

O-487-18

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION 3218482

BY ANDREW SWEENEY

TO REGISTER THE FOLLOWING TRADE MARK IN CLASS 29 AND CLASS 32:



AND

OPPOSITION THERETO UNDER NO. 410099

BY FOOD FOR PROGRESS SCANDINAVIA AB

Background and pleadings

1. The above trade mark was filed by Andrew Sweeney (“the applicant”) on 14 March 2017. It was published for opposition purposes on 26 May 2017. Registration of the mark is opposed by Food for Progress Scandinavia AB (“the opponent”) under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent relies on EU Trade mark (“EUTM”) registration 13697156, which was filed on 30 January 2015 and registered on 28 July 2015. This case therefore involves a conflict between the following marks and goods and services:

Applied for mark	Earlier mark
 <p>Class 29: Drinks made from dairy products.</p> <p>Class 32: Powders used in the preparation of soft drinks.</p>	<p>Oumph!</p> <p>Class 1: Protein prepared from soya beans for use in the manufacture of foodstuffs; soya bean oil for industrial purposes; lecithin derived from soya for use in the manufacture of foodstuffs.</p> <p>Class 29: Meat, fish, seafood, poultry and game and products thereof; vegetarian fish and seafood substitute for food use; meat extracts; preserved, frozen, dried and cooked fruits, vegetables and pulses; jellies, jams, compotes; eggs; milk and milk products; edible oils and fats; vegetarian meals; fish dishes; prepared dishes consisting principally of meat; soups; stocks; bean-based snacks; soya bean milk; soya milk; bean milk.</p>

	<p>Class 30: Rice; cereal flours; spices, ice; bread; biscuits; cakes; pastry and confectionery; ice-cream; condiments; sauce [edible]; pancakes; bean meal; soya flour; pasta; noodles; pies; pizza; breakfast cereals; honey; treacle syrup; vinegar; foodstuffs made of soya or soya beans; soybean paste condiment [doenjang]; soy-based ice cream substitute; soya drinks; vegetarian ice cream products; sushi; vegetarian sushi; rice based dishes; pasta based dishes; cereal based dishes; snacks based on rice; snacks based on nuts; cereal-based snack food; prepared desserts (pastries); prepared desserts (confectionary).</p> <p>Class 31: Fresh fruits and vegetables; natural plants and flowers; fresh soya beans.</p> <p>Class 32: Non-alcoholic beverages including soya-based beverages other than milk substitutes, vegetable juices, fruit juices, vegetarian drinks.</p> <p>Class 43: Provision of food and drink.</p>
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2. In its notice of opposition, the opponent contends that the applied for mark is similar to the earlier mark and that the goods for which the applied for mark is seeking protection are either identical and/or similar to the goods and services covered by the earlier mark. The opponent further contends that there exists a likelihood of confusion on the part of the public, which includes a likelihood of association with the earlier mark.

3. The applicant filed a counterstatement in which it denies that the applied for mark and the earlier mark are similar. It makes no comment regarding the parties' respective goods and services.

4. The applicant is represented by Trade Mark Wizards Limited. The opponent is represented by Potter Clarkson LLP. Only the opponent filed evidence. Whilst neither party asked to be heard, the opponent filed written submissions in lieu of attendance at a hearing.

Evidence

5. The opponent filed evidence which consists of a witness statement of Lucy Mills, a Trade Mark Attorney at the opponent's representative. It is dated 22 December 2017. Miss Mills' evidence concerns other trade marks and oppositions, which are not relevant for the purposes of these proceedings. I will refer to the relevant submissions, where appropriate, throughout the remainder of this decision.

Section 5(2)(b)

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

“5 (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.”

7. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

“6 (1) In this Act an “earlier trade mark” means –

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

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

8. In these proceedings, the opponent is relying upon the trade mark referred to in paragraph 1 above, which qualifies as an earlier trade mark under section 6 of the Act outlined above. As the opponent’s earlier mark had not completed its registration process more than five years before the publication date of the applied for mark, it is not subject to proof of use, as per section 6A of the Act. The opponent can, as a consequence, rely upon all of the goods and services for which its earlier mark is registered.

9. The following principles are gleaned from the judgment of the EU courts in *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 C3/03, *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.

(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 the 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

10. When making the comparison of goods and services, all relevant factors should be taken into account. In *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer* 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.”

11. Guidance on this issue has also come from Jacob J in the *Treat* case, [1996] R.P.C 281, where he identified the factors for assessing similarity as:

- (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. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

12. The General Court (“GC”) confirmed in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, that, even if goods/services are not worded identically, they can still be considered identical if one term falls within the scope of another (or vice versa):

“29. In addition, the goods can be considered as identical when the goods designated by the earlier trade mark are included in a more general category, designated by trade mark application (Case T-388/00 Institut für Lernsysteme v OHIM – Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark.”

13. In its notice of opposition, the opponent claims that the goods are identical or similar. The applicant did not address the parties’ respective goods and services in its counterstatement.

14. The opponent filed submissions which include analysis of the parties' respective goods. However, there are two flaws in its reasoning. Firstly, the opponent refers to the applicant's goods as being in class 30, when they are actually in class 32. Secondly, the opponent proceeds to compare these goods to terms such as, inter alia, cocoa in class 30, for which it does not have a registration, either explicitly or included within a broader term. Consequently, I will not say any more about these submissions as they are not relevant to the matter before me.

The applicant's goods in class 29

15. The opponent submitted:

“[...] “drinks made of dairy products” are identical to “milk and milk products” covered by Class 29 of the earlier registration, given that “milk” is a drink, and “milk products” can include milk based drinks, and that “milk” is a form of “dairy product”.”

16. I agree with the opponent. It is self-evident that “drinks made from dairy products” in the applicant's specification fall within the scope of “milk and milk products” in the opponent's specification. These goods are identical in accordance with the principle in *Meric*.

The applicant's goods in class 32

17. As far as “powders used in the preparation of soft drinks” in the applicant's specification are concerned, I am of the view that these goods are not identical to any of the goods or services in the opponent's specification. However, there is a possibility of similarity between “powders used in the preparation of soft drinks” in the applicant's specification and “non-alcoholic beverages [...]” in the opponent's specification, both of which fall within class 32. I will therefore proceed to compare these goods in line with the legal tests referred to in paragraphs 10 and 11.

18. The goods referred to in paragraph 17 have the same users, being members of the general public. Their uses are, to some extent, the same in that the final product in both cases is a drink. Further, their purpose is highly similar, being to quench a person's thirst. However, their physical nature is different, the applicant's product being a solid, in powder form, to which a liquid must be added in order to result in the final drink, whilst the opponent's product is already in its finished liquid form, ready to drink. Although both products will typically be sold in stores or online and will reach the market through similar trade channels, consumers will likely find them in different places within the shop and under different categories online. Consumers will however have the choice between purchasing a ready-made drink and purchasing the powder to make their own drink and therefore the goods are in competition with one another to some extent.

19. In relation to establishing whether the goods may be regarded as 'complementary', I refer to *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06. The General Court 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."

I do not consider the two products to be important for the use of one another. Whilst a soft drink can be made from a powder, it is not essential. However, the goods could come from the same undertaking, i.e. one undertaking could provide powder for making drinks and the ready-made drinks themselves and to that extent I find them to have a degree of complementarity.

20. Bearing all relevant factors in mind I find these goods to be similar to a medium degree.

The average consumer and the nature of the purchasing act

21. As principle (b) in paragraph 9 above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer, Case C-342/97*.

22. The average consumer for these goods is a member of the general public. The goods are inexpensive and purchased fairly frequently, for example during a weekly shop. The purchase is likely to be primarily visual: the goods are likely to be selected from physical stores or websites. However, I do not discount that there may be an aural element. I bear in mind that the average consumer is likely to consider, for example, the ingredients, flavours and nutritional content of the goods in question and I find that, taking all of these factors into account, the level of care and consideration that will be adopted during the purchasing process would be average.

Comparison of marks

23. It is clear from *Sabel BV v Puma AG* that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to their overall impressions created by the trade marks, bearing in mind their distinctive and dominant components. The Court of

Justice of the European Union (“CJEU”) stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“...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.”

It would be wrong, therefore, to artificially dissect the trade marks, although it is necessary to take into account the distinctive and dominant components of the trade marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the trade marks.

24. The trade marks to be compared are as follows:

Applied for mark	Earlier mark
	Oumph!

25. The opponent made submissions regarding the comparison of the marks, which I will refer to where relevant. The applicant did not make reference to the overall impression or the components of the marks within its counterstatement.

Overall impression

26. The applicant’s mark consists of the word “oomf” in blue, presented in a fairly standard font, followed by an exclamation mark. The words “a healthy kickstart to your day”, are presented, below the word “oomf!”, in red lower case letters. All of the words

are contained within a white 'bubble' or 'cloud' style element outlined with a border in the same colour blue as the word 'oomf!'. Behind this is a black rectangular background. I consider that the word "oomf!" has the greatest impact in the overall impression, given its size and position. A lesser role is played by the phrase "a healthy kickstart to your day" which, positioned beneath the word "oomf!" and in a smaller typeface, is likely to be seen as a promotional message or slogan by the average consumer. The white 'bubble' or 'cloud' background with the blue border plays a weaker role, though will not be ignored by the average consumer, while the black background is unlikely to be given any origin significance.

27. The opponent's mark consists solely of the word "oumph" followed by an exclamation mark. No part of the word is stylised or emphasised in any way. There are no other elements to contribute to the overall impression, which rests in the mark in its totality.

Visual comparison

28. Visually, the word "oomf!" within the applicant's mark is the largest component, is positioned prominently and centrally within the mark, and is therefore the visually dominant component. The same can be said for the opponent's mark in that the dominant component is the word "oumph!". The similarity lies in the first, third and final characters of the dominant component of the applicant's mark, which are the same as the first, third and final characters of the opponent's mark.

29. The applicant's mark contains additional wording in the form of a promotional message or slogan below the word "oomf!" which reads "a healthy kickstart to your day". I do not agree with the opponent that this will be easily overlooked by consumers, nor will it have a negligible impact on the visual comparison. Whilst I accept that it is in a subservient position within the mark and is in a smaller font to the dominant word "oomf!", the words are in a red font on a white background and are in a large enough font size to be noticeable. As I have found above, the words play a role within the mark, albeit, a lesser role than the word oomf!

30. There exists a further difference in that the applicant's mark also contains stylisation in the form of a white 'bubble' or 'cloud' style element with a blue border, which encases the word "oomf!" and the by-line below it. This 'bubble' is on a black rectangular background. In contrast, the opponent's mark consists solely of the word "Oumph!" with no stylisation.

31. In considering the presentation of the marks at issue I am mindful of the comments in *Sadas SA v OHIM*, Case T-346/04, where the Court of First Instance (now the General Court (GC)) assessed the similarity of 'Arthur' (in script) against the application 'ARTHUR ET FÉLICIE', in plain block capital letters. It held,

"47. At the visual level, given that the figurative elements of the earlier mark are secondary relative to its word element, the comparison of the signs may be carried out on the basis of the word element alone, whilst still adhering to the principle that an assessment of the likelihood of confusion, with regard to the similarity of the signs, must be based on the overall impression given by them. Accordingly, since the earlier mark Arthur is entirely included in the trade mark sought ARTHUR ET FÉLICIE, the difference linked to the addition of the words 'et' and 'Félicie' at the end of the trade mark sought is not sufficiently large to counter the similarity created by the coincidence of the dominant element of the trade mark applied for, namely the word 'Arthur'. Moreover, since registration of the trade mark ARTHUR ET FÉLICIE was sought as a word mark, nothing prevents its use in different scripts, such as, for example, a form comparable to that used by the earlier mark. As a result, the signs at issue must be considered visually similar."

32. The GC also applied *Sadas* in similar circumstances in *Peek & Cloppenburg v OHIM*, Case T-386/07, where the earlier mark was the plain word mark. It stated,

"27...the Board of Appeal was wrong to take into account the particular font used by the mark applied for in its comparison of the signs at issue. ... since the early mark is a word mark, its proprietor has the right to use it in different

scripts, such as, for example, a form comparable to that used by the mark applied for.”

Accordingly, in this case, normal and fair use of the opponent’s mark would include use of the mark in a range of typefaces, including those with a degree of stylisation which may reduce the apparent visual difference between the marks when the opponent’s mark is considered in block capitals.

33. With regard to the colours present in the application, the earlier mark is not limited to colour and the opponent would be entitled to present elements of its trade mark in the same colours as those present in the mark applied for. Consequently, the fact that the applicant’s mark is presented in particular colours is not a point that assists them.

34. Taking all of these factors into account, I consider the two marks in question to be visually similar to a medium degree.

Aural comparison

35. In terms of aural similarity, the opponent submits that “[their] mark and the Applicant’s mark will be pronounced in a highly similar (if not identical) manner”. The opponent submitted the following:

“Whilst OOMF! and OUMPH! are spelt slightly differently, it should be noted that to an English-speaking consumer the ‘PH’ and ‘F’ are pronounced identically. Furthermore, ‘OO’ and ‘OU’ can also be pronounced identically, an apt example of this are the words ‘wood’ and ‘would’. This pronunciation will be reinforced, in the consumer’s mind, by the semantic content of the marks, as both are misspellings of the word OOMPH...”

36. Whilst the applicant’s mark includes the promotional message or slogan “a healthy kickstart to your day”, words that have no equivalent in the opponent’s mark, the dominant component of the applicant’s mark and the opponent’s mark are aurally identical. I think it unlikely that the average consumer would refer to the applicant’s goods as ‘oomf! a healthy kickstart to your day’. I suggest it is more likely that this

would be shortened to 'oomf', with the remaining words being seen as a promotional slogan. Bearing this in mind, in my view, the marks are aurally identical, except where the average consumer does articulate the additional slogan, where I find the aural similarity to be of a medium degree.

Conceptual comparison

37. Regarding the conceptual similarity of the marks, in my view both marks may be perceived as misspellings of the English word 'oomph': meaning "power, strength, or energetic activity", as per the opponent's submissions. Whilst I recognise the possibility that "oomf" may be perceived as an invented word, I think it unlikely. The addition of the phrase, "a healthy kickstart to your day" gives the average consumer the message that these goods will give your morning oomph. Whereas, the earlier mark relates to the concept more generally. Consequently, I find these marks to have a high degree of conceptual similarity.

Distinctive character of the earlier trade mark

38. The degree of distinctiveness of the earlier mark must be assessed. This is because the more distinctive the earlier mark, the greater the likelihood of confusion (see *Sabel BV v Puma AG*, paragraph 24). In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

"22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not

contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

39. The opponent has submitted that:

“[...] the OUMPH! mark relied upon by the Opponent is at least of normal distinctive character, which means it enjoys broader protection than marks of minimal distinctive character. However, it should also be noted that it is possible for a mark to have enhanced inherent distinctiveness, where the mark is sufficiently original, unusual or unique [...] It is submitted that the word OUMPH! is arbitrary and bears no connection to the goods and services covered by the earlier registration, which means it possesses at least normal, and arguably enhanced distinctive character for the relevant goods and services.”

40. As no evidence has been filed by the opponent, I have only the inherent distinctiveness of the earlier mark to consider. I do not agree that the word “Oumph” is original, unusual or unique. As was argued in the opponent’s own submissions, the average consumer is likely to treat “Oumph” as a misspelling of the dictionary word ‘oomph’. I would suggest that a proportion of the average consumers may not have knowledge of whether the word in question is in fact spelt with ‘ou-’ or ‘oo-’ and therefore not recognise that “Oumph” is a misspelling. In either case the word will be seen as the word ‘oomph’.

41. Whilst I find that the earlier mark is not descriptive of the goods and services for which it is registered, it does suggest that the goods for which it is registered may provide the consumer with oomph, or energy and as such may allude to a desirable effect. Accordingly, I find the earlier mark to possess a slightly lower than average degree of inherent distinctive character.

Likelihood of confusion

42. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the opponent's trade mark as the more distinctive this trade mark is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind.

43. There are two types of confusion to consider: direct confusion (where one mark is mistaken for the other) and indirect confusion (where the respective similarities lead the consumer to believe that the respective goods come from the same, or related, trade source). I bear in mind the decision in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10, where Mr Iain Purvis, sitting as the Appointed Person, noted that:

“Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognised that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.”

44. Earlier in this decision I found that:

- The average consumer is a member of the general public, who will select the goods primarily by visual means (though I do not discount an aural component) and who will pay, in the main, an average degree of attention in their selection;
- The goods in class 29 are identical and the goods in class 32 are similar to a medium degree;
- The marks are visually similar to a medium degree, aurally identical (or aurally similar to a medium degree where the average consumer articulates the promotional slogan) and conceptually highly similar;
- The opponent's mark is inherently distinctive to a slightly lower than average degree.

The average consumer does not compare marks side by side, these are everyday goods which are similar to at least a medium degree and are, in the case of the goods in class 29, identical. These will both be seen as 'oomph' marks, whether the average consumer is familiar with the dictionary spelling of the word, or not. Bearing in mind the concept of imperfect recollection and the similarity of the goods and marks, the average consumer will simply mistake one mark for the other. I have taken into account the additional elements in the application but do not find these to be sufficient to alter the average consumer's perception of the parties' marks as being the same mark applied to the same or similar goods.

Conclusion

45. There is a likelihood of direct confusion. **The opposition succeeds.**

46. There is one point submitted by the applicant that I have not yet commented upon. In its counterstatement the applicant states:

"I also own trademark UK00002592005 which was registered in Aug 2011 prior to the [opponent's] mark being registered. If our mark is deemed [similar] we believe we have grounds to have their entire mark revoked."

47. Tribunal Practice Notice (“TPN”) 4/2000 is titled “*Statements of case and counter-statements in opposition, revocation and invalidity proceedings before the registrar of Trade Marks*” and is relevant to these proceedings. It states at paragraph 21:

“It has been noted that some counter-statements seek to challenge the validity of the trade mark(s) on which the opposition/invalidity proceedings are based. Whilst such claims can be made before the Court – see Civil Procedure Rules at Part 49 – the trade mark rules do not make provision for the making of such a counter-claim in opposition or invalidity proceedings before the Registrar. Should any party wish to challenge the validity of a trade mark cited in the statement of case then it would be a matter for them to commence revocation or invalidity proceedings before the Registrar or the Court.”

48. TPN 4/2009 is titled “*Trade mark opposition and invalidation proceedings – defences*” and is also relevant to these proceedings. Under the heading “*The position with regard to defences based on use of the trade mark under attack which precedes the date of use or registration of the attacker’s mark*”, the following is stated:

“4. The viability of such a defence was considered by Ms Anna Carboni, sitting as the appointed person, in *Ion Associates Ltd v Philip Stainton and Another*, BL O-211-09. Ms Carboni rejected the defence as being wrong in law.

5. Users of the Intellectual Property Office are therefore reminded that defences to section 5(1) or (2) grounds based on the applicant for registration/registered proprietor owning another mark which is earlier still compared to the attacker’s mark, are wrong in law. If the owner of the mark under attack has an earlier mark or right which could be used to oppose or invalidate the trade mark relied upon by the attacker, and the applicant for registration/registered proprietor wishes to invoke that earlier mark/right, the proper course is to oppose or apply to invalidate the attacker’s mark.”

49. That is the case here. Consequently, I will say no more about the applicant’s UK trade mark UK00002592005.

Costs

50. As the opponent has been successful it is entitled to a contribution towards its costs. The evidence filed by the opponent did not assist me in making a decision, the witness statement (concerning other trade mark oppositions), and the single exhibit (encompassing: (i) a printout from the Companies House website showing details of the directors of the applicant's company, and (ii) a printout from the Register for the trade marks referred to in the witness statement), not being relevant for the purposes of these proceedings: I make no award in respect of the opponent's evidence. Awards of costs are governed by Annex A of TPN 2/2016. Using that TPN as a guide but bearing in mind my comments above, I award costs to the opponent on the following basis:

Official fee:	£100
Preparing a statement and considering the other side's statement:	£200
Written submissions:	£300
Total:	£600

51. I order Andrew Sweeney to pay Food For Progress Scandinavia AB the sum of **£600**. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 6th day of August 2018

Emily Venables
For the Registrar,
The Comptroller-General