

O-449-14

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO 3005979  
BY  
COBURG COFFEE COMPANY LIMITED  
TO REGISTER THE TRADE MARK**

**Mountain Range**

**IN CLASS 30**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER NO 400845  
BY  
MOUNTAIN RANGE RESTAURANTS LIMITED**

## BACKGROUND

1) On 15 May 2013, Coburg Coffee Company Limited ('the applicant') applied to register the trade mark 'Mountain Range' in respect of '*Ground coffee, instant coffee, and coffee beans*' in class 30. The application was published on 14 June 2014 in the Trade Marks Journal and notice of opposition was subsequently filed by Mountain Range Restaurants Limited ('the opponent').

2) The opponent originally claimed that the application offended under Sections 5(2)(a), 5(3) and 5(4)(a) of the Trade Marks Act 1994 ('the Act'). However, as no evidence was filed to substantiate the latter to grounds, they were struck out in accordance with rule 20(3) of The Trade Marks Rules 2008.<sup>1</sup> Accordingly, the only ground remaining before me is under Section 5(2)(a) of the Act.

3) The opponent relies on the following UK trade mark registration ('UKTM'):

Earlier Mark details	Services relied upon
<b>UKTM No: 2429906</b>  <b>MOUNTAIN RANGE</b>  <b>Filing date: 15 August 2006</b>  <b>Date of entry in the register: 16 February 2007</b>	<b>Class 43: Bar and restaurant services.</b>

4) The opponent's mark has a filing date earlier than that of the contested mark and has completed its registration procedure; it is therefore an earlier mark in accordance with section 6 of the Act. Given the interplay between the date of entry in the register of the opponent's mark and the date of publication of the applicant's mark, the earlier mark is subject to the proof of use conditions contained in section 6A of the Act. However, as the applicant has not requested that the opponent provide proof of use,<sup>2</sup> the opponent is entitled to rely on its specification, as registered.

5) The applicant filed a counterstatement in which it denied the grounds of opposition. Both parties filed written submissions only in the evidential rounds. Neither party requested to be heard, nor did they file written submissions in lieu of a hearing. I now make this decision based on the papers before me, giving full consideration to all submissions and making reference to the same as, and when, I consider it appropriate.

## DECISION

6) The relevant section of the Act provides:

<sup>1</sup> The official letters of 24 March 2014 and 01 May 2014 refer.

<sup>2</sup> The applicant ticked 'No' in answer to Question 7 of the Form TM8 (which reads "Do you want the opponent to provide "proof of use"?").

“5. - ....

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

(a) it is identical with an earlier trade mark and is to be registered for goods or services 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.”

7) The leading authorities on the assessment of the likelihood of confusion are from the Court of Justice of the European Union (‘CJEU’): *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

### **The principles**

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, 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, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) 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;

(k) if the association between the marks creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

8) I keep in mind the established principles listed above insofar as they are relevant. I say 'insofar as' since the respective marks are clearly identical in this particular case, in the sense described in *S.A. Société LTJ Diffusion v. Sadas Vertbaudet SA*, Case C-291/00 (paragraph [54]), and therefore not all of the principles come into play.

9) Having established that the respective marks are identical, I must now compare the respective goods and services to decide whether they share similarities. For ease of reference, these are set out in the table below:

<b>Opponent's services</b>	<b>Applicant's goods</b>
<b>Class 43:</b> <i>Bar and restaurant services.</i>	<b>Class 30:</b> <i>Ground coffee, instant coffee and coffee beans.</i>

10) The leading authorities as regards determining similarity between goods and services are considered to be *British Sugar Plc v James Robertson & Sons Ltd* ('*Treat*') [1996] R.P.C. 281 and *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 117 ('*Canon*'). In the latter case, the CJEU accepted that all relevant factors should be taken into account including the nature of the goods/services, their intended purpose, their method of use and whether they are in competition with each other or are complementary. The criteria identified in the *Treat* case were:

(a) The respective uses of the respective goods or services;

(b) The respective users of the respective goods or services;

(c) The physical nature of the goods or acts of service;

(d) The respective trade channels through which the goods or services reach the market;

(e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;

(f) The extent to which the respective goods or services are competitive.

11) In *Beautimatic International Ltd v. Mitchell International Pharmaceuticals Ltd and Another* ('Beautimatic') [2000] FSR 267 Neuberger J held that the words must be given their natural meaning, subject to their being construed within their context; they must not be given 'an unnaturally narrow meaning simply because registration under the 1994 Act bestows a monopoly on the proprietor'. However, I must also bear in mind the comments in *Avnet Incorporated v Isoact Ltd* ('Avnet') [1998] FSR 16 where the court stated:

'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.'

12) Further, in *YouView TV Ltd v Total Ltd* ('YouView') [2012] EWHC 3158 (Ch) at paragraph [12] Floyd J said:

'... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question.'

13) On the matter of whether goods and services are complementary (one of the factors referred to in *Canon*), I bear in mind that in *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the General Court ('GC') stated that "complementary" means:

"...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".

Further, in *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as 'complementary' and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected

undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL-0-255-13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes.”

Whilst on the other hand:

“.....it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.

14) When comparing the respective services, if a term clearly falls within the ambit of a term in the competing specification then identical services must be considered to be in play (see *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) ('Meric')* Case T-133/05).

15) Finally, I also bear in mind the comments of the GC in *Commercy AG, v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-316/07, where it pointed out that:

“43. Consequently, for the purposes of applying Article 8(1)(b) of Regulation No 40/94, it is still necessary, even where the two marks are identical, to adduce evidence of similarity between the goods or services covered by them (see, to that effect, order of 9 March 2007 in Case C-196/06 P *Alecansan v OHIM*, not published in the ECR, paragraph 24; and Case T-150/04 *Mülhens v OHIM – Minoronzoni(TOSCA BLU)* [2007] ECR II-2353, paragraph 27).”

Thus where the similarity between the respective goods or services is not self evident/obvious, the opponent must show how, and in which respects, they are similar.

16) I will firstly assess the similarity between the opponent's 'restaurant services' and the applicant's goods. The opponent's submissions are extremely brief. It submits that:

“...restaurants sell coffee. It is therefore entirely likely that the goods and services offered under these identical marks will share the same customers.”

17) The applicant states, *inter alia*, the following:

“It will be noted that the Opponent's submission relies on and is confined to “coffee to be served in Mountain Range Restaurants”. The only possible meaning which can reasonably be attributed to the words used, is that the Opponent is referring to cups of liquid coffee served for customers to consume when served. There is no similarity for the purposes of Section 5(2)(a) between cups of liquid coffee served to customers in a bar or restaurant for virtually immediate consumption, and dry coffee or coffee beans sold through retail channels or by wholesale, as a product to be processed later by the purchaser or end user prior to use.”

18) Given the brevity of the opponent's submissions, I intend to consider each of the *Treat* and *Canon* factors in turn but keep in mind that, where there are no submissions or evidence before me on the point, I can only take into account factors which are obvious.

19) The nature of the applicant's goods is coffee in powdered/granular form (ground and instant coffee) or otherwise dry form (coffee beans). These goods are obviously not similar in nature to '*restaurant services*', not least because the applicant's goods are tangible and the opponent's services are not. As to respective uses and intended purpose, the applicant's goods are intended to enable the consumer to prepare a cup of coffee at home (by adding hot water) whereas the intended purpose of the opponent's '*restaurant services*' is, bearing in mind the *Avnet* principle, to enable consumers to enjoy a meal out which has been prepared for, and served to, them. The respective goods and services will therefore be used in quite different ways. Nevertheless, the users of the goods and services will be the same, namely the general public. In relation to respective trade channels, I agree with the applicant that its goods are likely to be sold through retailers (such as supermarkets and the like). Whilst I agree with the opponent that restaurants are likely to sell coffee, I would expect this to come only in the form of a prepared cup of coffee as an accompaniment or conclusion to a meal. I consider it unlikely that a restaurant will also sell coffee in dry or powdered form and there is no evidence or submissions before me to persuade me otherwise. It follows that there is unlikely to be any overlap in the respective trade channels. Further, a consumer will not, in my view, choose between purchasing a jar of instant coffee (for example) on the one hand and visiting a restaurant on the other. There is no competitive relationship. Lastly, insofar as any complementary relationship is concerned, it is not obvious to me that there is a close connection between the respective goods and services "in the sense that one is indispensable or important for the use of the other in such a way that consumers may think that the responsibility for those goods [and services] lies with the same undertaking". Bearing in mind all of these factors, it appears to me that there is no similarity within the parameters of the case law between the opponent's '*restaurant services*' and the applicant's goods.

20) Turning to the opponent's '*bar services*', the opponent makes no submissions at all in respect of why it considers these to be similar to the applicant's goods. As such, again I can only take into account factors which are obvious. To my mind, the natural and core meaning of '*bar services*' is the preparation and serving of drinks (primarily alcoholic) to the general public over a counter of some sort. Whilst the users of the respective goods and services may be the same, the respective nature, uses and intended purpose is clearly different. As for trade channels, while it is true that bars may serve coffee, this is again likely to be in prepared form i.e. cups of coffee. I see no reason to suppose, and there is nothing before me to show, that a bar will also sell coffee in dry or powdered form to the consumer. There is no overlap in trade channels. I also cannot see that there is any complementary relationship in play. Bearing all of this in mind, and in the complete absence of any evidence or submissions as to why I should find to the contrary, it is my conclusion that there is no similarity between the opponent's '*bar services*' and the applicant's goods.

21) As there cannot be a likelihood of confusion where there is no similarity between any of the respective goods and services, the opponent has no prospect of success. To this end, see, for example, *Waterford Wedgwood plc v OHIM* – C-398/07 P, where the CJEU stated:

“35....Since the Court of First Instance found, in paragraph 35 of the judgment under appeal, that the goods in question were not similar, one of the conditions necessary in order to establish a likelihood of confusion was lacking (see, to that effect, *Canon*, paragraph 22) and therefore, the Court of First Instance was right to hold that there was no such likelihood.”

**The opposition therefore fails.**

### **COSTS**

22) As the applicant has been successful, it is entitled to an award of costs. Using the scale in Tribunal Practice Notice 4/2007 as a guide, I award costs to the applicant on the following basis:

Considering the notice of opposition and preparing Form TM8 and counterstatement	£200
Written submissions:	£300
<b>Total:</b>	<b>£500</b>

23) I order Mountain Range Restaurants Limited to pay Coburg Coffee Company Limited the sum of **£500**. 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 17th day of October 2014**

**Beverley Hedley  
For the Registrar,  
the Comptroller-General**