

0-010-13

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2592408
BY LESLIE ALEXANDER GORT-BARTEN TO REGISTER THE TRADE MARK**

NX

IN CLASSES 6 AND 30

**AND IN THE MATTER OF OPPOSITION
THERETO UNDER NO 102762
BY MAXIM'S CATERERS LIMITED**

BACKGROUND AND PLEADINGS

1) On 23 August 2011, Leslie Alexander Gort-Barten applied under the Trade Marks Act 1994 ("the Act") for registration of the mark "NX" in respect of the following list of goods:

Class 6

Pods, capsules and containers for food & beverages including coffee.

Class 30

Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery, ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice; sandwiches; prepared meals; pizzas, pies and pasta dishes; preparations including coffee, coffee pods.

2) The application was published in the Trade Marks Journal on 16 September 2011 and on 12 December 2011, Maxim's Caterers Limited ("Maxim's") filed notice of opposition to the application. The opposition is based on a single ground, namely that the application offends under Section 5(2)(b) of the Act because it is in respect of a mark similar to an earlier mark in the name of Maxim's and is in respect of identical or similar goods. The opposition is directed at all of the goods listed in Mr Gort-Barten's application.

3) The relevant details of the earlier mark relied upon by Maxim's are reproduced below:

Mark and relevant dates	List of goods and services
Community Trade Mark (CTM) 7525876	Class 16: Paper, cardboard and goods made from these material, not included in other classes; printed matters; plastic materials for packaging (not included in other classes).
MX	Class 29: Meat and preserved meat; fish; poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies; jams; compotes; eggs; milk and milk products; milk powder; cream; yoghurt; sandwich spread on the basis of milk; nuts; pickles; preserved and dried sea products (except fish); all included in class 29.
Filing date: 15 January 2009	Class 30: Coffee, artificial coffee, coffee substitutes; tea, tea leaves and tea products; cocoa, cocoa powder and cocoa products; bread; biscuits; cakes; snack food, cookies; crackers; chinese cakes and Western style cakes; chinese dumplings, almond flakes; chocolate; bread sticks; pancakes; desserts; pudding; pastry and confectionery; macaroni, spaghetti, noodles and pasta products; honey; treacle; vinegar; mustard; spices; horseradish sauces; sauces (condiments) other than yeast based sauces; salad dressing; ketchup; curry; ice; rice; tapioca; sago; ice-cream; mayonnaise; fruit sauces; all included in class 30.
Registration date: 16 May 2012	

	<p>Class 35: Advertising; business management; business administration; office functions; advertising by mail order; business consultancy (professional-); business information; business inquiries; business investigations; business management assistance; business management consultancy; business organization consultancy; business research; commercial or industrial management assistance; demonstration of goods; direct mail advertising; dissemination of advertising matter; distribution of samples; organization of exhibitions for commercial or advertising purposes; import-export agencies; marketing research; marketing studies; organization of trade fairs for commercial or advertising purposes; sales promotion (for others); updating of advertising material; retail and distribution (distributorship) services connected with food other than soup stock, yeast, yeast products, baking powder, flour and preparations made from cereal, baking or brewing ingredients.</p> <p>Class 43: Provision and preparations of take-away food on behalf of third parties; restaurant, café and catering services; all included in class 43.</p>
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- 4) This mark is registered and was applied for before the contested mark. It therefore qualifies as an earlier mark as defined by Section 6 of the Act. It completed its registration procedures on 16 May 2012 and, because this is not more than five years before the publication of Mr Gort-Barten's mark, it is not subject to the proof of use provisions set out in Section 6A(1) of the Act.
- 5) The applicant subsequently filed a counterstatement denying Maxim's claim that the marks are similar and denying that its Class 6 goods are similar to any goods of the earlier mark but admitting that the goods in Class 30 are identical or similar.
- 6) Neither side filed evidence in these proceedings, but Mr Gort-Barten did file brief written submissions. Both sides ask for an award of costs. The matter came to be heard on 8 November 2012 when Maxim's was represented by Mr Alan Fiddes for Urquhart-Dykes & Lord LLP and Mr Gort-Barten represented by Mr David Moore for Jensen & Son.
- 7) At the hearing, and following completion of the parties' submissions on the substantive issue, a joint request was made to suspend the issuing of my decision whilst the parties negotiated over a settlement. I agreed to stay my decision for one month until 8 December 2012. Nothing was heard from the parties by this date and, further, no response has been received to subsequent follow-up enquiries by the Registry. Consequently, I issue my decision.

DECISION

Section 5(2)(b)

- 8) Section 5(2)(b) reads:

“(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.”

9) In my consideration of a likelihood of confusion, I take into account the guidance from the settled case law provided by the Court of Justice of the European Union (CJEU) in *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117 (“*Canon*”), *Lloyd Schuhfabrik Meyer & Co GmbH v Klijzen Handel B.V.* [2000] FSR. 77, *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] ETMR 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. 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 Klijzen 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*,

(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) in determining whether similarity between the goods or services covered by two 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*,
- (h) 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*,
- (i) 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*,
- (j) 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*,
- (k) 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*
- (l) 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*

Comparison of goods

10) In assessing the similarity of goods, it is necessary to apply the approach advocated by case law and all relevant factors relating to the respective goods and services should be taken into account in determining this issue. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the CJEU stated at paragraph 23:

„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) Other factors may also be taken into account such as, for example, the distribution channels of the goods concerned (see, for example, *British Sugar Plc v James Robertson & Sons Limited (TREAT)* [1996] RPC 281).

12) Complementarity, in the sense used by the CJEU in *Canon* has been explained by the General Court (“the GC”) in *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-325/06 (“*Boston Scientific*”) where it found 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”.

13) Finally, I am mindful that goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the application or when the goods designated by the application are included in a more general category designated by the earlier mark (the General Court (“GC”), in *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-133/05, at paragraph 29).

Class 6

14) In Maxim’s statement of case it submits that Mr Gort-Barten’s Class 6 goods are complementary to its Class 30 goods. I am unconvinced by this submission. The respective goods are not important or essential to the existence of the other. Bespoke packaging is not essential for such goods and a food packaging trader can develop its products so as to be suitable for any other foodstuffs. The consumers for the respective goods will be very different and therefore, their trade channels are different. Further, there is no overlap in nature or intended purpose. Consequently, when applying the guidance provided by the CJEU in *Canon* and the GC in *Boston Scientific*, I conclude that there is no similarity between these respective goods.

15) At the hearing, Mr Fiddes also contended that Maxim’s *plastic material for packaging* in its Class 16 specification is identical or similar to Mr Gort-Barten’s Class 6 goods. He argued that Mr Gort-Barten’s *pods, capsules and containers for food & beverages including coffee* are *plastic materials for packaging*. I do not agree, the term in Maxim’s specification describes materials (for packaging) rather than the packaging itself, which is what is covered by Mr Gort-Barten’s. Consequently, the goods are not identical. The average consumer for *plastic materials for packaging* will either be members of the general public who may wish to package small articles, such as presents, for posting or it may be packaging manufacturers who use the plastic materials for manufacturing the packaging itself. Mr Gort-Barten’s goods are types of packaging used for *food & beverages* and not a material for making that packaging. As such, the average consumer for his goods are the food and beverage traders who wish to package

their goods in his goods. Taking all of this into account, I conclude that if there is any similarity between these respective goods it is only low.

Class 30

16) In his counterstatement, Mr Gort-Barten conceded that his Class 30 goods are identical or similar to Maxim's Class 30 goods without providing any information as to how similar these goods are. As it is self evident, I take this concession to mean that Mr Gort-Barten's *Coffee, tea, cocoa, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery, ices; honey, treacle; mustard; vinegar, sauces (condiments); spices; ice; pasta dishes* are all identical to Maxim's goods by virtue of the identical terms appearing in its specification or because a very similar term appears that I consider to cover essentially the same goods. In addition, I consider *sandwiches* to be covered by Maxim's *snack foods*.

17) Further, I consider that *coffee pods* are covered by the term *coffee* in Maxim's Class 30 specification. In respect to *preparations including coffee*, this term includes, for example, preparations made from a mixture of coffee and other ingredients, such as chocolate. Consequently, such goods are highly similar to *coffee*.

18) It is less clear to me that there is a close connection between Mr Gort-Barten's, *yeast, baking-powder* and *flour and preparations made from cereal* with Maxim's goods. Clearly, they are all foodstuffs and Mr Gort-Barten's goods and some of Maxim's goods may be described as ingredients or seasoning for food. However, this is not enough to conclude anything other than only a moderate level of similarity. Maxim's case is no stronger by relying upon its retail services connected with food in its Class 35 specification because it is specifically stated in the specification that these services do not include those relating to *yeast, baking-powder* and *flour and preparations made from cereal* (and some other foodstuffs).

19) The position is slightly different when considering Mr Gort-Barten's *sugar, salt, prepared meals; pizzas and pies*. The retail of the same is covered by Maxim's Class 35 specification. The GC has commented, in *Oakley, Inc v OHIM - T-116/06*, that there is similarity between goods and the retail of those same goods, and consequently, I find a good deal of similarity here.

The average consumer

20) Matters must be judged through the eyes of the average consumer (*Sabel BV v.Puma AG*, paragraph 23), who is reasonably observant and circumspect (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijzen Handel B.V.*, paragraph 27). The degree of care and attention the average consumer uses when selecting goods and services can, however, very depending on what is involved (see, for

example, the judgment of the GC in *Inter-Ikea Systems B.V. v. OHIM*, Case T-112/06).

21) In respect to Mr Gort-Barten Class 6 goods, the average consumer is likely to be commercial enterprises that need to package their food goods for sale. Here, the goods are likely to be bought in bulk making the purchases reasonably high in value. Therefore, the purchasing act is likely to be more highly considered than average, but not necessarily involving the highest level of consideration.

22) With regard to the parties' Class 30 goods and Maxim's retail services, the average consumer is likely to be the ordinary members of the public, who are likely to purchase these goods as part of ordinary grocery shopping. Consequently, the purchasing act is unlikely to be that well considered and is likely to be influenced predominantly by visual considerations with goods being viewed on shelves, or on a computer screen if ordering online.

Comparison of marks

23) For ease of reference, the respective marks are:

Maxim's mark	Mr Gort-Barten's mark
MX	NX

24) When assessing the extent of similarity between the respective marks, I must do so with reference to their visual, aural and conceptual similarities bearing in mind their distinctive and dominant components (*Sabel BV v. Puma AG*, para 23). Both marks consist of two letters, neither of which appears to form a known word. The distinctive character of both these marks resides in the totality, with no one letter dominating.

25) Turning to the comparison of the marks, from a visual perspective, both marks are short, two letter marks and both share the same second letter, namely "X". Their respective first letters differ in being "M" and "N" respectively, but nevertheless, they still share some visual similarity in the first upright arm and first sloping arm in the letter "M" is replicated in the letter "N". Further, the last "arm" of both letters is the same. In other words, the letters differ only in the additional sloping third arm present in the letter "M". Both marks are presented in an ordinary font, and therefore, no difference can be detected from this perspective. Taking all of this into account, I conclude that there is a moderately high level of visual similarity.

26) Aurally, the marks differ in the pronunciation of the first letter with Maxim's mark being articulated as EM-ECKS, whereas, Mr Gort-Barten's mark will be articulated as EN-ECKS. Whilst not identical, these two first syllables share similarity. Clearly, the identical second syllable is also a point of similarity. Taking

all of this into account, I confirm that the respective marks share moderately high level of aural similarity.

27) Conceptually, neither mark has any meaning and therefore, no conceptual comparison can be made.

28) In summary, I have found that the respective marks share a moderately high level of both visual and aural similarity. Neither mark has a conceptual meaning that may offset this level of visual and aural similarity and I conclude that the marks share a moderately high degree of similarity overall.

Distinctive character of the earlier trade mark

29) I must consider the distinctive character of the earlier mark because the more distinctive it is, either by inherent nature or by use the greater the likelihood of confusion (*Sabel BV v Puma AG* [1998] RPC 199). The distinctive character of the earlier mark must be assessed by reference to the goods and 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)* [2002] ETMR 91). Maxim's mark consists of the letters MX that does not appear to have any meaning in respect to Maxim's goods and services. Consequently, its mark is endowed with a reasonable distinctive character in respect of these goods and services.

30) No evidence of use of Maxim's mark has been presented and, therefore, I am left to consider only the level of inherent distinctive character in its mark. Maxim's mark consists of two letters, but still endowed with a reasonable level of distinctive character.

Likelihood of confusion

31) I must adopt the global approach advocated by case law and take into account that marks are rarely recalled perfectly with the consumer relying instead on the imperfect picture of them he has in kept in his mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijzen Handel B.V* paragraph 27). I must take into account all factors relevant to the circumstances of the case, in particular the interdependence between the similarity of the marks and that of the goods or services designated (see Case T-162/01 *Laboratorios RTB v OHIM – Giorgio Beverly Hills (GIORGIO BEVERLY HILLS)* [2003] ECR II-2821, paragraphs 30 to 33).

32) In light of my finding that Mr Gort-Barten's Class 6 goods are only similar to a low degree with Maxim's *plastic materials for packaging* and also taking account of the different average consumers and the difference between the marks, there is little scope for confusion. Consequently, I conclude that there is no likelihood of confusion regarding these goods.

33) Mr Gort-Barten has said in written submissions that the consumer pays greater attention to shorter marks with individual elements having much greater weight, particularly where marks have no meaning, as here. It has been argued that support for this proposition can be found in the decision of the GC in *Henkel KGaA v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* (OHIM), T-342/05 where it concluded that the change of the first letter in a three letter mark was enough to avoid a likelihood of confusion. The marks in question were a stylised version of "DOR" and "COR" in plain text. I do not find this example to be on "all-fours" with the current case. The marks considered by the GC exhibit greater aural and visual differences than in the case of the marks I am considering here with the first letters "D" and "C" are less similar than the first letters "M" and "N" being considered here. There is no general rule that if the first letter is different then there is no likelihood of confusion and it is too simplistic to conclude that different first letters will automatically lead to the consumer differentiating between the marks.

34) The consumer is generally used to differentiating between letters of the alphabet, however the scope for confusion may be increased in some cases, for example, the letters "i" and "j" are visually less distinguishable than many letters, the letters "c" and "k" are aurally less distinguishable than many. It is my view that the letters "N" and "M" are also examples of letters that are less distinguishable than most. As I have already discussed, there are similarities in both visual appearance and in pronunciation. I take account of this, together with the fact that both marks contain the same second letter "X" that, relatively speaking, is a more unusual letter. When this is factored into the global assessment and taking imperfect recollection into account together with the level of aural and visual similarity between the marks, it is my view that because the purchasing act is not particularly well considered in the case of Class 30 goods, there is a likelihood that the consumer will confuse one mark for the other, at least where the respective goods are identical or where they share a high or good level of similarity, namely, in respect of the following of Mr Gort-Barten's goods:

Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery, ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice; sandwiches; prepared meals; pizzas, pies and pasta dishes; preparations including coffee, coffee pods.

35) I find there is no likelihood of confusion where the similarity of the goods is no more than moderate, namely:

yeast, baking-powder and flour and preparations made from cereal

36) In summary, the opposition succeeds against the Class 30 goods listed in paragraph 34 above, but fails against the whole of the Class 6 specification and the Class 30 goods listed in paragraph 35.

COSTS

37) The opposition has been partially successful with Mr Gort-Barden retaining his Class 6 specification and some terms in his Class 30 specification, but with Maxim's being successful against most of his Class 30 specification, the outcome is evenly balanced with both parties achieving a measure of success. Consequently, I find that each party should bear its own costs.

Dated this 8th day of January 2013

**Mark Bryant
For the Registrar,
the Comptroller-General**