

O-300-11

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 2544771
BY PAUL NORMAN
TO REGISTER A TRADE MARK IN CLASSES 29 & 30**

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 100954 BY COMPAGNIE GERVAIS DANONE**

BACKGROUND

1. On 13 April 2010, Paul Norman applied to register



as a trade mark. Following examination, the application was accepted and published for opposition purposes on 18 June 2010 for the following goods:

Class 29:

Beverages made from yoghurt, beverages made from yoghurts, custard style yoghurts, desserts made from yoghurt, desserts made from yoghurt with fruit additives, desserts made from yoghurt with herb additives, drinks containing yoghurt and soda, the yoghurt predominating, flavoured yoghurts, food products containing yoghurt, foodstuffs containing frozen yoghurt [as the main constituent], fruit flavoured yoghurts, low fat yoghurts, natural fruit flavoured yoghurt, preparations for making yoghurt, preparations made from yoghurt, prepared desserts made from yoghurt with fruit pastry additives, prepared desserts made from yoghurt with herbs additives, prepared desserts made from yoghurt with pastry additives, set yoghurt, soya yoghurt, yoghurt, yoghurt based drinks, yoghurt beverages, yoghurt desserts, yoghurt drinks, yoghurt made from goats milk, yoghurt powder, yoghurt preparations, yoghurt preparations containing fruit, yoghurt products, yoghurts containing or flavoured with custard, yoghurts containing pulped fruits.

Class 30:

Frozen yoghurt [confectionery ices], yoghurt (frozen-) [confectionery ices], yoghurt based ice cream [ice cream predominating].

2. On 15 September 2010, Compagnie Gervais Danone ("Danone") filed a notice of opposition. This consists of a single ground based upon section 5(2)(b) of the Trade Marks Act 1994 ("the Act"), directed, I note, against all of the goods in Mr Norman's application for registration. Danone relies upon the following trade mark:

Trade Mark	No.	Designation date	Protection date	Goods
ZEN	M811456	21.05.2003 IC date 6.01.2003, France	17.09.2006	Class 29 - Milk, powdered milk, flavoured jellified milks and whipped milk products; dairy products namely milk desserts, yoghurts, drinking yoghurts, mousses, creams, cream desserts, fresh cream, butter, cheese spreads, cheeses, ripened cheeses, mould-ripened cheese, fresh unripened cheeses and pickled cheeses, soft white cheese, plain or aromatised fresh cheese in paste or liquid form; beverages mainly consisting of milk or dairy products, milk beverages, mainly of milk, milk beverages containing fruits; plain or flavoured fermented dairy products.

3. On 17 November 2010, Mr Norman filed a counterstatement in which the ground of opposition is denied. In his counterstatement Mr Norman says inter alia:

“Comparison of Marks

The mark contained [in the application] is a figurative mark in a highly stylised form. The opponent’s mark consists of the word ZEN in capital letters and bold print...

Visually, the prominent and dominant element of the applicant’s mark is the highly stylised word Yo. The word Zen is in lower case and in smaller print and on a circular background and consists of five letters. The opponent’s mark consists of the word ZEN, being three letters in bold print. In view of the highly stylised form of the applicant’s mark it is denied that the respective marks are similar.

Aurally, the applicant’s mark consists of two syllables and would be pronounced as Yo/Zen. The opponent’s mark consists of three letters and one syllable and would be pronounced as Zen. In view of the aural differences between the respective marks, the marks are not similar.

Conceptually, the applicant's mark has no meaning, whereas the opponent's mark Zen would be seen as some form of Japanese religious meditation.

Comparison of the goods

The applicant's goods are yoghurt and products made from or containing yoghurt. The opponent's class 29 goods are in the main, milk/milk and dairy products. The product sold by the opponent under the ZEN mark has been described as a "magnesium-rich milk drink", as indicated in the enclosed extract from the website "Beveragedaily.com. As the nature, method and purpose of use of the opponent's Zen products are not the same as those of the applicant's goods, the respective goods are not similar."

The extract referred to consists of a page downloaded on 21 September 2010 from www.beveragedaily.com and relates to an article dated 2 July 2004 entitled "Danone launches new, magnesium-rich milk drink". The page explains that Danone have launched a novel dairy concept on the Belgian market. An extract from the article reads:

"Zen is targeted at the whole family and is particularly well adapted for people wishing to relax at the end of the day..."

4. Both parties filed evidence. Neither party asked to be heard; Danone filed written submissions in lieu of attendance at a hearing; I will refer to these submissions as necessary below.

Danone's evidence

5. This consists of a witness statement from Linda Bray, a trade mark attorney at Wildbore & Gibbons, Danone's professional representatives in these proceedings. The main purpose of Ms Bray's statement (and the associated exhibits LAB1, 2 and 3), appears to be to confirm the existence of the trade mark upon which Danone relies in these proceedings. Insofar as it is necessary, I will return to this point later in this decision.

Mr Norman's evidence

6. This consists of a witness statement from Graham Stephens who is a director of FCLS Group Limited, Mr Norman's professional representatives in these proceedings. Mr Stephen's statement consists of a mixture of fact and submission. While it is neither necessary nor appropriate for me to summarise the submissions here, I will keep them in mind when reaching a decision. The main points emerging from Mr Stephen's statement are, in my view:

- Mr Norman has worked for 25 years in the food sector, developing and bringing to the market food related products and brands. The last 8 years have been spent developing food products exclusively for the health food sector;
- The idea for a frozen yoghurt product came about after recognising a need in the market for a natural healthy indulgent “treat”;
- The brand name YOzen is a play on the word Frozen;
- Zen would not be used in isolation in any brand communication to market the YOzen brand;
- Exhibit GS1 consists of a single page downloaded on 24 February 2011 from www.new-nutrition.com. I note that the article (which appears to date from October 2004) and which is entitled: “Danone helps Ireland find the way to Zen”, refers to a: “100g daily dose Zen yoghurt drink” and comments that it contains “regular” yoghurt cultures”;
- Exhibit GS2 consists of what Mr Stephens describes as an article from Food and Drinks magazine (which appears to date from April 2010). The article (which appears to consist of “peter-wennstroms-observations-from-portugal”) contains the following text:

“That Danone’s innovation strategy par preference is New Segment creation becomes obvious when we bring in their failures to account: Danone Zen was a relaxation yoghurt and Danone’s Essensis was a skin health yogurt. Both failed, not because a lack of consumer demand but because of a lack of credibility for the new benefit under the Danone brand and also in both cases, a lack of understanding of the actual benefit.”

- Exhibit GS3 consists of a list of nine trade marks namely: FROZENGE/FROZENGES, ZENSE, ZENKY, ZENU, VEZEN, ZEN CAFÉ (and device), Zenya, ZEN DELI and ZENZI of which Mr Stephens says:

“Searches of the Trade Mark registry identify several registered marks with ZEN in the title who also list either ices or frozen dairy products in their classification. All of these marks have co-existed alongside the ZEN brand for many years without confusion to the public.”

7. In its written submissions Danone said:

“6. (iii) Exhibit GS3 consists of several registered marks with ZEN in the title who also list either ices or frozen dairy products in their classifications. No evidence has been filed that any of the marks in question are in use in the UK. Their presence on the Register is irrelevant to this opposition.”

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

“68. As regards the search of the Cedelex 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.”

9. 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 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*. I also note that in his judgment Mr Alexander referred to the *Madame* case being 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 considered that the principle of not giving weight to state-of-the-register evidence also applies in cases involving relative grounds issues. In short, I agree with Danone that the state-of-the-register evidence does not assist Mr Norman.

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

DECISION

11. The opposition is based upon section 5(2)(b) of the Act which reads as follows:

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

(a)....

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

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

12. 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.”

13. In these proceedings Danone is relying upon the trade mark shown in paragraph 2 above. This constitutes an earlier trade mark under the above provisions and is not (given the interplay between the date on which Mr Norman’s application was published and the date on which protection was conferred on Danone’s earlier trade mark) subject to proof of use, as per The Trade Marks (Proof of Use, etc) Regulations 2004.

Section 5(2)(b) – case law

14. The leading authorities which guide me are from the CJEU (Court of Justice of the European Union): *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77, *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* C-334/05 P (LIMONCELLO). It is clear from these cases that:

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

(b) the matter must be judged through the eyes of the average consumer for the goods/services in question; *Sabel BV v Puma AG*, who is deemed to be reasonably well informed and reasonably circumspect and observant -but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind; *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*,

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v Puma AG*,

(d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v Puma AG*,

(e) assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark; the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*

(f) it is only when all other components of a complex mark are negligible that it is permissible to make the comparison on the basis of the dominant element; *Shaker di L. Laudato & C. Sas v OHIM*.

(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*,

(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*,

(i) in determining whether similarity between the goods or services covered by two trade marks is sufficient to give rise to the likelihood of confusion, the distinctive character and reputation of the earlier mark must be taken into account; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,

(j) 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*,

(k) 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 and Adidas Benelux BV*,

(l) 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*.

The average consumer and the nature of the purchasing process

15. 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. The relevant goods at issue in these proceedings are yoghurts, goods made from or containing yoghurt, and preparations made from or for making into yoghurt. These are goods which will primarily be bought by the public at large; they then are the average consumer for such goods.

16. As to the manner in which the majority of the goods are likely to be selected by the average consumer, this is most likely to consist of a visual act made on the basis of self selection in, for example, either a retail environment such as a supermarket or on-line. In its written submissions Danone describe the goods at issue as “inexpensive food products”; I agree. In my experience the vast majority of the goods at issue are likely to be purchased on a fairly regular basis by an average consumer who will wish to ensure they select, for example, the correct style, flavour and size of yoghurt they prefer. The need to consider these factors will, in my view, counteract to some extent the low cost of the goods at issue, resulting in the average consumer displaying a reasonable level of attention to their selection.

Comparison of goods

17. For the sake of convenience, the goods to be compared are as follows:

Danone’s goods	Mr Norman’s goods
<p>Class 29</p> <p>Milk, powdered milk, flavoured jellified milks and whipped milk products; dairy products namely milk desserts, yoghurts, drinking yoghurts, mousses, creams, cream desserts, fresh cream, butter, cheese spreads, cheeses, ripened cheeses, mould-ripened cheese, fresh unripened cheeses and pickled cheeses, soft white cheese, plain or aromatised fresh cheese in paste or liquid form; beverages mainly consisting of milk or dairy products, milk beverages, mainly of milk, milk beverages containing fruits; plain or flavoured fermented dairy products.</p>	<p>Class 29</p> <p>Beverages made from yoghurt, beverages made from yoghurts, custard style yoghurts, desserts made from yoghurt, desserts made from yoghurt with fruit additives, desserts made from yoghurt with herb additives, drinks containing yoghurt and soda, the yoghurt predominating, flavoured yoghurts, food products containing yoghurt, foodstuffs containing frozen yoghurt [as the main constituent], fruit flavoured yoghurts, low fat yoghurts, natural fruit flavoured yoghurt, preparations for making yoghurt, preparations made from yoghurt, prepared desserts made from yoghurt with fruit pastry additives, prepared desserts made from yoghurt with herbs additives, prepared desserts made from yoghurt with pastry additives, set yoghurt, soya yoghurt, yoghurt, yoghurt based drinks, yoghurt beverages, yoghurt desserts, yoghurt drinks, yoghurt made from goats milk, yoghurt powder, yoghurt preparations, yoghurt preparations containing fruit, yoghurt products, yoghurts containing or flavoured with custard, yoghurts containing pulped fruits.</p>

	<p>Class 30</p> <p>Frozen yoghurt [confectionery ices], yoghurt (frozen-) [confectionery ices], yoghurt based ice cream [ice cream predominating].</p>
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18. I note that in his counterstatement Mr Norman describes his goods as “yoghurt and products made from or containing yoghurt”. Danone’s earlier trade mark contains references to “yoghurts” and “drinking yoghurts” at large. Equivalent terms can be found in Mr Norman’s specification i.e. “beverages made from yoghurt”, “beverages made from yoghurts”, “drinks containing yoghurt and soda, the yoghurt predominating”, “yoghurt”, “yoghurt based drinks”, “yoghurt beverages”, “yoghurt drinks”. The goods that remain are either yoghurts of one sort or another i.e. “custard style yoghurts”, “flavoured yoghurts”, “fruit flavoured yoghurts”, “low fat yoghurts”, “natural fruit flavoured yoghurt”, “set yoghurt”, “soya yoghurt”, “yoghurt desserts”, “yoghurt made from goats milk”, “yoghurts containing or flavoured with custard”, “yoghurts containing pulped fruits”, “frozen yoghurt” (all of which would fall within the term “yoghurt” at large and would be considered identical), or are (broadly speaking) goods made from or containing yoghurt or preparations made from or for making into yoghurt. In my view, the competing goods at issue in these proceedings are either identical, or if not identical they are, given the commonality of their uses, users, nature and the respective trade channels through which the respective goods are likely to reach the market, similar to a high degree.

19. In an official letter dated 7 June 2011, the TMR advised the parties:

“The Hearing Officer will decide the case on the specification currently before him. The applicant may wish to submit a limited specification which will be borne in mind by the Hearing Officer in reaching the decision. This will not represent a binding restriction of the specification”.

20. In response to the above, Mr Stephens, in a letter to the TMR dated 30 June 2011 said, inter alia:

“My client wishes to clarify their foodstuff in class 29. They only deal in frozen dairy produce therefore they are prepared to limit their description to frozen produce to include yoghurts, ice creams, ices and associated dairy produce.

As far as my client is aware the proprietor of Zen does not appear to market frozen dairy produce in the UK and, if this be the case, would put forward this amendment to their classification to further add distinction to their application.”

I note that this letter was copied to Wilbore & Gibbons and that they chose not to comment upon it in their written submissions dated 5 July.

21. Mr Stephen’s letter suggests that as Mr Norman is only currently trading in frozen dairy products, a suitable limitation to his specification of goods in class 29 to reflect this may assist. The starting point must be that all of the goods specified in Mr Norman’s

application for registration are either yoghurts of one sort or another, are goods made from or containing yoghurt or are preparations made from or for making into yoghurt. Unfrozen yoghurt and foodstuffs made from unfrozen yoghurt are proper to class 29 (the reference to “foodstuffs containing frozen yoghurt [as the main constituent]” which appears in class 29 of Mr Norman’s application is an error as these goods are proper to class 30); as soon as yoghurt is frozen (whether on its own or as part of another foodstuff) it becomes proper to class 30. In addition, and notwithstanding Mr Stephen’s suggestion, there are, in my view, some goods contained in Mr Norman’s specification in class 29 which are unlikely to be frozen and to which his limitation could not be realistically applied i.e. beverages made from yoghurt, beverages made from yoghurts, drinks containing yoghurt and soda, the yoghurt predominating, yoghurt based drinks, yoghurt beverages, yoghurt drinks and yoghurt powder.

22. If I have understood Mr Stephen’s letter correctly (and the comment in his witness statement in which he refers to “the idea for a frozen yoghurt product” appears to support my understanding of the position), it appears that Mr Norman may only actually have been interested in securing registration for, for example, frozen yoghurt and products made from or containing frozen yoghurt. If that is correct (and keeping in mind the specifications as originally filed), it may be that Mr Norman’s application should have been filed solely in class 30 with a specification reading:

“Frozen yoghurt [confectionery ices], yoghurt based ice cream, foodstuffs containing frozen yoghurt [as the main constituent]”.

23. If that was what Mr Norman intended, and had the application been published in this manner (with the “foodstuffs containing frozen yoghurt” published in the correct class), then it still would not, in my view, have assisted him. I say that because if frozen yoghurt and foodstuffs containing frozen yoghurt in class 30 are not identical goods to unfrozen yoghurt and foodstuffs containing unfrozen yoghurt in class 29 they must, in my view, given their uses, users, nature and the respective trade channels through which the respective goods are likely to reach the market, be regarded as similar to a high degree. In short, the suggested limitation does not assist to differentiate the goods of Mr Norman from those of Danone.

Comparison of trade marks

24. The trade marks to be compared are:

Danone’s trade mark	Mr Norman’s trade mark
ZEN	

25. The average consumer is considered to be reasonably well informed, circumspect and observant but perceives trade marks as wholes and does not pause to analyse their

various details. In addition, he rarely has the chance to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has kept in his mind. In reaching a conclusion on similarity, I must identify what I consider to be the distinctive and dominant components of the respective trade marks and, with that conclusion in mind, I must then go on and compare the respective trade marks from the visual, aural and conceptual perspectives.

Distinctive and dominant components

26. Danone's trade mark consists of the word ZEN presented in upper case. As no part of the trade mark is emphasised or highlighted in any way, its distinctiveness must lie in its totality.

27. Turning now to Mr Norman's trade mark, this consists of a number of elements namely, a stylised letter Y and a device which from Mr Stephen's statement (i.e. "the brand name YOzen is a play on the word frozen") is clearly intended to be construed by the average consumer as a letter O (albeit one containing a device of a heart). Also present to the top right of the O device is the word Zen contained in a circle. The remaining elements are the shadow effect under both the letters YO and the circle containing the word Zen. In his counterstatement Mr Norman said:

"Visually, the prominent and dominant element of the applicant's mark is the highly stylised word Yo..."

28. In its submissions Danone said:

"10. The mark applied for is the words YO ZEN in a stylised form. Despite the stylisation of the mark, the mark is clearly the words YO ZEN. Moreover, there is nothing distinctive about the pictorial elements of the mark. The letters at the beginning of the mark applied for, YO, are likely to be taken by consumers to indicate yoghurt. Hence, the mark applied for consists of the non-distinctive letters YO followed by the highly distinctive mark ZEN. Accordingly, when used in relation to the goods covered by the application, the part of the mark which is most likely to stick in the mind of a customer or potential customer is the word ZEN. ZEN is the dominant and most distinctive component of the mark applied for."

29. Given both its size and positioning, the YO element is, in my view, the dominant element of Mr Norman's trade mark. In its submissions Danone argue that the average consumer would construe this element as a reference to yoghurt. However, this is not a form of usage with which I (as a consumer of the goods) am familiar and, in the absence of evidence to support such an assertion, it remains just that, assertion. Consequently, the YO element is, in my view, both distinctive and the dominant element of Mr Norman's trade mark. Turning to the other elements in the trade mark, I very much doubt the average consumer will (if they notice them at all) place any reliance on

the areas of shadow I have mentioned above. That leaves the word Zen contained in a circle. In its written submissions Danone said:

“The trade mark ZEN is highly distinctive for the goods covered by the International registration and the application...”

30. As the word Zen neither describes nor is non-distinctive for the goods contained in either parties' specifications, it is, I agree, distinctive. In *Matratzen Concord GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-6/01 the Court of First Instance (now the General Court (GC)) said:

“30. In that regard, it should be pointed out, in general terms, that two marks are similar when, from the point of view of the relevant public, they are at least partially identical as regards one or more relevant aspects. As the Court's case-law indicates, the visual, aural and conceptual aspects are relevant (SABEL, paragraph 23, and Lloyd Schuhfabrik Meyer, paragraph 25).

31. In this case, the word 'Matratzen' is both the earlier trade mark and one of the signs of which the trade mark applied for consists. It must therefore be held that the earlier mark is identical, from a visual and aural point of view, to one of the signs making up the trade mark applied for. However, that finding is not in itself a sufficient basis for holding that the two trade marks in question, each considered as a whole, are similar.

32. In this context, the Court of Justice has held that the assessment of the similarity between two marks must be based on the overall impression created by them, in light, in particular, of their distinctive and dominant components (SABEL, paragraph 23, and Lloyd Schuhfabrik Meyer, paragraph 25).

33. Consequently, it must be held that a complex trade mark cannot be regarded as being similar to another trade mark which is identical or similar to one of the components of the complex mark, unless that component forms the dominant element within the overall impression created by the complex mark.

34. It should be made clear that that approach does not amount to taking into consideration only one component of a complex trade mark and comparing it with another mark. On the contrary, such a comparison must be made by examining the marks in question, each considered as a whole. However, that does not mean that the overall impression created in the mind of the relevant public by a complex trade mark may not, in certain circumstances, be dominated by one or more of its components.

35. With regard to the assessment of the dominant character of one or more given components of a complex trade mark, account must be taken, in particular, of the intrinsic qualities of each of those components by comparing them with those of other components. In addition and accessorially, account may be taken of

the relative position of the various components within the arrangement of the complex mark. “

31. In *Medion AG v Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, the CJEU said:

“29. In the context of consideration of the likelihood of confusion, assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark. On the contrary, the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components (see *Matratzen Concord*, paragraph 32).

30. However, beyond the usual case where the average consumer perceives a mark as a whole, and notwithstanding that the overall impression may be dominated by one or more components of a composite mark, it is quite possible that in a particular case an earlier mark used by a third party in a composite sign including the name of the company of the third party still has an independent distinctive role in the composite sign, without necessarily constituting the dominant element.

31. In such a case the overall impression produced by the composite sign may lead the public to believe that the goods or services at issue derive, at the very least, from companies which are linked economically, in which case the likelihood of confusion must be held to be established.

32. The finding that there is a likelihood of confusion should not be subject to the condition that the overall impression produced by the composite sign be dominated by the part of it which is represented by the earlier mark.

33. If such a condition were imposed, the owner of the earlier mark would be deprived of the exclusive right conferred by Article 5(1) of the directive even where the mark retained an independent distinctive role in the composite sign but that role was not dominant.

34. This would be the case where, for example, the owner of a widely-known mark makes use of a composite sign juxtaposing this mark and an earlier mark which is not itself widely known. It would also be the case if the composite sign was made up of the earlier mark and a widely-known commercial name. In fact, the overall impression would be, most often, dominated by the widely-known mark or commercial name included in the composite sign.

35. Thus, contrary to the intention of the Community legislator expressed in the 10th recital in the preamble to the directive, the guarantee of the earlier mark as

an indication of origin would not be assured, even though it still had an independent distinctive role in the composite sign.

36. It must therefore be accepted that, in order to establish the likelihood of confusion, it suffices that, because the earlier mark still has an independent distinctive role, the origin of the goods or services covered by the composite sign is attributed by the public also to the owner of that mark. “

32. While I accept that the word Zen is not the dominant element of Mr Norman’s trade mark, it is, in my view, an element which retains an independent distinctive role within it. I will approach the comparison of the competing trade marks with that conclusion in mind.

Visual similarity

33. Mr Norman’s views can be found in paragraph 3 above. In its submissions Danone said:

“12. Visually, the marks are similar because the mark applied for, despite its stylisation, is still primarily a word mark and there is a clear visual similarity between YO ZEN and ZEN.”

34. While the competing trade marks either consist of, or contain the word Zen as an independent distinctive element, the significant visual differences between the competing trade marks results, in my view, in only a relatively low level of visual similarity between them.

Aural similarity

35. In his witness statement Mr Stephens said:

“Aurally, the applicant’s mark consists of one syllable with five letters and would be pronounced as Yozen. The opponent’s mark consists of three letters and one syllable and would be pronounced as Zen.”

36. In its submissions Danone said:

“13. Phonetically, there is also similarity between the marks because, apart from the word YO, the marks are obviously phonetically identical.”

37. As a single word which is likely to be known to the average consumer, one can predict the manner in which Danone’s trade mark will be pronounced. However, the position is not so clear cut in relation to Mr Norman’s trade mark. Although Mr Stephens says above it will be pronounced as the single syllable word Yozen, given my finding above regarding the independent distinctive role the word Zen will play in Mr Norman’s trade mark, it is equally likely, in my view, that the average consumer will see Mr

Norman's trade mark as consisting of two separate elements, and would pronounce it as such with a pause between the words YO and ZEN. In the counterstatement Mr Stephens took a similar view when he said:

“ Aurally, the applicant's mark consists of two syllables and would be pronounced as Yo/Zen”.

If pronounced in the second manner suggested by Mr Stephens, I accept the degree of aural similarity between the competing trade marks will be somewhat lower than if articulated in what he originally considered the position to be (and what I agree is an equally plausible manner). In my view, Mr Stephen's original view of the matter results in a reasonable degree of aural similarity between the competing trade marks.

Conceptual similarity

38. Mr Norman's views on this aspect of the comparison are reproduced in paragraph 3 above. In its written submissions Danone said:

“14. The word Zen is defined as a “Japanese school of Mahayana Buddhism emphasising the value of meditation and intuition rather than ritual worship, or study of scriptures”. It is likely to be perceived by customers as such or, as proposed by Mr Stephens in his witness statement, as a form of Japanese religious meditation. The word YO is non-distinctive and, at most, may indicate yoghurt to consumers. The marks ZEN and YO ZEN are hence very similar conceptually.”

39. I have already commented and rejected Danone's argument regarding the YO element of Mr Norman's trade mark. However, I have also found that the Zen element plays an independent distinctive role within it. While in my view the YO element is unlikely to convey any conceptual meaning to the average consumer, the presence of the word Zen (meaning a form of meditation) in both parties' trade marks is likely to be fairly well known to the average consumer and will, I think, trigger similar conceptual images in the average consumer's mind.

Distinctive character of Danone's earlier trade mark

40. I must now assess the distinctive character of Danone's earlier trade mark. The distinctive character of a trade mark must be appraised first by reference to the goods in respect of which it has been registered and, second, 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. I have already concluded

above that the word Zen is neither descriptive of nor non-distinctive for the goods for which it stands registered. Although not in the category of an invented word, it is, absent use, a trade mark possessed of a fairly high degree of inherent distinctive character.

Likelihood of confusion

41. In determining whether there is a likelihood of confusion, I need to bear a number of factors 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. It is also necessary for me to keep in mind the distinctive character of Danone's earlier 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.

42. Earlier in this decision I concluded, inter alia, that: (i) the average consumer was the public at large, (ii) the goods at issue were identical or highly similar and would be purchased by primarily visual means (iii) while the word YO was a distinctive and dominant element of Mr Norman's trade mark the word Zen retained an independent and distinctive role within it, (iv) there was a relatively low degree of visual similarity and (v) a reasonable degree of aural similarity, (vi) the presence of the word Zen in both trade marks was likely to trigger similar conceptual images in the average consumer's mind, and (vii) Danone's earlier trade mark was possessed of a fairly high degree of inherent distinctive character.

43. While I have accepted that the word Zen is not the dominant component of Mr Norman's trade mark, it retains, in my view, an independent distinctive role within it. In those circumstances, the comments in *Medion* make it clear that the average consumer may believe that the goods at issue come, at the very least, from companies which are economically linked. Taking the above into account and applying it to the facts of these proceedings, I have concluded that there is a likelihood of indirect confusion and Danone's opposition succeeds.

Costs

44. As Danone has been successful, it is entitled to a contribution towards its costs. Awards of costs are governed by Annex A of Tribunal Practice Notice 4 of 2007. Using that TPN as a guide (and making no award to Danone for its evidence which consisted solely of documents showing its earlier right), I award costs to Danone on the following basis:

Preparing a statement and considering Mr Norman's statement:	£300
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Official fee:	£200
Considering Mr Norman's evidence:	£200
Written submissions:	£300
Total:	£1000

45. I order Paul Norman to pay to Compagnie Gervais Danone the sum of **£1000**. 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 23rd day of August 2011

C J BOWEN
For the Registrar
The Comptroller-General