

O-404-10

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2519930
BY
PAUL KEARNS
TO REGISTER THE TRADE MARK**



IN CLASS 32

AND

**THE OPPOSITION THERETO
UNDER NO 99972
BY
SAGA FOODS LTD**

Trade Marks Act 1994

**In the matter of application 2519930
by Paul Kearns
to register the trade mark:**



**in class 32
and the opposition thereto
under no 99972
by Saga Foods Ltd**

1. On 30 June 2009, Paul Kearns applied to register the above trade mark for *Fruit drinks, fruit flavoured drinks, fruit based drinks; fruit beverages, fruit flavoured beverages, fruit based beverages; fruit juices and fresh fruit juices; beverages consisting principally of fruit juices; soft drinks consisting principally of fruit juices*. These goods are in class 32¹.

2. Saga Foods Ltd (which I will refer to as Saga) filed notice of opposition to the trade mark application, claiming that registration would be contrary to section 5(2)(b) of the Trade Marks Act 1994 (the Act). It relies upon its earlier Community Trade Mark 6628069, GORILLA GUARANA, for the following goods:

Class 32: Mineral and aerated waters and other non-alcoholic drinks; energy drinks; fruit drinks and fruit juices.

Class 33: Alcoholic beverages (except beers); wines, spirits, liqueurs.

3. Saga's mark was applied for on 31 January 2008 and its registration procedure was completed on 18 December 2008. Mr Kearns' application was published in the *Trade Marks Journal* on 1 January 2010. Saga's mark is

¹ As per the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

therefore an earlier trade mark which is not subject to proof of use² because at the date of publication of the application it had been registered for less than five years.

4. Section 5(2)(b) of the Act states:

“(2) A trade mark shall not be registered if because –

....

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

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

Saga claims that the goods of both marks are identical or similar and that the visual, phonetic and conceptual similarities between the marks would cause a likelihood of confusion. Saga discounts ‘GUARANA’ from its mark on the basis that it says this element is descriptive, leaving GORILLA as the distinctive feature which it claims is virtually identical to GO-RILLA in Mr Kearns’ mark, the only difference being a hyphen. Saga claims that the hyphen makes no visual, aural or conceptual difference and that Mr Kearns’ use of a picture of a gorilla reinforces the concept of the GO-RILLA element. It claims that the combination of identical goods and similar marks would lead to a likelihood of confusion.

5. Mr Kearns filed a counterstatement, denying a likelihood of confusion. Neither side filed evidence or asked for a hearing, both being content for a decision to be made from the papers on file. Only Saga filed written submissions. In making my decision, I have taken into account the contents of Saga’s statement of case and written submissions made in lieu of a hearing, and the contents of Mr Kearns’ counterstatement.

Decision

6. The leading authorities which guide me in this ground are from the European Court of Justice: *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:

² See section 6A of the Act (added by virtue of the Trade Marks (Proof of Use, etc.) Regulations) 2004 (SI 2004/946) which came into force on 5th May 2004.

(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.*

Comparison of goods

7. Both of the parties' marks cover goods in class 32. Saga's mark includes the terms *other non-alcoholic drinks and fruit drinks and fruit juices*. All of these terms cover the various types of fruit-specific goods in Mr Kearns' specification. As all of the goods of the application fall within the scope of the terms in the earlier mark, the class 32 goods are identical.³ That being the case, Saga cannot be in a better position with regard to its class 33 goods, so I do not need to make a comparison between Saga's class 33 goods and the goods of the application.

Average consumer and the purchasing process

8. Fruit drinks and non-alcoholic beverages are bought by the general public, readily available from a wide range of retail outlets. The average consumer is reasonably well informed and reasonably circumspect and observant, but his level of attention is likely to vary according to the category of goods or services. I consider that the relevant consumer will pay only a moderate amount of attention when purchasing drinks, which are relatively inexpensive, everyday consumer goods. The purchasing process is largely a casual, visual process of self-selection, even taking into account oral purchase in a café or bar⁴.

³ The General Court (previously the Court of First Instance) said in *Gérard Meric v OHIM*, Case T-133/05: "29 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 Vedral 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)."

⁴ In *Simonds Farsons Cisk plc v Office for Harmonization in the Internal Market* (OHIM) Case T-3/04, the GC said:

"58 In that respect, as OHIM quite rightly observes, it must be noted that, even if bars and restaurants are not negligible distribution channels for the applicant's goods, the bottles are generally displayed on shelves behind the counter in such a way that consumers are also able to inspect them visually. That is why, even if it is possible that the goods in question may also be sold by ordering them orally, that method cannot be regarded as their usual marketing channel. In addition, even though consumers can order

Comparison of trade marks

9. The authorities direct that, in making a comparison between the marks, I must have regard to each mark’s visual, aural and conceptual characteristics. I have to decide which, if any, of their components I consider to be distinctive and dominant, without engaging in an artificial dissection of the marks, because the average consumer normally perceives a mark as a whole and does not analyse its details.

10. The marks to be compared are:

Saga’s mark	Mr Kearns’ application
GORILLA GUARANA	

Saga submits that the dominant distinctive element of its mark is the word GORILLA because GUARANA “refers to a tropical fruit which is often used to flavour soft drinks and to make fruit drinks”, which Saga submits makes it a descriptive and less distinctive element in the mark. Guarana is not a term with which I am familiar. Collins English Dictionary does not list it as a reference. In the Penguin English Dictionary (2003 Edition) the word is defined as an Amazonian shrub, the berries of which contain black seeds with a high caffeine content which can be made into a paste, powder or syrup for use in energy-boosting drinks or drugs. I do not consider that I am entitled to treat this as a notorious fact of which the average consumer of drinks would be aware⁵ without

a beverage without having examined those shelves in advance they are, in any event, in a position to make a visual inspection of the bottle which is served to them.

59 Moreover, and above all, it is not disputed that bars and restaurants are not the only sales channels for the goods concerned. They are also sold in supermarkets or other retail outlets (see paragraph 14 of the contested decision), and clearly when purchases are made there consumers can perceive the marks visually since the drinks are presented on shelves, although they may not find those marks side by side.”

⁵ As per the comments of Ms Anna Carboni, sitting as the Appointed Person, in *CHORKEE Trade Mark*, O-048-08: “Judicial notice may be taken of facts that are too notorious to be the subject of

any evidence on the point. The effect of this is that there are two word elements in the earlier mark, both of equal length, which are distinctive. GORILLA is a known dictionary word (the meaning of which is notorious); given my comments above, I consider that GUARANA will be seen as an invented word. Both elements have equal dominance in the mark and both are distinctive.

11. Mr Kearns' mark is a composite mark. It comprises the letters or word GO at the top, followed underneath by the hyphenated –RILLA word element. RILLA is not a dictionary word. The word elements take up the top half of the mark. The bottom half of the mark consists of a picture of a gorilla; the picture is falling into some opaque liquid which splashes. Apart from the liquid, all these elements are distinctive. The GO element and the gorilla picture are equally dominant; the –RILLA element less so, because it is smaller. Having said that, as I will come to later, the picture of a gorilla informs the word elements in the sense that the GO and –RILLA element combine to form the single word GORILLA, which is as equally dominant and distinctive a concept as the picture itself.

12. There are several points of visual difference between the marks: Saga's mark does not contain the device elements while Mr Kearns' mark does not contain the word GUARANA. The only point of similarity is the GORILLA or GO-RILLA element. In Saga's mark it is a complete, easily recognisable word. In Mr Kearns' mark, the word is split between the GO and the RILLA syllables, with GO above –RILLA; GO being a word in its own right. When considered as a whole with the other elements which are not common to the parties' marks, there is, overall, a low to moderate degree of visual similarity between the marks.

13. Considering Mr Kearns' mark as a whole means that the picture is a factor: it informs the word element which would mean an identical perception aurally of the word elements as 'gorilla'. If this is putting it too highly, when the two syllables in Mr Kearns' mark are put together, even allowing for a pause prompted by the hyphen and allowing for the different 'o' sound in the GO element (as in 'got'), there is still a high degree of aural similarity between GORILLA and GO-RILLA.

14. I have said that there is only a low degree of visual similarity with Saga's mark because of the visual disguise in the way in which the word component in Mr Kearns' mark is split (and the difference between the other elements). However, the picture in Mr Kearns' mark is clearly and unambiguously a picture of a gorilla. There is no doubt in my mind that the average consumer, encountering Mr Kearns' mark visually will understand the pictorial reference, which in turn will inform his view of the word element as a quirky split of the word

serious dispute...37. I have no problem with the idea that judicial notice should be taken of the fact that the Cherokee Nation is a native American tribe. This is a matter that can easily be established from an encyclopaedia or internet reference sites to which it is proper to refer. But I do not think that it is right to take judicial notice of the fact that the average consumer of clothing in the United Kingdom would be aware of this."

which describes the animal in the picture. The splashing liquid concept will have a secondary importance because the elements contributing to the gorilla concept are overwhelming in Mr Kearns' mark.

15. GORILLA is also a concept immediately recognisable in Saga's mark. I have found above that I cannot legitimately take as a notorious fact that GUARANA is a descriptive element. Even if I am mistaken and that it is well-known to the average consumer for drinks as denoting a particular feature of a drink, GUARANA would still be an independent element in the mark which does not affect the concept of GORILLA as a very specific, even iconic, type of ape. In the mind of the average consumer, both marks share this single conceptual identity. They are conceptually identical or at the very least highly similar.

Distinctiveness of Saga's mark

16. It is necessary to consider the distinctive character of GORILLA GUARANA because the more distinctive it is, either by inherent nature or by use (nurture) the greater the likelihood of confusion⁶. The distinctive character of a trade mark must be assessed by reference to the goods or services in respect of which registration is sought and by reference to the way it is perceived by the relevant public⁷. No use has been filed so I have only the inherent position to consider. GORILLA has no allusion to drinks and is therefore highly distinctive in relation to the goods. If GUARANA is seen as an invented word, it is also highly distinctive for drinks. Even if it is seen as having some reference to a characteristic of the goods, as Saga submits, the GORILLA element is so distinctive that the mark still has a high inherent capacity to distinguish Saga's goods from those of other undertakings.

17. Likelihood of confusion

In deciding whether there is a likelihood of confusion between the marks, I must weigh the various factors I have identified and also bear in mind the principle of interdependency, whereby a lesser degree of similarity between the goods and services may be offset by a greater degree of similarity between the trade marks, and vice versa (*Canon*). I bear in mind the whole mark comparison, the dominant and distinctive elements within the marks, and the effect which the purchasing process has upon the weight of these elements. I should guard against dissecting the marks so as to distort the average consumer's perception of them; the average consumer perceives trade marks as wholes and rarely has the opportunity to compare marks side by side, relying instead upon the imperfect picture he has of them in his mind.

⁶ *Sabel BV v Puma AG* [1998] RPC 199.

⁷ *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91.

18. I have found that there are identical goods, a low to moderate degree of visual similarity but identical, or high, aural and conceptual similarity between the marks. The earlier mark is highly distinctive for the goods. The semantic content, or conceptual hook (gorilla), of both marks is the same and is capable of being grasped immediately in what is mostly a visual, casual purchase. Even though the visual similarity is low to moderate, the conceptual link to gorilla is so strong in both marks that the overall impression, and the imperfect picture the average consumer will keep in his mind, will cause him to believe that the respective goods come from the same or economically linked undertakings. All the factors combine to create a likelihood of confusion. The opposition succeeds under section 5(2)(b).

Costs

19. Saga has been successful and is entitled to an award of costs on the following basis:

Preparing a statement and considering the other side's statement:	£200
Official fee:	£200
Written submissions:	£300
Total:	£700

20. I order Paul Kearns to pay Saga Foods Ltd the sum of £700. 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 24 day of November 2010

**Judi Pike
For the Registrar,
the Comptroller-General**