

**TRADE MARKS ACT 1994**  
**IN THE MATTER OF APPLICATION No 2149445**  
**BY JAMES HAVELOCK GORDON & ANGUS B LABUNSKI**

**AND**

**IN THE MATTER OF OPPOSITION THERETO UNDER No 49326**  
**BY KRAFT FOODS INC**

## **TRADE MARKS ACT 1994**

**IN THE MATTER of Application No 2149445  
by James Havelock Gordon & Angus B Labunski**

**and**

**IN THE MATTER OF Opposition thereto under No 49326  
by Kraft Foods Inc**

### **Background**

1. On 30 October 1997, James Havelock Gordon and Angus B Labunski, applied under the Trade Marks Act 1994 to register the trade mark JELLOSHOT for a specification of goods which, following amendment reads:

Class 33

Vodka impregnated jelly.

2. The application is numbered 2149445.

3. The application was accepted and published and on 23 December 1998, Kraft Foods Inc, filed notice of opposition to the application. The statement of grounds accompanying the notice of opposition set out numerous grounds of opposition under sections 3 and 5 of the Trade Marks Act 1994. However, at the hearing only the ground of opposition under section 5(2)(b) was pursued. This ground can be summarised as:

under section 5(2)(b) of the Trade Marks Act 1994 in that the trade mark the subject of the application is similar to the opponents' earlier trade marks JELL-O and is to be registered for goods similar to the goods for which the earlier trade marks are protected.

4. The applicants filed a counterstatement denying the grounds of opposition. Both sides seek an award of costs. The matter came to be heard on 27 September 2001. The applicants were represented by Mr John Boumphrey of Counsel instructed by W.H. Mathews & Co, the opponents were represented by Mr John Wallace of Boulton Wade Tennant.

### Evidence

5. Only the opponents filed evidence in the proceedings, this consists of an affidavit dated 30 November 1999 by Mr Robert J Eck. Mr Eck is the Vice President and Associate General Counsel - Trademarks for Philip Morris Management Corp., a management group providing services to the subsidiaries and affiliates of the Philip Morris family of companies which include, among others, Kraft Foods Inc. The opponents also filed a statutory declaration dated 10 January 2000 by Mr John Max Wallace, a trade mark attorney and partner with

Boulton Wade Tennant. In so far as it is necessary, I will refer to the evidence as part of my decision.

## Decision

6. The ground of opposition pursued at the hearing was that under section 5(2)(b) of the Trade Marks Act 1994. The relevant provision reads as follows:

- “5.- (1) .....
- (2) A trade mark shall not be registered if because -
- (a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, or
  - (b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

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

7. The term ‘earlier trade mark’ is defined in section 6 of the Act as follows:

- “6.- (1) In this Act an “earlier trade mark” means -
- (a) a registered trade mark, international trade mark (UK) or Community trade mark which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,”

8. In determining the question under section 5(2), I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* [1999] R.P.C. 117, *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v. Adidas AG* [2000] E.T.M.R. 723. It is clear from these cases that:-

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v. Puma AG* page 224;
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v. Puma AG* page 224, 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;

*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* page 84, paragraph 27.

- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v. Puma AG* page 224;
- (d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v. Puma AG* page 224;
- (e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* page 132, paragraph 17;
- (f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v. Puma AG* page 224;
- (g) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v. Puma AG* page 224;
- (h) further, 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; *Marca Mode CV v. Adidas AG* page 732, paragraph 41;
- (i) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, page 133 paragraph 29.

9. Under section 5(2), the test is a composite one, involving a global appreciation taking into account a number of factors. With these comments in mind I proceed to consider the opponents' case under section 5(2)(b).

10. The opponents have various trade marks all of which fall within the definition of an earlier trade mark in section 6 of the Act. At the hearing Mr Wallace made reference to a United Kingdom registration and a more recent Community Trade Mark registration. Both of these cover similar goods but for ease of reference I will consider the question in relation to the United Kingdom registration 416031. The opponents' and applicants' trade marks are reproduced below. The full specification of the opponents' trade mark is listed but the submissions made by both parties concentrated on the terms 'jellies; preparations for making jellies' in the list of goods in class 29.

Opponents' trade mark

Applicants' trade mark

**JELL-O**

**JELLOSHOT**

Class 29

Class 33

Meat, fish, poultry and game;  
meat extract; preserved, dried and  
cooked fruits and vegetables;  
**jellies; preparations for making jellies;** jams;  
fruit puree; eggs; milk and milk products;  
edible oils and fats.

Vodka impregnated jelly.

Class 30

Coffee; tea; cocoa; sugar; rice; tapioca; sago;  
flour and preparations made from cereals;  
bread; pastry; confectionery; ices; honey;  
treacle; salt; mustard; vinegar; sauces; spices;  
ice; puddings; but not including cakes or biscuits,  
and not including any similar goods to cakes or biscuits.

Class 32

Beverages and preparations for making beverages;  
fruit juices, fruit syrups and fruit drinks;  
but not including medicated or aerated goods.

Inherent Distinctiveness/Reputation of the Opponents' Earlier Trade Mark

11. Mr Wallace argued that the opponents' trade mark possesses a level of inherent distinctiveness. He pointed out that the trade mark had been registered since 1921. Absent use this is irrelevant. He also sought to rely on the evidence of use filed by the opponents as adding to the distinctive nature of the opponents' mark. As acknowledged by Mr Wallace, whilst Mr Eck's affidavit is extensive, most of the details and examples of use supplied therein relate to use in the United States of America. Turnover in the United States is clearly impressive but not relevant to the question before me. However, there is some evidence of use in the United Kingdom and I will consider whether this is sufficient to support Mr Wallace's claim.

12. At exhibit RJE5 of Mr Eck's affidavit, he filed various documents showing examples of advertisements appearing in the United Kingdom. The first is a page from a "Tesco Recipe Collection" dated April 1996. It is an advert for an offer available through Tesco Stores until 21<sup>st</sup> April. The offer is for a free jelly egg mould when you purchase two packets of "NEW Bird's JELL-O". Three packets of Bird's JELL-O are shown in the advert, juicy orange, raspberry and strawberry. The packets all indicate that the product is NEW. The second is a small advertisement from CHAT dated 3 August 1996. This is a free offer of Bird's JELL-O

jelly crystal sachets. There are similar free offers shown in Woman's Realm and House Beautiful, the Sunday Mirror Magazine for 16 June 1996 and BEST. There is also a magazine entitled "nisaway Link", this gives a retail price for sachets of JELL-O and covers the period April 1996. The turnover figures for the United Kingdom for the period January 1996 to January 1998 are said to be £165,602. There are also some references in the evidence to the fact that the trade mark JELL-O has been referred to on television shows and in films, examples given include *Third Rock from the Sun* and *Jurassic Park*.

13. The evidence of use in the United Kingdom was criticised by Mr Boumphrey as being insufficient to support a claim to an enhanced recognition amongst the relevant public. He pointed out that sales figures of £165,602 were very modest for a brand claiming to have substantial brand recognition. In addition he pointed out that the figures given were for sales under the trade mark JELL-O but did not indicate whether these were sales of the products shown in the advertisements or other products covered by the registration. Further, he also argued that the trade mark JELL-O did not possess a high degree of inherent distinctiveness. In his view, the element JELL was a clear reference to jelly, gel or gelatine.

14. I agree with the points made by Mr Boumphrey in criticising the opponents' evidence. The level of turnover given for the two year period is in my view very modest and it is not clear from the evidence the products to which that turnover relates. Further, the only examples of advertisements relating to the product all relate to a relatively narrow window of time in 1996. In these advertisements, the product is described as "new". Absent further and more detailed evidence I am unwilling to find that at the relevant date, the opponents' trade mark was entitled to an enhanced level of recognition in the United Kingdom.

15. As to any level of inherent distinctiveness that the opponents' mark enjoys, I again find that there is some weight to Mr Boumphrey's comments. The mark JELL-O is a clear reference to the nature of some of the goods covered by the registration. As such, I reach the view that it has a relatively low level of inherent distinctiveness. Nevertheless, the opponents' mark is an earlier registered trade mark and as such it is prima facie evidence of the validity of the mark; section 72 of the Trade Marks Act 1994. Consequently, I must of course take into account notional and fair use of the opponents' trade mark in relation to the goods for which it is registered. There is no evidence showing turnover of the applicants' trade mark in the United Kingdom prior to the relevant date but I must also assume notional and fair use of the applicants' mark; *Reactor* [2000] R.P.C. at page 288.

16. With these considerations in mind I consider whether the goods in question are similar or identical.

#### Identity/Similarity of Goods

17. The opponents' trade mark is registered for certain goods within Classes 29, 30 and 32. As stated earlier, at the hearing submissions focussed on the term 'jelly' falling within Class 29. The applicants' specification is for "Vodka impregnated jelly", in class 33. The comparison is therefore between 'jelly' and 'vodka impregnated jelly'.

18. In Mr Wallace's view, a jelly is a jelly and the mere fact that the registry classify the

applicants' goods as falling in Class 33 does not make the applicants' goods dissimilar to those covered by the opponents' specification. Mr Wallace used the example of chocolates and liqueur chocolates which occur in the same class. In contrast Mr Boumphrey argued that given the alcoholic content of his clients product it would be sold in licensed premises or, if sold in a supermarket, in a different part of the store to the opponents' goods.

19. In order to assist me in reaching a conclusion on this point I consider the test set out by Mr Justice Jacobs in *British Sugar Plc v James Robertson & Sons Ltd* [1996] R.P.C. 281 at page 296. Adapted to the instant it can be stated as:

- (a) the uses of the respective goods;
- (b) the users of the respective goods;
- (c) the physical nature of the goods;
- (d) the trade channels through which the goods reach the market;
- (e) in the case of self-serve consumer items, where in practice they are respectively found or likely to be found on the same or different shelves; and
- (f) the extent to which the respective goods 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.

20. These factors were referred to in the opinion of the Advocate General in *Canon*; page 127, paragraphs 45-48. In its judgment, the ECJ stated at paragraph 22:

“22. It is however, important to stress that, for the purposes of applying Article 4(1)(b), even where a mark is identical to another with a highly distinctive character, it is still necessary to adduce evidence of similarity between the goods or services covered. In contrast to Article 4(4)(a), which expressly refers to the situation in which the goods or services are not similar, Article 4(1)(b) provides that the likelihood of confusion presupposes that the goods or services covered are identical or similar.

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 end users and their method of use and whether they are in competition with each other or are complementary.”

21. It seems to me that the users of both the applicants' and opponents' goods are potentially the same; although this could be true of any food product. The uses will in my view depend on the alcoholic content of the applicants' goods. It may be that the applicants could produce a jelly in which the alcoholic content is merely for flavouring and so the product would be consumed because of its taste. Alternatively the level of alcohol may be such that the product is consumed because of its alcoholic content. Either way, the specification is not limited in any way. I would also agree with Mr Wallace that both products are jellies and as such the physical nature of the goods is the same. As for trade channels, I accept that the applicants' product may be sold in licensed premises, but they could equally be sold in supermarkets or corner shops. Where there is such use, the products may well appear side by side or close

together. Whether the applicants' product is sold in a separate area of the shop would probably be determined by the quantity of alcohol it contains. Again, it seems to me that taking into account notional and fair use of the trade marks on both products it could be said that the respective goods are competitive, they are both jellies and as noted above, one could be bought in place of the other if the alcoholic content of the applicants' product was low.

22. Taking all these factors into account, it seems clear to me that the goods in question are similar. I note that the only example of use of the applicants' product shown in the evidence is of "Vodka Jelly Strawberry - vodka blended in straw berry [sic] flavoured jelly"; see exhibits to Mr Wallace's statutory declaration. The level of alcohol is high at 15% VOL ALC but I see little if any difference between such use and use of the opponents' trade mark on strawberry flavoured jelly. Although the quantity of alcohol contained in the product may alter the way in which it is purchased, the inclusion of alcohol does not in my view make it a different good, it is still a jelly.

### Comparison of the Trade Marks

23. I will now consider the visual, aural and conceptual similarities between the trade marks by reference to the overall impression created by the marks but taking into account their distinctive and dominant components.

24. Visually, the opponents' earlier trade mark is the word JELL-O. Mr Boumphrey was pains to point out the hyphen in the opponents' mark but I do not think that it adds much to the mark. The applicants' trade mark is JELLOSHOT. It is evident that visually both marks start with the same five letters and that, absent the hyphen, the opponents' trade mark is contained within the applicants' mark. Visually therefore, there are clear similarities between the beginning of both marks. The counter argument is of course that the two trade marks are different in length and that the word SHOT is a clear visual difference between the two marks. However, although I found above that the element JELL-O or indeed JELLO is not very distinctive for goods relating to jelly, it can also be said, and I think that the applicants conceded, that the word SHOT is indicative of the presence of alcohol in the applicants' product. As such, it cannot be said that SHOT is a dominant or distinctive component of the applicants' trade mark. The applicants' trade mark is in effect made up of two rather descriptive elements. Thus, to conclude on this point, whilst the element JELLO is not particularly distinctive, it seems to me that the addition of the element SHOT in the applicants' trade mark is not such that the clear visual similarities between the opponents' and applicants' trade marks are displaced.

25. Aurally, the opponents' trade mark would be referred to as JELLO, and the applicants' as JELLOSHOT. Here there is no need to discuss the relevance or otherwise of the hyphen in the opponents' trade mark. In my view, the same considerations and comments can be made in respect of oral use of both trade marks. As such, I reach the view that there are clear aural similarities between the two trade marks. The presence of the same five letters at the start of both trade marks leads to a strong aural similarity which is again not displaced by the presence of the semi-descriptive element SHOT.

26. Conceptually, the JELLO element of both trade marks in my view brings to mind the foodstuff jelly. SHOT as Mr Boumphrey noted, clearly indicates the presence of alcohol.



Whilst I would agree it is not quantitative, it does indicate that an unknown measure of alcohol will be present. As such, the applicants' trade mark in my view brings to mind jelly which contains or is flavoured with alcohol; the very goods for which registration is sought.

27. From my conclusions above, it is my view that there are visual, aural and conceptual similarities between the two trade marks.

#### Conclusions under section 5(2)(b)

28. Mr Hobbs, Q.C., sitting as the Appointed Person *Balmoral Trade Mark* [1998] R.P.C. 297 at page 301, found that section 5(2) raised a single composite question. Adapted to this case it can be stated as follows:

Are there similarities (in terms of marks and goods) which would combine to create a likelihood of confusion if the opponents' trade mark JELL-O and the applicants' trade mark JELLOSHOT were used concurrently in relation to the goods for which they are respectively registered and proposed to be registered?

29. Having regard to the low level of distinctive character of the earlier trade mark, the similarity of the marks and goods, I reach the view that this question must be answered in the affirmative. Further, even if I am wrong and the differences in the marks were sufficient to avoid the likelihood of direct confusion, it seems to me that the average consumer assuming notional and fair use of the opponents' trade mark would wrongly believe that the applicants' goods came from the opponents or some economically linked undertaking. As such there is in my view a likelihood of confusion within the meaning of section 5(2)(b) of the Trade Marks Act 1994.

#### Costs

30. Mr Boumphrey in making submissions on costs asked, in the event that his clients were successful, that I should take account of the fact that the original statement of grounds had contained many grounds of opposition that were not pursued at the hearing. I sympathise with the proposition put forward by Mr Boumphrey. In this case there were eight grounds of opposition but only one was pursued. The opponents have succeeded and are entitled to a contribution towards their costs. However, in my view, it would have been helpful if the opponents had indicated at an earlier stage in the proceedings, that they did not intend to rely on several of the grounds of opposition. The fact that the opponents were only relying on one of their grounds of opposition only became apparent when the opponents' skeleton argument was filed. Mr Boumphrey had already prepared and filed his clients' skeleton argument dealing, albeit briefly in some cases, with all the grounds of opposition. In my view the award of costs in favour of the opponents should be reduced accordingly.

31. There is a difficult balance to strike and I would not wish to discourage parties from withdrawing grounds of opposition. Clearly it is better that such grounds are withdrawn before the hearing and not argued. However, it seems to me that this is a case where it was clear that the opponents' sole ground of opposition fell to be considered under section 5(2)(b). If the opponents had withdrawn the other grounds at an earlier stage then the applicants would have been saved some costs in preparing for the hearing. A standard award

from the scale when an opponent is successful would be £735-00. In the circumstances of this case I will reduce that award to £635-00. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 14<sup>TH</sup> day of November 2001**

**S P Rowan  
For the Registrar  
the Comptroller General**