

O/123/12

TRADE MARKS ACT 1994

**IN THE MATTER OF INTERNATIONAL REGISTRATION M1063032
BY FANTAWILD HOLDINGS INC IN RESPECT OF THE TRADE MARK:**

FANTAWILD

AND

OPPOSITION THERETO (NO 72266) BY THE COCA-COLA COMPANY

THE BACKGROUND AND THE PLEADINGS

1) On 25 November 2010 Fantawild Holdings Inc. (the “Holder”) filed International Registration (“IR”) no. M1063032 designating the UK for protection on the same date. The mark and the goods for which protection is sought can be seen below:

FANTAWILD

Class 09:Electronic publications (downloadable); computer programs (downloadable software); computer game programs; computer software (recorded); computer operating programs, recorded; amusement apparatus adapted for use with an external display screen or monitor; apparatus for games adapted for use with an external display screen or monitor; eyeglasses; animated cartoons; cinematographic film (exposed).

Class 28:Games; games other than those adapted for use with an external display screen or monitor; apparatus for games other than those adapted for use with an external display screen or monitor; air pistols (toys); toy pistols; percussion caps (toys); plush toys; toys; board games; stationary exercise bicycles; body-training apparatus.

Class 41:Organization of competitions (education or entertainment); publication of electronic books and journals on-line; providing on-line electronic publications (not downloadable); publication of books; television entertainment; film production; production of radio and television programmes; amusement parks; parks (amusement); amusements, entertainment information; game services provided on-line (from a computer network).

The IR claims a priority date of 12 July 2010 and was published in the Trade Marks Journal on 11 February 2011.

2) The Coca-Cola Company (the “Opponent”) opposes the protection of the IR in the UK. Its opposition was filed on 4 April 2011 under sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). In respect of section 5(3) two earlier marks are relied upon: Community trade mark no. 8711947 and UK trade mark no. 755423. Both these earlier marks consist of the word “FANTA”. In respect of the opposition under section 5(2)(b) only Community trade mark no. 8711947 is relied upon. Community trade mark no. 8711947 had not been registered for more than five years as of the date of publication of the IR, so there is no requirement to show that it has been genuinely used (section 6A of the Act refers). However, in respect of UK mark 755423, the proof of use provisions do apply to it given that it completed its registration procedure in the late 1950s; the Opponent made a statement of use that the mark has been used in relation to all of the goods for which it is registered. In relation to the section 5(4)(a) claim the Opponent relies on the use it claims to have made of the word FANTA since 1960.

3) The Holder filed a counterstatement denying the grounds of opposition. Only the Opponent filed evidence and submissions. Neither party requested to be heard. I therefore give this decision after a careful review of all the papers before me.

THE EVIDENCE

4) Only the Opponent filed evidence and submissions. The evidence consists of various documents relating to the history, use and reputation of the Opponent's mark FANTA in the UK and EU. It includes information and articles in the media, external valuations and brand surveys, and details of advertising campaigns. The documents are itemised in a witness statement by David Stone of Simmons & Simmons LLP, who are representing the Opponent in these proceedings; Mr Stone also provided a comprehensive set of submissions at the same time as filing his evidence. For reasons which will become apparent, I do not intend to provide a detailed evidence summary. I will instead refer to the evidence when dealing with the pleaded grounds. At this stage, suffice it to say that FANTA appears to be a very well-known soft drinks brand.

SECTION 5(2)(b)

5) As stated above, only one mark is relied upon under this ground, a mark which is not subject to the proof of use provisions and, which, consequently, may be relied upon for its specification as registered.

The law

6) Section 5(2)(b) of the Act reads:

"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."

7) In reaching my decision I have taken into account the guidance provided by the Court of Justice of the European Union ("CJEU") in a number of judgments: *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 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, *Case C-3/03 Matrazen Concord GmbH v GmbGv Office for Harmonisation in the Internal Market* [2004] ECR I-3657 *Medion AG V Thomson multimedia Sales Germany & Austria GmbH* (Case C-120/04) and *Shaker di L. Laudato & Co. Sas* (C-334/05). In *La Chemise Lacoste SA v Baker Street Clothing Ltd* (O/330/10) Mr Geoffrey Hobbs QC, sitting as the Appointed Person, quoted with approval the following summary of the principles which are established by these cases:

"(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, in certain circumstances, be dominated by one or more of its components;

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite 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 causes the public to wrongly believe that the respective goods [or services] come from the same or economically-linked undertakings, there is a likelihood of confusion."

The average consumer

8) According to the case-law, the average consumer is reasonably observant and circumspect (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27). The degree of care and attention the average consumer uses when selecting goods or service providers can, however, vary depending on what is involved (see, for example, the judgment of the General Court ("GC") in *Inter-Ikea Systems BV v*

OHIM (Case T-112/06)). The range of goods and services covered by both parties' specifications means that the average consumer and the nature of the purchasing process involved will vary.

9) For some of the goods and services (e.g. *computer software*) consumers may consist either of businesses or the general public. Some, though (e.g. *games, amusement parks*), will be aimed only at the general public. Whether it is members of the general public or businesses, the goods and services are such that the degree of care and attention used in their selection will vary. For example, the purchaser of an electronic publication or a game will pay no more than an average degree of care and consideration but the purchaser of body-training apparatus or production services will pay a higher degree of care and consideration than the norm. I will bear these considerations in mind when reaching my conclusions on the likelihood of confusion.

Comparison of the goods and services

10) In making an assessment of the similarity of the goods/services, all relevant factors relating to the goods and services in the respective specifications 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 *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281 where the following factors were highlighted as being relevant when making the comparison:

“(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) Whether goods/services are complementary (one of the factors referred to in *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*), will depend on whether there exists a close connection or relationship such that one is important or indispensable for the use of the other. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T- 325/06* it was stated:

“It is true that goods are complementary if 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 (see, to that effect, Case T-169/03 *Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI)* [2005] ECR II-685, paragraph 60, upheld on appeal in Case C-214/05 P *Rossi v OHIM* [2006] ECR I-7057; Case T-364/05 *Saint-Gobain Pam v OHIM – Propamsa (PAM PLUVIAL)* [2007] ECR II-757, paragraph 94; and Case T-443/05 *El Corte Inglés v OHIM – Bolaños Sabri (PiraÑAM diseño original Juan Bolaños)* [2007] ECR I-0000, paragraph 48).”

13) In relation to understanding what terms used in specifications mean/cover, the case-law informs me that “in construing a word used in a trade mark specification, one is concerned with how the product/service is, as a practical matter, regarded for the purposes of the trade” (see *British Sugar plc v James Robertson & Sons Limited* [1996] RPC 281) and that I must also bear in mind that words should be given their natural meaning within the context in which they are used; they cannot be given an unnaturally narrow meaning (see *Beautimatic International Limited v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267). However, I must also bear in mind that a listed service must not be given too broad an interpretation; in *Avnet Incorporated v Isoact Limited* [1998] F.S.R. 16 Jacob J 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) Finally, when comparing the respective goods/services, if a term clearly falls within the ambit of a term in the competing specification then identical goods/services must be considered to be in play (see *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-133/05*) even if there may be other goods/services within the broader term that are not identical.

15) The goods/services for which protection is sought are:

Class 09: Electronic publications (downloadable); computer programs (downloadable software); computer game programs; computer software (recorded); computer operating programs, recorded; amusement apparatus adapted for use with an external display screen or monitor; apparatus for games adapted for use with an external display screen or monitor; eyeglasses; animated cartoons; cinematographic film (exposed).

Class 28: Games; games other than those adapted for use with an external display screen or monitor; apparatus for games other than those adapted for use with an external display screen or monitor; air pistols (toys); toy pistols; percussion caps (toys); plush toys; toys; board games; stationary exercise bicycles; body-training apparatus.

Class 41: Organization of competitions (education or entertainment); publication of electronic books and journals on-line; providing on-line electronic publications (not downloadable); publication of books; television entertainment; film production; production of radio and television programmes; amusement parks; parks (amusement); amusements, entertainment information; game services provided on-line (from a computer network).

16) The (most relevant) goods and services for which the earlier mark is registered are:

Class 09: Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; Apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; automatic vending machines and mechanisms for coin-operated apparatus; cash registers, calculating machines, data processing equipment and computers; fire-extinguishing apparatus.

Class 16: Paper, cardboard and goods made from these materials, not included in other classes; Printed matter; book binding material; photographs; Stationery; adhesives for stationery or household purposes; Artists' materials; paint brushes; typewriters and office requisites (except furniture); instructional and teaching material (except apparatus); plastic materials for packaging (not included in other classes); printers' type; Printing blocks.

Class 28: Games and playthings; gymnastic and sporting articles not included in other classes; decorations for Christmas trees.

Class 41: Education; Providing of training; Entertainment; Sporting and cultural activities.

I will make the comparison with reference to the goods and services for which protection is sought by the Holder. I will go through them term by term (but grouping them when it is useful and reasonable to do so – see the comments of the Appointed Person in *Separode* BL O-399-10):

Class 9:

Electronic publications (downloadable)

17) The earlier mark covers *printed matter* in class 16. Whilst the format is different (electronic as opposed to paper) the purpose is identical. The methods of use differ owing to the format, but they could be sold through the same trade channels, i.e. an internet shop selling a publication in a choice of formats. This also creates a strong degree of competition. I consider the goods to be highly similar.

Computer programs (downloadable software); computer game programs; Computer operating programs (recorded); computer software (recorded)

18) The earlier mark covers *data processing equipment and computers* for which I consider there to be a clear and obvious complementary relationship, given the interdependence of the goods in their use and purpose. The primary purpose is to facilitate computing. The channels of trade may also be similar. I consider the goods to be similar to at least a reasonable degree. This applies equally to computer game programs due to some computers being specifically designed and sold for the playing of such games. Computer game programs would also be similar to *games* in class 28 of the earlier mark which would include hand held gaming systems to play games.

Amusement apparatus adapted for use with an external display screen or monitor; apparatus for games adapted for use with an external display screen or monitor

19) The earlier mark covers *apparatus for recording, transmission or reproduction of sound or images*. I have no reason to doubt that the above goods would fall within the ambit of this specification as the purpose of the listed apparatus is to reproduce sound or images. The goods are considered to be identical. I also see a reasonably high degree of similarity with the earlier mark's *games and playthings* in class 28 by reason of such goods including hand-held amusement apparatus which are intended for a similar purpose, used in a similar (although not identical) way and sold to the same types of consumer through the same trade channels.

Eyeglasses

20) The earlier mark covers *optical apparatus and instruments* which I consider the above term to fall within. The goods are considered to be identical.

Animated cartoons; cinematographic film (exposed)

21) I have considered similarity/identity on the basis of the earlier mark's *cinematographic ... apparatus and instruments*, but such goods are likely to cover apparatus and instruments such as cameras, projectors etc. rather than the finished film product. This is unlikely to create any significant degree of similarity. However, the earlier mark covers *entertainment services*, which include film and television entertainment. Measured from this perspective there is a similarity of purpose because such services are aimed at providing films and television content to users. The nature and method of use will differ but, on the other hand, it is common

knowledge that film and television entertainment will often end up as a finished film product for subsequent purchase. The differences do not outweigh the similarities and I conclude that there is a good degree of similarity.

Class 28

Games; games other than those adapted for use with an external display screen or monitor; apparatus for games other than those adapted for use with an external display screen or monitor; air pistols (toys); toy pistols; percussion caps (toys); plush toys; toys; board games

22) The earlier mark includes the term *games and playthings* in class 28. All of the above goods are games or toys and, as such, they all fall within the ambit of *games and playthings*. The goods must be considered as identical.

Stationary exercise bicycles; body-training apparatus.

23) The earlier mark includes the term *gymnastic and sporting articles*. The above goods are used in gymnasiums and, as such, I consider that they fall within the ambit of gymnastic articles. Such a term is broad enough to cover various types of equipment used in traditional gyms and also for specific gymnastic exercises. If I am wrong on this view, and gymnastic articles should be construed more narrowly, I consider there to be a high degree of similarity between the goods applied for and gymnastic and sporting articles, owing to the fact that they are all intended for exercise purposes and may be sold through similar trade channels. Whilst there may be differences in terms of methods of use of differing types of equipment, such differences do not outweigh the similarities.

Class 41

Organization of competitions (education or entertainment);

24) The earlier mark covers both *education* and *entertainment* services at large. As the competitions provided are for education or entertainment, it seems to me that such terms would fall within the ambit of the earlier mark's terms. The services are considered to be identical. If I am wrong on that then the similarity of purpose (to educate or to entertain) must, even if the method of use etc differs, mean that there is at least a reasonable degree of similarity.

Publication of electronic books and journals on-line; providing on-line electronic publications (not downloadable)

25) My finding here matches those I made with regard to electronic books in class 9. The above services merely represent a slightly differing format but, in comparison to printer matter in class 16, the purpose is still the same, as is the strong degree of competition. The services are highly similar to printed matter in class 16.

Publication of books

26) I do not consider that this term naturally falls within the ambit of any of the terms listed in the earlier mark's class 41 specification. However, it is noted that the earlier mark covers *printed matter* (which include books) in class 16. Whilst the exact purpose is different between a physical book and publication services, as are the methods of use, they both have the provision of written material to the public at their heart. There appears to me to be a key complementary relationship, as the services and the goods are really indispensable (and vice versa), and it is the sort of relationship where, owing to the prevalence of publishers' names appearing on physical books, consumers are used to expecting the publisher and the book to be linked. I consider the services and the goods to have a good deal of similarity.

Television entertainment

27) The earlier mark covers *entertainment* services of which television entertainment must be a subset. The services are considered to be identical.

Film production; production of radio and television programmes

28) I draw an analogy here with my findings in relation to the publication of books. I do so on the basis that the services of the earlier mark cover entertainment which includes television entertainment. The complementary relationship exists here also and I consider the services to have a good deal of similarity.

Amusement parks; parks (amusement); amusements

29) I consider that all of the above represent forms of entertainment and, as such, the services fall within the ambit of the earlier mark's *entertainment* services. The services are considered to be identical.

Entertainment information

30) I consider that the above term would fall within the general ambit of the earlier mark's *entertainment* services. The services are considered to be identical. If I am wrong on this view then the provision of information about entertainment should be considered as reasonably similar to entertainment per se, since there appears to me to be a complementary relationship, with undertakings often both providing information about entertainment and then providing or arranging the service itself.

Game services provided on-line (from a computer network)

31) I consider that the above term represents a form of entertainment and, as such, the services fall within the ambit of the earlier mark's *entertainment* services. The services are considered to be identical.

The distinctiveness of the earlier FANTA mark

32) The degree of distinctiveness of the earlier mark must be assessed. This is because the more distinctive the earlier mark (based either on inherent qualities or



because of use made), the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24).

33) From an inherent perspective I note that according to the Opponent's evidence the FANTA beverage's "fantastic" taste had something to do with the original choice of the mark. However, in my view the average consumer will not perceive FANTA in this way and will simply see it as a made up word; it is not descriptive or allusive in any way. I therefore consider that it possesses a high degree of inherent distinctiveness.

34) The Opponent submitted evidence designed to show that it has made considerable use of the FANTA mark. I have no doubt that the Opponent has a reputation in relation to beverages, but it claims that this reputation extends to activities such as online games and competitions. This is an important point because the Opponent cannot rely on its beverage reputation under section 5(2) because such goods are not similar to those which the holder wishes to protect. In my view, the online services relate to the promotion of the FANTA beverage rather than to the provision of the online services per se. Whilst I cannot rule out the possibility that promotion may, sometimes, provide a reputation beyond a core product, the evidence does not establish that this is the case here. Whilst some online activities have been run, the significance of this in the market (the market for the services in question) is not clear. I do not consider that this evidence can be used under Section 5(2)(b) of the Act to establish enhanced distinctiveness through use.

Comparison of the marks

35) The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The visual, aural and conceptual similarities of the marks must be assessed by reference to their overall impressions, bearing in mind their distinctive and dominant components. The marks to be compared are:

The applied for mark	The earlier mark
 The logo for FANTAWILD is written in a bold, stylized, rounded font. The letters are thick and have a slightly irregular, hand-drawn appearance. The 'A' and 'W' are particularly prominent.	 The logo for FANTA is written in a clean, standard, sans-serif font. The letters are evenly spaced and have a consistent weight.

36) The mark FANTAWILD is written in a stylised manner. This gives it an appealing presentation, but I think it is clearly the word itself which will be perceived by the consumer as the dominant component of the mark. Although FANTAWILD is presented as one word, I think the average consumer will perceive it as a conjoining of two words: FANTA and WILD. Within FANTAWILD, and as an invented word, FANTA has the greater degree of distinctiveness (compared to WILD). I think the rule of thumb, whereby the consumer normally attaches more importance to the first part of words, is an appropriate guide in this case. The only component of the earlier mark is the word FANTA which, therefore, constitutes its dominant and distinctive component.

37) From a visual perspective, both marks contain the word FANTA which constitutes the only element of the earlier mark and the more dominant element of the applied for mark. The applied for mark also contains the word WILD which, therefore, creates a visual difference. A further visual difference exists due to the stylization present in the mark, although, I do not consider that this difference should be overlaid as it does not provide a significant distinguishing feature. Weighing these factors, I consider there to be a reasonable (neither high nor low) degree of visual similarity. This assessment runs through to the aural comparison and there is no material difference in assessment; the marks are aurally similar to a reasonable degree.

38) As regards the conceptual comparison, FANTA, being an invented word, has no semantic content. To the extent that the word “wild” might sometimes be used in popular parlance as a synonym for “exciting”, it might perhaps be seen as serving a very vague and generalized puffing function for the goods and services covered by the Holder’s specifications. However, the mere addition of the word WILD to the word FANTA (the mark’s dominant element) provides no semantic content capable of establishing a conceptual dissonance with the earlier mark FANTA. The conceptual impact is neutral.

Likelihood of confusion

39) The factors assessed so far have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17), a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). However, there is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused.

40) I have found the goods and services specified in the application to be identical or at least reasonably similar to goods and services covered by the earlier mark. I have found the marks to have a reasonable degree of both visual and aural similarity, with a neutral conceptual content. I have found the earlier mark to possess a high degree of inherent distinctive character. The consumer is used to seeing businesses use variations of their marks in trade. Bearing all this in mind, together with my assessment of the nature of the average consumer and their purchasing process, and having regard to the interdependency principle, I think it likely that the average consumer will consider the relevant goods and services provided under the respective marks to be the responsibility of the same or an economically linked undertaking. Accordingly, there is a likelihood of confusion in respect of all the goods and services for which the Holder seeks protection. **The opposition on the basis of section 5(2)(b) of the Act succeeds in its entirety.**

41) In view of my finding for the Opponent under section 5(2)(b) of the Act, there is no need to consider the other grounds of opposition under sections 5(3) and 5(4)(a) of the Act, since the Opponent is in no stronger position under those provisions.

COSTS

42) The Opponent has been successful and is entitled to a contribution towards its costs. I hereby order Fantawild Holdings Inc. to pay the Coca-Cola Company the sum of £1,400. This sum is calculated as follows:

Preparing a statement and considering the other side's statement – £250

Preparing evidence – £600.

Opposition fee – £200

Written submissions – £350

43) The above sum should 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 20th day of March 2012

**Martin Boyle
For the Registrar,
The Comptroller-General**