

O-427-12

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2586571
BY SUMO DRINKS LIMITED
TO REGISTER THE TRADE MARK**



IN CLASS 32

AND

**THE OPPOSITION THERETO
UNDER NO 102971
BY
SUMOL + COMPAL MARCAS, S.A.**

Background

1. Sumo Drinks Limited (“the applicant”) applied to register



as a trade mark on 4 July 2011 for the following goods in Class 32:

Mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; powders, syrups, concentrates and other preparations for making beverages; soft drinks; thermogenic soft drinks; carbonated beverages.

2. The application was published on 4 November 2011 in the *Trade Marks Journal*, following which an opposition was filed by Sumol + Compal Marcas, S.A. (“the opponent”) under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). This section states:

“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,

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

3. The opponent relies upon its earlier registered Community trade mark 3962362, the details of which are as follows:

SUMOL

Class 30: *Beverages based on coffee, tea, artificial coffee and other cereals.*

Class 32: *Beverages, namely drinking waters, flavoured waters, mineral and aerated waters; energy and sports drinks; soft drinks, fruit drinks and aerated fruit juice drinks; vegetable and plant juices; syrups for beverages, concentrates, powders and other preparations for making beverages.*

Application date: 5 August 2004; date registration procedure completed: 14 August 2008.

4. The earlier mark is not subject to the proof of use provisions¹ because it had been registered for less than five years at the date on which the application was published. It can therefore be considered for all the goods for which it is registered on the basis of notional and fair use.

5. Neither side filed evidence. Both sides filed written submissions and chose to have a decision made from the papers rather than attending a hearing. In the decision which follows, I have borne in mind the parties' submissions, which I will refer to as and when is necessary.

Decision

6. The leading authorities which guide me in this Section 5(2)(b) ground are from the Court of Justice of the European Union ("CJEU"): *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

¹ 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.

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 and services

7. The opponent has referred, in its notice of opposition, to the goods of both parties as being identical and similar, without specifying which goods it considers to be identical and which are similar. It is necessary for me to determine the level of similarity between the parties' goods on account of the interdependency principle, whereby a lesser degree of similarity between the goods may be offset by a greater degree of similarity between the trade marks, and vice versa, as a factor in the global appreciation of the likelihood of confusion².

² As per *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*.

8. In comparing the respective specifications, all relevant factors should be considered, as per *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.* where the CJEU stated at paragraph 23 of its judgment:

“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.”

‘Complementary’ was defined by the General Court (“GC”) in *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-325/06*:

“82 It is true that goods are complementary if there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking...”.

9. Additionally, the criteria identified in *British Sugar Plc v James Robertson & Sons Limited (“Treat”)* [1996] R.P.C. 281 for assessing similarity between goods and services included an assessment of the channels of trade of the respective goods or services. Specifications should not be given an unnaturally narrow meaning, as per *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267.

10. Comparing the opponent’s class 32 goods with those of the application, the parties’ respective specifications are:

Opponent	Applicant
<i>Beverages, namely drinking waters, flavoured waters, mineral and aerated waters; energy and sports drinks; soft drinks, fruit drinks and aerated fruit juice drinks; vegetable and plant juices; syrops for beverages, concentrates, powders and other preparations for making beverages.</i>	<i>Mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; powders, syrups, concentrates and other preparations for making beverages; soft drinks; thermogenic soft drinks; carbonated beverages.</i>

11. I have emboldened the goods which appear in both of the parties’ specifications. These goods are identical.

12. If goods or services fall within the ambit of terms within the competing specification, they are considered to be identical, as stated by the GC in *Gérard*

Meric v OHIM, case T-133/05³. The applicant's *non-alcoholic drinks* encompass and, therefore, are identical to all the goods in the opponent's specification which are drinks. The applicant's *fruit drinks* include the opponent's *aerated fruit juice drinks* and so are identical. The applicant's *thermogenic soft drinks* are caught by the opponent's wider term *soft drinks* and these are therefore identical goods. Finally, the applicant's *carbonated beverages* is identical to the opponent's goods which are carbonated, in particular, aerated waters and aerated fruit juice drinks.

13. In summary, all of the applicant's goods are identical to goods appearing in the opponent's class 32 specification. I do not, therefore, need to consider additionally the goods of the application against the opponent's class 30 goods.

Average consumer and the purchasing process

14. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect, but his/her level of attention is likely to vary according to the category of goods. The average consumer for the parties' goods is the general public plus, in the case of powders, concentrates, syrups and preparations for making into beverages, those who make drinks such as in pubs and cafés, as well as the public at home (e.g. squash and cordials). The average consumer will pay an average level of attention to buying the goods. The purchasing process for drink is largely a visual process, but I do not ignore the potential for oral use of the mark⁴.

Comparison of trade marks

15. The marks are:

Opponent	Applicant
SUMOL	

³ 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 General Court (“GC”) in *Simonds Farsons Cisk plc v Office for Harmonization in the Internal Market* (OHIM) Case T-3/04

16. The above 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. The opponent's mark consists of a single word which is self-evidently its dominant and distinctive component. The application also consists of a single word, although within the final letter 'o' there is a device element. Although not negligible, the device element is small in proportion to the rest of the applicant's mark. The word element, SUMO, is the dominant and distinctive component of the applicant's mark.

17. The opponent's mark consists of five letters, the first four of which are identical, sequentially, to the four letters comprising the word element of the applicant's mark: SUMOL v. SUMO. Considering that words are read from left to right, the word elements of the two marks are highly similar. The applicant also has a device element within its letter 'o' which is said to represent the stylised head of a sumo wrestler. It is small, it is positioned at the end of the mark, and it is highly stylised. The average consumer will see the device in conjunction with the word SUMO and so this word is likely to give the device some context, leading to an interpretation that it is the device of a sumo wrestler's head. Weighing the differences between the marks (the small device in the applicant's mark and the letter L in the opponent's mark) against the similarities between them, there is a good deal of visual similarity between the marks.

18. The applicant submits that its mark would be pronounced SOO-MO, whilst it is not known how SUMOL, which it states to be a Portuguese brand, would be pronounced; the applicant submits that it could be said as SUM-OL, rather than SOO-MOL. The construction of SUMOL, in the UK⁵, will be seen as SOO-MOL. For the applicant's submission to carry weight, it would need to be spelled SUMMOL. Both parties' marks consist of two syllables⁶, the first of which would be pronounced identically: SOO (or SOOM). The second syllables sound very different: sooMO (or soomO) – the 'o' sounded as in 'mow' – and sooMOL (or soomOL) – the 'o' sounded as in 'collar'. Owing to the first half of each mark sounding identical, there is a good deal of aural similarity between the marks.

⁵ See, by analogy, the decision of Ms Amanda Michaels in *Topy Trademarks Limited v Cofra Holding AG*, BL O/092/11: "25. Secondly, the evidence goes to the question of how Topy's sign might be pronounced by Germans, Poles, etc resident in the UK and whether Yessica would be recognised as a name. However, again, it does not seem to me that this would have been a relevant point for the Hearing Officer to consider. What the Hearing Officer had to consider was how the mark would be perceived by the average UK consumer. Whilst of course there are many persons whose mother tongue is not English who live and work in the UK, such persons are not the average UK consumer for the purposes of considering the pronunciation or meaning of a word."

⁶ The break between the parties' marks will occur either after the 'u' or the 'm'.

19. The concept of the applicant's mark is of SUMO, which is commonly known to be a style of Japanese wrestling. As said above, in the context of this word, the device within the letter 'O' may be interpreted as a sumo wrestler's head, although it is highly stylised. (I disagree with the opponent's submission that, because the meaning of SUMO has no relevance to drinks, that it will be seen as an invented word.) The opponent's mark, SUMOL, is an invented word with no concept and is not evocative of any concept. As one mark has a clear meaning and as the other, for the average consumer, will be seen as an invented word, the marks on a conceptual level can be distinguished.

20. In summary, there is a good deal of similarity between the marks on an aural and visual level, but a conceptual difference.

Distinctiveness of the earlier mark

21. I must consider the distinctive character of the earlier mark because the more distinctive it is, either by inherent nature or by use (nurture), the greater the likelihood of confusion⁷. The distinctive character of the earlier trade mark must be assessed by reference to the goods for which it is registered and by reference to the way it is perceived by the relevant public⁸. I have only the inherent position to consider because the opponent has not filed any evidence of use that might support a claim to an enhanced level of distinctive character. SUMOL is an invented word. Invented words possess a high degree of distinctive character. SUMOL has a high degree of inherent distinctive character.

Likelihood of confusion

22. 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 may be offset by a greater degree of similarity between the trade marks, and vice versa (*Canon*). I have found that the parties' goods are identical and that there is a good deal of aural and visual similarity, but one mark has a clear conceptual meaning and the other is an invented word, allowing for them to be distinguished on a conceptual level.

23. I bear in mind the whole mark comparison and the dominant and distinctive elements within the marks. 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

⁷ *Sabel BV v Puma AG* [1998] RPC 199.

⁸ *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91.

his mind. This is important in the context of goods which may be bought without careful attention to detail, such as soft drinks (which are often bought in comparative hurry to quench thirst or to take on a journey, e.g. at kiosks, at railway stations and in petrol stations).

24. There is no conceptual similarity between the marks because one mark has a clear meaning and the other does not. Lack of conceptual similarity can offset visual and/or aural similarity⁹. This is not a rigid rule but is but one factor in the global comparison. In *Nokia Oyj v OHIM* Case T-460/07, the GC said:

“Furthermore, it must be recalled that, in this case, although there is a real conceptual difference between the signs, it cannot be regarded as making it possible to neutralise the visual and aural similarities previously established (see, to that effect, Case C-16/06 P *Éditions Albert René* [2008] ECR I-0000, paragraph 98).”

25. The factors in the opponent’s favour are the identity of the goods, the average attention given to the purchasing process, the good degree of visual and aural similarity and the high level of distinctive character of the earlier mark. In the applicant’s favour is the lack of conceptual similarity between the marks. There are more factors for the opponent than there are against it (although it is not a mathematical formula). The combination of these factors means that the lack of conceptual similarity is not enough to mitigate, or neutralise, the potential for imperfect recollection. There is a likelihood of confusion.

Outcome

26. There is a likelihood of confusion in relation to the whole application. The application is to be refused.

Costs

27. The opponent has been successful and is entitled to an award of costs¹⁰.

Filing a statement of opposition (including statutory fee):	£400
Written submissions	£300
Total:	£700

⁹ *Ruiz-Picasso v OHIM*, case 361/04 P [2006] E.T.M.R. 29.

¹⁰ As per the scale in Tribunal Practice Notice 4/2007.

28. I order Sumo Drinks Limited to pay to Sumol + Compal Marcas, S.A. 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 30th day of October 2012

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