

O-477-14

TRADE MARKS ACT 1994
IN THE MATTER OF
APPLICATION NO 3016910
BY STOCKDALE INVESTMENTS LIMITED
TO REGISTER THE TRADE MARK



IN CLASSES 29, 30, 32, 41 AND 43
AND
OPPOSITION THERETO (UNDER NO. 60000070)
BY
THE FEEL GOOD DRINKS COMPANY LIMITED

BACKGROUND

1) On 06 August 2013, Stockdale Investments Limited ('the applicant') applied to register the trade mark shown on the cover page of this decision in respect of the following goods and services:

Class 29: *Meat, fish, poultry, game; potato chips; prepared meals; snack foods; milk and milk products; milk based beverages; milkshakes; yoghurt drinks.*

Class 30: *Tea based beverages; coffee based beverages; chocolate based beverages; bakery products; bread; pastries; pies; cakes; scones; muffins; donuts; pancakes; waffles; biscuits; sandwiches; baguettes; wraps; pizza; pasta; hotdogs; hamburgers; snack foods; confectionery; candyfloss; fudge; chocolate; ice-cream, confectionery ices, edible ices, frozen yoghurt; popcorn.*

Class 32: *Beers; mineral and aerated waters and other non-alcoholic beverages; fruit beverages; fruit and vegetable juices; smoothies; syrups and other preparations for making beverages.*

Class 41: *Entertainment services; organising and planning parties; providing amusement arcade and gaming centre services.*

Class 43: *Providing of food and drink; restaurant and bar services; milkshake bar; catering services.*

2) The application was published on 08 November 2013 in the Trade Marks Journal and notice of opposition, under the fast track opposition procedure, was subsequently filed by The Feel Good Drinks Company Limited ('the opponent').

3) The opponent claims that the application offends under section 5(2)(b) of the Act. The opponent initially relied upon three earlier trade marks in its notice of opposition. However, at the opponent's request¹, its grounds of opposition were limited to rely solely on the trade mark shown in the table below:

UK Trade Mark (UKTM) details	Goods relied upon
UKTM No: 2523672 FEEL GOOD PUDS Filing date: 13 August 2009 Date of entry in the register: 15 June 2012	Class 29: <i>Meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies, jams, compotes, eggs, milk and milk products; edible oils and fats; extracts of fruit and/or vegetables; meat products; sausages; prepared meals; snack foods; fruit preserves, vegetable preserves; desserts; fruit desserts; prepared desserts; eggs; dairy products; yoghurt;</i>

¹ The opponent's letter of 11 June 2014 and the official letter of 01 July 2014 refers.

	<p><i>edible protein derived from soya beans; nuts and nut butters; pickles; tofu; weed extracts for foods; soups; bouillon, nut paste.</i></p> <p>Class 30: <i>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, pepper, mustard; vinegar, sauces (condiments); spices; ice; snack foods; breakfast cereals; pastry; pizza, pasta and pasta products; biscuits; cookies; cakes; ice cream, water ices, frozen confections; syrup, treacle; molasses; ketchup; sauces and preparations for making sauces; custard powder; prepared meals; mousses; desserts; puddings; yeast, baking powders; chutney; spices and seasonings; infusions (other than for medical use); meat pies; mayonnaise, meat tenderisers for household purposes; royal jelly for human consumption (other than for medical purposes); natural sweetener; salad dressings; sauces; herbs.</i></p>
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4) The trade mark relied upon by the opponent is an earlier mark in accordance with section 6 of the Act and it is not subject to proof of use, as per The Trade Marks (Proof of Use, etc) Regulations 2004.

5) The applicant filed a counterstatement denying, with explanation, the claims made by the opponent.

6) Rule 6 of the Trade Marks (Fast Track Opposition)(Amendment) Rules 2013, S.I. 2013 2235, disapplies paragraphs 1-3 of Rule 20 of the Trade Mark Rules 2008, but provides that Rule 20(4) shall continue to apply. Rule 20(4) states that:

“(4) The registrar may, at any time, give leave to either party to file evidence upon such terms as the registrar thinks fit.”

7) The net effect of these changes is to require parties to seek leave from the registrar in order to file evidence in fast track oppositions. No leave was sought in the instant proceedings.

8) Rule 62(5) (as amended) states that arguments in fast track proceedings shall be heard orally only if the Office requests it or if either party to the proceedings requests it and the registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost. Otherwise written arguments will be taken. A

hearing was neither requested nor considered necessary. Accordingly, I make the following decision based on the papers before me, giving full consideration to the written submissions of the parties and making reference to the same as, and when, I consider it appropriate.

DECISION

9) Section 5(2)(b) of the Act provides:

“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.”

10) The leading authorities which guide me 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.

Comparison of goods and services

11) The goods and services to be compared are shown in the table below:

Opponent's goods	Applicant's goods
<p>Class 29: Meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies, jams, compotes, eggs, milk and milk products; edible oils and fats; extracts of fruit and/or vegetables; meat products; sausages; prepared meals; snack foods; fruit preserves, vegetable preserves; desserts; fruit desserts; prepared desserts; eggs; dairy products; yoghurt; edible protein derived from soya beans; nuts and nut butters; pickles; tofu; weed extracts for foods; soups; bouillon, nut paste.</p> <p>Class 30: 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, pepper, mustard; vinegar, sauces</p>	<p>Class 29: Meat, fish, poultry, game; potato chips; prepared meals; snack foods; milk and milk products; milk based beverages; milkshakes; yoghurt drinks.</p> <p>Class 30: Tea based beverages; coffee based beverages; chocolate based beverages; bakery products; bread; pastries; pies; cakes; scones; muffins; donuts; pancakes; waffles; biscuits; sandwiches; baguettes; wraps; pizza; pasta; hotdogs; hamburgers; snack foods; confectionery; candyfloss; fudge; chocolate; ice-cream, confectionery ices, edible ices, frozen yoghurt; popcorn.</p> <p>Class 32: Beers; mineral and aerated waters and other non-alcoholic beverages; fruit beverages; fruit and vegetable juices; smoothies; syrups and other preparations for making beverages.</p>

(condiments); spices; ice; snack foods; breakfast cereals; pastry; pizza, pasta and pasta products; biscuits; cookies; cakes; ice cream, water ices, frozen confections; syrup, treacle; molasses; ketchup; sauces and preparations for making sauces; custard powder; prepared meals; mousses; desserts; puddings; yeast, baking powders; chutney; spices and seasonings; infusions (other than for medical use); meat pies; mayonnaise, meat tenderisers for household purposes; royal jelly for human consumption (other than for medical purposes); natural sweetener; salad dressings; sauces; herbs.

Class 41: Entertainment services; organising and planning parties; providing amusement arcade and gaming centre services.

Class 43: Providing of food and drink; restaurant and bar services; milkshake bar; catering services.

12) 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.

13) 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.'

14) 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.'

15) 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."

16) 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).

17) 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.

Classes 29 and 30

18) The applicant's goods in these classes are clearly identical to those of the opponent. The tables below set out where the identity lies:

Opponent's goods in class 29	Applicant's goods in class 29	Level of similarity
<i>Meat, fish, poultry, game</i>	<i>Meat, fish, poultry, game</i>	Identical
<i>Snack foods</i>	<i>Potato chips</i>	Potato chips are a kind of snack food. The goods are identical in accordance with <i>Meric</i>
<i>Prepared meals</i>	<i>Prepared meals</i>	Identical
<i>Snack foods</i>	<i>Snack foods</i>	Identical
<i>Milk and milk products</i>	<i>Milk and milk products; Milk based beverages; milkshakes; yoghurt drinks</i>	Identical

Opponent's goods in class 30	Applicant's goods in class 30	Level of similarity
<i>Coffee, tea, cocoa</i>	<i>Tea based beverages; coffee based beverages; chocolate based beverages.</i>	Identical.
<i>Biscuits; cookies; cakes; bread</i>	<i>bakery products</i>	Identical
<i>Bread</i>	<i>bread</i>	Identical
<i>Pastry; desserts; puddings</i>	<i>pastries</i>	Identical
<i>meat pies; desserts; puddings</i>	<i>pies</i>	Identical (the opponent's desserts and puddings would also include sweet pies e.g. apple

		pie).
<i>cakes; desserts;</i>	<i>Cakes; scones; muffins; donuts; pancakes; waffles</i>	Identical
<i>Biscuits</i>	<i>biscuits</i>	Identical
<i>Snack foods</i>	<i>Sandwiches; baguettes; wraps</i>	Identical
<i>Pizza; pasta</i>	<i>Pizza; pasta</i>	Identical
<i>Snack foods</i>	<i>Hotdogs; hamburgers</i>	Identical
<i>Snack foods; confectionery</i>	<i>Snack foods; confectionery</i>	Identical
<i>Confectionery</i>	<i>Candyfloss; fudge; chocolate</i>	Identical
<i>Ice cream, water ices, frozen confections; desserts</i>	<i>Ice cream, confectionery ices, edible ices; frozen yoghurt</i>	Identical
<i>confectionery</i>	<i>popcorn</i>	Identical

Class 32

19) In its written submissions in lieu of a hearing, the opponent claims that the parties' respective goods in class 32 are identical or similar. However, as will be apparent, UKTM 2523672, which is the only mark now relied upon by the opponent, is not registered in respect of class 32. Accordingly, I can only make the comparison on the basis of the goods in classes 29 and 30 covered by the opponent's mark. In doing so, I will take, what appears to me, to be the opponent's strongest case and compare it with the applicant's goods. I note that the applicant appears to consider that the opponent's strongest case lies with its '*coffee; tea*'. It makes the comparison of the respective goods on that basis and submits that there is no similarity. However, upon review of the goods covered by its earlier mark, it appears obvious to me that the opponent's best case lies with its '*milk products*' in class 29 (insofar as this term includes drinks i.e. '*milkshakes*') and '*syrops*' in class 30. In my view, the opponent has no stronger prospect of success in respect of any of its other goods. I will proceed on that basis.

Beers

20) The only obvious similarity between '*beers*' and '*milkshakes*' is that they are both beverages. However, '*beer*' is alcoholic whereas '*milkshakes*' are not and they are prepared in quite different ways. Whilst they may both be bought by the general public and sometimes share trade channels, they are unlikely to be sold in the same area in a supermarket. '*Beers*' are likely to be stocked with other alcoholic drinks on shelves; '*milkshakes*' are likely to be sold in refrigerators in a different area. Further, given their quite different tastes, textures, and viscosities and that one is alcoholic and other not, it is very unlikely that the consumer would choose between purchasing '*beer*' on the one hand and a '*milkshake*' on the other; they are not in competition. **There is no similarity between the opponent's best case, '*milkshakes*', and the applicant's '*beers*'.**

smoothies

21) A 'smoothie' is a 'non-alcoholic drink made from fresh fruit purée mixed with milk, yoghurt, or ice cream'.² It is obvious to me that such goods are very similar in nature to 'milkshakes'; they are both non-alcoholic, have similar ingredients and both may have a thick, smooth texture and similar fruity flavours. In light of these overlapping qualities, they may also be in competition i.e. a consumer may choose between purchasing a 'milkshake' or a 'smoothie'. Further, as both are drinks made from perishable ingredients (milk and/or fruit puree) they are likely to be sold in close proximity in the refrigerator section of a supermarket to maintain their freshness. **There is a high degree of similarity between the opponent's 'milkshakes' and the applicant's 'smoothies'.**

mineral and aerated waters and other non-alcoholic beverages; fruit beverages; fruit and vegetable juices

22) The applicant's goods listed above are all, like the opponent's 'milkshakes', non-alcoholic drinks. I think it likely that the respective trade channels will overlap significantly, the users would be the same (the general public) and that the competing goods are likely to be found in close proximity in a supermarket. I would also expect a degree of competition between the respective goods with a consumer perhaps choosing between a 'fruit beverage' and a 'milkshake', for example. **There is a good degree of similarity between the opponent's 'milkshakes' and the applicant's 'mineral and aerated waters and other non-alcoholic beverages; fruit beverages; fruit and vegetable juices'.**

syrups and other preparations for making beverages

23) Whilst the opponent's 'syrups' in class 30 are mainly those for the purpose of flavouring or topping foods (as opposed to preparing beverages), the term would also include 'chocolate syrup for making beverages'. Bearing this in mind, the respective goods have similar natures, the same intended purpose in that they will be used to prepare a beverage, the trade channels may overlap significantly and the users may be the same. **There is a good degree of similarity between the opponent's 'syrups' and the applicant's 'syrups and other preparations for making beverages'.**

Class 41

Entertainment services; organising and planning parties; providing amusement arcade and gaming centre services.

24) The opponent claims that the applicant's services listed above are "complementary services to the goods covered by [its earlier mark]". However, it does not elaborate any further beyond this bald assertion or provide any evidence in support of this contention. It is far from obvious to me that any of the opponent's goods are complementary to the aforementioned services of the applicant "in the

² "[Smoothie or smoothy](#)" 2007, in *The Penguin English dictionary*, Penguin, London, United Kingdom. Accessed: 28 October 2014, from Credo Reference

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” (*Boston*). Furthermore, I cannot see any obvious overlap in terms of respective nature, uses, trade channels, intended purpose and nor are the respective goods and services in competition. **There is no similarity between the applicant’s services in class 41 and the opponent’s goods.**

Class 43

Providing of food and drink; restaurant and bar services; catering services.

25) The opponent does not specifically identify its strongest case against the above services, merely stating that its goods are complementary to the same. It appears to me that the opponent’s best case lies with its goods which are in prepared form i.e. ‘*Prepared meals*’, ‘*Snack foods*’, ‘*prepared desserts*’ and ‘*milk products*’ (insofar as the latter term covers ‘*prepared milk drinks*’). Whilst the respective nature is clearly different as the opponent’s goods are tangible and the applicant’s services are not, there is nevertheless a shared purpose since both the goods and services are intended to satisfy thirst/hunger. The users are likely to be the same (the general public) and further, there is a competitive relationship as the consumer may choose between purchasing a ‘prepared meal’ or ‘prepared dessert’ and visiting a restaurant, for example. **There is a reasonable degree of similarity between the opponent’s goods in prepared form (identified above) and the applicant’s ‘Providing of food and drink; restaurant and bar services; catering services.’**

milkshake bar

26) The opponent’s ‘*milkshakes*’ represent its strongest case against the applicant’s ‘*milkshake bar*’. The respective natures differ, however, the users will be the same, the trade channels will be the same, they have a shared intended purpose (to satisfy a thirst for milkshake) and there is clearly a complementary relationship since ‘*milkshakes*’ are indispensable to ‘*milkshake bars*’. **I find there to be a reasonable degree of similarity between the opponent’s ‘*milkshakes*’ and the applicant’s ‘*milkshake bar*’ services.**

Average consumer and the purchasing process

27) It is necessary to consider these matters from the perspective of the average consumer of the goods and services at issue (*Sabel BV v. Puma AG*). 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 and services.

28) The average consumer of the goods and services in this case is the general public. The goods are generally low cost items which are likely to be purchased reasonably frequently and, as such, the degree of care and attention is likely to be, at best, at a moderate level. As for the applicant’s services, the cost of these may vary significantly. Generally speaking, I would expect a reasonable degree of attention to be afforded during the purchase of the services. All of the goods and services at issue are likely to be sought out primarily by eye. However, I bear in mind

that aural use may also play a part in the selection process such as, for example, where goods are requested orally over a counter.

Distinctive character of the earlier mark

29) The distinctive character of the earlier mark must be considered. The more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion (*Sabel BV v Puma AG*). The distinctive character of a trade mark must be assessed by reference to the goods or services for which it is registered and by reference to the way it is perceived by the relevant public (*Rewe Zentral AG v OHIM (LITE)* Case T-79/00 [2002] ETMR 91).


30) There is no evidence before me in the instant case and therefore I can only take into account the inherent characteristics of the opponent's mark. 'PUDS' is likely to be perceived as a shortened version of the word 'puddings'.³ Clearly puddings cannot, of themselves, 'FEEL GOOD' and therefore the use of these words to qualify the word 'PUDS' is somewhat unusual. Nevertheless, I consider that the average consumer will immediately make sense of the mark such that the meaning that will be immediately grasped is of 'puddings which make you feel good' ('you' being the consumer). Bearing this in mind, the mark is not particularly high on the distinctiveness scale, particularly for those of the opponent's goods which may be classed as 'puddings'. In my view, the mark is possessed of a fairly low degree of distinctive character.

Comparison of marks

31) The average consumer normally perceives a mark as a whole and does not proceed to analyse its details. The visual, aural and conceptual similarities 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*). Accordingly, there cannot be an artificial dissection of the marks, although it is necessary to take into account any distinctive and dominant components. Further, in *BIMBO S.A. v OHIM* Case C-591/12P, the CJEU stated:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

³ "Pud" 2000, in *Collins english dictionary*, Collins, London, United Kingdom. Accessed: 23 October 2014, from Credo Reference

Opponent's mark	Applicant's mark
<p>FEEL GOOD PUDS</p>	

32) The opponent submits that the dominant and distinctive element of its mark is the words 'FEEL GOOD', presumably on the basis that 'PUDS' is descriptive in relation to the relevant goods. Whilst it is true that 'PUDS' is a well known abbreviation of the word 'puddings' and thus descriptive in relation to, at least, certain of the opponent's goods, it is certainly not negligible; it is qualified by the words 'FEEL GOOD' such that all three words work together to form a phrase. In my view, the overall impression is of a complete phrase in which no one element greatly dominates.

33) Turning to the applicant's mark, the overall impression is made up of a number of elements. There is the 'feelgoods' element, in a stylised font, in which the base of the letter 'L' is elongated such that it sweeps underneath the word 'goods'. There are also the words 'PIZZA', 'PASTA', and 'PLAY' presented on an arc shape and the strap line 'Specialising in good times!' presented on a rectangular-shaped background (with curved corners). The mark is presented in the colours red, yellow and white. None of the elements of the mark are negligible. However, the 'feelgoods' element is the most distinctive and visually prominent and has the greatest relative weight in the overall impression compared to the other elements.

34) From a visual perspective, the applicant submits that the respective marks are 'very different' and that its mark is 'a graphical representation featuring a number of elements which include words, colours (red, yellow, white and grey), different graphical styles and different font types' whereas the opponent's mark 'simply feature the words "FEEL GOOD PUDS"'. Dealing firstly with the applicant's point about the colours in its mark, these colours are not a distinguishing factor since the opponent's mark is registered in black and white.⁴ I have therefore drained the colour from the applicant's mark for the purposes of the visual comparison. Whilst I note the applicant's other comments, there is, nevertheless, clearly a point of visual coincidence between the marks on account of the presence of the letters 'F E E L G O O D' in both. Whilst it is true that, in the opponent's mark, these are presented as two separate words in upper case whereas in the applicant's mark they are

⁴ See, for example, the comments of Mann J in *Specsavers International Healthcare Ltd v Asda Stores Ltd (No. 2)* [2011] FSR 1.

presented conjoined along with the letter 's' (all in lower case, in a stylised font), and that all other aspects of the marks are different, I still consider there to be a reasonably good degree of visual similarity between the marks overall.

35) Turning to the aural aspect, again the applicant submits that the marks are 'very different'. The opponent submits that the consumer would not articulate all of the words in the applicant's mark but rather, that they would only pronounce the 'FEELGOODS' element on the basis that this is 'the larger element of the trade mark as a whole'. I agree with the opponent's view. Whilst the whole of the opponent's mark is likely to be vocalised, I consider it unrealistic to suppose that the consumer will attempt to articulate all of the words in the applicant's mark; it is likely that only the prominent 'FEELGOODS' element will be vocalised. On that basis, I must disagree with the applicant that the marks are aurally very different. On the contrary, there is a good degree of aural similarity.

36) In terms of concept, the opponent does not make any specific submissions as regards how the respective marks are likely to be perceived. As for the applicant, whilst it contends that the marks are 'very different' visually and aurally, I note that it does not appear to dispute that the marks are conceptually similar as it stresses that 'the mere fact that two marks are conceptually similar is not sufficient in itself to conclude that there is a likelihood of confusion' (my emphasis). The idea conveyed by the opponent's mark is likely to be, as I have already stated, 'puddings which make you feel good'. The concept which will be grasped immediately from the applicant's mark is, in my view, the general idea of 'feeling good' on account of the prominent 'feelgoods' element and the strap line 'Specialising in good times'. The words 'PIZZA', 'PASTA' and 'PLAY' are likely to have little impact beyond merely being an indication of the nature of the goods/services. On the whole, I consider the level of conceptual similarity to be reasonably good.

Likelihood of confusion

37) I must now feed all of my earlier findings into the global assessment of the likelihood of confusion, keeping in mind the following factors:

- i) the interdependency principle, whereby a lesser degree of similarity between the goods and services may be offset by a greater similarity between the marks, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*);
- ii) the principle that the more distinctive the earlier mark is, the greater the likelihood of confusion (*Sabel BV v Puma AG*), and;
- iii) the factor of imperfect recollection i.e. that consumers rarely have the opportunity to compare marks side by side but must rather rely on the imperfect picture that they have kept in their mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.*).

38) On account of my earlier finding that the applicant's 'Beers' in class 32 and services in class 41 are not similar to the opponent's goods, the opponent has no prospect of success in relation to those goods and services. 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 in relation to the applicant’s ‘Beers’ in class 32 and all of the services in class 41.

39) Turning to the remainder of the applicant’s goods and services, I have found these to be either identical or similar (to varying degrees, as identified) to the goods of the opponent. I have also found that the opponent’s mark shares a reasonably good degree of visual similarity, a good degree of aural similarity and a reasonably good degree of conceptual similarity with the applicant’s mark. The average consumer will be the general public. The level of attention of the average consumer is likely to be, at best, moderate in relation to the goods at issue and reasonable in relation to the services. The purchasing act will be mainly visual but aural considerations must also be considered since they may also play a part in the selection process. As for the distinctive character of the earlier mark, I have concluded that this is fairly low. In this connection, I bear in mind the comments of the GC in *Air Products and Chemicals, Inc v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) (Air Products)* Joined Cases T – 305/06 to T 307/06, where it stated:

“59 With regard to the weak distinctiveness of the common components and of the earlier marks as a whole, it should be recalled that the finding of a weak distinctive character for the earlier trade mark does not preclude a finding that there is a likelihood of confusion. While the distinctive character of the earlier mark must be taken into account when assessing the likelihood of confusion (see, by analogy, Canon, paragraph 24), it is only one of a number of elements entering into that assessment. Even in a case involving an earlier mark of weak distinctive character, there may be a likelihood of confusion on account, in particular, of a similarity between the signs and between the goods or services covered (Case T-134/06 *Xentral v OHIM – Pages jaunes (PAGESJAUNES.COM)* [2007] ECR II-5213, paragraph 70; see, to that effect, Case T-112/03 *L’Oréal v OHIM – Revlon (FLEXI AIR)* [2005] ECR II-949, paragraph 61).

60 In addition, the argument of OHIM and of the applicant in that regard would have the effect of disregarding the notion of the similarity of the marks in favour of one based on the distinctive character of the earlier mark, which would then be given undue importance. The result would be that, where the earlier mark is only of weak distinctive character, a likelihood of confusion would exist only where there was a complete reproduction of that mark by the mark applied for, whatever the degree of similarity between the marks in question (order of the Court of 27 April 2006 in Case C-235/05 P *L’Oréal v OHIM*, not published in the ECR, paragraph 45). Such a result would not, however, be consistent with the very nature of the global assessment which the competent authorities are required to undertake by virtue of Article 8(1)(b) of Regulation No 40/94

(judgment of 15 March 2007 in Case C-171/06 P T.I.M.E. ART v Devinlec and OHIM, not published in the ECR, paragraph 41, and PAGESJAUNES.COM, paragraph 71).”

40) Having weighed all of the relevant factors against each other, I have reached the conclusion that, notwithstanding the fairly low degree of distinctive character of the earlier mark, the respective overall impressions of the marks are sufficiently similar, bearing in mind the identity and level of similarity between the respective goods and services, to result in a likelihood of indirect confusion i.e. that the average consumer is likely to believe that the respective goods and services are produced by the same, or linked, undertaking(s). Further, as this conclusion applies to all of the applicant's goods in classes 29, 30 and 32 (with the exception of 'beers') and all of the services in class 43, the fall-back position provided by the applicant in those classes (with the exception of the suggested fall-back to 'beers') does not assist it.

OUTCOME SUMMARY

41) The opposition succeeds in relation to the following goods and services:

Class 29: Meat, fish, poultry, game; potato chips; prepared meals; snack foods; milk and milk products; milk based beverages; milkshakes; yoghurt drinks.

Class 30: Tea based beverages; coffee based beverages; chocolate based beverages; bakery products; bread; pastries; pies; cakes; scones; muffins; donuts; pancakes; waffles; biscuits; sandwiches; baguettes; wraps; pizza; pasta; hotdogs; hamburgers; snack foods; confectionery; candyfloss; fudge; chocolate; ice-cream, confectionery ices, edible ices, frozen yoghurt; popcorn.

Class 32: mineral and aerated waters and other non-alcoholic beverages; fruit beverages; fruit and vegetable juices; smoothies; syrups and other preparations for making beverages.

Class 43: Providing of food and drink; restaurant and bar services; milkshake bar; catering services.

42) The opposition fails in relation to the following goods and services:

Class 32: Beers.

Class 41: Entertainment services; organising and planning parties; providing amusement arcade and gaming centre services.

COSTS

43) The opponent has been largely, but not wholly, successful. As such, I consider it appropriate to adopt the approach taken by Ms Amanda Michaels, sitting as the Appointed Person in *Wm Morrison Supermarkets Plc v Nisa-Today's (Holdings) Limited* (BL O/197/11), where she stated:

"22. The starting point for the exercise of the discretion, as set out in CPR 44.3 and reflected in *Johnsey*, is that costs should follow the event. As CPR 44.3(2)(a) puts it "the general rule is that the unsuccessful party will be ordered to pay the costs of the successful party". Nevertheless, as CPR 44.3(4) indicates, the judge "must have regard to all the circumstances" which may include "whether a party has succeeded on part of his case, even if he is not be wholly successful." The court may therefore make different orders for the costs incurred in relation to discrete issues and should consider doing so where a party has been successful on one issue but unsuccessful on another.

...

Approaching the matter in accordance with CPR 44.3, it seems to me that NISA ought be considered the successful party and to have its costs, subject to a deduction of an amount to reflect the fact that it was not wholly successful in the invalidation application or in respect of the opposition based on sub-section 5(2)(b). NISA was only unsuccessful in both the invalidation and opposition proceedings in relation to a fairly narrow range of goods, yet in my judgment some credit should be given to Morrisons to reflect the result. Without a breakdown of the parties' costs by reference to the issues, a process which it would be disproportionate to ask the parties to undertake at this stage, making such a reduction is necessarily a rough and ready process. Doing the best I can, in my judgment it would be appropriate to reduce the costs awarded to NISA by 20% to reflect its partial level of success (save as stated in sub-paragraph 27(d) below)."

44) In the case before me, the opponent has been successful against all of the goods and services in classes 29, 30 and 43 and against all but one term in class 32. I assess the opponent's degree of success to be roughly 80%. Bearing this in mind, and using the guidance set out in Tribunal Practice Notice 4/2007, I award costs to the opponent on the following basis:

Preparing notice of opposition and considering the counterstatement	£200
Opposition fee	£100
Written submissions:	£300
Less 20% to reflect partial success	- £120
Total:	£480

45) I order Stockdale Investments Limited to pay The Feel Good Drinks Company Limited the sum of **£480**. 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 5th day of November 2014

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