

O-116-14

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO 2635825
IN THE NAME OF OLUMOLAWA OLUSI

AND


OPPOSITION THERETO UNDER NO 104371
BY VISA INTERNATIONAL SERVICE ASSOCIATION

Background

1. Application No 2635825 has a filing date of 22 September 2012 and stands in the name of Olumolawa Olusi (“the applicant”). It seeks registration of the trade mark Visamalt in respect of the following goods:

Non alcoholic malt drinks

2. Following publication of the application in the *Trade Marks Journal* on 26 October 2012, a notice of opposition was filed by Visa International Service Association (“the opponent”). The opponent bases its objection on grounds under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”) relying on the following community trade mark (“CTM”) insofar as it is registered for the following goods:

Mark	Dates	Goods relied upon
CTM 5908785 	Filing date: 15 May 2007 Date of entry in register: 4 March 2008	Mineral and aerated waters and other non-alcoholic drinks

3. The applicant filed a counterstatement in which, in summary, he denies the respective marks are similar and further denies there is a likelihood of confusion.

4. Only the opponent filed evidence. The matter came before me for a hearing on 11 March 2014 at which Mr Anthony Pluckrose of Boulton Wade Tennant represented the opponent. Throughout the proceedings, the applicant had been represented by a trade mark attorney but he advised the registrar by email on 3 March 2014 that he had “severed relationship” with his advisors and that all future communications relating to the application and this opposition to it, should be directed to the applicant himself. Whilst notification had been properly sent to his advisors at the date the hearing was appointed, in responding to that email less than 24 hours later, the registrar reminded the applicant of the time and date of the hearing. At the appointed hour, the applicant had not arrived. I delayed the start of the hearing for ten minutes then made a final check to ascertain whether or not he had arrived or contact had been received from him. Nothing having been heard from him, the hearing went ahead in his absence.

The evidence

5. The opponent’s evidence consists of a single witness statement by Donna Mary Trysburg who is a trainee trade mark attorney at Boulton Wade Tennant, the opponent’s representatives in these proceedings. Ms Trysburg’s witness statement consists primarily of submissions rather than evidence and for this reason I do not intend to summarise it here. I have, however, considered it and will refer to it as necessary later in this decision.

The objection under section 5(2)(b)

6. Section 5(2)(b) of the Act states:

(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. An “earlier trade mark” is defined in section 6 of the Act, the relevant part of 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.”

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark”.

8. The CTM relied on by the opponent is an earlier mark within the meaning of the Act. Given the interplay between the date the earlier mark was entered in the register and the date of publication of the application, the earlier mark is not subject to the proof of use provisions set out in section 6A of the Act and the opponent is entitled to rely on it for all of the goods as set out in paragraph 2 above.

9. In considering this ground of objection, and the likelihood of confusion between the respective marks, I take into account the guidance from the settled case law provided by the CJEU in *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) C-334/05 P (LIMONCELLO)*. In the case of *La Chemise Lacoste SA v Baker Street Clothing Ltd [ALLIGATOR]* O/333/10, Mr Hobbs Q.C., acting as the Appointed Person, set out the test shown below which was endorsed by Arnold J. in *Och-Ziff Management Europe Ltd and Oz Management Lp v Och Capital LLP; Union Investment Management Ltd & Ochocki*, [2010] EWCH 2599 (Ch).

(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/ 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; 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;

(e) 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 in that mark;

(f) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa;

(g) 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;

(h) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient;

(i) 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;

(j) 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.

Comparison of the respective goods

10. The goods to be compared are:

Opponent's goods	Applicant's goods
Mineral and aerated waters and other non-alcoholic drinks	Non alcoholic malt drinks

The General Court in *Gérard Meric v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* case T-133/05 commented 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 trade mark application...”

In his counterstatement, the applicant disputes that his goods are similar to the opponent’s “mineral and aerated waters”. He admits that his goods are encompassed by the term “other non-alcoholic drinks” as appears in the opponent’s specification.

11. As the applicant’s goods are included within the term “other non-alcoholic drinks” I find, on the basis of *Merica*, that identical goods are involved.


The average consumer and the nature of the purchasing process

12. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties’ goods and then to determine the manner in which these goods are likely to be selected by the average consumer in the course of trade. The competing goods are non-alcoholic drinks and will be bought by members of the general public, on a regular basis, at relatively low cost. They are goods which may be bought on impulse and not as a result of a particularly careful or educated decision. As a consequence, the effect of imperfect recollection will be increased.

13. The selection of drinks from retail outlets such as supermarkets, other retail premises or from websites is likely to consist predominantly of self-selection. As a consequence, visual considerations are likely to dominate the selection process. When purchased in other venues, for example, in a bar or restaurant, the average consumer may have inspected the bottle or other dispenser containing the goods or selected the goods by reference to, for example, a drinks menu prior to placing their order, in which case visual considerations will also dominate the selection process. That is not to say that other aspects can be ignored: it may be that the average consumer may simply ask for the goods by reference to, for example, the brand and type of drink they require. In these latter circumstances, aural considerations will be of some importance.

Comparison of the respective marks

14. For ease of reference, the marks to be compared are:

Earlier mark	Application
	Visamalt

In his counterstatement, the applicant submits:

“The word ‘VISA’ is depicted in large, thick, bold black or very dark grey letters, having the appearance of slightly inclining towards the right. The initial letter ‘V’ appears as if the top left hand corner has been turned over creating a flap or ‘winged’ effect, which is in a contrasting lighter shade to the rest of the mark.

The Applicant submits that the registered CTM rights granted are limited solely to the particular figurative i.e. stylised representation of the word ‘VISA’ as described above and shown in the representation below*, and it is this figurative i.e. stylised representation (rather than the plain word ‘Visa’) with which the applicant **Visamalt** mark should be visually compared.

*

The image shows the word "VISA" in a bold, italicized, sans-serif font. The letter 'V' is significantly larger and more prominent than the other letters, and its top-left corner is folded over, creating a winged effect. The letters are dark grey or black.

In addition to the differences outlined in paragraph 5. above, the Applicant mark, in contrast to the Opponent’s short, four letter figurative mark, comprises the much longer ‘invented’ (i.e. non dictionary, with no meaning in the English language generally or in relation to the goods applied for) non-stylised upright eight letter plain word ‘Visamalt’, the initial letter ‘V’ being in upper case and the remaining letters all being in ‘lower case’. This further distinguishes and differentiates the respective marks visually, and it is submitted that the ‘Visamalt’ mark should be read and regarded as a single word and not as two segments namely ‘Visa’ and ‘Malt’ as suggested by the Opponent.

Given the additional element ‘malt’ in the Applicant mark, aurally and phonetically, the respective marks also sound very different.

The Applicant further submits that the Opponent’s subject figurative VISA mark is likely to be readily recognised by the majority of the public in relation to financial services, specifically in connection with credit/debit card services, and is therefore likely to be pronounced in the same manner i.e. as with the dictionary word ‘Visa’ (phonetically therefore as if ‘veesa’). On the contrary however, since the applicant mark is invented, no immediate pronunciation springs to mind. It is equally likely therefore that this mark will be pronounced with the second letter ‘i’ as if the word ‘eye’ i.e. as with the English dictionary word ‘Visor’ (*meaning “A piece projecting from the front of a cap or an elastic headband to shade or protect the eyes”*), so that Visamalt is phonetically pronounced as “V’eye’samalt’ or ‘Visormalt’.

15. For the opponent, Mr Pluckrose referred me to the *Medion* case (supra) and submitted that the word VISA within the applicant’s mark was an independent and distinctive element of that mark.

16. The earlier mark has a degree of stylisation in that it is presented in a bold and somewhat italicised font and the top of the left hand upright of the initial letter V is, as

the applicant puts it: “turned over creating a flap or “winged” effect, which is in a contrasting lighter shade to the rest of the mark”. Despite this stylisation, which is relatively minor and may not even be noticed by the average consumer, the mark will be seen clearly as the word VISA. It has no dominant elements and the distinctiveness of the mark rests in its whole. The mark applied for is presented as a single word but, particularly in view of the fact that the goods are malt drinks, naturally breaks down into its two component parts. The word ‘malt’ is non distinctive for the goods for which registration is sought. The word Visa has an independent, distinctive and dominant role within the mark.

17. I have to compare the marks as wholes. The commonality of the letters VISA as the first or only letters within the marks leads to there being a high degree of similarity between the respective marks from both the visual and aural perspectives. I reject the applicant’s submission that these letters will be pronounced as in ‘veesa’ when referring to the opponent’s mark but as in ‘visor’ when referring to his mark: I accept that both are possible pronunciations of the word VISA, however, I can discern no reason why the average consumer will pronounce one differently to the other. Instead, as the spelling of both elements is identical, however they choose to pronounce the word, the average consumer will pronounce both in the same way. For similar reasons, any conceptual meanings the respective marks may have are also likely to be the same. Overall, the respective marks are highly similar.

The distinctiveness of the earlier mark

18. I must also assess the distinctive character of the earlier mark. The distinctive character of a mark can be appraised only, first, by reference to the goods for which it is registered and, secondly, by reference to the way it is perceived by the relevant public –*Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the mark to identify the goods for which it has been registered as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings –*Windsurfing Cheimsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

19. The opponent has filed no evidence of any use of the earlier mark and therefore I have only its inherent distinctiveness to consider. The word Visa is an ordinary dictionary word which will be known to the average consumer but it has no meaning in relation to the goods at issue. It is a mark with an average degree of inherent distinctive character.

Likelihood of confusion

20. In determining whether there is a likelihood of confusion, a number of factors must be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. I must also factor in the distinctive character of the earlier trade mark as the more distinctive this trade mark is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods, the nature of the purchasing process and the fact that the

average consumer rarely has the opportunity to make direct comparisons between the trade marks and must instead rely upon the imperfect picture of them he has retained in his mind.

21. Earlier in my decision, I found:

- that identical goods are involved;
- that the goods are such as are purchased by the general public on a regular basis, at relatively low cost and may be bought on impulse and not as a result of a particularly careful or educated decision;
- that the respective marks are highly similar.

22. Taking all matters into account, I find that there is a likelihood of confusion between the respective marks. The opposition based on section 5(2)(b) of the Act succeeds.

Summary

23. The opposition succeeds in full.

Costs

24. The opponent having been successful is entitled to an award of costs in its favour. In making the award, I take note that the applicant filed no evidence whilst that filed by the opponent was essentially submission and of no assistance. Whilst the opponent requested to be heard and a hearing took place, it was brief and is unlikely to have taken any significant time or effort to prepare.

25. I make the award on the following basis:

For filing a statement and reviewing the other side's statement:	£300
Fee:	£200
Preparing for and attending a hearing:	£300
Total:	£800

26. I order Olumolawa Olusi to pay Visa International Service Association the sum of £800 as a contribution towards its costs. This sum is to be paid within seven days of the expiry of the period for appeal against this decision or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 12th day of March 2014

**Ann Corbett
For the registrar
The Comptroller-General**