

**O-349-04**

**TRADE MARKS ACT 1994  
IN THE MATTER OF APPLICATION NO. 2292782  
IN THE NAME OF ARLA FOODS AMBA  
TO REGISTER A TRADE MARK IN CLASSES 29 AND 30**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER NO. 91692 IN THE NAME OF  
MOLKEREI ALOIS MULLER GMBH & CO**

## Trade Marks Act 1994

**In the matter of application No. 2292782  
in the name of Arla Foods Amba  
to register a trade mark in Classes 29 and 30**

**And**

**In the matter of opposition thereto  
under No. 91692 in the name of  
Molkerei Alois Muller GmbH & Co**

### Background

1. On 15 February 2002, Arla Foods Amba applied to register YOGGI as a trade mark in Classes 29 and 30 in respect of the following specifications of goods:

**Class 29:** Milk, edible cream, cheese, dried milk and condensed milk; yoghurt, fromage frais, milk based desserts; butter, edible oils and fats.

**Class 30:** Rice pudding

2. On 15 May 2003, Molkerei Alois Muller GmbH & Co filed notice of opposition based on the following grounds:

**1. Under Section 5(2)(b)** because the opponents are the owners of earlier marks that are similar to the mark which is the subject of the application, and is sought to be registered in respect of the same or similar goods to those of the opponents= earlier marks.

**2. Under Section 5(4)(a)** by virtue of the law of passing off.

3. Details of the earlier marks relied upon can be found as an annex to this decision.

4. The applicants filed a counterstatement in which they admit that milk, yoghurt and fromage frais are goods covered by the opponents= registrations and that the remaining goods are similar to the goods covered by the opponents' earlier mark. They nonetheless deny the grounds on which the opposition is based.

5. Both sides ask that an award of costs be made in their favour.

6. Both sides filed evidence in these proceedings. Neither party took up the offer of a hearing. After a careful study of the evidence I now give my decision.

## Opponents= evidence

7. This consists of a Witness Statement dated 18 December 2003, from Florian Nikolai Edward Mattinson, Company Secretary and Legal Counsel for Muller Dairy (UK) Limited, a wholly owned subsidiary and holding company of the opponents.

8. Mr Mattinson recounts his company's development of their YOGZ yogurt products, saying that on 4 October 1997 they launched a one part range, and on 8 May 1999 a two-part range. He further details the launch of a range of YOGZ fromage frais on 6 June 1998, and a multi-pack range of jelly products on 4 October 1999.

9. Exhibit FM1 consists of a press release, dated 17 June 1998, announcing the extension of the YOGZ children's brand with the introduction of YOGZ multi-pack fromage frais. Exhibit FM2 consists of a press release dated 12 June (year not given) relating to the YOGZ DUO product. The article appears to be a draft for approval. It details the success of Muller in the children's yogurt market in the past year. As it refers to research conducted in April 2003, it cannot be seen to provide any insight into the period prior to the relevant date.

10. Exhibit FM3 consists of samples of packaging for YOGZ yogurts, showing the word to be used in conjunction with the MULLER house brand. None can be dated as originating prior to the relevant date. Exhibits FM4 and FM5 consist of an advertisement for YOGZ yogurt which from the details below show it to originate from after the relevant date, and an advertising schedule that relates to October/November 2003, also after the relevant date.

11. Mr Mattinson gives the following turnover figures for YOGZ products sold in the period 1997 to October 2003:

1997	, 5,668,000
1998	, 8,955,000
1999	, 13,602,000
2000	, 6,681,000
2001	, 7,459,000
2002	, 8,478,000
2003	, 7,482,000

12. Mr Mattinson says that his company's YOGZ branded yogurt is the number one brand in the children's sector in the UK, holding a 26% share of the , 43 million market. Mr Mattinson refers to exhibit FM6, which consists of a chart showing the range of products sold under the mark YOGZ by value and volume, highlighting that it shows a rise from approximately , 9 million in 2001 to , 11 million by October 2003. Exhibit FM7 consists of a further chart relating to sales of YOGZ in the period December 2000 to November 2003, showing there to have been a growth in sales. Exhibit FM8 consists of a chart of sales of the range of YOGZ products in the year to the end of November 2003, which Mr Mattinson says indicates that the product is the fourth biggest brand in the children's short-life dairy market that is made up of yogurt, fromage frais and treat/dessert products.

13. Mr Mattinson next refers to his company's advertising expenditure in the period 1998 to 2003, showing this to have been, , 84,165, , 1,233,545, , 1,210,395 and , 479,782 in the years 1998 to 2001, there was no expenditure in 2002 and the remaining year is after the relevant date. Exhibit FM9 consists of a list of television advertisements for YOGZ products, television being the most widely used medium. Exhibit FM10 consists of CD ROM disks illustrating television advertisements for YOGZ yogurts. There is nothing that establishes that these pre-date the relevant date. Mr Mattinson lists some of the outlets at which YOGZ products can be purchased. The list includes most of the leading supermarket and wholesale retailers.

#### **Applicants= evidence**

14. This consists of a Witness Statement dated 12 February 2004, from Mark John Hickey, a trade mark attorney and partner in the firm of Castles, the applicants= trade mark attorneys. Mr Hickey's Statement consists of submissions on the evidence filed by the opponents. Whilst I do not consider it necessary or appropriate to provide a summary, I have taken these submissions fully into account in determining this case.

#### **Opponents= evidence**

15. This consists of a Witness Statement dated 12 May 2004, from Florian Nikolai Edward Mattinson.

16. Mr Mattinson's Statement consists of submissions on the applicants= evidence. Whilst I do not consider it to be necessary or appropriate to summarise them here, I will take them fully into account in my determination of this case.

17. That concludes my review of the evidence insofar as it is relevant to these proceedings.

#### **Decision**

18. I turn first to consider the ground under Section 5(2)(b). That section reads as follows:

**A5.-(2) A trade mark shall not be registered if becauseB**

(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.@

19. An earlier trade mark is defined in Section 6 of the Act as follows:

**A6.- (1) In this Act an earlier trade mark means**

- (a) a registered trade mark, international trade mark (UK) or Community trade mark which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

20. In my consideration of a likelihood of confusion or deception I take into account the guidance 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] 45 F.S.R. 77 and *Marca Mode CV v Adidas AG* [2000] E.T.M.R. 723. It is clear from these cases that:

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*;
- (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) 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*;
- (h) further, the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense; *Marca Mode CV v Adidas AG*;

- (i) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*

21. The applicants concede that the milk, yogurt and fromage frais in the specification of their application is also covered by the opponents' earlier mark, and that the remaining goods of their application, namely, edible cream, cheese, dried milk and condensed milk, milk based desserts; butter, edible oils and fats are similar to the goods for which the opponents' earlier mark is registered. Accordingly there is no question of similarity to be considered.

22. The specifications of the respective marks are not limited in any way, so notionally at least, the respective marks must be considered to be capable of sharing the same channels of trade, from manufacturer to retailer, and also the same end consumer.

23. Although not ordinarily high price items, food is likely to be selected with a degree of care, probably with more attention being paid to the description of the foodstuff to ensure that the correct product is obtained than to the trade name. That said, I am aware that foodstuffs can, and do attract brand loyalty from the consumer, who, having bought a product once and found it to their liking will make a repeat purchase of the same item, or another item bearing a brand from the same stable as that previously purchased.

24. In my experience retailers display the different branded products of the same type together, so this is one of the areas of commerce where the consumer may see marks displayed side-by-side. However, not all traders stock all of the available brands and it may well be that a consumer will see a brand in one shop, but not in another. This leaves open the possibility of the applicants' and the opponents' goods being displayed in close proximity, affording the opportunity for a direct comparison, or in different retail outlets where the consumer will have to rely on their potentially imperfect recollection.

25. Whilst marks should be compared as a whole, it is inevitable that in any comparison reference will be made to the various constituent parts of which marks are composed, and rightly so where there is a particularly distinctive or dominant element. The opponents' mark is the word YOGZ but not in plain script. The font is stylised, the arms of the letter Y being embellished with hands giving a thumbs-up sign, and the letter O being underlined. Whilst I would not say that the underlining brings anything to the mark, the style of font and particularly the graphical addition to the letter Y are significant additions. Even so, the mark is still clearly the word YOGZ.

26. The mark applied for is YOGGI, the opponents' earlier mark is YOGZ. Setting aside the stylisation of the opponents' mark, it is self evident that both share the syllable formed by the letters YOG. If only to that extent the marks must have a degree of visual and aural similarity. However, the opponents' mark terminates with a letter Z which runs through into the pronunciation in much the same way as a letter S would. The applicants' mark ends with the syllable GI which is a distinct sound in the way it will be enunciated. Whilst it is generally acknowledged that in any comparison it is the beginnings of the marks that are of most significance, this does not mean that all other elements should be ignored. Marks must be

compared as a whole and particularly so in cases such as this where the words have so few letters, for in short marks, small differences have a disproportionate effect. Balancing the similarities and the differences, I have little difficulty in deciding that these marks are visually and aurally different. Insofar as both marks allude to yogurt, I would say that they must send out the same conceptual message.

27. As far as I am aware, YOGZ is not an ordinary English word, and other than as the badge of origin for the opponents' goods, has no direct use in trade in relation to the goods for which it is registered. It is an invented word, albeit none too skilful or covert in its construction; the reference to yogurt is plain for all to see.

28. The opponents claim to have first used YOGZ some four or five years prior to the relevant date, in respect of yogurt, fromage frais and jelly products, although the evidence only substantiates use in relation to the first two items. The extent of use is significant by any standards and is likely to have established a substantial reputation in respect of the goods for which it has been used. Even though the goods are aimed at the children's yogurt sector, I have no doubt that there will have been a spill-over of this reputation into a wider group of consumers; children in the main do not do their own food shopping. However, the mark YOGZ has consistently been used in conjunction with the MULLER house brand, and whilst the manner of use may have been sufficient for it to have developed as a mark in its own right, given its none too hidden reference to yogurt I cannot be sure of this. In the circumstances I do not feel able to say that the opponents are in a position to claim that the mark has become any more distinctive and warranting a greater degree of protection by virtue of the use they have made of it.

29. In the *Office Cleaning Services Ltd* case, [1946] RPC 39 it was held that where a trader adopts a trading name containing words in common use, some risk of confusion may be inevitable, but that risk must be run unless the first trader is allowed an unfair monopoly, and in such cases the Court will accept comparatively small differences as sufficient to avert confusion. This seems an eminently sensible approach. YOGZ may not be a word in common use, but it sails close to the term that is the name for the goods for which it is used.

30. Taking all of the above into account and adopting the global view advocated, I find the marks to be different, and although there are similarities in the goods and trade, this is not sufficient to swing the balance of probability towards a finding of there being a likelihood of confusion. In my view there is no likelihood that the public will be wrongly led into believing that goods bearing the mark applied for come from the opponents or some economically linked undertakings, and the opposition fails on the section 5(2)(b) ground.

31. Turning to the ground under Section 5(4)(a). That section reads as follows:

5(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented-

- (a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade...

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an “earlier right” in relation to the trade mark.@

32. Mr Geoffrey Hobbs QC, sitting as the Appointed Person set out a summary of the elements of an action for passing off in his decision in the *WILD CHILD* Trade Mark case [1998] RPC 455. Mr Hobbs summarised the requirements as follows:

- (a) that the plaintiff’s goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;
- (b) that there is a misrepresentation by the defendant (whether or not intentional leading or likely to lead the public to believe that goods or services offered by the defendant are goods or services of the plaintiff; and
- (b) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant’s misrepresentation.

33. For the opponents to have any likelihood of succeeding with a claim to passing off, they must discharge the onus of establishing that they have the requisite reputation or goodwill in respect of YOGZ. For the reasons given earlier in this decision I do not consider that the opponents have made out their claim to a reputation in the mark YOGZ and I believe it follows that the same must be the case in respect of goodwill. Setting this aside, I do not consider that the marks are similar, so even if it were to be accepted that the reputation or goodwill existed, I do not see how I could find that use of the mark applied for in respect of the goods covered by the application, would be a misrepresentation likely to lead the public to believe that their goods are those of, or connected with the opponents. Consequently, I do not see that the opponents are likely to suffer damage, and the ground under Section 5(4)(a) is accordingly dismissed.

34. The opposition having failed on all grounds, I order the opponents to pay the applicants the sum of , 1,750 as a contribution towards their costs. This sum 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 25<sup>th</sup> day of November 2004**

**Mike Foley  
for the Registrar  
the Comptroller-General**

Trade mark Registration No	Mark	Date Registration Effective	Specification of Goods/Services
2136536		20 June 1997	<p><b>Class 29:</b> Yoghurt; desserts comprising yoghurt and jelly, yoghurt and fruit, yoghurt and honey, yoghurt and nuts, yoghurt and cereal, all made wholly or principally of yoghurt; jellies; jams; fruit sauces; fruit purees; fromage frais; milk and milk products; milk beverages.</p> <p><b>Class 30:</b> Desserts and puddings; desserts made wholly or principally of rice; preparations for use as desserts and puddings; ice cream; water ices; sugar confectionery; sweets; croissants; filled croissants.</p>
2169225	YOGZ	12 June 1998	<p><b>Class 03:</b> Soap; dentifrices, talcum powder, bubble bath, non-medicated toilet preparations.</p> <p><b>Class 09:</b> Sunglasses, computer games, electronic games for use with television apparatus, computer software and publication in electronic form supplied-on-line from databases or from facilities provided on the Internet (including web-site), computer software; mouse mats, screen savers; and parts and fittings for all the aforesaid goods, cameras.</p> <p><b>Class 14:</b> Watches, jewellery and parts and fittings therefor.</p>

			<p><b>Class 16:</b> Pens, pencils, erasers, pencil cases, pencil boxes, notebooks, posters, stationery, calendars, printed matter, books, printed publications, magazines, painting sets, greeting cards, wrapping paper, paper tableware, decalcomanias (transfers), badges.</p> <p><b>Class 18:</b> Bags, rucksacks, purses, cases and umbrellas.</p> <p><b>Class 21:</b> Coolbags, lunchboxes, mugs, tableware, pottery, household and kitchen utensils and containers, drinking flasks.</p> <p><b>Class 24:</b> Bedlinen, duvet covers, bed covers, pillowcases, curtains, cushions.</p> <p><b>Class 25:</b> Articles of clothing for children, T-shirts, sweatshirts, baseball caps, footwear, trainers.</p> <p><b>Class 26:</b> Badges for wear; shoelaces; hair decorations.</p> <p><b>Class 27:</b> Wallpaper, rugs.</p> <p><b>Class 28:</b> Toys, games and playthings; hand-held computer games; toy models, all for games.</p>
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			<p><b>Class 29:</b>  Yogurt; desserts comprising of yogurt and honey, yogurt and fruit, yogurt and nuts, yogurt and cereals, all made wholly or principally of yogurt; dairy products; dairy desserts; preparations all for use as desserts and puddings; milk; milk products; milk beverages; jellies; jams; fruit sauces; fruit purees; fromage frais; ready to eat snack foods; snack dips; spreads; meat, fish, poultry and game products; fruit, vegetable and nut products; potato products, potato based snack foods; potato crisps and chips; prepared meals sold in multicompartment packaging; dips sold together with biscuits in multicompartment packs; salads; pre-prepared salads.</p> <p><b>Class 30:</b>  Desserts, all made wholly or principally of rice; desserts and puddings; ice cream; croissants; ready to eat snack foods all being packaged with dips; snacks; snack dips; bread and pastry products; tortilla snacks; snack foods made from corn; salted snacks; pretzels, corn and taco chips, burritos, enchiladas, pancakes, corn chips, tortilla chips, prawn crackers, crackers; snacks made from extruded potato/maize flour; flour based chips; biscuits, cookies; cereals and cereal preparations; chutney, relish, sauces, salad dressings; multicompartment meals; biscuits and dips in multicompartment packs.</p>
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			<p><b>Class 32:</b> Non-alcoholic drinks, fruit drinks.</p> <p><b>Class 35:</b> Advertising and promotion services and information services relating thereto; all provided on-line from the computer data-base or the Internet; compilation of advertisements for use as web pages on the Internet.</p> <p><b>Class 41:</b> Information relating to entertainment or education provided on-line from a computer data-base or the Internet, electronic games services provided by means of the Internet.</p> <p><b>Class 42:</b> Providing access to and leasing access time to computer data-bases.</p>
European Community No. 935700	YOGZ	12 June 1998	<p><b>Class 03:</b> Soap; dentifrices, talcum powder, bubble bath, non-medicated toilet preparations.</p> <p><b>Class 09:</b> Sunglasses, computer games, electronic games for use with television apparatus, computer software and publication in electronic form supplied-on-line from databases or from facilities provided on the Internet (including web-site), computer software; mouse mats, screen savers; and parts and fittings for all the aforesaid goods, cameras.</p>

		<p><b>Class 14:</b> Watches, jewellery and parts and fittings therefor.</p> <p><b>Class 16:</b> Pens, pencils, erasers, pencil cases, pencil boxes, notebooks, posters, stationery, calendars, printed matter, books, printed publications, magazines, painting sets, greeting cards, wrapping paper, paper tableware, decalcomanias (transfers), badges.</p> <p><b>Class 18:</b> Bags, rucksacks, purses, cases and umbrellas.</p> <p><b>Class 21:</b> Coolbags, lunchboxes, mugs, tableware, pottery, household and kitchen utensils and containers, drinking flasks.</p> <p><b>Class 24:</b> Bedlinen, duvet covers, bed covers, pillowcases, curtains, cushions.</p> <p><b>Class 25:</b> Articles of clothing for children, T-shirts, sweatshirts, baseball caps, footwear, trainers.</p> <p><b>Class 26:</b> Badges for wear; shoelaces; hair decorations.</p> <p><b>Class 27:</b> Wallpaper, rugs.</p> <p><b>Class 28:</b> Toys, games and playthings; hand-held computer games; toy models, all for games.</p>
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