

O-119-13

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION 2603157
BY LIDL STIFTUNG & CO KG TO REGISTER THE FOLLOWING SERIES OF
TRADE MARKS IN CLASS 29:**


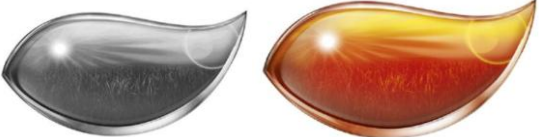








AND

OPPOSITION THERETO (NO 103190) BY IGLO FOODS GROUP LIMITED

The background and the pleadings

1) This dispute is between Lidl Stiftung & Co KG (“Lidl”), the applicant for the above referenced series of trade marks, and Iglo Foods Group Limited (“Iglo”), who opposes registration of them. Iglo’s opposition is based on section 5(2)(b) of the Trade Marks Act 1994 (“the Act”), relying on the following 11 trade marks:

2508545A	
2508545B	
2508545C	
CTM 7593353	
CTM 7597198	
CTM 9757031	
CTM 9690744	
CTM 9691106	
CTM 8716565	<p data-bbox="539 1682 954 1780"><i>Field Fresh</i></p>
CTM 8585978	<p data-bbox="493 1801 987 1852">IGLO FIELD FRESH</p>



2) Lidl filed a counterstatement denying the grounds of opposition. Its defence is based, essentially, on its view that none of the respective marks are “confusingly similar”. I take this to mean that the marks are not similar enough, when all the other factors are borne in mind, for there to be a likelihood of confusion. Neither party filed evidence. Neither party requested a hearing, both opting to file written submissions instead. Although I have not set out the details above, there is no dispute that Iglo’s marks constitute earlier marks under section 6 of the Act and there is no dispute that Iglo is free from the requirement to prove that genuine use has been made of the earlier marks given that none of them completed their registration procedures five years or more before the date on which Lidl’s marks were published.

The legislation and the case-law

3) 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.”

4) The Court of Justice of the European Union (“CJEU”) has provided relevant guidance 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."

Iglo's best prospect(s) for success

5) There is a degree of overlap between the earlier marks. For example, CTMs 7593353 & 7597198 are replicas of two of the UK registrations relied upon. Consequently, the CTMs take matters no further forward. Furthermore, CTMs 9757031, 9690744 & 9691106 are further away from the applied for marks (in terms of mark similarity) than the earlier figurative UK registrations and, consequently, are unlikely to improve Iglo's position. The same can be said of UK registration 2508545B, which, because it contains added matter (a field like representation is contained within the lozenge) compared to the other earlier UK figurative marks, matter which is not shared by the applied for mark. Therefore, in terms of the figurative marks, I will focus my assessment on earlier marks 2508545A and 2508545C.

6) In terms of the earlier marks with verbal elements, I will focus my assessment on earlier CTMs 8716565 & 9476102. The remaining CTM, 8585978, is further away from the applied for mark than earlier CTM 8716565, so is unlikely to improve Iglo's position.

The competing goods

7) Lidl wishes to register its mark for:

“Fish and fish products”

8) Earlier marks 2508545A, 2508545C, CTM 8716565 & CTM 9476102 are all registered for a variety of goods and services, included in which are the following terms in class 29: “fish” and “fish products”. **The goods are identical.**

The average consumer

9) The case-law informs me that 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 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)).

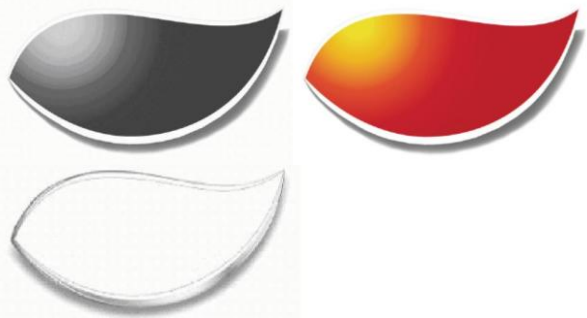

10) Fish and fish products are “consumed” by members of the general public. They are purchased on a fairly frequent basis, often as part of a weekly shop. They are relatively inexpensive products costing a few pounds in general. Whilst it is fair to say that the goods are likely to be purchased with greater care than the proverbial bag of sweets due to the fact that they may be inspected to see what type of fish the product consists of/contains and whether it is boneless/skinless etc, I do not consider that the degree of care and attention likely to be deployed

by the average consumer is any greater than the norm; it is not a highly considered purchase.

11) In terms of how the goods will be selected, most will be self-selected from a supermarket freezer/refrigerator area (or the online equivalents). This suggests a process of visual selection, however, aural similarity will not be completely ignored, particularly as in this case goods could be requested orally at a fishmonger or from the fresh fish department of a supermarket.

The competing marks

12) 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. I will firstly compare the figurative marks:

Earlier marks	Applied for marks
	

13) The dominant and distinctive element of the applied for marks are the words HARBOUR FRESH. However, the figurative aspect will not be ignored from the assessment because it is not negligible; nevertheless, the words strongly dominate the overall impression of the mark. In respect of those words, although FRESH is given more prominence visually, the words will be perceived as a single composite phrase, HARBOUR FRESH. In terms of the earlier marks, there is only one element in each of them which, therefore, constitutes its dominant and distinctive element.

14) From a visual perspective, the earlier marks consist of a curved outline shape. The applied for mark has a curved outline background which, if turned upside down, roughly matches the shape of the earlier mark. However, the applied for mark also contains the words HARBOUR FRESH which does not appear in the earlier marks, such words being the dominant and distinctive element of the applied for mark. The curved outline creates a degree of similarity,

but given the additional words in the applied for mark and given the different configuration of the outline (upside down), and given that the overall impression of the applied for mark is dominated by its verbal element, I consider the degree of visual similarity to be low.

15) From an aural perspective, the applied for mark will clearly be referred to as HARBOUR FRESH. There will be no attempt to articulate the figurative element. I doubt whether the earlier marks will be articulated at all given that (as I will come on to) they have no clear semantic context. In any event, even if an attempt is made to articulate the mark it will have nothing to do with HARBOUR FRESH. There is no aural similarity.

16) In terms of concept, Lidl submits that the earlier marks are evocative of a bird's body whereas its marks are not. However, this argument appears to stem from the fact that Iglo apparently uses the marks in conjunction with the words BIRDSEYE. I cannot take this into account when making the comparison as it is the marks before the tribunal that must be compared. Iglo submits that the figurative element in the applied for mark will be seen as a fish and the earlier mark as a fish or a bird. In deciding on concept, it is, of course, the perception of the average consumer that is paramount. I come to the view that the average consumer will see nothing other than a curved lozenge shape. To reach the conclusion that the marks consist of/contain a device of a fish or a bird requires too great a process of analysis – it would not be the natural reaction of the average consumer (even when bearing in mind that the goods are fish and fish products). I am left with the view that the earlier marks have no semantic context and the applied for marks' concept being based on the words HARBOUR FRESH (suggestive of seafood that is as fresh as it was when brought to the harbour), consequently, there is no conceptual similarity.

17) I next compare the applied for marks with the verbal earlier marks:

Earlier marks	Applied for marks
	

18) The dominant and distinctive element of the earlier marks are the words FIELD FRESH/CATCH FRESH. Neither of the two words that make up the earlier marks dominates the other, it will be seen as a single phrase. The words strongly

dominate the overall impression of the marks. I have already commented upon the dominant and distinctive elements of the applied for marks.

19) There is a degree of visual and aural similarity between the respective marks because they all contain the word FRESH. However, the first words in each of the marks have no points of visual or aural co-incidence. The applied for mark also has a figurative element which is not shared by the earlier marks. Indeed, the CATCH FRESH mark has a different figurative element. I consider the degree of visual and aural similarity to be low.

20) Conceptually, all the marks allude to freshness in a particular context; i.e. “field fresh” is suggestive of a grown food product that is as fresh as it was when in the field, “catch fresh” is suggestive of seafood that is as fresh as it was when caught, “harbour fresh” is suggestive of seafood that is as fresh as it was when brought to the harbour. The similar idea creates some conceptual similarity, but the difference between a field and a harbour is quite distinct so any conceptual similarity between FIELD FRESH and HARBOUR FRESH is low. There is greater conceptual similarity between CATCH FRESH and HARBOUR FRESH as there is greater linkage between the act of catching fish and the act of bringing the fish to harbour. The concepts are not, contrary to what Iglo submits, identical – the concepts are nevertheless similar to a reasonable degree.

21) In none of the above assessments have I referred to colour. This is because two of the earlier figurative marks are non-coloured, and the closest verbal mark (CATCH FRESH) is too. The consequence of the above is that even from the perspective of the applied for mark which is in colour, its colour cannot act as a distinguishing element.

The distinctiveness of the earlier mark

22) The more distinctive an earlier mark (based either on inherent qualities or through the use made of it), the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24). I have only the inherent characteristics of the earlier marks to consider in these proceedings, no evidence of use having been filed. In relation to the CATCH FRESH and FIELD FRESH marks, these have clear suggestive characteristics (as per my assessment of concept). I consider them to have only a moderate degree of inherent distinctive character.

23) In relation to the earlier figurative marks, they consist of simple curved (and in one case coloured) shapes. The marks are certainly not highly distinctive. Lidl submits that the shape is banal and commonplace which, in the absence of something else in the mark, means that the average consumer would not associate it as giving a clear indication of the source of the goods; it considers that any degree of distinctiveness is very much towards the lower end of the scale. Iglo highlights that there is no evidence of such devices being commonplace and that, therefore, Lidl is pitching the matter too low.

24) Lidl's explanation borders on a claim that the earlier marks have no distinctiveness, however, this cannot be right as the earlier marks must be assumed to be distinctive¹. Nevertheless, the degree or level of distinctiveness may be low, high or various shades between. Levels of distinctiveness are to be assessed on the lesser or greater capacity of the mark(s) to indicate trade origin in a particular undertaking. Whilst there is no evidence of commonality, the figurative earlier marks do not grab out at the average consumer, there is no conceptual hook, there is nothing remarkable about them. The marks are distinctive, but only to a low to moderate degree.

Likelihood of confusion

25) 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.

26) In its submissions, Iglo refers to the existence of a family of marks. However, this submission is misconceived given that for a family of marks to be relevant in assessing whether there exists a likelihood of confusion, the claimed family of marks must be in use². No evidence has been filed so the claim cannot be taken into account.

Is there a likelihood of confusion with the earlier figurative marks?

27) In terms of direct confusion, where the marks are, effectively, mistaken for one another, then this can be easily ruled out in respect of the earlier figurative marks. The presence in the applied for mark of the words HARBOUR FRESH will clearly be appreciated and, notwithstanding the fact that the goods are identical, and bearing in mind the principle of imperfect recollection, the average consumer will not be directly confused. **There is no likelihood of direct confusion.**

28) I next consider indirect confusion, where, even though the average consumer will notice the differences between the marks, they will nevertheless put the similarities that exist between them (when all other factors are considered) down to the undertakings responsible for the goods being the same or being related. Lidl refers to the *Shaker di L. Laudato & Co. Sas* case, with its submissions focusing on the overall impression of its mark which it says is

¹ See Case C-196/11 P, *Formula One Licensing BV v OHIM, Global Sports Media Ltd*

² This has been held on numerous occasions, see, for example, the judgment of the CJEU in Case C-234/06P, *Il Ponte Finanziaria v OHIM*.

dominated by the words HARBOUR FRESH with the figurative element playing only a secondary role, even if it is noticed at all. At point (f) of the list of relevant factors in paragraph 4 is the following:

“(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;”

29) The above is a factor stemming largely from the judgment of the CJEU in *Medion AG V Thomson multimedia Sales Germany & Austria GmbH*. This is a case referred to by Iglo in its submissions. Iglo also refers to guidance issued by the IPO (in PAN 11/06) dealing with circumstances when one mark is subsumed within another:

“49.7 Where Trade Mark A is subsumed within Trade Mark B

In the case of composite marks comprised of two or more **distinctive** elements, it will often be difficult to determine that any one of those elements is dominant.

The most obvious example is that of a full name such as „Alexander Morgan’, where both elements contribute roughly equally to the origin identification message sent by the composite sign, which therefore depends upon the presence of both elements. Accordingly, the registrar would not normally regard the marks „Alexander’ or „Morgan’ as being in conflict with the mark comprised of the full name, even if the respective goods are the same.

Nevertheless, there may be cases even of this type where one part of the name will be seen as the dominant and distinctive feature. For example, in the full name „Tony Copland’, the surname is rare whereas the forename is common. The surname therefore contributes more to the distinctive character of the mark than the forename. „Tony Copland’ should therefore be cited against „Copland’ alone (subject to the respective goods/services being identical or at least closely similar) on the basis that „Copland’ is the dominant and distinctive feature of „Tony Copland’. But the mark „Tony’ would not be cited against the mark „Tony Copland’.

Where trade mark A is incorporated into trade mark B in such a way that it **cannot** be said to be a **dominant** element of trade mark B, there may still be a likelihood of confusion where:

- the respective goods or services are identical or virtually so, and
- the element which corresponds to trade mark A retains an independent role within trade mark B, and

- the common element is not prima facie lacking or low in distinctive character.”

30) Iglo argues that its figurative mark(s) is subsumed within the applied for mark (albeit in an inverted fashion) and that this element performs an independent trade mark role. Iglo also referred to other cases³ which are borne in mind, but I also bear in mind that those decisions were, of course, reached on the facts (and marks) in question there.

31) I should say upfront that the above PAN guidance has little significance. There can be no hard or fast rules applied to the tribunal by guidance of this type. In any event, even on the above guidance, Iglo’s argument is weak given my finding that the earlier figurative marks have only a low to moderate degree of distinctiveness, not a normal level of distinctiveness. However, stepping back from the guidance in paragraph 29, and focusing on the case-law and applying it to the circumstances before me, I come to the view that the figurative element in the applied for mark plays such a minor role (even though it is not negligible), and given that the figurative element is not particularly distinctive (although it has some distinctiveness), and when the figurative element is not quite the same due to its inversion, the net effect of all this is that there is not a strong enough signal to inform the consumer that the goods sold under the respective trade marks come from the same or an economically linked undertaking. **There is no likelihood of indirect confusion.**

Is there a likelihood of confusion with the earlier verbal marks?

32) Of the earlier verbal marks the closest is CATCH FRESH given its closer conceptual significance. In terms of direct confusion and, again, bearing in mind all the relevant factors, including imperfect recollection, then I consider the difference in the words CATCH and HARBOUR to be sufficiently different to avoid the marks from being directly confused. The conceptual similarity is borne in mind but the HARBOUR/CATCH significance is in my view likely to be remembered and recalled as such. In terms of indirect confusion, I bear in mind that the average consumer may see one as a variant brand of the other. However, without a family of marks being in use it is my view that the average consumer will not put the similarities between them down to them coming from the same stable. The average consumer will simply consider that different undertakings have come up with different marks to send the same suggestive message – any similarity will be put down to co-incidence and not connection. **There is no likelihood of indirect confusion.**

³ *Ikea Systems BV v Walter Waibal* T-112/06 referring to a figurative element which was deemed as important as the verbal element in a mark, *Polypipe Buildings Products v Polyplast GmbH & Co KG* referring to common elements not being overcome by slight differences between the marks, and, *Nestle v Master Beverages* referring to some conceptual similarity can come from the common presence of figurative marks even if one of the marks included words.

Outcome

33) In relation to the marks I identified as representing Iglo's best prospect of success, I have found no likelihood of confusion. I confirm again that I have fully considered all the earlier marks and I do not see how Iglo is in a better position. Even if some of the earlier marks are more distinctive than the earlier marks I have assessed, such additional distinctiveness gives rise to a more distant mark. There would be no likelihood of confusion in relation to any of them. **The opposition is hereby dismissed.**

Costs

34) Lidl has been successful and is entitled to a contribution towards its costs. Lidl submitted that the "scattergun" approach that Iglo has adopted in these proceedings should be borne in mind in the costs assessment. I have taken this into account and I consider that Iglo could have been more economical in the earlier marks it relied upon. I have therefore given a slightly higher award than I would otherwise have made, but still within the published scale. The conduct of Iglo is not on a level where costs above the published scale should be considered. I hereby order Iglo Foods Group Limited to pay Lidl Stiftung & Co KG the sum of £1300. This sum is calculated as follows:

Preparing a statement and considering the other side's statement
£500

Written submissions
£800

35) 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 13th day of March 2013

Oliver Morris
For the Registrar,
The Comptroller-General