

O/1132/22

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3618905
IN THE NAME OF KRISP NUTRITION LLC
IN RESPECT OF THE TRADE MARK**

CANDO

IN CLASSES 05 & 29

AND

**THE OPPOSITION THERETO UNDER NO. 426480
BY SDP RUNGIS**

Background and pleadings

1. Krisp Nutrition LLC (“the applicant”) applied to register the trade mark registration number 3618905 for the mark CANDO in the UK on 30 March 2021. The application claims priority from US trade mark number 90297792 from 4 November 2020. It was accepted and published in the Trade Marks Journal on 28 May 2021. On 22 November 2021 the applicant added a limitation to its applied for specification of goods which now stands as below:

Class 5: Protein supplements formed and packaged as bars; Protein supplements; Nutritional supplement energy bars; all of the aforementioned products having a low carbohydrate content for use as part of or being compatible with ketogenic diet.

Class 29: Fruit- and nut-based snack bars featuring chocolate ingredients not as a coating; Nut-based snack bars; Nut- and dried fruit- based snack bars; Cacao butter-based snack bars; cocoa butter- based snack bars; Snack bars for a keto diet; Nutbased snack bars for a keto diet; Low carb snack bars; Nutbased low card snack bars; all of the aforementioned products having a low carbohydrate content for use as part of or being compatible with ketogenic diet.

2. SDP RUNGIS (“the opponent”) opposes the trade mark on the basis of section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). This is on the basis of its earlier UK comparable trade mark no. 917302894 for the mark below:



3. The following goods and/or services are relied upon in this opposition:

Class 29: Meat, fish, poultry and game; Meat extracts; Preserved, dried and cooked fruits and vegetables; Jellies, jams, compotes; Eggs; Milk and milk products; Edible oils and fats; Crustaceans, not live; Sardines; Cheese products; Sauerkraut; Caviar; Charcuterie; Salted meats; Gherkins; Mussels, not live; Oysters, not live; Vegetable and fruit salads; Truffles, preserved.

Class 30: Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; Flour and preparations made from cereals, bread, pastry and confectionery, ices; Honey, treacle; Yeast, baking-powder; Salt, mustard; Vinegar, sauces (condiments); Spices; Ice; Sandwiches, pizzas; Pancakes; Biscuits; Cakes; Tarts; Rusks; Confectionery; Chocolate; Cocoa, coffee, chocolate or tea-based beverages; Infusions, not medicinal; Macaroons (pastry); Meat pies; Quiches; Sweetmeats [candy]; Filled chocolates (confectionery); Halvah; Fruit pastes (confectionery); Petits fours (cakes); Pralines.

4. By virtue of its earlier filing date of 06 October 2017, the above mark constitutes an earlier mark in accordance with section 6 of the Act.

5. The opponent argues that the respective goods are highly similar and that the marks are similar, and that as such there exists a likelihood of confusion between the same.

6. The applicant filed a counterstatement denying that the marks are similar but submitting that alternatively that they are similar only to a low degree, and denying that there is any similarity between the goods.

7. Both sides filed evidence in these proceedings. This will not be summarised but has been fully considered and will be referred to where necessary. The opponent filed submissions during the evidence rounds and the applicant filed written submissions in lieu of a hearing, which will not be summarised but will be referred to as and where appropriate during this decision. No hearing was requested and so this decision is taken following a careful perusal of the papers.

8. Both parties are represented in these proceedings. The opponent is represented by Williams Powell. The applicant is represented by Haseltine Lake Kempner LLP.

9. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied upon in these proceedings are derived from an EU Directive. That is why this decision continues to refer to EU trade mark law.

Proof of use

10. The earlier mark holds a registration date of 26 January 2018. As it had not been registered for a period of five years or more at the priority date of the application, it is not yet subject to the proof of use provisions in accordance with section 6A of the Act. The opponent may therefore rely upon all of the pleaded goods within the opposition.

Preliminary issues

11. I note at this stage that a preliminary indication was issued in respect of this opposition. Both parties have made reference to this within submissions. I note particularly that within its final written submissions, the applicant states:

The Applicant welcomes the Examiner's Preliminary Indication dated 16 December 2021, which determined that the Class 5 goods claimed in the Application are different to the goods covered by the Earlier Mark. We submit that nothing in the Opponent's evidence or submissions alters this finding."

12. For clarity, I note here that I am neither bound nor influenced by the preliminary indication issued in respect of this matter, nor does it impose an additional burden on the opponent (or indeed the applicant) to file evidence or submissions in order to 'alter' the preliminary finding that the opposition may be partially successful. Preliminary indications are issued in order to assist the parties in navigating the proceedings, and have no influence on the ultimate outcome of the case. This decision will therefore be made from scratch with reference to the issues and papers before me.

Decision

Section 5(2)(b)

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

14. Section 5A of the Act is as follows:

“5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

15. 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

16. 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”.

17. 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 service;

(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.

18. 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."

19. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the General Court ("GC") stated there is "complementary" where:

"...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".

20. With these factors in mind, the goods for comparison under each of the marks are set out below:

Earlier goods	Contested goods
<p><i>Class 29: Meat, fish, poultry and game; Meat extracts; Preserved, dried and cooked fruits and vegetables; Jellies, jams, compotes; Eggs; Milk and milk products; Edible oils and fats; Crustaceans, not live; Sardines; Cheese products; Sauerkraut; Caviar; Charcuterie; Salted meats; Gherkins; Mussels, not live; Oysters, not live; Vegetable and fruit salads; Truffles, preserved.</i></p> <p><i>Class 30: Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; Flour and preparations made from cereals, bread, pastry and confectionery, ices; Honey, treacle; Yeast, baking-powder; Salt, mustard; Vinegar, sauces (condiments); Spices; Ice; Sandwiches, pizzas; Pancakes; Biscuits; Cakes; Tarts; Rusks; Confectionery; Chocolate; Cocoa, coffee, chocolate or tea-based beverages; Infusions, not medicinal; Macaroons (pastry); Meat pies; Quiches; Sweetmeats [candy]; Filled chocolates (confectionery); Halvah; Fruit pastes (confectionery); Petits fours (cakes); Pralines.</i></p>	<p><i>Class 5: Protein supplements formed and packaged as bars; Protein supplements; Nutritional supplement energy bars; all of the aforementioned products having a low carbohydrate content for use as part of or being compatible with ketogenic diet.</i></p> <p><i>Class 29: Fruit- and nut-based snack bars featuring chocolate ingredients not as a coating; Nut-based snack bars; Nut- and dried fruit- based snack bars; Cacao butter-based snack bars; cocoa butter-based snack bars; Snack bars for a keto diet; Nutbased snack bars for a keto diet; Low carb snack bars; Nutbased low card snack bars; all of the aforementioned products having a low carbohydrate content for use as part of or being compatible with ketogenic diet.</i></p>

21. As previously mentioned, both the opponent and the applicant have filed evidence in these proceedings. Some of this appears to be for the purpose of showing the similarity or dissimilarity of the goods filed. Whilst I do not intend to summarise this in great detail, I will highlight here some of the evidence relating to this aspect of the proceedings.

22. The opponent has filed evidence in the form of a witness statement in the name of Nicola Harrison, of the opponent's representative. The statement introduces four exhibits, namely Exhibit 1 – Exhibit 4. Exhibits 1 & 2 are articles describing what a ketogenic ("keto") diet is and the types of goods that may be eaten on a ketogenic diet. A BBC Food article is provided at Exhibit 2 and describes the diet as below:

The low-carb, high-fat ketogenic diet is promoted online and in the media as a weight-loss tool and seemingly all-round magical healer. Yet it was **first developed in the 1920s** for children with epilepsy.

23. The article provided at Exhibit 1 explains the types of meat, vegetables, dairy and tea and coffee to eat on a Keto diet. I note at this stage that whilst this suggests users, by way of the general public sticking to a keto diet, may purchase these goods alongside those designed for a keto diet as applied for by the applicant, I do not consider this factor alone to be sufficient for a finding of similarity between the goods. Nor do I consider the fact that products targeted at a keto diet may be sold in the same supermarkets or on some of the same websites as other some other groceries as shown at Exhibit 3 and Exhibit 4 in the opponent's evidence to be sufficient alone to find similarity between all of these goods.

24. The applicant has provided its evidence in the form of a witness statement from Michael Conway, a chartered trade mark attorney at the applicant's representative firm. The witness statement introduces 12 Exhibits, namely Exhibit MC1 to Exhibit MC12. At exhibit MC2, Mr Conway provides a definition of 'confectionery' from the Cambridge Online English Dictionary. It defines confectionery as meaning sweets or chocolate. Within its submissions in reply, the opponent has accepted the applicant's definition of 'confectionery' but stated it does not see its relevance to the proceedings. I accept the agreed definition of confectionery and find it will not be identical to the contested goods.

25. Provided at Exhibit MC3 is a screenshot from Sainsbury's supermarket showing the category of confectionery leading to various options of chocolate and sweets. This seems to reiterate the point in the paragraph above. Exhibit MC10 provides images from two online retailers that appear to specialise in selling food for those following a keto diet. The goods shown include those such as chocolates, biscuits, cereal and granola. The websites show the price of the goods in GBP and one includes 'UK' within its URL. Both appear to be aimed at UK consumers. Exhibit MC12 provides screenshots showing search results for the word 'KETO' at four supermarkets, namely Aldi, Waitrose, Tesco and Asda. A webpage provided at Exhibit MC11 shows these supermarkets all rank in the top eleven most popular supermarkets in 2022 according to a YouGov list. The search for KETO at Exhibit MC12 brings up no results at Aldi, one book at Waitrose, two 'keto' Slimfast shakes at Tesco, and the both the book and the Slimfast shakes at Asda.

26. With the evidence filed in mind, I will now continue with the comparison of the goods and services.

Class 29

27. The earlier mark covers the goods [...] *preparations made from cereals* which will include cereal bars and *chocolate* which will include chocolate bars. The purpose of these goods is for consumption as a small, usually sweet snack to satiate hunger. This will be shared with the contested goods below:

Class 29: Fruit- and nut-based snack bars featuring chocolate ingredients not as a coating; Nut-based snack bars; Nut- and dried fruit- based snack bars; Cacao butter-based snack bars; cocoa butter- based snack bars; Snack bars for a keto diet; Nutbased snack bars for a keto diet; Low carb snack bars; Nutbased low card snack bars; all of the aforementioned products having a low carbohydrate content for use as part of or being compatible with ketogenic diet.

28. Whilst I note the contested goods are limited to those having a low carbohydrate content for use as part of, or being compatible with a ketogenic diet,¹ I note the earlier goods are not limited and will include all types including those tailored for or compatible with diet trends, insofar as they are included in class 30, similar to constraints of the limitation to the applicant's goods in class 29. I find that users will be shared, and due to the shared purpose of the goods, I consider there will be an element of competition between the same, with the consumer choosing between one sweet snack and another. The nature of the goods will differ somewhat, with the earlier goods being primarily cereal based or chocolate based. However, there will be an overlap in terms of the shape and presentation of the goods, and often due to the presence of additional ingredients such as chocolate or fruit. I consider there is likely to be an overlap in trade channels and that cereal bars are likely to be placed next or near to the applicant's goods in stores, whilst chocolate bars will be placed near the same. I do not consider the goods to be complementary. Overall, I find the earlier goods to be similar to the above goods to between a medium and high degree.

Class 5

29. Within its final written submissions, and in respect of the goods in class 5, the applicant has referred me to the decision of the Hearing Officer in opposition O/291/22, specifically to paragraphs 30 and 31 which read as below (footnotes omitted):

30. The contested herbal beverages for medical use; nutritional supplements in the form of drinks; food supplements for medical use containing CBD have been limited to being medical and nutritional. Whilst the earlier mark is not registered for goods in Class 5, it does have certain food and beverage goods in Classes 29, 30 and 32. However, the edibles and potables in classes 29, 30 and 32 do not include varieties used for medical,

¹ Although expressed in positive terms, I note here that the limitation applied to the applicant's specification attempts to limit the goods in terms of whether they possess particular characteristics, such as those deemed to be objectionable in line with the *POSTKANTOOR* principle. The limitation chosen does not appear to allow the scope of the rights to be determined with the necessary legal certainty set out by this principle. It is, for example, difficult to determine where the line will fall in terms of goods which are 'compatible with a ketogenic diet', leading to uncertainty for third parties. However, as the goods covered by the opponent are not limited in any way, I do not consider that dismissing this limitation will impact overall on the outcome of the comparison of the goods in this instance.

pharmaceutical or nutritional purposes. The Nice Classification guidelines set out what is and also what is not included in each Class. For example, the Explanatory Note in Class 30 states: "This Class does not include, in particular... medicinal teas and dietetic food and substances adapted for medical use." Despite the Applicant's argument that the average consumer is unaware that certain goods are categorised as being medicinal or pharmaceutical etc., it is nevertheless a reality that such goods are sold in pharmacies or in specific sections of a supermarket. In my opinion it is unlikely that a consumer would assume goods sold in sections of the supermarket other than the identified medical and pharmaceutical aisles would have medicinal or pharmaceutical properties, unless otherwise stated. Therefore, although the manner of use and end user of the contested herbal beverages for medical use; nutritional supplements in the form of drinks; food supplements for medical use containing CBD may be the same as that of goods in Classes 29, 30 and 32, the nature, intended purpose and trade channels are nevertheless different. Further, the contested goods are neither complementary to, nor in competition, with the goods of the earlier mark.

31. All of the contested goods in Class 5 are considered to be dissimilar.

30. Whilst I acknowledge the points made by the hearing officer in the case above, I note firstly that I am not bound by the findings of other hearing officers, and in any case, the goods to be considered in the matter above do not reflect identically those which I must consider in this instance. The contested food products in class 5 as filed by the applicant in this instance are not limited to those for medical use as they are in the case above. Whilst I accept that by being placed in class 5 it is indicated that they will have a function that is supplementary to that of general snack foods found in other classes, in the case of the applicant's goods I consider this function to be nutritional, rather than medical or pharmaceutical necessarily. The goods may be purchased by the general public including fitness enthusiasts for the purpose of being eaten as a nutritional snack and to aid training, or by the general public for the purpose of being eaten as a snack whilst attempting to lose, gain, or sustain weight, rather than

solely by consumers for the purpose of addressing a specific medical need. Whilst I note the hearing officer also considered the goods *nutritional supplements in the form of drinks* against other beverages in the decision above, this is not the comparison I have here and his findings in this respect are not relevant. Whilst I therefore note the comments above reflect the position the applicant would like me to take in respect of the goods I have to consider, I will continue to conduct my own assessment of the goods, in accordance with the guiding factors as set out in the case law.

31. In respect of the contested goods in class 5, namely *Protein supplements formed and packaged as bars; Protein supplements;*² *Nutritional supplement energy bars; all of the aforementioned products having a low carbohydrate content for use as part of or being compatible with ketogenic diet*³ I note the primary purpose is for providing the consumer with additional protein, nutrition, or energy. However, I note these will be eaten, and having been prepared as bars, they will be for the purpose of consumption as convenient sweet snack to satiate hunger. In the evidence provided by the opponent at Exhibit 4, a number of examples of protein bars are displayed on the website musclefood.com are shown. These are offered in flavours such as white chocolate, cookie dough, chocolate fudge and chocolate orange, with their prices displayed in GBP. Whilst I note the exhibit provided is undated, this tallies with my understanding that protein supplement bars and nutritional supplement energy bars are often sweet flavoured and are intended to also be enjoyed as a snack that tastes good. I also note the opponent's goods including [...] *preparations made from cereals* which includes cereal bars may be chosen as a healthier and more nutritional alternative to other snack foods.

32. The method of use will therefore be shared and there will be an element of overlap in intended purpose with the opponent's earlier goods [...] *preparations made from cereals* which includes cereal bars. The nature of the goods will differ to an extent as the contested goods will be made from ingredients that are purposely high in protein or other nutritional or high energy elements. However, I consider that the contested

² I note that *protein supplements* per se will include the former contested goods *protein supplements formed and packaged as bars* and it is on this basis that the comparison of the goods has been carried out.

³ My comments made in respect of this limitation in class 30 also apply to this limitation to class 5.

goods may all be sold in bar form, and there may be common features and ingredients such as chocolate or fruit, and particularly in the case of energy bars, even cereal.

33. There is a dispute between the parties about whether the goods share trade channels. I note the applicant's evidence at Exhibit MC12 showing searches for the term KETO at major supermarkets brings up only limited results, and I acknowledge the applicant's submission that this will be representative of the consumers experience. However, I do not consider this to be evidence that the supermarkets referenced will not sell protein supplement bars or nutritional supplement energy bars compatible with a ketogenic diet, and I accept the opponent's criticism of this evidence within its submissions, although I note the opponent did not submit any further searches in reply evidence. In my experience the sale of the contested class 5 goods will not be limited exclusively to specialist shops or pharmacies, or to medical or pharmaceutical aisles of the supermarket. Indeed, I note the applicant itself later submits that these goods may be sold in either "(specialist stores or different aisles of the supermarket to indicate suitability for different dietary requirements or lifestyle choices)". I find it unlikely the goods will commonly share producers, or that they will be placed directly next to each other in stores, however, I consider they may be placed relatively near each other all being snack bars.

34. Users will be shared to the extent that they will both be purchased by the general public, including those seeking healthy or nutritional sweet snack options. I find there may be an element of competition between the goods with consumers choosing between them for this reason, although I do not consider this will be at a high level due to the differences in the additional intended purpose of the contested goods being specifically for providing additional protein and nutrition. Considering all of the factors, I find there to be at least a low to medium level of similarity between the goods.

Comparison of marks


35. 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.”

36. It would be wrong, therefore, to dissect the trade marks artificially, 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.

37. The respective trade marks are shown below:

Earlier trade mark	Contested trade mark
	CANDO

38. The earlier mark comprises the word element Canto, which is placed on a white label and is surrounded by a decorative border. It is well established that word elements are generally more distinctive and often more dominant than figurative elements within marks.⁴ The word Canto is placed in a central position within the earlier mark and is the element the eye is initially drawn to, and I find it to be the most distinctive and dominant element of this mark. The white label and border element

⁴ See *Migros-Genossenschafts-Bund v EUIPO – Luigi Lavazza (CReMESPRESSO)*, Case T-189/16, paragraph 52 which refers to the judgment of 6 December 2013, *Premiere Polish v OHIM – Donau Kanol (ECOFORCE)*, T-361/12, not published, EU:T:2013:630, paragraph 32 and the case-law cited, and explains it is well established in the case law that word elements are generally regarded as more distinctive and even as dominant over figurative elements.

appear to be largely decorative and feature on the peripheral of the central word element. However, whilst the white label element plays only a very small role in the overall impression of the mark, the large size and intricate nature of the border element means it plays a larger role, and I do not consider either element to be negligible.

39. The contested mark is the single word CANDO. The overall impression resides in the mark as a whole.

Visual comparison

40. Visually, the marks coincide through the use of the letters CAN-O which feature in the same order within the distinctive and dominant elements of the marks. However, they differ by way of the earlier marks use of 't' as the fourth letter and the contested marks use of 'D' in the same place. I note this difference is somewhat hidden being placed in the middle of the marks, however, it still acts as a point of visual difference. The contested mark is filed as a word mark and so it may be used in either upper case or lower-case lettering, or a combination of the two. The fact that the earlier mark presents itself in a mixture of the two cases does not help to differentiate the marks visually. However, I do find the decorative border featured in the earlier mark adds a further significant point visual difference between the marks. Overall, due to the high level of similarity of the words, which are the most dominant and distinctive elements, I find the marks to be visually similar to at least a medium degree.

Aural comparison

41. The verbal element of the earlier mark is the single two syllable word CANDO. Presented as it is, I find this will be most likely be pronounced as CAN-DOE, with a single 'O' at the end of a multiple syllable word often representing an 'OE/OH' sound in the English language, such as in the *panto* or *scenario*. However, as it does not appear to be a known English word, a further portion of consumers may also choose to pronounce this as CAN-DOO. Similarity, the aural element of the contested mark comprises one word and two syllables and it is my view that for the reasons outlined it will more commonly be pronounced as CAN-TOE, and very occasionally may be pronounced as CAN-TOO. I find the 'd' and 't' sound in each of the marks to be similar, and overall I find the marks to be aurally similar to a high degree.

42. I note at this stage the applicant's contention that the marks will be pronounced as CAN-DOO and CAN-TOE and that as such they are aurally similar to no more than a modest degree. The applicant argues this is on the basis that consumers will break a verbal sign down into elements which for him suggest a concrete meaning, or resemble words that are known to him, referencing the GC decision *Usinor SA v OHIM*, Case T-189/05. Whilst I note this case discusses how consumers will conceptualise the mark, I understand the point the applicant is making, namely that consumers will see its mark as the two words CAN DO and will verbalise it accordingly. I also note the evidence filed relating to the meaning of can-do, which I will address in more detail in the conceptual comparison below. However, it is my view that even if some consumers consider the contested mark to be the two words CAN DO, I find it unlikely that all or even the majority of consumers would view the mark in this manner in this instance. It is my view that CANDO appears to be a new singular word, and I believe most, or at least a significant portion of consumers would see and verbalise the mark as CAN-DOE.

43. For completeness, I note the word element of the earlier mark is also made up of the two words CAN TO and so a similar argument could apply, however for the avoidance of doubt I note here that I consider it to be unlikely the consumer would view it in this way, and there appears to be no logic behind combining these words and presenting them as they appear in the earlier mark.

44. For the portion of consumers that do consider the contested mark to be a combination of the two words CAN DO, I accept the mark will be pronounced as CAN-DOO. I also accept that some of these consumers may pronounce in earlier mark as CAN-TOE as submitted, and as such only a modest degree of aural similarity will exist for the same. However, this does impact my earlier finding that at least a significant portion of consumers will pronounce the marks as CAN-TOE and CAN-DOE and for these consumers, the aural similarity will remain high.

Conceptual comparison

45. The applicant has provided a definition of the earlier mark CANTO as a poetic device commonly found in Renaissance or Medieval poetry but has stated that this meaning is fairly specialist and is unlikely to be called to mind by the majority of consumers. I agree. The applicant goes on to submit that the earlier mark would be considered to be a foreign derived word without any known meaning. Whilst I accept it would be considered to be a word with no meaning, and that some may consider the word to have foreign origins, I find that there will be at least a significant portion of consumers who will consider this to simply be a made-up word and not attribute a foreign quality to the same.

46. In respect of the contested mark, as mentioned above, the applicant suggests it would be broken down into the two elements CAN and DO and that as such it would allude to the idea of a positive, 'can-do' attitude. The applicant refers to the dictionary definitions for 'can-do' and also to a third-party article provided at Exhibit MC7 referring to the applicant's business and branding, referencing the applicant's brand messaging regarding the "CanDo spirit". I note firstly that the evidence referring to the applicant's own brand messaging is not relevant to the assessment I must make. I note the article provided has been written by a third party, however, it still clearly draws on marketing and branding messages that have been put out by the applicant in relation to its activities. In *Devinlec Développement Innovation Leclerc SA v OHIM*, Case C-171/06P, the CJEU stated that:

"59. As regards the fact that the particular circumstances in which the goods in question were marketed were not taken into account, the Court of First Instance was fully entitled to hold that, since these may vary in time and depending on the wishes of the proprietors of the opposing marks, it is inappropriate to take those circumstances into account in the prospective analysis of the likelihood of confusion between those marks."

47. I must therefore conduct my assessment based on the mark as filed. I note that, being a word mark, CANDO may be presented in upper case or lower case lettering, or in a combination of the two (such as Cando). Even if I were on this basis to allow my notional assessment to cover a scenario such where the mark is presented as CanDo such as at Exhibit MC7, I remind myself that there are many other instances

where the fair and notional use of the mark as filed would not separate the CAN and DO elements of the mark in this manner. Whilst I have taken into account that the consumer may break up marks into recognisable elements and look for a possible meaning, I also consider that a concept should be easily graspable, and the consumer will not seek to attribute a meaning to *all* trade marks they encounter where they do not initially appear to have one.

48. It is my view that the concept of a 'can-do attitude' will not be brought to mind for at least a significant portion of consumers when viewing the contested mark. For at least this portion of consumers, the marks will be conceptually neutral. I accept however, that there may be a portion of consumers, particularly those who pronounce the mark CANDOO, to whom the mark may allude to the idea of a can-do attitude, and to these consumers the marks will appear conceptually dissimilar.

Average consumer and the purchasing act

49. 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.

50. 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.”

51. It is my view that there will be two sets of consumers that will purchase the goods in this instance. The first will be the general public who will purchase the goods for general consumption or for the purpose of making consumable goods. The general public may purchase the goods fairly frequently and for a relatively low cost, however, they will consider factors such as nutritional content, flavour, and dietary requirements. I consider that a medium degree of attention will be paid to these purchases.

52. There will also be a group of professional consumers, who may purchase the goods for the purpose of stocking retail stores, or in the case of the class 5 goods, professionals who may purchase the goods to sell on to their clients, for instance in the case of personal trainers and health and fitness advisors. These consumers are likely to pay a higher degree of attention to the goods and the level of attention paid is will likely be above medium.

53. The goods are likely to be primarily purchased visually, either in physical or online retail, or where they are purchased by the professional consumers, via physical or online wholesale stores or catalogues. However, I consider that assistance from retail staff may play a part in the purchasing process as may word of mouth recommendations from health and fitness professionals. I also consider that professional consumers may place orders over the phone. As such I cannot completely discount the aural comparison.

Distinctive character of the earlier trade mark

54. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. 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).

23. 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).”

55. The opponent has not filed evidence demonstrating the use of its earlier mark. I therefore only have the inherent position to consider. Earlier in this decision I found the earlier word element CANTO will be perceived as a made-up word. It is not descriptive nor is it allusive of the goods, and I consider it to hold a high level of inherent distinctive character. I consider that additional elements of the mark are decorative and will not assist in raising the distinctiveness of the mark further when considered as a whole.

GLOBAL ASSESSMENT – Conclusions on Likelihood of Confusion

56. Prior to reaching a decision under Section 5(2)(b), I must first consider all relevant factors, including those as set out within the principles A-K at paragraph 15 of this decision. I must view the likelihood of confusion through the eyes of the average consumer, 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 they have kept in their mind. I must consider the level of attention paid by the average consumer, and consider the impact of the visual, aural and conceptual similarities of the marks by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. I must consider that the level of distinctive

character held by the earlier mark will have an impact on the likelihood of confusion. I must remember that the distinctive character of the earlier mark may be inherent, but that it may also be increased through use, and that the distinctiveness of the common elements is key.⁵ I must keep in mind that a lesser degree of similarity between the goods may be offset by a greater degree of similarity between the marks, and vice versa. I must also consider that both the degree of attention paid by the average consumer and how the goods are obtained will have a bearing on how likely the consumer is to be confused.

57. I consider at this point that there are two types of confusion that I may find. The first type of confusion is direct confusion. This occurs where the average consumer mistakenly confuses one trade mark for another. The second is indirect confusion. This occurs where the average consumer notices the differences between the marks, but due to the similarities between the common elements, they believe that both products derive from the same or economically linked undertakings.⁶

58. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, Mr James Mellor Q.C. (as he then was), as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association not indirect confusion.

59. I found the degree of similarity between the goods to range from between medium and high to at least low to medium. I found the marks to be visually similar to a medium degree. I found the marks to be aurally similar to a high degree for at least a significant portion of consumers and to a modest degree for a further portion of consumers. I found the marks to be conceptually neutral for at least a significant portion of consumers, although I found there may be a further group of consumers who find the marks to be conceptually dissimilar. I found the earlier mark to hold a high level of distinctive character by virtue of its dominant and distinctive element CANTO, and I

⁵ See *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, in which Mr Iain Purvis Q.C. as the Appointed Person pointed out that the level of 'distinctive character' is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar.

⁶ *L.A. Sugar Limited v Back Beat Inc*, BL O/375/10

found its additional elements to be decorative and not to raise the distinctiveness of the earlier mark when considered as a whole. I found the general public will pay a medium level of attention to the goods, whilst the professional public is likely to pay an above medium level of attention in respect of the same. I found the goods will be primarily purchased visually, but that I cannot completely discount the aural comparison.

60. Keeping in mind the consumers imperfect recollection, it is my view that without a conceptual hook helping to differentiate these marks for a significant portion of consumers, the elements CANTO and CANDO may easily be misremembered or mistaken for one another. Further, whilst I note in this instance, I found the border element to play a role in the overall impression of the earlier mark and to reduce its visual similarity with the contested mark, I consider that this element in and of itself appears to act as a purely decorative feature, and it does not offer the consumer anything concrete to hold on to in order to assist with their recollection of this element of the earlier mark. I therefore consider that having viewed the earlier mark, the consumer may well only hold in their mind the highly distinctive word element, and accounting for imperfect recollection, may believe the later mark to be the same as the earlier mark, particularly considering this may be presented in the same standard font. I therefore find there to be a likelihood of direct confusion in respect of all of the goods for at least a significant portion of consumers in this instance.

61. For completeness, I also consider the likelihood of indirect confusion. In *L.A. Sugar* Mr Iain Purvis Q.C. (as he then was), as the Appointed Person set out three examples of when indirect confusion may occur as below:

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).”

62. In this instance, I do not consider that the marks fall directly into one of these categories. However, I note that the examples above were intended to be illustrative and are not exhaustive.

63. In *Aveda Corporation v Dabur India Ltd* [2013] EWHC 589 (Ch), Arnold J (as he then was) considered in depth the correct application of the decision in case C-120/04 *Medion AG v Thomson multimedia Sales Germany & Austria GmbH* and whether there may be a likelihood of indirect confusion based on similar (rather than identical) elements and the imperfect recollection of the same, where those elements play an independent distinctive role within the marks. In that case, it was found that there was a likelihood of confusion based on the marks AVEDA vs DABUR UVEDA. Whilst it was considered that the introduction of DABUR was in that case sufficient to overcome a likelihood of direct confusion, there remained a likelihood of indirect confusion, as the consumer was still likely to imperfectly recollect the highly similar AVEDA/UVEDA elements of the marks.

64. Whilst I do not consider the above case to be exactly on all fours with the present case, I find there to be similarities, and I consider that the principles relating to a likelihood of indirect confusion based on the imperfect recollection of the similar elements may still apply. In the present case, it is my view that considering all of the factors previously set out, should the border element of the earlier mark be recalled by the portion of consumers for whom the marks are conceptually neutral, there will still exist a likelihood of indirect confusion due to the likelihood that these consumers may imperfectly recollect the CANTO/CANDO elements of the marks. In these instances, it is my view that the consumer, believing the highly distinctive and dominant element

of the marks to be the same, would consider that the earlier mark was simply a more decorative or updated version of the earlier mark. I therefore find that even if the border element of the earlier mark were to be recalled, there will be a likelihood of indirect confusion for these consumers in respect of all of the goods.

65. As I have found a likelihood of confusion in respect of all of the goods amongst a significant portion of consumers, the opposition under section 5(2)(b) succeeds in full.

Final Remarks

66. The opposition has been successful, and subject to a successful appeal, the application will be refused in its entirety.

COSTS

67. The opponent has been successful and is entitled to a contribution towards its costs. In the circumstances I award the opponent the sum of £1200 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Official fee:	£100
Preparing the TM7 and considering the counterstatement:	£300
Preparing the evidence and submissions and considering the other side's evidence:	£800
Total:	£1200

68. I therefore order Krisp Nutrition LLC to pay SDP RUNGIS the sum of £1200. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 21st day of December 2022

**Rosie Le Breton
For the Registrar**