

O-269-18

TRADE MARKS ACT 1994

**TRADE MARK APPLICATION NO. 3190415
IN THE NAME OF HUNTAPAC PRODUCE LTD**

AND

**OPPOSITION NO. 60000538
BY KETTLE PRODUCE LIMITED**

**AND TRADE MARK REGISTRATION NO. 3091074
IN THE NAME OF KETTLE PRODUCE LIMITED**

AND

**APPLICATION NO. 501671
BY HUNTAPAC PRODUCE LTD TO INVALIDATE THE REGISTRATION OF THE
TRADE MARK NO. 3091074**

Background

1. These consolidated proceedings consist, in part, of an opposition by Kettle Produce Limited (Kettle) to an application (no. 3190415) filed on 11 October 2016 by Huntapac



Produce Ltd (Huntapac) to register as a trade mark in respect of the following goods:

Class 29: *Vegetables Cooked; Vegetable fats for cooking; Vegetables, tinned [canned (Am.)]; Vegetable preserves; Vegetables, preserved; Vegetable stock; Vegetable soup preparations; Vegetable mousses; Vegetable juices for cooking; Vegetable jellies; Vegetable-based meat substitutes; Vegetable-based snack foods; Vegetable-based entrees; Vegetable-based spreads; Vegetable fats for food; Vegetables preserved in oil; Vegetable puree; Vegetable purees; Vegetable marrow paste; Vegetable powders; Vegetable chips; Vegetable spreads; Vegetable burgers; Vegetable pastes; Vegetable oils for food; Crisps; Crisps (Potato -).*

Class 30: *Prepared Meals; Vegetable concentrates used for seasoning; Vegetable pulps [sauces - food]; Vegetable flour; Vegetable purees [sauces]; Vegetable-based seasonings for pasta; Vegetable pastes [sauces]; Vegetable pies; Vegetable flavoured corn chips; Vegetable thickeners; Vegetable based coffee substitutes; Crisps made of cereals.*

Class 31: *Vegetables Fresh; Vegetable seeds; Vegetables, fresh; Vegetable marrows, fresh.*

Class 32: *Non Alcoholic Drinks; Vegetable juices [beverages]; Vegetable juice; Vegetable juices [beverage]; Vegetable drinks; Vegetable-based beverages; Vegetable smoothies.*

Class 33: *Alcoholic beverages, except beer.*

2. The mark was published for opposition purposes on 28 October 2016. The opposition is based upon Section 5(2)(b) of the Trade Mark Act (“the Act”) with Kettle relying upon its UK trade mark registration number 3091074 for the following mark:

(Series of 3)

roots collective

Roots Collective

ROOTS COLLECTIVE

Filing date: 26 January 2015

Registration date: 17 April 2015

3. Kettle relies on the full list of goods in respect of which the mark is registered, namely:

Class 29: *Vegetables, cooked.*

Class 30: *Prepared meals containing [principally] rice; prepared meals containing [principally] pasta.*

Class 31: *Vegetables, fresh.*


Class 32: *Non-alcoholic drinks.*


Class 33: *Alcoholic beverages, except beer.*

4. The opposition, was originally directed at all the goods applied for, however, following a hearing it was limited to the goods shown in paragraph 28, below.

5. Kettle claims that the applied for mark is confusingly similar to its earlier mark and covers goods that are identical with and/or highly similar to those under the earlier mark, such that there would be a likelihood of confusion.

6. The other part of the consolidated proceedings consists of an application under Section 5(2)(b) and 5(4)(a) of the Act filed by Huntapac on 22 May 2017 to invalidate Kettle's earlier 3091074 mark. This is based on the earlier UK mark 2523426

consisting of the sign  which was filed on 8 August 2009 and registered on 25 December 2009 in respect of carrots in class 31, as well as associated common law

rights in the word Roots and in the sign  which are claimed have been used since January 2007 in relation to vegetables, prepared vegetables, crisps, potato crisps, vegetable crisps.

7. The parties filed counterstatements denying the grounds of opposition and invalidation, respectively, put forward by the other party. I note in particular that:

(i) In the opposition, Huntapac admits that the respective marks are similar and that the respective goods are identical or, at least, similar;

(ii) In the invalidation, Kettle puts Huntapac to proof of use of the earlier mark



(2523426) in relation to carrots and proof of (use and) goodwill in relation to each of the goods for which goodwill is claimed;

(iii) In the invalidation, Kettle denies that the respective marks are similar enough so as to cause confusion and that the use of the registered mark would cause damage to any alleged goodwill in the unregistered rights that Huntapac enjoys. According to Kettle i) the distinctive and dominant component of its registered marks is the word collective; ii) the word Roots in relation to carrots in Huntapac's mark is merely descriptive of the goods which are a root vegetable and ii) the distinctiveness of Huntapac's mark resides in its stylisation;

(iv) In the invalidation, Kettle states that it is not aware of any instance of confusion and requires Huntapac to provide evidence of misrepresentation.

8. Only Huntapac filed evidence. Kettle filed written submissions. These will be summarised to the extent that it is considered appropriate. A hearing took place on 23 February 2018 at which Mr Charles Brabin instructed by CMS Cameron McKenna appeared as counsel for Kettle and Mr Edward Bragiel instructed by Nabarro Olswang LLP appeared as counsel for Huntapac.

The evidence



9. Huntapac's evidence consists of a witness statement by Steven Kay, who is the Director of Huntapac, a UK company based in Preston Lancashire. Mr Kay states that the information contained in his statement is from his own knowledge or from the information contained in the records of Huntapac to which he has full access. He states that Huntapac commenced use of the trade mark Roots and Roots logo in the UK "as early as 2010". He then provides his narrative evidence about the following exhibits:

- HP1: described by Mr Kay as "a table setting out the range of Roots branded products available in the UK and the date from which each product was first used/sold" in the UK, the exhibit lists, in table form, a number of Roots products, a description of the goods and the date of first use. The goods include asparagus, broccoli, carrots (in 3 different packaging weight) cauliflower, lettuce, parsnip, swede, mixed selection and vegetable crisps and the dates range from 2 August 2010 to 29 November 2013;
- HP2: provides what Mr Kay says to be "details of the customers and geographical locations in respect of which Roots branded vegetables and crisps have been sold". The exhibit refers to Roots fresh vegetables having been sold to a wholesaler chain called James Halls & Co Ltd servicing over 600 stores across the north of England, including 28 Booths supermarkets. In relation to Roots vegetable crisps, the exhibit refers to the goods "being sold and distributed in a number of retailers, wholesalers and independent food outlets" and provides a list which includes the same 28 Booths stores previously mentioned as well as another 24 customers most of which appear to be located in the north of England, with only four located in Bristol, Kent, Middlesex and

London. The list also includes one customer based in Ireland and one in Denmark. Mr Kay does not say when the goods were sold;


- HP3: is an excel spreadsheet setting out what Mr Kay describes as “the annual sales data by product under the Roots brand [...] for the period 2010-2017.” Each product is identified by a product code. This includes sales of “Roots fresh produce” and sales of “Roots vegetable crisps”. The spreadsheet also shows that sales of Roots vegetable crisps have grown from 5% of the total sales in 2010 (£2,010) to 51% in 2014 (£41,390) and 58% in 2017 (£131,122), outstripping those of “Roots Fresh Produce”. The total value of the sales for the period 2010-2017 is £913,944, of which £440,471 are sales of “Roots vegetable crisps” and £457,364 are sales of “Roots Fresh Produce”. Most of the sales of “Roots Fresh Produce” are sale of asparagus (£283,698) and carrots (£167,754) together totalling to £451,452 with the total sale of broccoli, cauliflower, lettuce, parsnip and swede amounting to only £5,912.
- HP4: consists of samples of invoices which Mr Key states relate to “the sale of Roots branded products in the UK”. These include:
 - i. Four invoices for “Roots Crisps”, two dated December 2015 and June 2016 and two dated July and September 2017 (i.e. after the application date). The mark Roots is not identified on the invoices but only on the description of the goods. In this connection, I note that the product codes for these goods correspond to those provided at HP3 for Roots branded vegetable crisps. The invoices are from HUNTAPAC to Booker Ltd in Manchester (x2), E H Booth & Co Ltd in Preston and South Eastern Foods in Kent. The amounts vary from £464.94 to £1,512 with the invoices from 2015 and 2016 amounting to £2,205;
 - ii. Two invoices, dated 13 May 2016 and 29 April 2017 respectively, from HUNTAPAC to E H Booth & Co Ltd in Preston. The invoices, which are for a range of vegetables including carrots, do not feature the mark Roots. I note that with the exception of asparagus and turnips, which are merely described as “asparagus x 16” and “loose turnips 3 Kg” all of the


goods are all described as E H Booth(s), e.g. E.H. Booths 1 Kg Carrots x 16. I also note that the only product code on the invoices that correspond to the ones provided at HP3 for Roots branded products is that relating to asparagus;

- iii. Six invoices dated between June 2010 and May 2012, each of which list a range of vegetables. These are addressed to John Sharrock (Preston) Ltd. With the exception of goods described as “asparagus x 16” and “1 Kg carrots every day”, all the goods are identified as H E Booth(s) or Booths. However, I note that on three invoices¹, dated 7 August 2010, 3 September 2011 and 5 May 2012 respectively, some of the goods sold are identified as “Booth 1 Kg Roots Carr” and that the product code associated to these goods corresponds to that indicated at HP3 for Roots (branded) Carrots 1 Kg, i.e. CAR5126.
- HP5: described by Mr Kay as “copies of Roots branded vegetables and crisps products” the exhibit consists of photocopies of photos of goods presented in packaging displaying the  mark. The copies include an advert displaying vegetables in branded packaging. Although the quality of the copies is very poor, images of broccoli, leeks, carrots, lettuce and cauliflowers can just about be made out. These are placed above a tag which contains the following text: “THE ROOTS RANGE. Fresh Quality every day. The best of British produce. Grown, washed, packed and delivered into store daily by Huntapac”. The exhibit also includes photos of packaging of asparagus, vegetable selection, swede and vegetable crisps displaying the  mark. These are all but one undated. The only page which carries a date is a copy reproducing a package of asparagus with a “display until” date of 26 April 2014;
 - HP6: consists of copies of advertisements (in the form of articles) placed on online local press publications, including Marketing Lancashire, Town Talk (Blackpool), Lancashire Business View and Lancashire Evening Post. The

¹ One is a duplicate

copies which are all dated 2014, relate to Roots branded crisps and show packs

of crisps featuring the mark  ;

- HP7: are two undated copies of the back of a truck which features prominently the mark  . On the right hand side of the truck there is a picture of carrots, arranged vertically; this is visibly prominent. Above the mark are the words “Quality it’s in our” and below it is the website address www.roots.uk.com.
- HP8: described by Mr Kay as “a document taken from the records of Huntapac Produce Limited which lists all of the invoices generated for Roots product sales since 2010-2017 including the United Kingdom sales”, it is a collection of excel spreadsheets printed on 8 November 2017 and detailing sales of vegetable products. The relevant details are not easy to decipher, however, at the hearing Mr Bragiel provided some assistance in interpreting the data. The material record the sales of asparagus (£283,698), Broccoli Roots (£1,155.90), Roots Carrots 750g (£850.99), Roots 500g Carrots (£216), Roots 1Kg Carrots (£166,643.65), Cauliflower Roots (£1,281.84), Iceberg Lettuce (£1,320.38), Roots Parsnip (£237.25), Roots Swede (£150.48) and Roots Veg Selection (£1,766.16). Whilst there are slight variations, I note that these figures correspond to those provided at HP3. Each sale making up the totals is recorded. The sales are dated between 2010 and 2017. The copies also show the delivery address (of the purchaser), however, this is in the form of six digits letter and number codes so it is impossible to establish where the goods were despatched. At the hearing Mr Bragiel attempted to provide some clarification asserting that SHA stands for Sharrock and HAL for James Hall and pointing out that some of the invoices exhibited at HP4 are to John Sharrock. He also asserted that the list provided at HP8 is made up of mostly UK sales although he did not point out which transactions were not UK sales. Whilst I consider that Mr Bragiel’s submission about the sales being mostly UK sale is not admissible as evidence of fact, his clarification was useful in that it led me to cross-reference the delivery addresses listed at HP8 with the invoices exhibited at HP4, the latter indicating customer A/C numbers that correspond to some of

the delivery address codes listed at HP8. Having gone through that exercise, I found that the totality of the sales of asparagus and Roots 1Kg Carrots listed at HP8 were made to two retailers, namely that identified by the code BRL001, which stands for E H BOOTH & CO LTD with an address in Preston, and that identified by the code SHA004, which stands for John Sharrok (Preston) Ltd with an address in Preston. The sales of the other products listed at HP8, were all made to a retailer (HAL001) whose delivery address does not match any of the retailers identified in the invoices exhibited at HP4.

DECISION

Huntapac's application to invalidate Kettle's trade mark 3091074

10. The relevant Section regarding invalidity states:

“47. - (1) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 3 or any of the provisions referred to in that section (absolute grounds for refusal of registration).

Where the trade mark was registered in breach of subsection (1)(b), (c) or (d) of that section, it shall not be declared invalid if, in consequence of the use which has been made of it, it has after registration acquired a distinctive character in relation to the goods or services for which it is registered.

(2) The registration of a trade mark may be declared invalid on the ground-

(a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or

(b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

(2A) But the registration of a trade mark may not be declared invalid on the ground that there is an earlier trade mark unless –

(a) the registration procedure for the earlier trade mark was completed within the period of five years ending with the date of the application for the declaration,

(b) the registration procedure for the earlier trade mark was not completed before that date, or

(c) the use conditions are met.

(2B) The use conditions are met if –

(a) within the period of five years ending with the date of the application for the declaration 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) it has not been so used, but there are proper reasons for non-use.

(2C) 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.

(2D) In relation to a European Union trade mark or international trade mark (EC), any reference in subsection (2B) or (2C) to the United Kingdom shall be construed as a reference to the European Union.

(2E) 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.

(2F) Subsection (2A) does not apply where the earlier trade mark is a trade mark within section 6(1)(c)

(3) An application for a declaration of invalidity may be made by any person, and may be made either to the registrar or to the court, except that-

(a) if proceedings concerning the trade mark in question are pending in the court, the application must be made to the court; and

(b) if in any other case the application is made to the registrar, he may at any stage of the proceedings refer the application to the court.

(4) In the case of bad faith in the registration of a trade mark, the registrar himself may apply to the court for a declaration of the invalidity of the registration.

(5) Where the grounds of invalidity exists in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made.

Provided that this shall not affect transactions past and closed.”

The ground of invalidation based on Section 5(2)(b) of the Act

11. The first ground of invalidity is under Section 5(2)(b) of the Act, which reads 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,

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

12. An earlier trade mark is defined in Section 6 of the Act, 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 or international trade mark (EC) 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.

....

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

13. Huntapac relies upon its UK trade mark no. 2523426, which it states has been used in relation to the goods for which it is registered, i.e. carrots in class 31. Huntapac’s registration qualifies as an earlier mark under the above provisions. In its counterstatement Kettle puts Huntapac to proof that it has used the trade mark upon which it relies. In view of Kettle’s request, and as Huntapac’s application for invalidation was filed on 22 May 2017, and its earlier trade mark completed its registration procedure on 25 December 2009, it is necessary, as per section 47(2)(B) above, for Huntapac to show genuine use of the mark in relation to the goods upon which it relies. The relevant period to prove use ends at the date of the application for invalidity, i.e. 23 May 2012 to 22 May 2017.

Genuine Use

14. In *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*, [2016] EWHC 52, Arnold J. summarised the case law on genuine use of trade marks. He said:

“217. *The law with respect to genuine use* . In *Stichting BDO v BDO Unibank Inc* [2013] EWHC 418 (Ch), [2013] FSR 35 I set out at [51] a helpful summary by Anna Carboni sitting as the Appointed Person in *SANT AMBROEUS Trade Mark* [2010] RPC 28 at [42] of the jurisprudence of the CJEU in Case C-40/01

Ansul BV v Ajax Brandbeveiliging BV [2003] ECR I-2439 , Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159 and Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759 (to which I added references to Case C-416/04 *P Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237). I also referred at [52] to the judgment of the CJEU in Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16 on the question of the territorial extent of the use. Since then the CJEU has issued a reasoned Order in Case C-141/13 *P Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and that Order has been persuasively analysed by Professor Ruth Annand sitting as the Appointed Person in *SdS InvestCorp AG v Memory Opticians Ltd* (O/528/15).

218. An important preliminary point to which Prof Annand draws attention in her decision is that, whereas the English versions of Articles 10(1) and 12(1) of the Directive and Articles 15(1) and 51(1)(a) of the Regulation use the word “genuine”, other language versions use words which convey a somewhat different connotation: for example, “ernsthaft” (German), “efectivo” (Spanish), “sérieux” (French), “effettivo” (Italian), “normaal” (Dutch) and “sério/séria” (Portuguese). As the Court of Justice noted in *Ansul* at [35], there is a similar difference in language in what is now recital (9) of the Directive.

219. I would now summarise the principles for the assessment of whether there has been genuine use of a trade mark established by the case law of the Court of Justice, which also includes Case C-442/07 *Verein Radetsky-Order v Bunderversammlung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223 and Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR 7, as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use:

Ansul at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

15. In *Awareness Limited v Plymouth City Council*, Case BL O/236/13, Mr Daniel Alexander Q.C. as the Appointed Person stated that:

“22. The burden lies on the registered proprietor to prove use [...] However, it is not strictly necessary to exhibit any particular kind of documentation, but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public.”

and further at paragraph 28:

“28. I can understand the rationale for the evidence being as it was but suggest that, for the future, if a broad class, such as “tuition services”, is sought to be defended on the basis of narrow use within the category (such as for classes of a particular kind) the evidence should not state that the mark has been used in relation to “tuition services” even by compendious reference to the trade mark specification. The evidence should make it clear, with precision, what specific use there has been and explain why, if the use has only been narrow, why a broader category is nonetheless appropriate for the specification. Broad statements purporting to verify use over a wide range by reference to the wording of a trade mark specification when supportable only in respect of a much narrower range should be critically considered in any draft evidence proposed to be submitted.”

16. In *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*, Case BL 0/404/13, Mr Geoffrey Hobbs Q.C. as the Appointed Person stated that:

“21. The assessment of a witness statement for probative value necessarily focuses upon its sufficiency for the purpose of satisfying the decision taker with regard to whatever it is that falls to be determined, on the balance of probabilities, in the particular context of the case at hand. As Mann J. observed in *Matsushita Electric Industrial Co. v. Comptroller- General of Patents* [2008] EWHC 2071 (Pat); [2008] R.P.C. 35:

[24] As I have said, the act of being satisfied is a matter of judgment. Forming a judgment requires the weighing of evidence and other factors. The evidence required in any particular case where satisfaction is required depends on the nature of the inquiry and the nature and purpose of the decision which is to be made. For example, where a tribunal has to be satisfied as to the age of a person, it may sometimes be sufficient for that person to assert in a form or otherwise what his or her age is, or what their date of birth is; in others, more formal proof in the form of, for example, a birth certificate will be required. It all depends

who is asking the question, why they are asking the question, and what is going to be done with the answer when it is given. There can be no universal rule as to what level of evidence has to be provided in order to satisfy a decision-making body about that of which that body has to be satisfied.

22. When it comes to proof of use for the purpose of determining the extent (if any) to which the protection conferred by registration of a trade mark can legitimately be maintained, the decision taker must form a view as to what the evidence does and just as importantly what it does not ‘show’ (per Section 100 of the Act) with regard to the actuality of use in relation to goods or services covered by the registration. The evidence in question can properly be assessed for sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use.”

17. At the hearing Mr Brabin, on behalf of Kettle, argued that Huntapac’s evidence was not enough to show genuine use of the mark in relation to carrots. His main proposition was that each exhibit had significant failings and that the Tribunal should not be filling the gaps and making assumption in favour of Huntapac. According to Mr Brabin, taken at its best, Huntapac’s evidence shows a small scale, geographically limited, goodwill in relation to vegetable crisps. He also stated that without supporting evidence, the assertions in Mr Kay’s witness statement cannot be accepted. In this connection, he pointed out that there is a strong inference that some of the invoices exhibited at HP4 identify the sales of E H BOOTH branded vegetables, which contradicts Mr Kay’s statement that HP4 relates to the sale of Roots branded products. According to Mr Brabin, the approach to the evidence should be that “where there is no Roots branding it is not Roots branding”. He also relied, in his skeleton arguments, on the finding of the hearing officer in his decision BL O-428/17, where he decided the same point against Huntapac, finding that it had not shown genuine use of the mark 2523426 in respect of the registered goods during the relevant period. However, whilst some of the invoices filed in those proceedings may have been the same as those exhibited at HP4, I have to decide the issue of use on the totality of the evidence I have in front of me which, I note, is not the same as that filed in BL O-428/17.


18. Mr Bragiel's submission was that the evidence, taken cumulatively, makes sense and is sufficient to satisfy the requirement of genuine use. For the sake of completeness, I should say that, in response to Mr Brabin's criticisms, Mr Bragiel said that Huntapac did not seek to rely on exhibit HP4. However, he later referred me to HP4 when cross-referring the delivery address codes at HP8 with the names of the retailers to whom the goods were sold, i.e. John Sharrock.

19. Whilst Huntapac's evidence could have been more focused, I agree with Mr Bragiel that, taken cumulatively, it shows that Huntapac sold at least £166K worth of "Roots 1Kg Carrots" to two UK retailers based in Preston between 2010 and 2014 (HP8). Having gone through the process of trying to identify how much of that total relates to sales made during the relevant period, i.e. 23 May 2012 to 22 May 2017, I found it useful to refer back to the table provided at HP3. This shows the annual sale of "Roots 1Kg Carrots" over the period 2010-2017. These were £56,819 in 2012, £22,764 in 2013 and £653 in 2014 for a total of about £80,236². The best point that was argued by Mr Brabin is that the description of the goods on some of the invoices exhibited at HP4 seems to refer to a third party brand, i.e. E H BOOTH, which would undermine Mr Kay's evidence that all the invoices refer to the sale of Roots branded products. However, I note that the product code associated to "Roots carrots 1Kg", i.e. CAR5126, in HP3 corresponds to that specified for the same goods at HP8; the same code also features on three invoices exhibited at HP4 in connection with goods sold to John Sharrock (Preston) Ltd and described as "Booths 1 Kg Roots Carr"; this would, in my view, suggest that the sales evidenced by these invoices were actually sales of Roots branded carrots (as identified by the product code). Consequently, in the absence of conflicting evidence or cross-examination,³ I agree with Mr Bragiel that it would not be right to disregard the evidence filed on the base of the alleged conflict in Mr Kay's statement. In relation to the rest of the evidence, Mr Brabin did not challenge the evidence relating to goods identified as Roots branded. He also accepted that there is no suggestion that the pictures reproducing Roots branded vegetables displaying the registered mark were made up. I have no reason to doubt the figures provided by Mr Kay which clearly refers to the sale of Roots branded carrots and/or the evidence showing a Roots branded truck reproducing the registered mark together

² No sale are recorded at HP3 in the period 2015-2017

³ See BL 371/09, paragraph 78-80

with images of carrots. Whilst Mr Brabin is right in saying that the latter is not actually use in relation to carrots, i.e. the mark is not affixed to carrots offered for sale, it seems to me very likely that this truck was used at some point to transport Huntapac's Roots branded vegetables, including carrots. Though I do not consider this to be material in establishing use of the mark within the relevant period, it does, nevertheless, corroborate the rest of the evidence that Huntapac had developed a business under the mark in carrots. There is nothing inherently incredible about Mr Kay's evidence and whilst I accept that, taken in isolation, none of the exhibit is determinative, they together build a clear picture which shows a non-insignificant trade under the mark in carrots. As far as the mark being used is concerned, the evidence indicates carrots

sold under the 'Roots' brand and there are various examples of the mark  used throughout the product range, including carrots. Accordingly, I find that the sale of £80,236 worth of carrots to two different retailers (or wholesalers) based in Preston in the period 2012-2014 is enough to demonstrate genuine use of the mark no. 2523426 in the UK for carrots in class 31 during the relevant period. Consequently, Huntapac can rely upon these goods for the purpose of its application for invalidation of Kettle's mark no. 3091074.

Section 5(2)(b) - case-law

20. 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:

- (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 greater 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

21. 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:

“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”.

22. 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 uses of the respective goods or services;
- b) The respective users of the respective goods or services;
- c) The physical nature of the goods or acts of services;
- d) The respective trade channels through which the goods or services reach the market;
- e) In the case of self serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;

- f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

23. I also bear in mind the decision in *Boston Scientific Ltd v OHIM*, Case T-325/06, where the General Court (GC) stated that “complementary” means:

“...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”.

24. In *Avnet Incorporated v Isoact Limited*, [1998] F.S.R. 16, Jacob J. (as he then was) stated that:

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

25. In *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

“... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language

unnaturally so as to produce a narrow meaning which does not cover the goods in question."

26. In *Gérard Meric v OHIM*, Case T- 133/05, the GC stated:

"29. 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".

27. The competing services are as follows:

Kettle's specification	Huntapac's specification
<p>Class 29: Vegetables, cooked.</p> <p>Class 30: Prepared meals containing [principally] rice; prepared meals containing [principally] pasta.</p> <p>Class 31: Vegetables, fresh.</p> <p>Class 32: Non-alcoholic drinks.</p> <p>Class 33: Alcoholic beverages, except beer</p>	<p>Class 31: Carrots</p>

Class 29

28. Kettle's *vegetables cooked* include cooked carrots in the form, of example, of tinned carrots. The nature and purpose of the goods is highly similar, the users are the same and there is a degree of competition as the consumer could either buy fresh carrots and cook them at home or buy ready-made canned carrots. The goods are similar to a high degree. In relation to Kettle's *vegetables, cooked* other than carrots, I find that these goods are similar to a medium degree to Huntapac's carrots in class 31 since the goods have a similar nature, target the same users, share the same trade

channels and are complementary in the sense that customers may think that the responsibility for those goods lies with the same undertaking.

Class 30

29. Whilst Huntapac's *carrots* could be a component of Kettle's *prepared meals containing [principally] rice; prepared meals containing [principally] pasta*, the nature and purpose of the respective goods are different, one being a fresh uncooked vegetable and the other one a highly processed pasta or rice-based ready meal. The users and uses are different, the goods are not competitive and there is no complementarity. Finally, even if both set of goods may be found in supermarkets, they are not likely to be found in close proximity. There is no similarity here.

Class 31

30. Huntapac's *carrots* in class 31 are encompassed by the term *vegetables, fresh* in the same class in Kettle's specification. These goods are identical on the *Meric* principle.

Class 32

31. At the hearing Mr Bragiel argued that Huntapac's *carrots* are similar to Kettle's *non-alcoholic drinks* because the latter term would include carrot juice and smoothies. The physical nature and method of use of the goods is different, one being a fresh vegetable the other one a drink, trade channels are different and the goods are unlikely to be found in supermarkets in close proximity. However, I accept that Kettle's *non-alcoholic drinks* encompass carrot juice and carrots are by definition the main ingredient of carrot juice so consumers could purchase fresh carrots for the purpose of making carrot juice. Consequently, the goods are competitive to a certain degree and can target the same consumers. To the extent that Kettle's *non-alcoholic drinks* include carrot juice there is a low degree of similarity with Huntapac's *carrots*. As to the similarity between *carrots* and *smoothies*, as a sub-set of *non-alcoholic drinks*, there is not such a relationship since smoothies' recipes normally contain a variety of

fruits, as well as other ingredients, e.g. milk, yogurt or ice cream. The goods are neither complementary nor in competition and the distribution channels do not coincide.

Class 33

32. Finally there is no obvious similarity between Kettle's *alcoholic beverages, except beer* and Huntapac's *carrots*. The users, uses, nature, purpose of the goods and trade channels are different, the goods are not in competition and there is no complementarity. Mr Bragiel's argument in this connection was that "*alcoholic beverages can be made from vegetable (e.g. potatoes)*". I agree with Mr Brabin's general submission on the point that the fact that vodka is made from potatoes does not make the goods similar from trade mark perspective but, in any event the comparison is here between *alcoholic beverages, except beer* and *carrots* and as far as I am aware, there are not *alcoholic beverages* made from carrots. There is no similarity here.

33. At the hearing Mr Brabin argued that any similarity between the parties' class 31 registrations is limited to a subset of Kettle's 31 specification, namely what he identified as "whole fresh vegetables" which, he explained, would include carrots and potatoes. In this connection, he drew a distinction between whole fresh vegetables (which, he accepted, are similar to Huntapac's carrots) and a much broader category of fresh vegetables which, he explained, would extend to, for example, spinach, kales, salad and stir fry, and would be classed as "prepared vegetables". According to Mr Brabin because of the way "prepared vegetables" are prepared, i.e. vegetables are copped up, washed, prepared and packaged, different trade channels are involved and there is no similarity with Huntapac's carrots. In this connection, he submitted that any similarity with Huntapac's carrots is limited to "whole fresh vegetables" and raised the possibility of narrowing Kettle's specification as a fallback position to exclude "whole fresh vegetables".

34. I do not accept Mr Brabin's submission that the express exclusion in Kettle's specification of "whole fresh vegetables" would avoid an overlap of the specifications. Adopting Mr Brabin's approach, there would be no similarity between, for example, fresh loose carrots and prepared carrot batons, i.e. fresh carrots which have been

peeled and chopped. All the vegetable goods within class 31 are fresh vegetables and it does not seem to me that the distinction drawn by Mr Brabin between carrots and potatoes being “whole fresh vegetables” and “prepared vegetables” being goods that have been washed and chopped can be drawn in the way suggested by Mr Brabin. Consequently, I find that that Huntapac’s *carrots* are similar to medium degree to Kettle’s *vegetables, fresh* other than carrots, which I have already held identical. The goods have the same nature and providers, target the same users, share the same trade channels, are likely to be found in close proximity in the same sections of supermarkets/shops and are clearly complementary.

35. In *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, Lady Justice Arden stated that:

“49..... I do not find any threshold condition in the jurisprudence of the Court of Justice cited to us. Moreover I consider that no useful purpose is served by holding that there is some minimum threshold level of similarity that has to be shown. If there is no similarity at all, there is no likelihood of confusion to be considered. If there is some similarity, then the likelihood of confusion has to be considered but it is unnecessary to interpose a need to find a minimum level of similarity.”

36. Accordingly, for a claim under Section 5(2)(b) to succeed, there must be at least a degree of similarity of goods. Having concluded that there is no meaningful similarity between Huntapac’s goods and Kettle’s:

Class 30: *Prepared meals containing [principally] rice; prepared meals containing [principally] pasta.*

Class 33: *Alcoholic beverages, except beer.*

37. I conclude that there is no likelihood of confusion and the application for invalidation in relation to these goods under Section 5(2)(b) fails accordingly.

Average consumer

38. 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 and services in question: *Lloyd Schuhfabrik Meyer, Case C-342/97*. 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 in these terms:

“60. 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.”

39. The goods are everyday food and beverages products. The average consumer is the general public but along the way both parties' products are likely to be handled through wholesalers or intermediaries. Such items will be sold in a variety of outlets and online. Consequently, the selection process is likely to be by eye and it is the visual aspect of the competing marks that will dominate it, although aural considerations must not be overlooked. Even if the goods are relatively inexpensive and frequently purchased, to my mind the average consumer will pay a normal degree of attention when selecting them, in order to choose the correct product and quantity and ensure that the goods are within the “best before” or “use by” date.


Comparison of marks

40. 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 CJEU 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.”

41. It would be wrong, therefore, artificially to dissect the 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 marks are shown below:

Kettle’s mark (3091074)	Huntapac’s mark (2523426)
(Series of 3) roots collective Roots Collective ROOTS COLLECTIVE	

42. Mr Bragiel’s position at the hearing was that Kettle does not dispute the similarity of the marks. The concession means that I accept the marks are similar for the purpose of assessing the likelihood of confusion under Section 5(2)(b). However, I will still need to carry out my own assessment to determine the overall impression the marks convey and their level of similarity.

43. Kettle’s registration consists of a series of 3 marks each consisting of the words roots collective/Roots Collective/ROOTS COLLECTIVE presented in lower case, title case and upper case respectively. Mr Bragiel’s stated in the consolidated opposition

proceedings that the word 'roots' is the dominant and distinctive element of its mark and that the word collective is non-distinctive. As he quite rightly did not try to adopt a different approach to the comparison of marks in the invalidation proceedings, I will proceed on the basis that this is Kettle's approach to the comparison of marks in both proceedings. Huntapac's mark consists of the word Roots presented in a stylised handwritten typeface. The tail of the R is meant to be a stylised carrot, however, this is not immediately noticeable. Though the stylisation is not negligible the dominant and distinctive element of the mark is the word Roots.

44. In term of similarity of the marks, I have already said that Kettle accepts that the marks are similar. Whilst the stylisation of Huntapac's mark introduces a visual difference, it is not remarkable. Likewise, given the non-distinctive nature of the word 'collective' in Kettle's mark, any visual, aural and conceptual difference it introduces is likely to have little impact on the perception of the average consumer. I find that the mark are visually similar to a medium degree. Aurally, the marks are also similar to a medium degree. This is because 'roots' is the first element in Kettle's mark and, although shorter than 'collective', will therefore make at least as much aural impression as the longer word. In term of concept, the word 'collective' does not add much and is likely to be perceived as somehow referring to the company providing the goods. The word 'roots' means the part of the plant that goes in the ground or the basic cause or origin of something. The word will convey much the same meaning in both marks. Accordingly, I find that the marks are conceptually similar to a high degree.

Distinctive character of the earlier mark

45. 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)."

46. Whilst I found that Huntapac's evidence is enough to show genuine use of the mark 2523426 in relation to carrots, the use shown is modest in scale and does not serve to establish an enhanced degree of distinctive character.

47. At the hearing Mr Brabin submitted that Huntapac's earlier mark has a very low degree of distinctiveness in relation to the registered goods, because carrots are root vegetables. Collins online dictionary contain the following definition:

Root vegetable:

1. the fleshy enlarged root of a plant used as a vegetable, e.g. a carrot, swede, or beetroot

Roots:

1. the part of a plant which attaches it to the ground or to a support, typically underground, conveying water and nourishment to the rest of the plant via numerous branches and fibres.
2. the basic cause, source, or origin of something.

48. The word Roots in the plural form is not, to the best of my knowledge, an accepted abbreviation for, or way of describing, root vegetable(s) so it is not, strictly speaking, descriptive in relation to carrots. Further, it has a double meaning as it also means, in a metaphoric way, origin, source, so it has a degree of distinctiveness in relation to carrots. Having said that, it falls well short of being a particularly distinctive mark. Whilst the stylisation adds some distinctiveness to the mark it is the distinctive character of the common element that matters. In my view, the mark does not command any more than a modest degree of distinctive character.

Likelihood of confusion

49. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective marks may be offset by a greater degree of similarity between the respective goods and vice versa. 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 marks and must instead rely upon the imperfect picture of them he has retained in his mind.

50. There are two types of relevant confusion to consider: direct confusion (where one mark is mistaken for the other) and indirect confusion (where the respective similarities lead the consumer to believe that the respective goods come from the same or a related trade source). In *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10 Mr Iain Purvis Q.C. sitting 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.

51. Earlier in my decision I found that the goods involved are similar to various degrees. The marks are visually and aurally similar to a medium degree, and conceptually similar to a high degree. The selection of the goods is likely to be visual with a normal degree of attention being paid. Notwithstanding my finding that ‘roots’ has only a modest degree of distinctiveness for carrots, given that the dominant and most distinctive element in both marks is the word Roots, and that the differences between the marks are created by the non-distinctive element ‘collective’ in Kettle’s registration, and by the modest stylisation of the word ‘Roots’ in Huntapac’s mark, I consider that there is a likelihood of direct confusion through imperfect recollection in relation to Kettle’s carrots (covered by Kettle’s specification in class 31) and prepared carrots (covered by Kettle’s specification in class 29). In relation to the remaining goods, namely i) *vegetables, fresh* (in class 31) and *vegetables, cooked* (in class 29) other than carrots and ii) carrot juice drinks (to the extent that they are covered by Kettle’s *non-alcoholic drinks* in class 32) even were the goods involved are similar only to a low degree, on encountering Kettle’s mark the average consumer is likely to believe that he is seeing a mark from the same stable or from an undertaking linked to Huntapac. **There is a likelihood of both direct and indirect confusion.**

52. The ground of invalidity based upon Section 5(2)(b) succeeds in full relation to:

Class 29: *Vegetables, cooked.*

Class 31: *Vegetables, fresh.*

53. And fails in relation to:

Class 30: *Prepared meals containing [principally] rice; prepared meals containing [principally] pasta.*

Class 33: *Alcoholic beverages, except beer*

54. Finally, I have not lost sight of the fact that the similarity between Kettle's *non-alcoholic drinks* in class 32 and Huntapac's *carrots* in class 31 is limited to carrot juice drinks. The issue of partial refusal is dealt in TPN 1/2012. That TPN includes the following:

"In a case where amendment to the specification(s) of goods and/or services is required as the result of the outcome of contested proceedings the Hearing Officer will, where appropriate, adopt one or a combination of the following approaches:

a) Where the proceedings should only succeed in part, or where the proceedings are directed against only some of the goods/services covered by the trade mark and the result can be easily reflected through the simple deletion of the offending descriptions of goods/services, the Hearing Officer will take a "blue pencil" approach to remove the offending descriptions of goods/services. This will not require the filing of a Form TM21 on the part of the owner. If, however, any rewording of the specification is proposed by the owner in order to overcome the objection, then the decision of the Hearing Officer will take that rewording into account subject to it being sanctioned by the Registrar as acceptable from a classification perspective;

b) Where the result cannot be easily reflected through simple deletion, but the Hearing Officer can clearly reflect the result by adding a "save for" type exclusion to the existing descriptions of goods/services, he or she will do so. This will not require the filing of a Form TM21 on the part of the owner. If, however, any rewording of the specification is proposed by the owner in order to overcome the objection, then the decision of the Hearing Officer will take that rewording into account subject to it being sanctioned by the Registrar as acceptable from a classification perspective." (my emphasis)

55. In those circumstances, the text I have highlighted above seems apposite and points towards limiting Kettle's specification in class 32 as follows:

Class 32: *Non-alcoholic drinks, except carrot juice drinks*

The grounds for invalidation based on Section 5(4)(a)

56. Huntapac has raised other grounds under Section 5(4)(a). Its claim under Section 5(4)(a) would be in respect of the goodwill arising from its business in vegetables, prepared vegetables, crisps, potato crisps, vegetable crisps. Even accepting that the evidence establishes the necessary goodwill I do not consider that it would offer Huntapac any greater success than it has already achieved under Section 5(2)(b). I do not consider that crisps are closer to Kettle's goods than carrots. In particular, I do not consider that crisps are any closer to Kettle's rice and pasta based prepared meals. If anything they are further apart. Consequently, a moderate goodwill in crisps would not result in a misrepresentation sufficient to invoke Section 5(4)(a) in relation to any of the goods for which I found that there is no likelihood of confusion under Section 5(2)(b). I do not, therefore, propose to give further consideration to this ground.

INVALIDATION OUTCOME

57. The invalidity action has succeeded in part and so the goods in paragraph 52 above will be removed from the Register and regarded as never having been part of the registered specification. However, the mark will remain on the register for the goods listed in paragraphs 53 and 55 above.

Kettle's opposition to Huntapac's application 3190415

58. I now turn to consider the opposition filed by Kettle in respect of the application no. 3190415 made by Huntapac. The sole ground of opposition is under section 5(2)(b). In terms of marks, Huntapac's application is almost identical to its earlier mark 2523426. The only difference is the presence of a ® symbol, indicating trade mark registration and the use of the colour brown. Since I do not consider either of these differences to be material, the aspects of the global comparison already undertaken in the invalidation proceedings in relation to the similarity of the marks carry forward to this opposition.

59. However, in terms of goods, the specification in Huntapac’s application is much broader than the one in its earlier registration, so I must compare the respective specification. Kettle’s earlier mark survives for:

Class 30: *Prepared meals containing [principally] rice; prepared meals containing [principally] pasta.*

Class 32: *Non-alcoholic drinks, except carrot juice drinks.*

Class 33: *Alcoholic beverages, except beer.*

60. Kettle’s opposition is limited to the goods highlighted in bold. Further, in its submissions, Kettle specifies the limit of the opposition with the wording to “*the extent that*” which are reproduced in brackets and in italic:

Huntapac’s goods	Kettle’s goods
<p>Class 29: Vegetables Cooked; Vegetable fats for cooking; Vegetables, tinned [canned (Am.)] [to the extent these comprise cooked vegetables]; Vegetable preserves [to the extent these comprise cooked vegetables]; Vegetables, preserved[to the extent these comprise cooked vegetables]; Vegetable stock; Vegetable soup preparations; Vegetable mousses; Vegetable juices for cooking; Vegetable jellies; Vegetable-based meat substitutes; Vegetable-based snack foods; Vegetable-based entrees; Vegetable-based spreads; Vegetable fats for food; Vegetables preserved in oil [to the extent these comprise cooked vegetables]; Vegetable puree; Vegetable purees;</p>	<p>Class 30: Prepared meals containing [principally] rice; prepared meals containing [principally] pasta.</p> <p>Class 32: Non-alcoholic drinks, except carrot juice.</p> <p>Class 33: Alcoholic beverages, except beer</p>

Vegetable marrow paste; Vegetable powders; Vegetable chips; Vegetable spreads; Vegetable burgers; Vegetable pastes; Vegetable oils for food; Crisps; Crisps (Potato -).

Class 30: Prepared Meals; Vegetable concentrates used for seasoning; **Vegetable pulps [sauces - food] [to the extent these comprise prepared meals containing [principally] rice or pasta];** Vegetable flour; **Vegetable purees [sauces] [to the extent these comprise prepared meals containing [principally] rice or pasta];**Vegetable-based seasonings for pasta; **Vegetable pastes [sauces] [to the extent these comprise prepared meals containing [principally] rice or pasta];** **Vegetable pies;** Vegetable flavoured corn chips; Vegetable thickeners; Vegetable based coffee substitutes; Crisps made of cereals.

Class 31: Vegetables Fresh; Vegetable seeds; **Vegetables, fresh; Vegetable marrows, fresh.**

Class 32: Non Alcoholic Drinks; **Vegetable juices [beverages];** **Vegetable juice; Vegetable juices [beverage];** **Vegetable drinks;**

Vegetable-based beverages; Vegetable smoothies.	
Class 33: Alcoholic beverages, except beer.	

Class 29

61. Huntapac's *vegetables cooked* would cover vegetables that have undergone treatment to stop or slow down their spoilage, loss of quality, edibility or nutritional value. The goods include canned and frozen vegetables as well as items that have been cooked and are sold in a ready to eat state (cooked beetroot for instance). Such goods do not include prepared meals based on vegetables and are not normally considered to constitute meals in their own right. As such they seem to me to differ in their nature and uses to prepared meals, would not be in competition and would not be found in close proximity in supermarkets. Whilst a tin of carrots might be bought to accompany another dish and whilst the manufacture of *prepared meals containing [principally] rice; prepared meals containing [principally] pasta* may use vegetables in their recipes, this does not, in my view, make the goods similar as it does not create a complementary relationship in the sense required by the case-law. There is no similarity here.

62. The same consideration apply to *vegetables, tinned; vegetable preserves; vegetables, preserved* and *vegetables preserved in oil*. There is no similarity.

63. *Vegetable soup preparations*. Whilst the point has not been argued, it might be said that a soup may be consumed as a meal. As such the goods could be an alternative to Kettle's *prepared meals containing [principally] rice; prepared meals containing [principally] pasta*. Though the nature of the goods is different, the purpose, users and uses could be the same, goods could be in competition and may be found in close proximity in sections of shops/supermarkets. There is a low to medium degree of similarity.

Class 30

64. Huntapac's *prepared meals* encompass Kettle's *prepared meals containing [principally] rice; prepared meals containing [principally] pasta*. The goods are identical on the principle outlined in Meric.

65. Huntapac's *vegetable pulps [sauces - food], vegetable purees [sauces] and vegetable pastes [sauces]* are all ready-made sources made from vegetables. They are attacked by Kettle to the extent that they *comprise prepared meals containing [principally] rice or pasta*. However, the goods would only comprise sources used to make pasta or rice dishes, e.g. tomato sauce, pesto, and would not include *prepared meals containing [principally] rice or pasta*. The opposition against these goods must therefore fail to the extent that the conflict identified by Kettle is not reflected in the specification.

66. *Vegetable pies* include ready-made baked dishes made with vegetables. Similarly to what I found in relation to Huntapac's *vegetable soup preparations, vegetable pies* might be consumed as a meal so the goods may target the same users, be in competition with each other's and be found in close proximity in sections of shops/supermarkets. In my view the goods are similar to a low to medium degree.

Class 31

67. Earlier in my decision I found that Huntapac's carrots were similar to a low degree to Kettle's *non-alcoholic drinks* to the extent that the latter include carrot juice. Here I have now to compare Kettle's *non-alcoholic drinks, except carrot juice* with Huntapac's *vegetables fresh; vegetables, fresh and vegetable marrows, fresh*. As it is apparent from my finding below, Kettle's registration is broad enough to cover vegetable juices and drinks. However, from my experience, juices and drinks whose main ingredient is a vegetable are limited to carrot juices. More often than not vegetables are mixed with fruit and/or seeds to produce healthy mixed fruit and vegetables drinks. The mere fact that vegetables can be used for making juices does not make the goods competitive and/or complementary and is not sufficient for a finding of similarity. The goods have different nature, purposes and methods of use. They do not share the same

distribution channels and there is no evidence that they usually have the same commercial origin. These goods are not similar.

Class 32

68. Kettle's *non-alcoholic drinks, except carrot juice* encompass Huntapac's *non alcoholic drinks; vegetable juices [beverages]; vegetable juice; vegetable juices [beverage]; vegetable drinks; vegetable-based beverages; vegetable smoothies* in the same class. The goods are identical on the *Meric* principle.

Class 33

69. Both parties' specification include the identical term *alcoholic beverages, except beer*. The goods are self-evidently identical.

70. In terms of average consumer, like in the invalidation proceedings the goods here are everyday food and beverages products. Consequently, my findings at paragraph 39 above carry forward to this opposition. Finally, in term of Kettle's earlier mark, there is no evidence of use so I have only the inherent distinctive character to consider. The words 'roots collective' are not descriptive of Kettle's goods in classes 30, 32 and 33. Again, 'roots' is more dominant and distinctive than 'collective', which appears to refer to a type of undertaking. The mark is in my view possessed of an average degree of distinctive character.

71. Huntapac's opposed application is almost identical to its earlier mark 2523426, which is the earlier mark relied upon in the invalidation proceedings. The earlier mark relied upon by Kettle in the opposition is the same mark attacked by Huntapac in the invalidation proceedings. Like the invalidation proceedings, the grounds of opposition here are based on 5(2)(b). The question I need to answer is essentially the same, i.e. whether there is a likelihood of confusion between the parties' marks. My answer in the invalidation proceedings was that there was, even where the goods involved were similar only to low degree. Here the position is reversed. The only difference is that the earlier mark has an average degree of distinctive character, which is higher than I found Huntapac's mark to have for carrots. This makes the case for a likelihood of

confusion even stronger. The nature of the goods involved in this comparison is also highly similar to the goods I considered in the invalidation proceedings. For similar reason to those outlined at paragraph 51, I find that there is a likelihood of direct confusion were identical or similar goods are involved, i.e. *Prepared Meals* (in class 30), *Non Alcoholic Drinks; Vegetable juices [beverages]; Vegetable juice; Vegetable juices [beverage]; Vegetable drinks; Vegetable-based beverages; Vegetable smoothies* (in class 32) and *Alcoholic beverages, except beer* (in class 33) and a likelihood of indirect confusion where the goods are similar to a lower degree, i.e. *Vegetable soup preparations* (in class 29) and *Vegetable pies* (in class 30). The opposition therefore succeeds in relation to:

Class 29: *Vegetable soup preparations;*

Class 30: *Prepared Meals; Vegetable pies*

Class 32: *Non Alcoholic Drinks; Vegetable juices [beverages]; Vegetable juice; Vegetable juices [beverage]; Vegetable drinks; Vegetable-based beverages; Vegetable smoothies.*

Class 33: *Alcoholic beverages, except beer.*

72. And fails in relation to:

Class 29: *Vegetables Cooked; Vegetables, tinned [canned (Am.)] [to the extent these comprise cooked vegetables]; Vegetable preserves [to the extent these comprise cooked vegetables]; Vegetables, preserved [to the extent these comprise cooked vegetables]; Vegetables preserved in oil [to the extent these comprise cooked vegetables];*

Class 30: *Vegetable pulps [sauces - food] [to the extent these comprise prepared meals containing [principally] rice or pasta]; Vegetable purees [sauces] [to the extent these comprise prepared meals containing [principally] rice or pasta]; Vegetable pastes [sauces] [to the extent these comprise prepared meals containing [principally] rice or pasta];*

Class 31: *Vegetables Fresh; Vegetables, fresh; Vegetable marrows, fresh.*

73. The opposition against the following goods was withdrawn at the hearing so they can proceed to registration:

Class 29: *Vegetable fats for cooking; Vegetable stock; Vegetable mousses; Vegetable juices for cooking; Vegetable jellies; Vegetable-based meat substitutes; Vegetable-based snack foods; Vegetable-based entrees; Vegetable-based spreads; Vegetable fats for food; Vegetable puree; Vegetable purees; Vegetable marrow paste; Vegetable powders; Vegetable chips; Vegetable spreads; Vegetable burgers; Vegetable pastes; Vegetable oils for food; Crisps; Crisps (Potato -).*

Class 30: *Vegetable concentrates used for seasoning; Vegetable flour; Vegetable-based seasonings for pasta; Vegetable flavoured corn chips; Vegetable thickeners; Vegetable based coffee substitutes; Crisps made of cereals.*

Class 31: *Vegetable seeds;*

COSTS

74. Since both sides have achieved a measure of success, each should bear their own costs.

Dated this 2nd day of May 2018

Teresa Perks

For the Registrar

The Comptroller General

