

O-181-16

Trade Marks Act 1994

**IN THE MATTER OF TRADE MARK APPLICATION NO 3100534 BY
DUEBROS LTD TO REGISTER THE TRADE MARK**



IN CLASS 30

**AND OPPOSITION THERETO UNDER NO 404645
BY HEIRLER CENOVIS GMBH**

Background and pleadings

1) On 23 March 2015, Duebros Ltd (“the applicant”) applied to register the following trade mark:



2) The application was accepted and subsequently published on 3 April 2015 for the following goods:

Class 30: (Staple Foods) Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery, edible ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice; sandwiches; prepared meals; pizzas, pies and pasta dishes.

3) On 1 July 2015, Heirler Cenovis GmbH (“the opponent”) opposed the application under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). This is on the basis of its earlier Community Trade Mark no. 5480744 (“the earlier mark”). Pertinent details of the registration are as follows:

Mark: EDEN
Filing date: 9 November 2006
Date of entry on the register: 23 October 2010
Relied upon goods¹:

Class 30: Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; beverages with a base of artificial coffee, cocoa or chocolate, and

¹ The earlier mark also covers classes 5, 29, 31 and 32 but these have not been relied upon.

preparations for making the aforesaid beverages; honey, including spiced and/or with added fruit; bread, in particular crispbread; products with a cereal, nut and/or honey base, being spreads (containing fats) and/or sandwich fillings; tofu; sauces (condiments), in particular tomato sauces; tomato products of all kinds, in particular ketchup, tomato puree, peeled, strained and chopped tomatoes; vinegar; bakery mixes, pastry, snacks, included in class 30; puddings; sweeteners (natural) for sweetening foodstuffs and beverages; cereal products with added fruit, in particular cereal flakes, cereal preparations, cereal snacks; vegetarian snacks, namely meat substitute products with a soya and/or cereal base, in particular vegetarian sausages, including as spreads, nuggets, vegetarian rissoles, vegetarian meat balls, schnitzels, ham; vegetarian prepared meals, namely soups and stews, mainly containing vegetables and/or meat substitute products; including all the aforesaid goods being dietetic foods, not adapted for medical purposes.

4) The opponent argues that some of the applied for goods are identical to those covered by the earlier mark, and the remaining goods are highly similar. It also claims that the respective marks are highly similar and that there is a likelihood of confusion on the part of the relevant public in the UK.

5) The applicant filed a counterstatement denying the claims made.

6) Neither side filed evidence. Both sides filed written submissions which will not be summarised but will be referred to as and where appropriate during this decision.

7) A hearing took place via video-link on 26 January 2016. The opponent was represented by Ms Lianne Shaw-Gray of Squire Patton Boggs and the applicant by Mr Stamate Iulian Stancu, a director of the applicant company.

Proof of use

8) In the applicant's counterstatement it requested that the opponent provide evidence of use of its earlier mark. Section 6A of the Act states that:

“Raising of relative grounds in opposition proceedings in case of non-use

6A. - (1) This section applies where -

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a),

(b) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if -

(a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes -

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5) In relation to a Community trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.”

9) The application was published on 3 April 2015. The date on which the earlier mark was entered on the register was 23 October 2010. Since this is less than 5 years prior to the publication date, the opponent is not required to provide evidence of use under section 6A.

DECISION

Legislation and case law

10) Section 5(2)(b) of the Act is as follows:

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

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

11) The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case

C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

The principles

(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 be dominated by one or more of its components;

(f) however, it is also 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 creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods

12) In the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

“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”.

13) The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

a) The respective users of the respective goods or services;

- b) The physical nature of the goods or acts of services
- c) The respective trade channels through which the goods or services reach the market
- d) 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;
- e) 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.

14) The respective goods are as follows:

Applicant	Opponent
Class 30: (Staple Foods) Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery, edible ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice; sandwiches; prepared meals; pizzas, pies and pasta dishes.	Class 30: Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; beverages with a base of artificial coffee, cocoa or chocolate, and preparations for making the aforesaid beverages; honey, including spiced and/or with added fruit; bread, in particular crispbread; products with a cereal, nut and/or honey base, being spreads (containing fats) and/or sandwich fillings; tofu; sauces (condiments), in particular tomato sauces; tomato products of all kinds, in particular ketchup, tomato puree, peeled, strained and chopped tomatoes; bakery mixes, pastry, snacks, included in class 30; puddings; sweeteners (natural) for sweetening foodstuffs and beverages; cereal products with added fruit, in particular cereal flakes, cereal preparations, cereal snacks; vegetarian snacks, namely meat substitute products with

	<p>a soya and/or cereal base, in particular vegetarian sausages, including as spreads, nuggets, vegetarian rissoles, vegetarian meat balls, schnitzels, ham; vegetarian prepared meals, namely soups and stews, mainly containing vegetables and/or meat substitute products; including all the aforesaid goods being dietetic foods, not adapted for medical purposes.</p>
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15) I note that the application begins with the term “Staple foods” in brackets. I do not consider this to be an acceptably precise and clear term. It does not clearly define the goods in question. Nevertheless, since it is in brackets I am adopting the approach that it is a broad characterisation of the applied for goods, and that the list of specific goods thereafter are what protection would be granted for.

Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; vinegar, sauces (condiments)

16) The application and the earlier mark each contain the above mentioned goods. So they are clearly identical.

Mustard, sandwiches; pizzas, pies and pasta dishes

17) In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, the General Court stated at paragraph 29 that:

“In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 Institut fur Lernsysteme v OHIM- Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

18) Applying the principles of *Merica*, I find that the earlier “sauces (condiments)” cover “mustard”. Therefore, they are identical. I also find that the earlier broad term

“snacks” covers “sandwiches; pizzas, pies and pasta dishes”. Therefore, these goods are also identical.

Honey

19) The applied for “honey” is identical to the earlier “honey, including spiced and/or with added fruit”.

Prepared meals

20) The earlier marks includes the term “vegetarian prepared meals, namely soups and stews, mainly containing vegetables and/or meat substitute products”. Use of the word “namely” in the list of goods must be approached as follows (as indicated in the Trade Mark Registry’s classification guidance):

“Note that specifications including “namely” should be interpreted as only covering the named Goods, that is, the specification is limited to those goods. Thus, in the above “dairy products namely cheese and butter” would only be interpreted as meaning “cheese and butter” and not “dairy products” at large. This is consistent with the definitions provided in Collins English Dictionary which states “namely” to mean “that is to say” and the Cambridge International Dictionary of English which states “which is or are.”

21) Accordingly, the scope of specification is effectively “soups and stews, mainly containing vegetables and/or meat substitute products”. I consider these to be forms of “prepared meals” and, therefore, identical.

Preparations made form cereals

22) The applied for “preparations made from cereals” are identical to “cereal products with added fruit, in particular cereal flakes, cereal preparations, cereal snacks”.

Preparations made from confectionery

23) Applying the principle set out in *Meric*, I consider the applied for “preparations made from confectionery” to be covered by the broad term snacks. They are identical.

Preparations made from bread, pastry

24) The applied for “preparations made from bread” are goods whereby bread is the main constituent. Therefore, I find them to be highly similar to the earlier “bread, in particular crispbread”.

25) I also find “preparations made from pastry” to be highly similar to the earlier “pastry” since this is the main constituent. Therefore, I consider them to be purchased by the same end users, via similar trade channels.

Flour; yeast; baking powder

26) I consider the earlier “bakery mixes” to cover a combination of ingredients (for example flour, yeast, baking powder, etc.) which have been pre-prepared for convenience. They are likely to be used by the same end users and sold in close proximity to one another. Further, they will be in competition with one another since customers would have the choice of whether to buy the mix or the individual ingredients. On this basis, I find that the goods are similar to a high degree.

Edible ices; ice

27) The term “edible ices” covers ice cream which is often eaten as a pudding. Therefore, the respective goods are (at least) highly similar. Since “ice” also includes “edible ices”, I also find that these goods are highly similar.

Treacle

28) Treacle is uncrystallised syrup made during the refining of sugar. It is often spread on other foods (e.g. bread), or poured over items such as ice cream to enhance the flavour to suit individual needs. The earlier mark covers honey which has the same intended purpose and most likely to be sued by the same end users. The goods are also likely to be sold in close proximity to one another, and there is a degree of completion. Therefore, I find the goods to be highly similar.

Salt

29) The opponent argues that since “salt” are components for baking or cooking they are identical to the goods covered by the earlier mark. Salt is generally added to a wide range of foods to enhance the flavour and taste, and virtually all food contains a degree of salt. In *Les Éditions Albert René v OHIM*, Case T-336/03, the General Court found at paragraph 61 that:

“... The mere fact that a particular good is used as a part, element or component of another does not suffice in itself to show that the finished goods containing those components are similar since, in particular, their nature, intended purpose and the customers for those goods may be completely different.”

30) See also: *Galileo International Technology, LLC v European Union (formerly European Community)* [2011] ETMR 22 (HC): *Polytetra GmbH v OHIM* Case T-660/11 (use of TEFLON as name of coating material not use in relation to products manufactured by third parties using the material and branded with other marks).

31) Further, I am of the view that “salt” does not fall under the category of “bakery mixes”. If one were to purchase a bakery mix I do not consider it to contain a sachet of salt. Salt is a product that all households will own and a finding that “bakery mixes” covers “salt” is too broad a generalisation. Nevertheless, they would be sold in the same outlet (albeit not likely to be in close proximity) and the end users would be the same. Therefore, I consider them to be similar to a low degree.

Spices

32) Again the applicant argues that because “spices” are “convenient goods or components for baking or cooking” they are highly similar. I agree that spices are a constituent of many foods. However, applying the principle set out in *Les Éditions Albert René*, the mere fact that it is a component of another does not result in the goods being similar. Further, the earlier mark does not cover the broad term “convenient goods or components for baking or cooking”. The relied upon goods do include bakery mixes though I do not consider these to include “spices”. Notwithstanding this, spices are likely to be sold in the same outlets (though not in close proximity), via similar trade channels and used by the same end users. I consider them to be similar to a low degree.


Comparison of marks

33) It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

34) It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and

therefore contribute to the overall impressions created by the marks. The respective trade marks are shown below:

Application	Earlier mark
	<p style="text-align: center;">EDEN</p>

35) The applicant’s trade mark consists of a number of elements. The device is of a circle with five stars at the top and a picture of a bird in flight. The words within the trade mark are Eden Chocolat, and then below in smaller script, be more chocstanza. The applicant argues that the word “Eden” in its mark “has a weight of less than 8% of the entire trademark” and during the hearing Mr Stancu also argued that the word “Eden” is lost in the mark as a whole. In assessing the overall impression of the mark, I cannot take a mathematical approach. The case law dictates that I must consider the visual, aural and conceptual similarities between the marks with reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components. Even though Eden and chocolat are presented next to one another, I consider Eden to be more distinctive and more likely to be remembered. It was argued at the hearing that since the word “Chocolat” does not have an “e” at the end (i.e. the correct English spelling), consumers would not view it as being descriptive. I disagree. The lack of an “e” at the end would either go unnoticed or one would assume that it is a foreign spelling and manufacturer of chocolate. However, I find that Eden is not more prominent than the device but it is a distinctive and dominant component.

36) Mr Stancu also argued that the device is the more prominent element of the mark and consumers would focus on the device rather than the words, citing the lion in the Metro-Goldwyn-Mayer mark as an example. Generally, when a trade mark consists of a combination of words and figurative elements, it is by the word elements that the trade mark is most likely to be referred. Although the applicant’s

trade mark contains additional words mentioned above, given the size, proximity and difference in colour that Eden is from the remaining words, it is by the element Eden that the applicant's trade mark will be referred.

37) The words Eden and Chocolat are above "be more chocstanza" and in a larger font. Therefore, they are more prominent. Further, the word "Eden" is in a different colour to the remaining words so it is more prominent to the remaining words. Overall, I consider the device to be more dominant than the words, however since the word "Eden" is larger and different in colour is also a prominent feature of the mark as a whole. With regard to the earlier mark, this consists of one element, i.e. Eden. Therefore the overall impression of the application is based upon the single word Eden.

38) Visually, the opponent essentially argues that since each of the respective marks share the same element "EDEN" they are similar. It argues that the additional elements are insufficient to render the signs dissimilar. The applicant argues that:

"It can be seen clearly that the element "Eden", and not "EDEN" has the lowest significance through the faded variation of Arctic Blue colour and positioning in the figurative trade mark. It should be noted that all the other elements in the trade mark applied for give the sign an unmistakable distinctiveness against all other registered trade marks on the market and also against the opponent's. According to the human eye, the trademark is revealing itself from top to bottom and from left to right. Therefore "Eden" is not the first element of the trade mark seen by the human eye, but the graphical element, which has the highest power."

39) Whilst the application consists of numerous elements and the device is the most prominent element, I still consider "Eden" to be distinctive in the mark as a whole. The eye would be drawn to Eden. Therefore, I consider there to be a medium degree of visual similarity.

40) With regard to the applicant's argument that the mark is distinguishable from all other marks on the register, I refer to the guidance in *Zero Industry Srl v OHIM*, Case T-400/06, whereby the General Court stated at paragraph 73 that:

“As regards the results of the research submitted by the applicant, according to which 93 Community trade marks are made up of or include the word ‘zero’, it should be pointed out that the Opposition Division found, in that regard, that ‘... there are no indications as to how many of such trade marks are effectively used in the market’. The applicant did not dispute that finding before the Board of Appeal but none the less reverted to the issue of that evidence in its application lodged at the Court. It must be found that the mere fact that a number of trade marks relating to the goods at issue contain the word ‘zero’ is not enough to establish that the distinctive character of that element has been weakened because of its frequent use in the field concerned (see, by analogy, Case T-135/04 GfK v OHIM – BUS(Online Bus) [2005] ECR II-4865, paragraph 68, and Case T-29/04 Castellblanch v OHIM – Champagne Roederer (CRISTAL CASTELLBLANCH) [2005] ECR II-5309, paragraph 71). “

41) In view of the above, other registered trade marks are not taken into consideration when deciding whether there is a likelihood of confusion.

42) Aurally, the earlier mark would clearly be pronounced as Eden. The applicant argues that the pronunciation would vary from language to language. However, I must consider the position from the average UK consumer who, in my opinion would pronounce Eden in the same manner. Whilst the application consists of a number of words, I am of the view that the only elements which would be verbalised are Eden Chocolat. Consumers are unlikely to refer to the goods as “Eden Chocolat be more chocstanza” since the last three words would be viewed as a strapline and therefore unlikely to be articulated. With regard to the device, whilst it would be instantly recognisable as a bird, it would not be verbalised. In view of the aforementioned, the marks are aurally similar to an above medium degree.

43) The opponent states that the term “EDEN” is an English word which may mean the garden of God and the first home of Adam and Eve, or a delightful place a paradise. In my view, the word Eden would be instantly recognisable and remembered and whichever meaning is adopted, it will be the same. Although the application also contains a device, the word Eden would be recalled by the average consumer. The marks are conceptually similar to a high degree.

Average consumer and the purchasing act

44) The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer, Case C-342/97*.

45) In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer at paragraph 60 in these terms:

“The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

46) The goods in question are various food items which would be purchased and consumed by the general public. They are inexpensive goods which are bought following a visual inspection of them on supermarket and shop shelves, or on a website for home delivery. Whilst they will predominantly be purchased following a visual inspection, I do not discount aural recommendations. Given the low cost of

the goods, the level of care and attention paid when purchasing the goods will be above low but not medium.

Distinctive character of the earlier trade mark

47) In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated at paragraphs 22 and 23 that:

“In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

48) The opponent has not provided evidence showing that the distinctiveness of its mark has been enhanced through use. Therefore, I only have the mark’s inherent nature to consider.

49) From an inherent perspective, the earlier mark is the word “EDEN”. This word does not describe or allude to the goods which the opponent relies upon. It is not an

invented word but it is instantly recognisable. Therefore, I consider the inherent distinctive character of the earlier mark to be medium.

GLOBAL ASSESSMENT – Conclusions on Likelihood of Confusion

50) Where there is no similarity between the goods there cannot be a likelihood of confusion. Therefore, the opposition fails against “ice”.

51) Deciding whether there is a likelihood of confusion is not scientific; it is a matter of considering all the factors, weighing them and looking at their combined effect, in accordance with the authorities set out earlier in this decision. One of those principles states that a lesser degree of similarity between the services may be offset by a greater degree of similarity between the marks, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*). I must also keep in mind the distinctive character of the opponent’s mark as the more distinctive these marks are, the greater the likelihood of confusion. I must also keep in mind the average consumer for the services, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between marks and must instead rely upon the imperfect picture retained in their mind.

52) To summarise, I have found that the following applied for goods are identical to those set out in paragraphs 16 to 23 above:

“Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; vinegar, sauces (condiments); mustard; flour; yeast, baking-powder; sandwiches; honey; prepared meals; preparations made from cereals and confectionery; pizzas, pies and pasta dishes”

53) I have found that “preparations made from bread and pastry; treacle; edible ices; ice” are all highly similar to the goods covered by the earlier mark (as set out in paragraphs 24 to 28).

54) I concluded that “salt” and spices” are similar to the goods covered by the earlier mark to a low degree (paragraphs 29 to 32).

55) I have also found that:

- Visually the marks are similar to a medium degree. They are aurally similar to an above medium degree and conceptually similar to a high degree.
- The earlier mark has a medium degree of inherent distinctive character.
- The average consumer of the goods are the general public who will pay an above average, but medium degree of care and attention when purchasing the goods.
- The goods will be purchased following a visual inspection of the goods, though I do not discount aural recommendations.

56) Taking all of the above factors into account I am of the view that there is a likelihood of direct confusion. Where the goods are only similar to a low degree, I find that the overall degree of similarity between the marks offsets the lesser degree of similarity between the goods. I understand that Mr Stancu believes that Eden is only one component of a mark which contains many elements, though Eden does contribute to the overall impression of the mark. It would be immediately noticed and remembered by consumers which would lead to a likelihood of confusion.

57) Mr Stancu has argued that since the application contains a prominent device and additional elements, the word “Eden” has no distinctive significance. Even if I am found to have placed too much emphasis on the word “Eden” in the mark as a whole, I am mindful of the comments made in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10, Mr Iain Purvis Q.C. as the Appointed Person noted that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal

terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

58) In view of the above, even if the application is not directly mistaken for the earlier mark and the average consumer would notice the differences between them, I believe the common factor (“Eden”) would be remembered. Consumers would believe that it is another brand of the owner of the earlier mark and indirect confusion would arise.

OUTCOME

59) The opposition succeeds in its entirety. Subject to appeal, the application shall be refused.

COSTS

60) The opponent has been successful and is entitled to a contribution towards its costs. In the circumstances I award the opponent the sum of £600 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Official fee	£100
Preparing a statement of case and considering the counterstatement	£200
Preparing for and attending a hearing	£300
Total	£600

61) I therefore order Duebros Ltd to pay Heirler Cenovis GmbH the sum of £600. The above sum should be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 8th day of April 2016

MARK KING

For the Registrar,

The Comptroller-General