

O-334-10

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION No 2497459  
BY ERSEN SALIH AND REBECCA MCGUIRE TO REGISTER THE TRADE  
MARK**

**YOG**

**IN CLASSES 21, 25, 29, 30, 32, 35 AND 43**

**AND IN THE MATTER OF OPPOSITION  
THERE TO UNDER NO 99188  
BY ARLA FOODS AB**

## **TRADE MARKS ACT 1994**

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by Ersen Salih and Rebecca McGuire to register the trade mark  
YOG in Classes 21, 25, 29, 30, 32, 35 and 43**

**and**

**IN THE MATTER OF Opposition thereto under No. 99188  
by Aria Foods AB**

## **BACKGROUND**

1) On 12 September 2008, Ersen Salih and Rebecca McGuire, c/o G Coulson, Braund & Fedrick Solicitors, 10 Hatherley Road, Sidcup, Kent DA14 4BQ applied under the Trade Marks Act 1994 for registration of the trade mark YOG in respect of goods and services in classes 21, 25, 29, 30, 32, 35 and 43. For the purposes of these proceedings, the relevant goods and services are:

### **Class 29**

Yoghurt, frozen yoghurt; preparations for making yoghurt; dairy products; fruits, vegetables and mushrooms, all being preserved, dried, canned, cooked or frozen; prepared meals; frozen prepared meals consisting principally of meat, fish, poultry or vegetables; all included in Class 29.

### **Class 30**

Frozen yoghurt and frozen yoghurt based desserts combined with fruit, nuts, cereal, rice cakes and sauces; ice-cream and ice-cream products. Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery, ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice.

### **Class 35**

Retail and wholesale services connected with the sale of frozen yoghurts, smoothies and shaved ice, snack bars, fruit and rice cake desserts.

### **Class 43**

Take-away services; counter service for the provision of take-away food; counter service for the provision of fast foods; counter service for the

provision of frozen yoghurts; restaurant services; cafe services; snack bar services; cafe, bar and bistro services.

2) The application was subsequently published on 6 March 2009 and on 8 June 2009, Arla Foods AB (“Arla”) of S-105 46 Stockholm, Sweden filed notice of opposition to the application. It relies on a single ground of opposition, namely that the application offends under Section 5(2)(b) of the Act because, in respect of the goods and services listed above (plus the Class 32 goods that were subsequently removed by voluntary amendment), it is similar to two of Arla’s earlier marks and it is in respect of identical or similar goods and services. The relevant details of Arla’s to earlier marks are reproduced below:

<b>Registration number and relevant dates</b>	<b>Mark</b>	<b>Goods and services</b>
Trade Mark 2292782  Filing date: 15 February 2002  Registration date: 4 February 2005	YOGGI	<b>Class 29:</b> Milk, edible cream, cheese, dried milk and condensed milk; yoghurt, fromage frais, milk based desserts; butter, edible oils and fats.  <b>Class 30:</b> Rice pudding.
International Trade Mark 830761  Date of international registration: 30 March 2004  Date of designation in UK: 30 March 2004	<b>YOGGI</b>	<b>Class 29:</b> Meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits; jams, jellies; eggs, milk and milk products; edible oils and fats; pickles.  <b>Class 30:</b> Sugar, flour and preparations made from cereals, bread and pastry; ices; honey, treacle; yeast, baking-powder; salt, mustard; pepper, vinegar, sauces; ice.

3) The applicants subsequently filed a counterstatement admitting that the following goods are identical:

<b>Class</b>	<b>Arla’s goods</b>	<b>Applicants’ goods</b>
29	Yoghurt	Yoghurt
29	Preserved, dried and cooked fruits	Fruits... all being preserved, dried, [or]...cooked
30	Sugar	Sugar
30	Flour and preparations made from cereals, bread and pastry	Flour and preparations made from cereals, bread and pastry

30	Vinegar, sauces, ice	Vinegar, sauces (condiments), ice
30	Honey, treacle; yeast, baking-powder; salt, mustard	Honey, treacle; yeast, baking-powder; salt, mustard
30	Ices	Ice

4) Further, the applicants also concede that the following goods are similar:

<b>Class</b>	<b>Arla's goods</b>	<b>Applicants' goods</b>
29	Milk and milk products	Dairy products
29	Preserved, dried and cooked fruits	Fruit being canned

5) The applicants deny the remainder of Aria's claims.

6) Both sides filed evidence in these proceedings. Both sides ask for an award of costs. The matter came to be heard on 22 July 2010 when Arla was represented by Mr Douglas Campbell of Counsel, instructed by Murgitroyd & Company and the applicants represented by Ms Isabel Jamal of Counsel, instructed by Bristows. The applicants also submitted written submissions that I will keep these in mind.

### **Opponent's Evidence**

7) This takes the form of two witness statements. The first of these is by Mark John Hickey, Trade Mark Attorney and Director in the firm of Murgitroyd & Company, Aria's representatives in these proceedings. Mr Hickey recounts details of his visit to a Sainsbury supermarket on 25 September 2009. The part of the chilled dessert aisle dedicated to the sale of yoghurts contained about fifty percent of Sainsbury own-branded products. The remaining products were branded yoghurts but Mr Hickey observed that none of these brands incorporated the prefix YOG. He repeated this exercise at the nearby Waitrose supermarket where, once again, none of the yoghurts.

8) At Exhibit MJH1, Mr Hickey provides extracts from the online dictionary [www.askoxford.com](http://www.askoxford.com) (published by Oxford University Press) providing the following definitions:

#### **yoghurt**

**noun** a semi-solid slightly sour food prepared from milk fermented by added bacteria

#### **smoothie**

**noun** [...] 2. N. Amer. & Austral./NZ a thick, smooth drink of fresh fruit puréed with milk, yoghurt, or ice cream.

**ice**

**Noun** [...] 2. Chiefly Brit. An ice cream or water ice.

9) The second witness statement is by Claire Huntington, Product Business Unit Director for Arla Foods Limited. She explains that her company and the opponent are companies related by shareholding and that she has access to all relevant files and records pertaining to the use of the mark YOGGI.

10) Ms Huntington states that YOGGI was first used in the UK in 2006 and there was continuous use until around June 2008. Sales were made through major UK supermarkets including Netto, Morrisons, Co-op and Asda. Sales turnover was as follows:

2006 (September – December)	£51,788
2007	£240,073
2008 (January – July)	£46,348

### **Applicant's Evidence**

11) This is in the form of two witness statements. The first of these, dated 4 February 2010, is by Ersen Salih, co-founder (together with the other applicant, Ms Rebecca McGuire) of Yog Ltd, a UK company responsible for the manufacture and distribution of YOG branded frozen yoghurt. He explains that, as the contested application was made before the company was incorporated, he and Ms McGuire applied in their joint names.

12) He explains that the mark YOG was conceived in late 2006 as it was a simple, yet catchy mark that was allusive in respect of their core product. After nine months of product development, the YOG mark was first used on frozen yoghurt sold at small festivals around the UK in the summer of 2007. A retail outlet was opened in London in April 2008, with two more following in 2009.

13) Mr Salih explains that he has asked five to ten customers a day for the previous three months and at least ten customers a week for the previous year. He does not elaborate on what it was he asked. He states that none of these customers have heard of YOGGI and neither have they associated YOG with it. He also states that, in almost three years of trading, he is not aware of a single incident of consumer confusion involving the respective marks.

14) Mr Salih also states that the YOG product was pitched to Waitrose in September 2008 and that its team had no apparent awareness of YOGGI products. He also states that he has asked Jane Jonas, a recruitment consultant specialising in the food industry sector, if she had heard of YOGGI. She stated that she had not heard of it and, further, that she would not relate or confuse the YOGGI mark with YOG in any way.

15) Mr Salih has also asked a number of branding professionals for their expert opinion and all agreed that there is no likelihood of confusion between YOG and YOGGI. One of these branding professionals is Juan Scott who has provided a witness statement, dated 4 February 2010. He explains that he has worked in the advertising and branding industry for over twenty years and he now runs his own brand consultancy business. Whilst recording that he has advised the applicants on branding issues, he stresses that his views are based upon objective analysis and honestly held professional opinions.

16) Mr Scott explains the important issues during the development of a new brand including the need for the brand name to be distinctive but, ideally, subtly alluding to the product. Part of his role in this process is to assess potential names from the point of view of whether they are likely to cause consumer confusion with other, existing brands. In his capacity as a brand development specialist, he has been asked to consider the two brands YOG and YOGGI. He states that it is his opinion there would be no likelihood of confusion. He further states that many people he has spoken to pronounce the “o” in YOGGI as a long syllable (as in “home”), further distancing it from YOG (as in “dog”).

17) Both witness statements also contain a number of submissions that I will not detail here, but I will bear in mind.

### **Opponent’s Evidence in reply**

18) Arla did not file any evidence of fact, but did file submissions in reply. I will not detail these here, but I will bear them in mind.

## **DECISION**

### **Preliminary point**

19) Arla objected to Ms Jamal’s inclusion of a reference to two video clips viewable on the *YouTube* website and purportedly showing television adverts for Arla’s YOGGI product. Ms Jamal argued that these were relevant as they demonstrated that when Arla markets these products, it does so where YOGGI is pronounced as YO-GI with a long “o”. Both are clearly targeted at a non-UK audience (possibly Swedish) and did not enlighten me as to how the goods are marketed, if at all, to UK consumers. As such, they are not relevant to the proceedings. I, therefore, declined to admit these into the proceedings.

### **Section 5(2)(b)**

20) Section 5(2)(b) reads:

“(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,

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

21) 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), 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.”

22) Of potential relevance to a ground of opposition under Section 5(2) are the provisions that relate to proof of use. Section 6A(1) details the circumstances where these provisions apply:

**“6A Raising of relative grounds in opposition proceedings in case of non-use**

(1) This section applies where –

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

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.”

23) Arla relies upon two earlier rights, both have completed registration procedures and are therefore earlier marks within the meaning of Section 6(1)(a). Further, their registration procedures were completed less than five years before the publication of the applicants’ mark and, as such, are not subject to the proof of use provisions.

24) In my consideration of a likelihood of confusion, I take into account the guidance from the settled case law provided by the European Court of Justice (ECJ) in *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] FSR. 77, *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] ETMR 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 of 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) 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*,
- (f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either *per se* or because of the use that has been made of it; *Sabel BV v Puma AG*,
- (g) 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*,
- (h) 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*,

(i) 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*,

(j) 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.*

(k) 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*

(l) 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 (LIMONCELLO)*

### ***Comparison of goods and services***

25) In assessing the similarity of goods and services, it is necessary to apply the approach advocated by case law and all relevant factors relating to the respective goods and services should be taken into account in determining this issue. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the ECJ stated at paragraph 23:

‘In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, *inter alia*, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary.’

26) Other factors may also be taken into account such as, for example, the distribution channels of the goods concerned (see, for example, *British Sugar Plc v James Robertson & Sons Limited (TREAT)* [1996] RPC 281).

27) For ease of reference, the offending goods and services are listed below, together with Arla’s goods that, for convenience, I have provided in a single list:

Arla's goods	Applicants' relevant goods and services
<p><b>Class 29:</b> Milk, edible cream, cheese, dried milk and condensed milk; yoghurt, fromage frais, milk based desserts; butter, edible oils and fats. Meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits; jams, jellies; eggs, milk and milk products; edible oils and fats; pickles.</p> <p><b>Class 30:</b> Rice pudding. Sugar, flour and preparations made from cereals, bread and pastry; ices; honey, treacle; yeast, baking-powder; salt, mustard; pepper, vinegar, sauces; ice.</p>	<p><b>Class 29:</b> Yoghurt, frozen yoghurt; preparations for making yoghurt; dairy products; fruits, vegetables and mushrooms, all being preserved, dried, canned, cooked or frozen; prepared meals; frozen prepared meals consisting principally of meat, fish, poultry or vegetables; all included in Class 29.</p> <p><b>Class 30:</b> Frozen yoghurt and frozen yoghurt based desserts combined with fruit, nuts, cereal, rice cakes and sauces; ice-cream and ice-cream products. Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery, ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice.</p> <p><b>Class 35:</b> Retail and wholesale services connected with the sale of frozen yoghurts, smoothies and shaved ice, snack bars, fruit and rice cake desserts.</p> <p><b>Class 43:</b> Take-away services; counter service for the provision of take-away food; counter service for the provision of fast foods; counter service for the provision of frozen yoghurts; restaurant services; cafe services; snack bar services; cafe, bar and bistro services.</p>

28) The applicants have conceded that its *yoghurt, fruits... all being preserved, dried, [or]...cooked* in Class 29 and its *sugar, flour and preparations made from cereals, bread and pastry and honey, treacle, yeast, baking-powder, salt, mustard, vinegar, sauces (condiments), ice* in Class 30 are identical to goods in Arla's registrations and I do not intend to consider these comparisons further. In addition, at the hearing, Mr Campbell confirmed that Arla no longer wished to pursue the opposition insofar as it relates to *prepared meals; frozen prepared*

*meals consisting principally of meat, fish, poultry or vegetables and fruits [...] being frozen; vegetables and mushrooms, all being preserved, dried, canned, cooked or frozen in Class 29 and coffee, tea, cocoa, [...], rice, tapioca, sago, artificial coffee; [...] confectionery, [...]; spices in Class 30. As such, I have no need to comment on these.*

#### The applicants' Class 29 goods

29) Firstly, it is important to remember the guidance provided by the General Court (GC) in *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) ("Meric")* Case T-133/05, where, at para 29, it is stated:

"In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 *Oberhauser v OHIM – Petit Liberto (Fifties)* [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 *Vedial v OHIM – France Distribution (HUBERT)* [2002] ECR II-5275, paragraphs 43 and 44; and Case T-10/03 *Koubi v OHIM – Flabesa (CONFORFLEX)* [2004] ECR II-719, paragraphs 41 and 42)."

30) Firstly, I consider the similarity or otherwise between Arla's *yoghurt, milk based desserts/products* and *ices* and the applicants' *frozen yoghurt* as this appears to be central to the dispute. Ms Jamal drew a distinction based upon the perceived health benefits of frozen yoghurt, when compared to Arla's goods, because they are a healthy, low fat treat or dessert. Further, she argues that, unlike *frozen yoghurt*, *chilled yoghurt* is eaten at breakfast, that they have different consumers because, on the one hand there are health conscious adults in cafes and boutique-stalls and, on the other hand, a broader demographic. She also identifies physical differences in texture and the difference between frozen and chilled products. In addition, Ms Jamal contended that *frozen yoghurt* is not similar to *milk based desserts* and *milk based products* because Arla's terms will be understood as referring to goods such as rice pudding and not frozen yoghurt.

31) Mr Campbell criticised this approach as being overly analytical and pointed out that *frozen yoghurt*, despite being frozen, is still *yoghurt* and is therefore identical. Further, he pointed out that yoghurt is no more than a fermented milk product and therefore is also covered by the terms *milk based desserts* and *milk based products*.

32) In considering these arguments, I am mindful of the guidance provided by the court that terms should be interpreted so as to reflect the circumstances of the

particular trade and the way the public would perceive the use (*Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32). Further, the public perception is relevant because the consumer must know the purpose of the description (*Animal Trade Mark* [2004] FSR 19) and words should be given their ordinary (rather than an unnaturally narrow) meaning (*Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd* (“*Beautimatic*”) [2000] FSR 267). Whilst these cases related to how to identify a fair specification when considering a claim of genuine use, the underlying principles are equally applicable here. With this guidance in mind, together with that provided in *Merix*, it is clear to me that the term *yoghurt* will be understood as including both chilled and frozen yoghurt. To conclude otherwise would be contrary to the guidance in both *Merix* and *Beautimatic*. Similarly, frozen yoghurt must be covered by the broad terms *milk based desserts* and *milk based products* as one of the primary ingredients of yoghurt (both chilled and frozen) is milk. Further, the average consumer recognises yoghurts and yoghurt products as dairy goods and this is further reinforced in retail outlets where yoghurts are generally displayed alongside other dairy based products, whether these are frozen or chilled. I therefore conclude that Arla’s *yoghurt*, *milk based desserts/products* and the applicants’ *frozen yoghurt* are identical.

33) Whilst I note the applicants’ concession that *fruits all being canned [...] frozen* are similar to *preserved, dried and cooked fruits*, I would go further. Its *fruits all being canned [...] or frozen* can include *cooked fruits* and are therefore identical when applying the guidance in *Merix*. Further, as canning and freezing are processes that are for the purpose of preserving, it follows that these goods are also identical to Arla’s *preserved [...] fruits*.

#### The applicants’ Class 30 goods

34) Next, I consider the applicants’ *frozen yoghurt and frozen yoghurt based desserts combined with fruit, nuts, cereal, rice cakes and sauces*. The explanatory note for Class 30 in WIPO’s International Classification of Goods and Services states that the class “includes mainly foodstuffs of plant origin...”. With this explanation in mind, it appears that the applicant’s goods are only proper to this Class (as opposed to Class 29 where it also lists *frozen yoghurt*) where they are predominantly made from cereals. That being the case, such goods would appear to be covered by Arla’s *preparations made from cereals*. If I am wrong in this analysis and the applicants’ goods are predominantly made from yoghurt, then there is a very high level of similarity with *yoghurt* and *milk based desserts* as covered by Arla’s Class 29 specification (and, in fact, it is unclear as to whether there are any differences).

35) The applicants argue that its *ice-cream and ice-cream products* are not similar to Arla’s products. I cannot agree. Arla provides a dictionary reference (see paragraph 8) illustrating that *ice* also describes *ice cream*. This being the case, it is clear that identical goods are involved. Even if I discount this dictionary

reference and accept the applicants' position that the term *ices* is understood as referring only to frozen water based confections, there is still a high level of similarity. The respective trade channels are often the same. Frozen confection manufacturers often produce confections based upon dairy products (such as ice cream) as well as frozen water based confections. Further, these occur in the same freezer areas of shops and are also in direct competition with each other. Whilst their nature may be slightly different, their intended purpose, of providing a frozen confection treat, is the same.

#### The applicants' Class 35 services

36) At the hearing, Mr Campbell contended that all the services listed in the applicants' Class 35 are similar to Arla's goods in that they all relate to the provision of frozen yoghurt and, therefore, the average consumer will be the same. I obtain guidance on the level of similarity between goods and the retail of the same goods from the ECJ in *Praktiker Bau- und Heimwerkermärkte C-418/02*. At paragraph 34 the ECJ identified that the objective of the retail trade is the sale of goods to consumers and that this includes, in addition to the legal sales transaction, all activity carried out by the trader for the purpose of encouraging the conclusion of such a transaction. Further, the GC in *Oakley, Inc v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-116/06 when considering goods in Class 18 and Class 25, and the retail of the same, stated:

“54 Clearly, in the present case, the relationship between the retail services and the goods covered by the earlier trade mark is close in the sense that the goods are indispensable to or at the very least, important for the provision of those services, which are specifically provided when those goods are sold. As the Court held in paragraph 34 of *Praktiker Bau- und Heimwerkermärkte*, paragraph 17 above, the objective of retail trade is the sale of goods to consumers, the Court having also pointed out that that trade includes, in addition to the legal sales transaction, all activity carried out by the trader for the purpose of encouraging the conclusion of such a transaction. Such services, which are provided with the aim of selling certain specific goods, would make no sense without the goods.”

37) Whilst the comments of the court were made in the context of comparing clothing with the retail of the same, the principle that the goods are indispensable, or at least important, for the provision of the retail service holds good in the current case. As such, I find that there is complementarity between Arla's *yoghurt, milk based desserts, milk products, preserved, dried and cooked fruits* [as this term includes *fruit desserts*], *preparations made from cereals, bread and pastry* [as this term includes *snack bars*] and *ice* and the applicants' *[r]etail and wholesale services connected with the sale of frozen yoghurts, smoothies and shaved ice, snack bars, fruit and rice cake desserts*. Taking this into account,

I find that the respective goods and services share a reasonably high level of similarity.

38) However, there is no obvious similarity between any of Arla's goods and the applicants' *[r]etail and wholesale services connected with the sale of [...] rice cake desserts*.

#### The applicants' Class 43 services

39) Once again, Mr Campbell contended that all of the applicants' services, covered by its specification in this class, are similar to Arla's goods. When considering the level of similarity, if any, I am mindful of the guidance in *Avnet Incorporated v Isoact Ltd* ("Avnet") [1998] FSR 16 where Jacob J (as he then was) says:

"In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase."

40) With this guidance in mind, the applicants' services of *[t]ake-away services; counter service for the provision of take-away food; counter service for the provision of fast foods; restaurant services; cafe services; snack bar services; cafe, bar and bistro services*, by virtue of producing food that may include food covered by Arla's earlier marks, share at least some similarity with Arla's goods. However, the nature and intended purpose of these services will be different to these goods because the services involve the preparation of the food and in respect of the restaurant and café-style services, they also involve the provision of a conducive environment for consuming food. Taking all of this into account, I conclude that the respective goods and services share a moderate level of similarity, but I would put it no higher than that.

41) The position is slightly different in respect of the applicants' *counter service for the provision of frozen yoghurts*. Here, a specific product is itemised and as such, the public will understand the term as relating specifically to frozen yoghurt. Here, as the food product provided as part of the service is specifically relating to goods listed in Arla's specification, the level of similarity is higher and I conclude that the respective goods and services share a moderately high level of similarity.

#### ***The average consumer***

42) As matters must be judged through the eyes of the average consumer (*Sabel BV v.Puma AG*, paragraph 23) it is important that I assess who the average consumer is for the goods and services at issue. All the respective goods and services are either everyday foods or the services of retailing such products or restaurant, café or take-away services.

43) The average consumer of such goods and services is reasonably observant, paying a reasonable degree of attention. The goods are generally of a relatively low cost and purchased in a retail environment or café with choice often being influenced by the general type of food required and on occasions without specific consideration to trade origin. The purchase will be a combination of visual and aural, with labels and other marks often being visible at the point of purchase. In respect of the services, take-away food and cafés are generally at the lower end of services relating to the provision of food to the consumer and as such, the purchasing act will involve the same or similar level of attention as the goods already discussed.

44) Restaurant services occupy a wider range in terms of cost and may involve a correspondingly wider range of attention on the part of the consumer when selecting such services.

### **Comparison of marks**

45) For ease of reference, the respective marks are:

Arla's mark	Applicants' mark
YOGGI	YOG

46) When assessing the extent of similarity between the respective marks, I must do so with reference to their visual, aural and conceptual similarities bearing in mind their distinctive and dominant components (*Sabel BV v. Puma AG*, para 23). From a visual perspective, the marks are similar in that the first three letters of Arla's mark are also the same three letters that comprise the applicants' mark. However, they differ in that Arla's mark also has the letters GI added to these first three letters. This results in a longer word and this difference is visually apparent. Taking these similarities and differences into account, I conclude that the marks share a moderately high level of visual similarity.

47) From an aural perspective, Arla's mark will be pronounced either as YOG-EE or YOO-GEE (where the letter "G" is pronounced as a "hard G"). The applicants' mark is pronounced as the single syllable YOG. There is an obvious element of similarity if Arla's mark is pronounced as in the first way. Here the first syllable of Arla's mark is pronounced in an identical way to the applicants' mark. When associated with yoghurt products, Arla's mark may be seen by the consumer as having some allusive quality and a "nod" to such products and will therefore be pronounced as YOG-EE with the first syllable mirroring the first syllable of the word "yoghurt". However, when it is used in respect of products not related to yoghurt, the second pronunciation is equally likely. Therefore, when used in respect of yoghurt products, the respective marks share a moderately high level of aural similarity, but that this level may be reduced slightly when used in respect to non-yoghurt based goods or in respect of services.

48) From a conceptual perspective, neither mark appears to have a dictionary meaning, however, I do note that the word “yogi” describes a person proficient in yoga<sup>1</sup> and that this is a similar word to Arla’s mark. However, any argument that the slightly different spelling present in Arla’s mark may go unnoticed and such a conceptual identity may attach itself to Arla’s mark is not persuasive. Applying the guidance provided Ms. Anna Carboni sitting as the Appointed Person in *Cherokee*, BL O-048-08, I can take judicial notice that a “yogi” is a person proficient at yoga, but I am not prepared to take such notice that the average consumer will know this. Therefore, neither mark, in totality, has any apparent concept in the minds of the average consumer. Both, though, are derived from the word “yoghurt”, but given this word’s descriptive context, I do not regard this as particularly significant. There is no relevant conceptual similarity or dissonance

49) Taking all of the above into account, I find that the respective marks share a moderately high level of similarity overall.

#### ***Distinctive character of the earlier trade mark***

50) I have to consider whether Arla’s marks have a particularly distinctive character either arising from the inherent characteristics of the marks or because of the use made of them. They both consist of the word YOGGI. This has no meaning. As an invented word it enjoys a reasonably high degree of inherent distinctive character, but taking account of its allusion to yoghurt and yoghurt based products, not the highest level of distinctive character.

51) I must also consider the effect of reputation on the global consideration of a likelihood of confusion under Section 5(2)(b) of the Act. However, whilst some turnover figures have been provided covering the period September 2006 to July 2008, these are modest in nature, totalling in the region of £338,000 for that period. It appears that the product provided under the mark is no longer available. In the absence of any more persuasive evidence, I must conclude that the inherent level of distinctive character is not enhanced through use.

#### ***Likelihood of confusion***

52) Mr Salih, in his witness statement, pointed out that it is significant that, when they made a pitch to the supermarket Waitrose, the buying team, with its specialist knowledge, did not mention the YOGGI brand or associate it in any way. He also referred to an “informal survey” that he undertook by questioning his customers and also his enquiries with Jane Jonas, a recruitment manager for the food manufacturing industry, to conclude that there is no confusion between the respective marks. In the case of the Waitrose team, Mr Campbell claims that

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<sup>1</sup> “yogi n.” The Concise Oxford English Dictionary, Twelfth edition . Ed. Catherine Soanes and Angus Stevenson. Oxford University Press, 2008. Oxford Reference Online. Oxford University Press. Intellectual Property Office. 28 July 2010 <<http://www.oxfordreference.com/views/ENTRY.html?subview=Main&entry=t23.e65847>>

such evidence carries no weight as Mr Salih has not provided any information regarding whom this team was composed of and, anyway, it does not necessarily follow that because they were silent on the issue, that they would have no concerns regarding potential confusion. He criticises the informal survey because Mr Salih has not provided any information regarding what questions he asked or in what circumstances they were asked and also that Arla have no opportunity to test the accuracy of this evidence. Similar criticisms were made of the evidence relating to Jane Jonas. All these criticisms are valid and, as such, I am minded to place little weight on this evidence.

53) In addition to the above criticism, generally there are concerns regarding a reliance on the absence of confusion in the marketplace. In particular, I am mindful of the following comments of Laddie J in *Compass Publishing BV v Compass Logistics Ltd* [2004] RPC 41 to which Mr Campbell directed me to at the hearing:

"22. It is frequently said by trade mark lawyers that when the proprietor's mark and the defendant's sign have been used in the market place but no confusion has been caused, then there cannot exist a likelihood of confusion under Article 9.1(b) or the equivalent provision in the Trade Marks Act 1994 ("the 1994 Act"), that is to say s. 10(2). So, no confusion in the market place means no infringement of the registered trade mark. This is, however, no more than a rule of thumb. It must be borne in mind that the provisions in the legislation relating to infringement are not simply reflective of what is happening in the market. It is possible to register a mark which is not being used. Infringement in such a case must involve considering notional use of the registered mark. In such a case there can be no confusion in practice, yet it is possible for there to be a finding of infringement. Similarly, even when the proprietor of a registered mark uses it, he may well not use it throughout the whole width of the registration or he may use it on a scale which is very small compared with the sector of trade in which the mark is registered and the alleged infringer's use may be very limited also. In the former situation, the court must consider notional use extended to the full width of the classification of goods or services. In the latter it must consider notional use on a scale where direct competition between the proprietor and the alleged infringer could take place."

54) Mr Campbell also criticised the witness statement of Juan Scott. He claimed that Mr Scott is not in position to provide an unbiased view because of his declared business relationship with the applicants. Mr Scott describes himself as marketing and brand creation specialist and the thrust of his statement is that, in his view, there is no likelihood of confusion when considering the marks YOG and YOGGI. Mr Campbell contends that his opinions carry no weight and referred me to the comments of Lord Justice Millett in *The European Limited v The Economist Newspaper Limited* [1998] FSR 283 where he said:

“The function of an expert witness is to instruct the Judge of those matters which he would not otherwise know but which it is material for him to know in order to give an informed decision on the question which he is called to determine. It is legitimate to call evidence from persons skilled in a particular market to explain any special features of that market of which the Judge might otherwise be ignorant and which may be relevant to the likelihood of confusion. It is not legitimate to call such witnesses merely in order to give their opinions whether the two marks are confusingly similar. They are experts in the market, not on confusingly similarity ... In the end the question of confusingly similarity is one for the Judge. He was bound to make up his own mind and not leave the decision to the opinion of the witnesses.”

55) Taking account of these comments, it is clear that Mr Scott’s statement does little to assist the applicants’ case.

56) I should also comment upon the applicants’ reliance upon two earlier OHIM decisions. The first of these is Opposition No B1134222 where the respective marks are GAM and GAMMA and the second is Opposition No B752149 where the respective marks are NET and NETTY. In both these cases, the OHIM found that there was no likelihood of confusion and the applicants argue that the same findings should apply in the current case because of the parallels that exist regarding the similarity and differences between the respective marks. I should say that I will give the appropriate weight to these decisions, but that I am not bound by them and I am required to make my own independent analysis of the facts before me (see the comments of Geoffrey Hobbs QC, sitting as the Appointed Person, in *Zurich Private Banking* BL O/201/04).

57) Turning to the global analysis that I am required to undertake, I take into account that marks are rarely recalled perfectly with the consumer relying instead on the imperfect picture of them he has in kept in his mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27). I have found that the respective marks share a moderately high level of visual and aural similarity that may be reduced when used in respect of non-yoghurt based goods or in respect to services not specifically related to the provision of yoghurt. I also found that there was no relevant conceptual similarity or dissonance.

58) In respect of use relating to yoghurt and yoghurt based products, I have already found that it is likely that the average consumer will pronounce the applicants’ mark and the YOG element of Arla’s mark in the same way. Nevertheless, the addition of the letters GI to the short term YOG creates a difference that will not go unnoticed by the consumer, as it creates a noticeably longer word with an additional syllable. This is likely to be apparent to the average consumer even where imperfect recollection is a factor. It is therefore unlikely that the mark will be recalled as the opponent’s mark (i.e. direct

confusion). Further, it is also unlikely that it will be assumed that the marks originate from the same or an economically linked undertaking as any link identified between the marks will be to “yoghurt” rather than any link to trade origin. Whilst I believe the outcome is finally balanced, taking all these factors into account, I find that there is no likelihood of confusion in respect of these goods. It follows that, where there is more distance between the respective goods and services, and there is scope for Arla’s marks to be pronounced with a long “o”, there is even less likelihood of confusion.

59) In summary, the grounds based upon Section 5(2)(b) of the Act are dismissed and the opposition fails in its entirety.

### **COSTS**

60) The opposition having failed, Ersen Salih and Rebecca McGuire are entitled to a contribution towards their costs. I award costs on the following basis:

Considering Notice of Opposition and preparing statement in reply	£300
Preparing evidence and considering other side’s evidence	£500
Preparing for and attending hearing	£600
<b>TOTAL</b>	<b>£1400</b>

61) I order Arla Foods AB to pay Ersen Salih and Rebecca McGuire the sum of £1400. 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 27 day of September 2010**

**Mark Bryant  
For the Registrar,  
the Comptroller-General**