

O-496-13

TRADE MARKS ACT 1994
IN THE MATTER OF APPLICATION NO 2611931
BY
JANSC'S LTD
TO REGISTER THE TRADE MARK

Banilla

IN CLASS 29
AND
IN THE MATTER OF OPPOSITION THERETO
UNDER NO 103693
BY
BARILLA G. E R. FRATELLI – SOCIETA PER AZIONI

BACKGROUND

1) On 27 February 2012, JanSC's Ltd ('the applicant') applied to register the trade mark '**Banilla**' in respect of '*Food stuff, jam*' in class 29. The specification was subsequently amended to '*Spreads*' in class 29.

2) The application was published on 18 May 2012 in the Trade Marks Journal and notice of opposition was subsequently filed by Barilla G.e R. Fratelli – Societa per Azioni ('the opponent'). The opponent claims that the application offends under section 5(2)(b) of the Trade Marks Act 1994 ('the Act').

3) Four earlier Community trade mark ('CTM') registrations are relied upon, details of which are as follows:

Mark details	Goods relied upon
<p>CTM No: 8585614</p>  <p>The Italian Food Company. Since 1877.</p> <p>Filing date: 30 September 2009</p> <p>Date of entry in the register: 22 February 2010</p>	<p>Class 29: <i>Meat, fish, poultry and game; meat extracts; preserved, frozen, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs, milk and milk products; edible fats and oils.</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, pasta, biscuits, ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice.</i></p>
<p>CTM No: 8585721</p>  <p>Filing date: 30 September 2009</p> <p>Date of entry in the register: 22 February 2010</p>	<p>Class 29: <i>Meat, fish, poultry and game; meat extracts; preserved, frozen, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs, milk and milk products; edible fats and oils.</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, pasta, biscuits, ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice.</i></p>

<p>CTM No: 8585747</p> <p>BARILLA</p> <p>Filing date: 30 September 2009</p> <p>Date of entry in the register: 22 February 2010</p>	<p>Class 29: <i>Meat, fish, poultry and game; meat extracts; preserved, frozen, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs, milk and milk products; edible fats and oils.</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, pasta, biscuits, ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice.</i></p>
<p>CTM No: 9461468</p> <p>BARILLA</p> <p>Filing date: 20 October 2010</p> <p>Date of entry in the register: 28 March 2011</p>	<p>Class 29: <i>Meat, fish, poultry and game; Meat extracts; Preserved, frozen, dried and cooked fruits and vegetables; Jellies, jams, compotes; Eggs, milk and milk products; Edible fats, edible oils.</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, pasta, biscuits, ices; Honey, treacle; Yeast, baking-powder; Salt, mustard; Vinegar, sauces (condiments); Spices; Ice.</i></p>

4) All of the marks that are relied upon have completed their registration procedure and are therefore earlier marks in accordance with section 6 of the Act. Further, as all of the earlier marks have been registered for less than five years prior to the publication of the opposed trade mark, none are subject to the proof of use conditions contained in section 6A of the Act.

5) The applicant filed a counterstatement in which it stated, *inter alia*, the following:

“The opponent BARILLA argues that the trade mark BANILLA is similar to his (BARILLA) and contends that the trade mark BANILLA is likely to cause ‘confusion on the part of the public’, which includes a likelihood of confusion or association with his trademarks, but likelihood of confusion only happens if ‘the marks are exactly the same in spelling and how they are pronounced’, which is not the case when looking at BANILLA and BARILLA and when pronouncing BANILLA and BARILLA.

BANILLA uses ‘N’, BARILLA uses a ‘R’. The letters ‘N’ and ‘R’ have two recognised and distinguished phonetic writings and sounds in any spoken languages as well as sign languages.

Both trademarks are spelled differently and pronounced differently as shown above.”

6) The applicant filed evidence and submissions; the opponent filed submissions only¹. The matter came to be heard before me on Tuesday 22 October 2013. Ms Lucy Mills of Potter Clarkson LLP represented the opponent. Mr Engoue, Legal Consultant and Advisor of JanSC Ltd represented the applicant, accompanied by Ms Muller (a director of the applicant company).

The applicant’s evidence

7) In her skeleton argument, Ms Mills had contended that part of the applicant’s evidence should be disregarded on the basis that i) the content of exhibits CCMSV8, CCMSV15-16 did not comply with the guidance set out by Whitford J in *Imperial Group Plc v Phillip Morris Ltd* [1984] and ii) a portion of the evidence constituted *additional* evidence. As regards the latter, I note the applicant had been granted an extension of time during its evidence round to re-submit its evidence in the correct format. The amended evidence admitted by the registry on 25 March 2013 contained additional information to that which had originally been filed. I dealt with this as a preliminary point at the hearing. My decision was that all of the applicant’s evidence would remain in the proceedings, particularly since it had already been admitted, and I could not see that any specific prejudice had been caused to the opponent by its admission. Therefore, for the avoidance of doubt, I have fully considered the contents of all of the applicant’s evidence (and, of course, submissions) before reaching my decision.

8) The applicant’s evidence consists of an undated witness statement in the joint names of Sandrine Voltaire and Cindia Claude Muller, directors of JanSC’s Limited, trading as Jamco. The witness statement contains a mixture fact and submissions. It suffices to record here that, in terms of factual material, the evidence consists, essentially, of the following:

- Exhibits CCMSV1-CCMSV5 consist of examples of pre-launch activities conducted by the applicant such as, for example, copies of payment for artwork designs for labels etc.
- Exhibits CCMSV5-CCMSV14, in the applicant’s words, “demonstrate effort from the applicant to start the process of awareness and exposure of their products including the goods with mark BANILLA to different organisations and people”.
- Exhibit CCMSV15 consists of an electronic disk containing short recordings of a survey conducted with 27 people in Wolverhampton which the applicant states shows “a number of ordinary consumers....making clear distinctions and discernments between both marks ‘BANILLA’ and ‘BARILLA’.” All of the the interviewees are told “I am going to show you two marks and I want you to tell me whether or not they look similar to you”. A number of the interviewees state that the colour of the marks is different and some refer to the different

¹ Mr Engoue had been under the mistaken impression that the documents filed with Ms Mills’ skeleton argument constituted ‘evidence’ and had sought to exclude them. As I explained to Mr Engoue at the hearing, these documents were merely copies of legal authorities which the opponent had referred to in its submissions and, as such, would not be excluded.

font and spelling. Some of the interviewees are also asked to pronounce the respective marks with a number stating BAN-ILL-A and BAR-ILL-A.

- Exhibit CCMSV16 is a short recording of a 6 year old child being asked whether she thinks two marks are similar.
- Exhibit CCMSV17 shows what the applicant states is “both marks BANILLA and BARILLA as they would appear on shelves”. This exhibit does not show the exact marks which are pertinent to this opposition.
- Exhibit CCMSV18 shows results of Internet searches for the words ‘BANILLA’ and ‘BARILLA’.
- Exhibit CCMSV19 shows, what the applicant states, is “the label on which the mark ‘BANILLA’ is applied as regards to its font, its colour and its style”.

DECISION

Section 5(2)(b)

9) This section of the Act states:

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

(a)

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

10) The leading authorities which guide me are from the Court of Justice of the European Union (CJEU): *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77, *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) C-334/05 P (LIMONCELLO)*. It is clear from these cases that:

(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*,

(b) the matter must be judged through the eyes of the average consumer for the goods/services in question; *Sabel BV v Puma AG*, who is deemed to be reasonably well informed and reasonably circumspect and observant - but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind; *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*,

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v Puma AG*,

(d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks

bearing in mind their distinctive and dominant components; *Sabel BV v Puma AG*,

e) assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark; the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*,

f) it is only when all other components of a complex mark are negligible that it is permissible to make the comparison on the basis of the dominant element; *Shaker di L. Laudato & C. Sas v OHIM*,

(g) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,

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

(i) in determining whether similarity between the goods or services covered by two trade marks is sufficient to give rise to the likelihood of confusion, the distinctive character and reputation of the earlier mark must be taken into account; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,

(j) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v Puma AG*,

(k) further, the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense; *Marca Mode CV v Adidas AG and Adidas Benelux BV*,

(l) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*.

Comparison of goods

11) In the instant case, the goods to be compared are:

Opponent's goods	Applicant's goods
Class 29: <i>Meat, fish, poultry and game; Meat extracts; Preserved, frozen, dried and cooked fruits and vegetables; Jellies,</i>	Class 29: <i>Spreads.</i>

jams, compotes; Eggs, milk and milk products; Edible fats, edible oils.

Class 30: *Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; Flour and preparations made from cereals, bread, pastry and confectionery, pasta, biscuits, ices; Honey, treacle; Yeast, baking-powder; Salt, mustard; Vinegar, sauces (condiments); Spices; Ice.*

12) At the hearing, Ms Mills highlighted that the opponent's goods include 'jams and compotes' in class 29 and 'honey and treacle' in class 30. She submitted that those goods should be deemed identical or, at least highly similar, to the applicant's 'spreads'.

13) The applicant has continually stated from the outset of these proceedings, that its spread is handmade, fair trade, consists (predominantly of) banana and vanilla, and is distributed at market fairs, delicatessens and food festivals. These points were further stressed to me at the hearing. As such the applicant considers that its goods differ from those of the opponent as it has stated that the opponent's specification covers 'Many products except banana' which are 'industrially made' and are distributed through supermarkets and 'big retailers'.

14) It has been held by the General Court (GC) on a number of occasions that marketing strategies are temporal and may alter with the passage of time and, as such, they have no bearing on issues surrounding the likelihood of confusion. By way of example, in *Oakley, Inc v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-116/06* the GC stated:

"76 Consideration of the objective circumstances in which the goods and services covered by the marks in dispute are marketed is fully justified. The examination of the likelihood of confusion which the OHIM authorities are called on to carry out is prospective. Since the particular circumstances in which the goods covered by the marks are marketed may vary in time, and depending on the wishes of the proprietors of the trade marks, the prospective analysis of the likelihood of confusion between two marks, which pursues an aim in the general interest, that is, that the relevant public may not be exposed to the risk of being misled as to the commercial origin of the goods in question, cannot be dependent on the commercial intentions, whether carried out or not – and which are naturally subjective – of the trade mark proprietors (QUANTUM, paragraph 75 above, paragraph 104, and T.I.M.E. ART/Devinlec v OHIM, paragraph 75 above, paragraph 59)."

15) I must assess the matter notionally and objectively in relation to the goods which are listed in the respective specifications (which are set out in the table above) and not on the basis of the actual goods which either party may currently be using their marks on, or in relation to, in the marketplace. It follows that both parties' goods could be handmade and fair trade or both could be industrially made. Furthermore,

they could all reach the average consumer through the same trade channels. It must also be noted that the applicant's specification is not limited to spreads consisting of banana and vanilla and, even if it were so limited, this would not assist it since the opponent's 'jams and compotes', for example, would cover all kinds of flavours and compositions (including banana and vanilla).

16) The GC in *Gérard Meric v OHIM*, Case T-133/05 ('*Meric*') held:

"29 In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 *Oberhauser v OHIM – Petit Liberto (Fifties)* [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 *Vedial v OHIM – France Distribution (HUBERT)* [2002] ECR II-5275, paragraphs 43 and 44; and Case T- 10/03 *Koubi v OHIM – Flabesa (CONFORFLEX)* [2004] ECR II-719, paragraphs 41 and 42)."

17) The applicant's specification is 'spreads'. 'Jams and compotes' in the opponent's specification are types of spread. It follows that, in accordance with the *Meric* principle, and bearing in mind my comments above, I must conclude that the respective goods are identical.

Average consumer and the purchasing process

18) It is necessary to consider these matters from the perspective of the average consumer of the goods 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.

19) The applicant has submitted that its goods are targeted at sophisticated, "prudent buyers" and are relatively costly and therefore a high degree of attention will be paid during the purchase. Ms Mills on the other hand submitted that both parties' goods are low cost, everyday consumer products and as such, the average consumer will be the general public who will not extend a huge amount of thought during the purchasing act.

20) I reiterate that I am required to assess the matter notionally and objectively. I have already concluded that the parties' goods 'jams and compotes' and 'spreads' are identical. It follows that the average consumer will be the same and I do not consider that they should be considered to be a sophisticated one. The average consumer for the respective goods, which as Ms Mills states are everyday consumer items, will be the general public. As for cost and the resultant level of attention that will likely be paid during the purchase, both parties' goods may vary in price, with the exact cost being dependent on factors such as their quality, composition and method of production. However, given the nature of the goods, being every day foodstuffs, the cost is unlikely to vary significantly; even those at the higher end of the cost scale (such as those which are homemade and fair trade) can still be described as low

cost and are likely to be purchased on a reasonably frequent basis. Further, whilst I bear in mind that the average consumer may wish to ensure that the goods are of a preferred flavour (for example), the level of attention afforded during the purchasing act is, taking all matters into account, likely to be fairly low nonetheless. As for the manner in which the goods are likely to be selected, this is likely to take place ‘off the shelf’ from retail establishments or after perusal of a website and therefore the purchase is likely to be mainly visual. However, that is not to say that the aural aspect is disregarded; this too will be given due consideration in my assessment.

Comparison of marks

21) In its evidence, the applicant has provided images at Exhibit CCMSV17 of what it states are the respective marks to be compared. Its written submissions focus on the comparison of those marks and it refers, in particular, to the differences in colour and font of those marks. However, the exhibit does not show the exact mark which is the subject of the trade mark application in the instant case and nor does it show the exact marks relied upon by the opponent. As I pointed out to Mr Engoue at the hearing, in approaching the assessment of similarity of the marks and likelihood of confusion, I must do so on the basis of the applicant’s mark as applied for, and the opponent’s marks as registered. In this regard, the following comments of the Court of Appeal in *L’Oreal SA v Bellure NV* [2008] R.P.C. 9 are pertinent:

“The test is, and must be, founded on the mark as registered, not material which forms no part of that. There is simply no warrant in the Directive for taking more than the registered mark into account. The global appreciation test does not amount to the proposition that once a registered mark is used in marketing, anything, extraneous to the mark used in marketing, comes in too—as though it formed part of the registered mark.”

22) The opponent relies upon four earlier registrations. To my mind, and for reasons which will become apparent in my assessment of the similarities between the marks, I consider the opponent’s strongest case lies with its CTM No: 8585721. Accordingly, the relevant marks to be compared are:

Opponent’s marks	Applicant’s mark
	

23) 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.

24) In its submissions, the applicant has stated:

“A likelihood of confusion has to be assessed globally taking into account the visual, aural, and conceptual similarity of the marks, based on the overall impression given by the marks and with particular reference to their distinctive and dominant component. In this case is 90% of banana.”

25) When the case law speaks of dominant and distinctive components it is referring to components of the marks, not the goods. None of the respective marks consist of any distinctive or dominant elements; the distinctiveness of each mark lies in its totality.

Visual comparison

26) After I pointed out to Mr Engoue that colour was not an element of either parties' mark, he tailored his submissions by stating that even if colour could not be taken into account, the respective marks were nevertheless clearly dissimilar. In particular, Mr Engoue pointed out that the third letter in the marks differs, being an 'r' and 'n' respectively. Conversely, Ms Mills submitted that there is a strong degree of visual similarity on account of there being only one letter difference between the marks and, in light of the 'r' and 'i' in the opponent's mark appearing to run into each other resulting in an appearance similar to an 'n'.

27) Having considered both parties' submissions, I am inclined to agree with Ms Mills. Whilst the respective marks are presented in different fonts (although not markedly different), they both consist of seven letters with six of those seven letters being the same. Further, there is some force in Ms Mills' contention that the presentation of the opponent's mark is such that the 'r' and 'i' have a similar appearance to that of an 'n'. I find there to be a high degree of visual similarity overall.

Aural comparison

28) Mr Engoue submitted that there is a huge difference in the manner in which the respective marks would be pronounced. In his view, the applicant's mark would be pronounced BAN-ILL-A whereas the opponent's mark would be pronounced BAR-RIYA in an Italian fashion.

29) Ms Mills contended that the respective marks consist of the same number of syllables. She further stressed that it is the beginning of marks which give the greatest impression aurally and that the marks were identical in this regard and, as a result of the one letter difference being in the middle of each mark, this may become lost in pronunciation. Consequently, she considered the marks to be aurally highly similar.

30) Whilst I agree with Mr Engoue as regards how the applicant's mark would be pronounced, I disagree with his view in relation to the opponent's mark. I must

assess how the average consumer in the UK is likely to pronounce the marks.² There is nothing before me (other than the applicant's bald assertion) to suggest that the UK general public would be familiar with the word BARILLA as being an Italian one which should be pronounced as BA-RIYA. In my view, the general UK public is likely to pronounce the opponent's mark as BAR-ILL-A. It follows that both marks consist of three syllables, the latter two of which are identical and the first of which is highly similar. I agree with Ms Mills that there is a high degree of aural similarity overall.

Conceptual comparison

31) Turning to the conceptual aspect of the comparison, at the hearing, Ms Mills submitted that neither mark has any meaning. Mr Engoue did not specify exactly how he thought the marks would be perceived by the average consumer however, he did point out that the applicant uses its mark on a spread consisting of banana and vanilla and I note that in its written submissions, the applicant has stated:

“...applicant I keen and determined to combine the element that constitutes its products which are **Banana + vanilla= Banilla.**”

32) Considering the opponent's mark first, to my mind, the word Barilla will not portray any immediately graspable concept- it is likely to be perceived as an invented word with no meaning. As regards the applicant's mark, I remind myself that I must assess the concept it is likely to portray in relation to 'spreads' (at large). For the majority of 'spreads', the mark is unlikely to convey any meaning. In respect of spreads containing banana and vanilla, whilst it is possible that the consumer may perceive the mark as meaning banana and vanilla, it is also possible, in my view, that they will merely perceive it as an invented word with no meaning. On the most part then, the conceptual position is neutral however I acknowledge the possibility that, for certain spreads, the applicant's mark may possess a concept which is not shared by the opponent's mark.

Distinctive character of the earlier mark

33) I must consider the distinctive character of the earlier mark. 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*).

34) Ms Mills made reference to the fact that the opponent is the proprietor of a large number of trade marks. In her skeleton argument under the heading 'Distinctive Character' she states:

“It is noted that the Opponent is the proprietor of 102 UK and Community Trade Marks either for, or incorporating the term BARILLA, and enjoys

² Ms Amanda Michaels, sitting as the Appointed Person, in *Toppy Trademarks Limited v Cofra Holding AG*, BL O/092/11 stated: “25. What the Hearing Officer had to consider was how the mark would be perceived by the average UK consumer. Whilst of course there are many persons whose mother tongue is not English who live and work in the UK, such persons are not the average UK consumer for the purposes of considering the pronunciation or meaning of a word.”

exclusive rights in this trade mark, and in relation to trade marks commencing with the prefix “BA” and ending with the suffix “ILLA”.

The Opponent respectfully submits, that the distinctive character (both inherent and acquired) enjoyed by their registration, significantly increases the likelihood that confusion will arise in the mind of the relevant public.”

35) The mere fact that the opponent is the proprietor of a large number of marks on the register does not lead to a conclusion that the earlier mark has acquired an enhanced distinctive character. Firstly, the opponent has relied upon only four of its marks in this opposition and secondly, it has not filed any evidence to show that any of those marks have been used in the UK. Accordingly, I have only the inherent level of distinctiveness to consider. As I have already stated, it is my view that the opponent’s mark will be perceived as an invented word and, as such, it neither describes nor alludes to the goods covered by the registration in any way and I therefore agree with Ms Mills’ submission at the hearing that the mark should be attributed a high level of inherent distinctive character.

Likelihood of confusion

36) At the hearing, Mr Engou submitted that the applicant trades in a small local area in the UK whereas the opponent does not trade in the UK and, as a consequence, there can be no likelihood of confusion. This is not a relevant factor in my assessment of the likelihood of confusion. The opponent’s earlier CTM currently enjoys protection in the whole of the UK. The applicant has also applied for a trade mark which, if registered, would enjoy protection in the whole of the UK. As I have already indicated, matters must be assessed from a notional and objective stand point and must not be based on how, or where, the parties’ currently choose to market their respective goods.

37) The applicant has made much of the short recordings in its evidence purporting to demonstrate that the average consumer would not confuse the respective marks. Ms Mills was heavily critical of this evidence at the hearing, submitting that it does not meet the guidelines set out by Whitford J in *Imperial Group Plc v Philip Morris Ltd* [1984] for numerous reasons. In her submission, the questions put to the interviewees were leading and the number of people in the survey was extremely small so as to be of no relevance whatsoever. Moreover, she submitted that it would appear from the responses given, that the interviewees were not shown the exact marks at issue in the instant case. I must agree with Ms Mills that, from the answers given, it would appear the survey was conducted in relation to marks which are not pertinent to this opposition, specifically, those present at Exhibit CCMSV17. However, even if the correct marks had been used, the nature of the survey is such that it would still be of no assistance. Simply presenting pictures of two marks side by side to a small number of people and asking them whether they think the marks are similar does not assist in assessing the likelihood of confusion. The issue of similarity of the marks is a matter for the Tribunal to decide. Furthermore, even where the marks are found to share similarities, this is not, of itself, determinative of the likelihood of confusion. The likelihood of confusion requires a multifactorial assessment and must be based on the likely perception of the average consumer during the purchasing act, where, importantly, the consumer rarely has the

opportunity to compare marks side by side³ and does not proceed to analyse their details.⁴

38) The applicant has also claimed that none of “over fifty five thousand viewers, tasters and buyers [of its products]...have made any connections with the opponent’s mark ‘BARILLA’”. The applicant’s evidence indicates that it did not start trading until 13 June 2012 and that it had no sales prior to the date of filing. I also have no evidence before me to show that the opponent has used its mark in the UK. There is therefore nothing before me to indicate that the average consumer has been exposed to both marks in the marketplace and been able to distinguish between them. As for the remainder of the applicant’s evidence demonstrating pre-launch activities, “effort from the applicants to start the process of awareness and exposure of their products....to different organisations and people” and the search engine results purporting to show “no connections, relations and confusion between both marks”, I fail to see how any of this material assists me.

39) 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 may be offset by a greater similarity between the marks, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*);
- ii) 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*), and;
- iii) the principle that the more distinctive the opponent’s mark is, the greater is the likelihood of confusion (*Sabel BV v Puma AG*).

40) There are two possible types of confusion which may occur. These are direct and indirect confusion. Direct confusion occurs where one mark is mistaken for the other because the average consumer thinks they are the same. Indirect confusion occurs when the average consumer will realise that the marks are not the same but will nonetheless assume, in light of the similarities between them, that the respective goods emanate from the same, or economically linked, undertaking(s). In the event I find that at least one type of confusion (direct or indirect) is likely, the opposition will succeed. If neither type of confusion is likely to exist, the opposition will fail.

41) I have found there to be identity between the respective goods. The average consumer will be the general public who will pay a fairly low degree of attention during the mainly visual purchasing act. However, aural considerations must also be given due weight in my considerations. As regards the marks themselves, I have found the earlier mark to be possessed of a high degree of inherent distinctive character and that the respective marks share a high degree of visual and aural similarity. Conceptually, the position is neutral for the most part. However, I

³ *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V*

⁴ *Sabel BV v. Puma AG*

acknowledge the possibility that the applicant's mark may, in certain circumstances, possess a concept which is not shared by the opponent's mark.

42) As has been held by the courts, whilst conceptual differences between marks may counteract visual and aural similarities⁵, they do not always do so⁶. Drawing all of my findings together, I find that, notwithstanding the potential for the applicant's mark to possess a concept alien to the opponent's mark, this does not serve to counteract the high degree of visual similarity (bearing in mind that the purchasing act will likely be primarily visual) and aural similarity that exists. In my view, the similarities between the marks outweigh the differences and, this, together with the identity between the respective goods and the fairly low degree of attention that will likely be paid during the purchasing act (increasing the effects of imperfect recollection), leads me to conclude that there is a likelihood of direct confusion i.e. that the average consumer is likely to mistake one mark for the other.

The opposition succeeds. The application is refused.

COSTS

43) The opponent has been successful and, as a consequence, is entitled to a contribution towards its costs. On the matter of costs, Mr Engoue asked me take into account that the applicant had received no notification of the opponent's intention to launch an opposition prior to the Form TM7 being filed⁷. I note however that a Form TM7A was filed by the opponent on 17 July 2012, one month prior to the filing of Form TM7. Furthermore, and more crucially, despite claiming to have had no notification of the intended opposition, the applicant has nevertheless opted to defend its trade mark application - in so doing it has voluntarily joined the proceedings and must therefore be prepared to incur the potential cost implications associated with that course of action. As is stated in Tribunal Practice Notice 6 of 2008:

“Where an opposition is defended, the provision or otherwise of prior notice will not usually affect the award of costs at the conclusion of the proceedings, which will normally be based on the published scale of costs.”

44) As I mentioned at the hearing, cost awards are governed by Annex A of Tribunal Practice Notice (TPN) 4 of 2007. Bearing in mind the guidance provided by the aforementioned TPN, I award costs to the opponent as follows:

Preparing notice of opposition and considering a counterstatement:	£300
Opposition fee:	£200
Written Submissions:	£300

⁵ *The Picasso Estate v OHIM* – C-361/04 P

⁶ *Nokia Oyj v OHIM* - T-460/07

⁷ A letter from the applicant filed subsequent to the hearing (dated 24 October 2013) reiterated this request.

Preparation for and attendance at the hearing £500

Total: £1300

45) I order JanSC's Ltd to pay Barilla G.e R. Fratelli Societa Per Azioni the sum of **£1300**. 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 10th December 2013

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