or “largechocolate”. If that is correct, are either or both of these combinations ones which may serve in trade to designate a characteristic of the goods concerned as required by section 3(1)(c) of the Act? If they are, then it is likely that their abbreviation to MAXICHOC may also serve in trade to designate a characteristic of the goods. While I accept that MAXI and CHOC are both in use in relation to the goods at issue, the closest the evidence gets to suggesting that the combinations above may serve in trade are the references to “Plain Chocolate Maximum” and “White Chocolate Maximum” on page 30 of exhibit EL7, and the reference to “SUGAR CONE MAXI CHOC DIPPED” on page 32 of the same exhibit. As I mentioned above, properly understood, the reference on page 32 is to SUGAR CONE MAXI and not MAXI CHOC

DIPPED. What is telling in my view, is that even with the internet at their disposal, the entries mentioned above are the best examples of potential use which KW could obtain.

31. Having considered all of the evidence before me, I agree with NF that as no concrete meaning can be discerned from the combination MAXICHOC, the combination is, by its very nature, imprecise. Therefore in the absence of persuasive evidence to the contrary, this, in my view, renders NF's trade mark resistant to natural descriptive usage by other traders in this field. **The opposition based on section 3(1)(c) of the Act fails accordingly.**

The objection under section 3(1)(b) – case law

32. The purpose of section 3(1)(b) of the Act is set out in the ECJ's judgment in *SAT.1 Satellitenfernsehen GMBH v OHIM*, case C-329/02 P [2005] E.T.M.R. 20:

“23 First, the essential function of a trade mark is to guarantee the identity of the origin of the marked product to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish the product or service from others which have another origin (see, in particular, Case 102/77 Hoffmann-La Roche [1978] ECR 1139, paragraph 7, and Case C-299/99 Philips [2002] ECR I-5475, paragraph 30). Article 7(1)(b) of the regulation is thus intended to preclude registration of trade marks which are devoid of distinctive character which alone renders them capable of fulfilling that essential function.

24 Secondly, in order to determine whether a sign presents a characteristic such as to render it registrable as a trade mark, it is appropriate to take the viewpoint of the relevant public. Where the goods or services with which the registration application is concerned are intended for all consumers, the relevant public must be deemed to be composed of the average consumer, reasonably well-informed and reasonably observant and circumspect (see Case C-342/97 Lloyd Schuhfabrik Meyer [1999] ECR I-3819, paragraph 26, and Case C-104/01 Libertel [2003] ECR I-3793, paragraph 46).

.....

27 Furthermore, in view of the extent of the protection afforded to a trade mark by the regulation, the public interest underlying Article 7(1)(b) of the regulation is, manifestly, indissociable from the essential function of a trade mark, as observed in paragraph 23 above.”

33. In *Postkantoor* the court said:

“86. In particular, a word mark which is descriptive of characteristics of goods or services for the purposes of Article 3(1)(c) of the Directive is, on that account, necessarily devoid of any distinctive character with regard to the same goods or services within the meaning of Article 3(1)(b) of the Directive.

A mark may none the less be devoid of any distinctive character in relation to goods or services for reasons other than the fact that it may be descriptive.”

34. It is well established that an objection under Section 3(1)(b) operates independently of an objection under Section 3(1)(c) – (*Linde AG (and others) v Deutsches Patent-und Markenamt*, Joined Cases C-53/01 to C-55/01, paragraphs 67 to 68) and that a trade mark may be devoid of distinctive character in relation to goods for reasons other than the fact that it may be descriptive (*Postkantoor* paragraph 86).

35. The public interest role underlying section 3(1)(b) is about what the average consumer thinks, i.e. does the trade mark perform the essential function by identifying the goods as emanating from a single undertaking. As I have already concluded under section 3(1)(c) of the Act that any message NF’s MAXICHOC trade mark may send is imprecise and resistant to natural descriptive usage, it follows that it will, in my view, be taken by the average consumer as an indication of trade origin. **The opposition based on section 3(1)(b) of the Act also fails.**

The objection under section 5(2)(b)

36. I will now consider the final ground of opposition which is based upon section 5(2)(b) of the Act. This section reads:

“5 (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.”

37. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

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

(a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) 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,

(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.”

38. In these proceedings KW are relying on the trade mark shown in paragraph 4 above which has application/priority dates earlier than that of the application for registration; as such, it qualifies as an earlier trade mark under the above provisions. The application for registration was published for opposition purposes on 19 October 2007 and KW's earlier trade mark became protected on 26 November 2007. As KW's earlier trade mark had not been registered for five years at the point at which NF's application was published, it is not subject to The Trade Marks (Proof of Use, etc) Regulations 2004.

Section 5(2)(b) – case law

39. The ECJ has provided guidance in a number of judgments germane to this issue. The principal cases are: *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 117, *Lloyd Schuhfabrik Mayer & Co. GmbH v. Klijsen Handel B.V* [2000] F.S.R. 77 and *Marca Mode CV v. Adidas AG + Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG V Thomson multimedia Sales Germany & Austria GmbH* (Case C-120/04) and *Shaker di L. Laudato & Co. Sas* (C-334/05).

It is clear from these cases that:

(a) the likelihood of confusion must be appreciated globally, taking account of all the relevant factors: *Sabel BV v. Puma AG*, paragraph 22;

(b) the matter must be judged through the eyes of the average consumer of the good/services in question; *Sabel BV v. Puma AG*, paragraph 23, who is deemed to be reasonably well informed and circumspect and observant – but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind; *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* 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) when considering composite marks, it is only if all the other components of the mark are negligible that the assessment of the similarity can be carried out solely on the basis of the dominant element; *Shaker di L. Laudato & Co. Sas* (C-334/05), paragraph 42;

(f) an element of a mark may play an independent distinctive role within it without necessarily constituting the dominant element; *Medion AG V Thomson multimedia Sales Germany & Austria GmbH*, paragraph 30;

(g) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17;

(h) 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;

(i) 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;

(j) 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 + Adidas Benelux BV*, paragraph 41;

(k) 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.

The average consumer and the purchasing act

40. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods; I must then determine the manner in which these goods are likely to be selected by the average consumer in the course of trade. Ice cream, edible ice, water ices, frozen confectionery and preparations for making these goods are all everyday consumer items that will be bought by the general public; they then are the average consumer for such goods.

41. In both their Notice of Opposition and written submissions KW argue that the goods at issue will be purchased following either a visual inspection and/or by requesting the goods by name. I agree and will proceed on the basis that both visual and aural considerations will play a part in the selection process.

42. Given the inexpensive nature of the goods at issue (they are akin to the much quoted "bag of sweets" case) one may conclude that the average consumer will pay only a minimal level of attention to their selection. However, it is, I think, also possible that the average consumer may have, for example, a favourite ice cream or ice lolly; in those circumstances they can, in my view, be expected to pay at least a sufficient degree of care when selecting the goods to ensure that they receive the frozen confection they desire.

Comparison of goods

KW's goods	NF's goods
Edible ices.	Ice cream; edible ice; water ices; frozen confectionery; preparations for making said goods not included in other classes.

43. Strictly speaking given my comments at paragraphs 10 and 11 above, it is not necessary for me to deal with this aspect of the comparison at all. However, for the sake of completeness it is, in my view, clear, given the comments of the General Court in *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) ("Meric")* Case T-133/05, that the "edible ices" in KW's specification are either identical or highly similar goods to all of the goods contained in NF's application.

Comparison of trade marks

KW's trade mark	NF's trade mark
MaxX	MAXICHOC

44. It is well established that the average consumer is considered to be reasonably well informed, circumspect and observant but perceives trade marks as a whole and does not pause to analyse their various details. In addition, he/she rarely has the chance to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he/she has kept in his or her mind. In reaching a conclusion on similarity I must identify what I consider to be the distinctive and dominant elements of the respective trade marks and, with that conclusion in mind, I must, as the case law dictates, then go on and compare the respective trade marks from the visual, aural and conceptual perspectives.

45. KW's trade mark consists of the four letters shown above in which the first and last letters are capitalised and the middle two letters presented in lower case; NF's trade mark consists of the eight letters shown above presented as one word all in upper case.

46. Insofar as the distinctive and dominant elements of KW's trade mark is concerned, the presentation is such that the letters Max form a clearly identifiable element of the trade mark. I am aware that the letters Max represent a male forename (either in their own right or as a shortened form of, for example, Maximillian). However, a review of the Concise Oxford English Dictionary defines "max" as an abbreviation for maximum and The Oxford Dictionary of English 2005 defines maximum as a noun meaning "the greatest amount, extent, or intensity possible, permitted or recorded", and as an adjective meaning "as great, high, or intense as possible or permitted." When selecting the goods at issue it is, in my view, the non forename meaning that is likely to be uppermost in the mind of the average consumer.

47. On the basis of KW's own arguments, the abbreviation Max presented as a clearly identifiable element in their trade mark is likely to be perceived as descriptive. While the Max element of KW's trade mark may (by virtue of its positioning) be considered the dominant element of the trade mark, the distinctiveness of the trade mark as a whole resides, in my view, in its totality and in particular the visual impact created by the two letters X and the somewhat unusual positioning of the capitalised letter X at the end of the trade mark.

48. Turning to NF's trade mark, as I mentioned above this is presented as one word all in upper case. In my view the trade mark has no truly dominant element; each element has equal impact and contributes to the trade mark's overall distinctiveness.

Visual similarity

49. I have described the competing trade marks above. One is four letters long, the other eight. Insofar as they share the same first three letters there is a degree of visual similarity. However, when the differences between the competing trade marks are taken into account i.e. the capital letter X appearing in KW's trade mark, and the capital letter I and the abbreviation CHOC appearing in NF's trade mark, the overall degree of similarity between the competing trade marks is, in my view, low.

Aural similarity

50. KW's trade mark is most likely, in my view, to be pronounced as Max (where the second letter X is silent) although it may be pronounced as Max X (where the second letter X is specifically articulated). NF's trade mark is most likely to be pronounced as a three syllable word MAX-I-CHOC. Once again there is a degree of aural similarity created by the beginnings of the competing trade marks, but when considered as totalities the overall degree of aural similarity is, in my view, once again low.

Conceptual similarity

51. Insofar as KW's trade mark is concerned, it is just possible that the average consumer may see it as the name of an individual whose surname begins with the letter X. More realistically it is likely to be seen as a reference to maximum. As the average consumer is likely to be familiar with both MAXI and CHOC, NF's trade mark is likely to be seen as an allusion to something which contains an imprecise amount of chocolate. While it is possible the respective trade marks may send different conceptual messages i.e. the name of an individual versus a product which contains an imprecise amount of chocolate, it is likely that at least insofar as the Max/MAXI element of each trade mark is concerned, a similar conceptual message will be conveyed.

Distinctive character of KW's earlier trade mark

52. I must now assess the distinctive character of KW's earlier trade mark. As I mentioned in paragraph 19 above, no evidence has been provided which shows, for example, when the trade mark was first used, if and to what extent the trade mark has been promoted and neither has any indication been provided of sales achieved under the trade mark. In those circumstances I can only consider the trade mark's inherent characteristics. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods for which it has been registered as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

53. The dictionary definitions indicate that Max is an abbreviation for the word maximum which has the meanings I have highlighted above. KW considers that the word maximum is descriptive and lacks distinctive character. If that is right, as a well known abbreviation of maximum, Max alone is also likely to be descriptive and lacking in distinctive character. While the presentation of KW's earlier trade mark isolates this word, the two letters xX at the end of the trade mark is, in my view, and in relation to the goods for which it is protected, sufficiently unusual to imbue the trade mark as a whole with a limited degree of distinctive character.

Likelihood of confusion

54. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of KW's trade mark, as the more distinctive this trade mark is the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind.

55. The only similarity between the respective trade marks is in relation to an element in KW's trade mark which on their own analysis of the matter I should consider to be descriptive and non-distinctive; in paragraph 9 above I noted how NF considered this affected the likelihood of confusion. The goods at issue are of course identical or highly similar. While I am mindful of the low cost of the goods and how they are likely to be selected by the average consumer, and notwithstanding the degree of conceptual similarity created by the Max/MAXI elements, the low degree of both visual and aural

similarity and the limited degree of distinctive character I consider KW's trade mark enjoys are, when taken together, more than sufficient to avoid either direct confusion (where one trade mark is mistaken for the other) or indirect confusion (where the average consumer would assume that the goods of NF come from an undertaking linked to KW). **The opposition under section 5(2)(b) of the Act fails accordingly.**

56. In summary, the opposition has failed on all grounds and the application will proceed to registration.

Costs

57. As NF have been successful they are entitled to a contribution towards their costs. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 4 of 2007. Using that TPN as a guide, I award costs to NF on the following basis:

Preparing a statement and considering the other side's statement:	£300
Preparing evidence and considering and commenting on the other side's evidence:	£500
Written submissions:	£100
Total:	£900

58. I order Kaufland Warenhandel GmbH & Co. KG to pay New Forest Ice Cream Limited the sum of £900. 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 2010

**C J BOWEN
For the Registrar
The Comptroller-General**