

TRADE MARKS ACT 1994

IN THE MATTER OF AN APPLICATION BY EVIE DEMOSTHENOUS TO REGISTER A TRADE MARK NO 2347497 IN CLASS 43

BACKGROUND

1. On 4 November 2003 Evie Demosthenous of 112 Cranley Gardens, Muswell Hill, London, N10 3AH applied under the Trade Marks Act 1994 for registration of the trade mark:



2. The services for which registration is sought are:

Class 43

“A café bar providing alcoholic and non-alcoholic drinks, along with food and coffee.”

3. Objection was taken under Section 5(2) of the Act in respect of the following registered marks 1571971, 2213202 and International trade mark 678760. However, following a revision to the specification of services this objection was waived in respect of 1571971 and International trade mark 678760. The objection was maintained in respect of 2213202 which is registered for the following series of two marks:



4. These earlier trade marks are registered in Class 42 for the following services:

“Restaurant, café, cafeteria, coffee shop, coffee bar services; provision of facilities for the consumption of food and beverages.”

5. A hearing was held on 26 May 2004 at which Ms Demosthenous represented herself. At the hearing the objection under Section 5(2) of the Act was maintained and Notice of Final Refusal was subsequently issued.

6. I am now asked under Section 76 of the Act and Rule 62(2) of the Trade Marks Rules 2000 to state in writing the grounds of my decision and the materials used in arriving at it.

7. No evidence has been put before me, therefore no claim under Section 7 of the Act has been made.

DECISION

The Law

8. Section 5(2) of the Act reads as follows:

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

- (a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, or
- (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.”

9. An earlier trade mark is defined in Section 6(1) which states:

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

- (a) a registered trade mark, international trade mark (UK) or Community trade mark 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,”

10. I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* [1999] E.T.M.R. 1, *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v. Adidas AG* [2000] E.T.M.R. 723.

11. 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 of 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) 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*;

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

(g) 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*;

(h) 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*.

Distinctive character of the earlier trade mark

12. It is clear from the ECJ's judgment in the case of *Sabel BV v Puma AG* that the likelihood of confusion may be increased where the earlier trade marks have a highly distinctive character.

13. The earlier trade marks are registered trade marks and are therefore deemed to be valid (Section 72 of the Act refers). The earlier trade marks do not consist solely of invented words so they cannot be accorded the very highest level of distinctive character. Both marks are identical other than the fact that the first mark is subject to a claim to the colours teracota, minty green and warm orange. Both marks are contained within a rectangular border and incorporate the word VIVA together with the words COFFEE IS LIFE which are less prominent. Both marks also have a faint device situated above the word VIVA.

14. Collins English Dictionary (5th. Edition first published 2000) defines the word VIVA as:

“1; interj. Long live; up with (a specified person or thing). 2; Brit; n. an oral examination. Vb. -vas; -vaing; -vaed; tr; 2. to examine orally. [shortened from viva voce]”

15. The word VIVA is, therefore, not a word which is descriptive of the services in question nor can it, by itself, be considered non-distinctive for such services. I must, of course, consider both marks in their entirety and, having done so, I have concluded that these earlier trade marks possess a relatively high degree of distinctive character.

Similarity of the services

16. It is clear from the applicant's specification in Class 42 that there is a direct conflict with the services contained within the specification of the earlier trade marks. The applicant's application is, essentially, for the provision of food and beverages in a café bar. The earlier trade marks are registered for services which include the provision of facilities for the consumption of food and beverages. These services are, by definition, identical to the services applied for. Furthermore, I consider that the services applied for are similar to the "Restaurant, café, cafeteria, coffee shop, coffee bar services" which are also contained within the specification of the earlier trade marks. In determining that these conflicting services are similar I have born in mind the guidelines set out by Jacob J in *British Sugar Plc v James Robertson & Sons Ltd* [1996] RPC 281 as set out below:

"The following factors must be relevant in considering whether there is or is not similarity:

- (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 services;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve items, where in particular 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."

17. Whilst I acknowledge that in the view of the CANON-MGM judgment by the European Court of Justice (3-39/97) the *Treat* case can no longer be wholly relied upon, the ECJ said the factors identified by the UK Government in its submissions (which are listed in *TREAT*) are still relevant in respect of a comparison of goods and/or services.

Similarity of the marks

18. Since the trade mark of this application is not identical to the earlier trade marks the matter falls to be decided under sub-section (b) of Section 5(2) of the Act. The question, therefore, is whether the mark of this application is so similar to the earlier trade marks that there exists a likelihood of confusion which includes the likelihood of association on the part of the public.

19. The similarity of the marks must be assessed by reference to the visual, aural and conceptual similarities of the trade marks. It is clear from the judgment of the ECJ in the case of *Sabel BV v Puma AG* that I must assess the overall impressions created by the marks bearing in mind their distinctive and dominant components.

20. All of the conflicting marks are contained within rectangular borders although I note that these borders are of slightly different dimensions. The earlier trade marks contain the word VIVA, the additional words COFFEE IS LIFE together with a rather faint device. The word VIVA is positioned centrally and is far more pronounced than the words COFFEE IS LIFE. Furthermore the word VIVA is much larger in size and is, in my view, the most distinctive and compelling component within the marks. This application is for the words VIVA VIVA repeated and placed side by side in the centre of the rectangular border. Placed in the centre of the top of the rectangular border is a small square containing the words VIVA with a reversed image of that word. It is clearly not de minimis within the mark but if it is placed under close scrutiny it will be identified as the word VIVA together with a mirror image of that word. If this component of the earlier trade marks is not subjected to such scrutiny it may not be identified as the word VIVA together with a mirror image of that word but in such circumstances will be perceived as a meaningless logo. In my view it is the words VIVA VIVA positioned centrally and very large in size which feature as the dominant and compelling component within this mark. I consider the marks to be very similar both visually and aurally. Furthermore, it is my view that there are clear conceptual similarities between the conflicting marks.

Likelihood of confusion

21. I must, of course, bear in mind that a mere possibility of confusion is not sufficient. (See e.g. *React Trade Mark* [2000] RPC 285 at page 290.) The Act requires that there must be a likelihood of confusion. I have already found the services for which the earlier trade mark is registered to contain services which are either identical or similar to the services applied for. It is clear that where there is a lesser degree of similarity between the trade marks this may be offset by a greater degree of similarity between the services (and vice versa) - see *Lloyd Schuhfabrik Meyer & CO GmbH v Klijsen Handel BV*.

22. Furthermore, it is now well established that the matter must be determined by reference to the likely reaction of an average consumer of the services in question, who is deemed to be reasonably well informed, reasonably observant and circumspect. In relation to the services in question I consider the average consumer of such services to be the general public as well as those who would provide trade supplies for use in relation to the provision of such services. The average consumer generally relies upon the imperfect picture of the earlier trade mark that he or she has kept in his or her mind and must therefore rely upon the overall impression created by the trade marks in order to avoid confusion.

23. I must of course consider the likelihood of confusion by reference to the visual, aural and conceptual points of similarity. In my view the weight to be attached to all aspects of confusion is significant. The similarities between the marks and the identical and similar services which are in conflict are likely to lead to both visual and aural confusion. I have found that all marks in conflict possess a relatively high

degree of distinctive character and this is a factor that I have born in mind in concluding that there are also conceptual similarities between the marks.

24. In this case I believe the identical and similar services that I have identified coupled with the relatively high degree of distinctive character of the marks and the similarity between them, is sufficient to give rise to a likelihood of confusion within the meaning of Section 5(2)(b) of the Act.

25. I therefore conclude that there is a likelihood of confusion which includes the likelihood of association. In reaching this conclusion I bear in mind that it is sufficient if an average consumer encountering the respective marks would assume that the marks identify a single undertaking or undertakings with an economic connection.

CONCLUSION

26. In this decision I have considered all of the documents filed by the applicant and all of the arguments submitted to me in relation to this application and, for the reasons given, it is refused under the terms of Section 37(4) of the Act because it fails to qualify under Section 5(2) of the Act.

Dated this day of January 2005

**A J PIKE
For the Registrar
The Comptroller-General**