

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 2045573A BY
D. C. THOMSON & CO LIMITED TO REGISTER A SERIES OF 2 MARKS
IN CLASSES 29, 30 AND 32**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER NO. 49362
BY COMPAGNIE GERVAIS DANONE**

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BACKGROUND

1. On 20 November 1995, D.C. Thomson & Co Limited of Dundee, Scotland, applied to register the following as a series of two trade marks in Classes 29, 30 and 32:

THE DANDY



2. The application was accepted and published for the following specifications of goods:

Class 29

Meat, poultry, fish and game and preparations made therefrom; milk and milk products, snack foods and prepared meals; potato chips, potato crisps; baked beans; soups and preparations for making soup; jellies, jams, fruit sauces.

Class 30

Coffee, tea, cocoa, artificial coffee and beverages based thereon; rice, tapioca, sago and preparations made therefrom; flour and preparations made from cereals; pasta and pasta products; bread, pastry and confectionery; ices; puddings and desserts; honey, treacle; sauces (condiments).

Class 32

Mineral and aerated waters and other non-alcoholic drinks; syrups and other

preparations for making beverages.

3. On 15 January 1999, Compagnie Gervais Danone of Levallois-Perret, France, filed notice of opposition. The grounds of opposition were based on Sections 3(4), 3(6), 5(2)(b), 5(3), 5(4)(a) and Section 56 of the Act. On 19 April 1999, the applicants filed a counterstatement which, in essence, consisted of a denial of the various grounds. Both sides sought an award of costs.

4. Both parties then filed evidence and in accordance with the Trade Mark Registry's practice I reviewed the case and informed them that I did not consider it necessary for an oral hearing to be held in order that a decision on the substantive issues could be reached. The parties agreed. Therefore after a careful review of the pleadings and evidence filed by Wildbore & Gibbons (on behalf of the opponents) and Frank B Dehn & Co (on behalf of the applicants), both of whom also provided written submissions, I give the decision set out below.

DECISION

5. In their written submissions dated 14 December 2001, Wildbore & Gibbons explained that the opponents would not be pursuing the grounds of opposition based on Sections 3(4), 3(6), 5(3), 5(4)(a) and Section 56 of the Act. This leaves a single ground of opposition based on Section 5(2)(b) of the Act. In their Statement of Grounds, the opponents say that they are the registered proprietors of thirty six trade marks all of which consist of either the word DANONE solus, or the word DANONE together with other features. They then comment as follows:

“(2) The opponents allege that the mark applied for is confusingly similar to the said earlier marks.

(3) The application in suit covers goods in Classes 29, 30 and 32 which are identical or similar to the goods for which the opponents' said trade marks are registered and there exists a likelihood of confusion on the part of the trade and public including the likelihood of association of the mark applied for with the opponents' earlier marks. Registration of the mark applied for would thus be contrary to the provisions of Section 5(2)(b)”.

6. Section 5(2)(b) of the Act 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 mark is protected,

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

7. An earlier right is defined in Section 6 of the Act, the relevant part of which states:

“6.- (1) In this Act an ‘earlier trade mark’ means -

(a) a registered trade mark, international trade mark (UK) or Community trade mark which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,”.

8. In my consideration of the likelihood of confusion, 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] E.T.M.R. 1, **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 7, 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 8, paragraph 24;
- (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 9 paragraph 29.

9. As mentioned above, in support of their ground of opposition based on Section 5(2)(b) of the Act, in their Statement of Grounds the opponents identify thirty six registrations in a range of classes, a number of which I note post-date the application in suit. The remainder pre-date the application and in so doing qualify as “earlier trade marks” within the meaning of Section 6(1) of the Act. The marks on which the opponents rely consist either of the word DANONE alone, or the word DANONE together with other words or devices or indeed other words and devices. It appears to me that the high point of the opponents’ case must be based on those registrations consisting of the word DANONE alone. If they are unable to succeed on the basis of those, they are, in my view, unlikely to succeed on the basis of the remaining registrations, all of which contain additional features. Thus for present purposes, I shall compare the following:

Applicants’ marks

Opponents’ mark (best case)

THE DANDY

DANONE



10. It is clear from the guidance provided by the ECJ in the decided cases mentioned above, that: the likelihood of confusion must be appreciated globally taking account of all relevant factors; that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by them bearing in mind their distinctive and dominant components; that the matter should be judged through the eyes of the average consumer of the goods in question who whilst being deemed reasonably well informed and reasonably circumspect and observant rarely has the chance to make direct comparisons between marks and must instead rely on the imperfect picture of them they have kept in their mind; that 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.

11. The goods for which the applicants seek registration are aimed at the “mass market”. Consequently, the average consumer of such goods would be the public at large. The goods at

issue are by their nature relatively inexpensive. While the average consumer is considered to have all the traits indicated above, in such circumstances it is well established that the amount of care with which they will approach such purchases is likely to be somewhat less than higher cost items. Nevertheless, with foodstuffs would-be purchasers are not likely to buy without some care and attention. With that in mind I turn to consider the trade marks themselves.

12. The applicants' trade marks consists of two words, the first word of each mark being the definite article THE. This is accompanied by the dictionary word DANDY. In the first trade mark in the series both words are presented in ordinary typeface. The second trade mark in the series has the word DANDY presented in an enlarged font, in a somewhat stylised script with the word THE wholly contained within the confines of the initial letter D. The opponents' trade mark consists of the single word DANONE which appears on its face to be an invented word. The applicants appear to share this view. In their written submissions they say:

“.....DANONE is, to our knowledge, a word that has no obvious meaning”.

In their written submissions the opponents say:

“In relation to the allegation of similarity, we submit that the first thing to be looked at are the details of the massive sales in the United Kingdom under the trade mark DANONE.....”

13. The case law of the ECJ makes it quite clear that 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 8, paragraph 24**. In her evidence, which consists of a witness statement dated 21 September 2000, Ms Linda Bray, a Trade Mark Attorney with Wildbore & Gibbons, the opponents' trade mark agents, provides ample facts, supported by exhibits, to show that the opponents' trade mark DANONE has acquired distinctive character through use as well as achieving that as a result of its being an invented word. This distinctive character acquired through use covers a variety of goods; yoghurts, fromage frais; milk desserts. Thus in this case the opponents' DANONE mark is, in my view, highly distinctive per se (a view which, as mentioned above, the applicants do not appear to dispute) and it has an enhanced level of recognition as a result of its use.

14. The opponents, in a witness statement, dated 20 December 2000, by Christopher Thomson, a Director, as well as giving some background to The DANDY trade mark (used on comics principally) claims to have undertaken merchandising in relation to that trade mark in respect of food (and non food) products. But this does not represent a factor which I need to weigh into the equation.

15. The opponents in their written submissions comment as follows:

“When comparing the two marks, we ask that the Hearing Officer bears in mind that the application is for a registration of a series of two marks and that the second mark in the series ie. the device form, is tantamount to the word DANDY alone. The word THE in the mark is so small as to be negligible and is likely not to be noticed by members of the public”.

16. Whilst I am of course required to compare fair and notional use of the trade marks applied for against fair and notional use of the trade marks registered - (see the comments of Simon Thorley QC sitting as the Appointed Person in **React Music Limited v Update Clothing Limited** [2000] RPC 285), I agree that in the context of the second mark in the series, the word THE is somewhat “lost” in the totality of the mark. It is then the word DANDY in my view which becomes the distinctive and dominant component of the second mark in the series. However, the same can not be said of the first mark in the series where each element has equal prominence.

17. Before I compare the respective trade marks I note that in their written submissions the applicants comment as follows:

“The visual test is the predominant test when dealing with foodstuffs - people will generally buy foodstuffs by sight.....”

In their written submissions the opponents comment:

“If a member of the public were to be recommended a DANONE product by a friend, and then upon entering a shop saw the same or similar product with the name THE DANDY on it the customer might well think that he or she had not heard correctly the name given by the friend, and purchase THE DANDY product in mistake for the DANONE product. In addition, a member of the public who had purchased a DANONE product before and then, upon entering a shop saw the same or similar product with the name THE DANDY on it, might well mistake it for a DANONE product or think that the product was another product from the DANONE company”.

18. Whilst inevitably the goods at issue may on occasions be asked for or recommended by word-of-mouth, given that in the main these types of goods will be purchased by self-selection from, for example, a supermarket shelf, I agree with the applicants that in relation to foodstuffs, it is the visual consideration of the global assessment that is the most important. Even though the word DANONE and the word DANDY share the same first three letters i.e DAN, their respective endings are quite different. Whilst for the purposes of comparison the beginning of marks are considered to be more important than the endings, in short trade marks such as these, it is the overall visual impression that is of importance. The word DANDY is, of course, a dictionary word in its own right meaning “a man greatly concerned with smartness of dress” or informally as “very good or fine”. In view of all the above, both trade marks in the series are, in my view, sufficiently different visually to the invented word DANONE for there to be no likelihood of visual confusion. I reach this view in comparing the word DANONE with the word DANDY solus (which I have already accepted is the distinctive and dominant element of THE DANDY and the second mark in the series). Even having regard to the highly distinctive nature of the opponents' trade mark, which I have accepted, does not suggest to me that the public at large will confuse their trade mark with the applicants and thus displace that finding.

19. Also, despite the opponents assertions to the contrary, I think that aural confusion is most unlikely. The DANDY element appearing in the applicants' marks is, in my view, a sufficiently well enough known dictionary word to be easily recollected by the average consumer and

consequently articulated accordingly. Conceptually, given that the opponents' mark DANONE is an invented word, whereas the word DANDY appearing in the applicants' trade marks is a dictionary word, I do not think there is any possibility of conceptual confusion.

20. In summary, I have considered the two trade marks in the series the subject of the application in suit against what I consider to be the high point of the opponents' case under Section 5(2)(b) of the Act ie. the word DANONE solus. Having done so, I do not consider that the first trade mark in the series which consists of the words THE DANDY in normal typeface, nor the second trade mark in the series which consists of the word DANDY in an enlarged, stylised font (in which I have accepted that the word DANDY is the distinctive and dominant element) to be either visually, aurally or conceptually similar to the opponents' trade marks.

21. Having reached this conclusion and in view of the comments of Mr Geoffrey Hobbs QC sitting as the Appointed Person in **Raleigh International** [2001] RPC 202 where he said:

"Similarities between marks cannot eliminate differences between goods or services; and similarities between goods or services cannot eliminate differences between marks. So the purpose of the assessment under section 5(2) must be to determine the net effect of the given similarities and differences"

it is not, strictly speaking, necessary for me to go on to consider the goods for which the parties trade marks are respectively applied for and registered. I note that in their written submissions the applicants do not touch upon the issue of the identity or similarity of goods, preferring instead to focus their submissions on the comparison of the respective trade marks. Whether this is a tacit acceptance that identical/similar goods are involved is difficult to say. For my part, I note that, for example, registration Nos: 699705, 890359, 890361, 1578335 and 2027470 (details of which can be found in the Annex to this decision), all of which consist of the word DANONE solus and all of which pre-date the application in suit, contain a range of goods which are, in my view, either identical or similar to the vast majority of the goods for which the applicants seek registration. Of course, this aspect of the case is academic given my decision in relation to the marks themselves.

22. The opposition brought under Section 5(2)(b) of the Act fails because the trade marks the subject of the application are not similar to the opponents' earlier trade marks and therefore there is no confusion on the part of the public likely to arise as a result of the registration of this application. The applicants are entitled to a contribution toward their costs and I order the opponents to pay to the applicants the sum of £535. 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 11 day of February 2002

M KNIGHT
For the Registrar
the Comptroller-General

- No:** 699705
- Mark:** DANONE
- Date:** 11. 7. 1951
- Goods:** 29 -Yogurt and yogurt preparations.
- No:** 890359
- Mark:** DANONE
- Date:** 7. 2. 1966
- Goods:** 29 - Milk and milk products (for food).
- No:** 890361
- Mark:** DANONE
- Date:** 7.2.1966
- Goods:** 30 - Non-medicated confectionery and biscuits (other than biscuits for animals).
32 - Non-alcoholic beverages and preparations for making such beverages, all included in Class 32; fruit juices and vegetable juices for use as beverages.
- No:** 1578335
- Mark:** DANONE
- Date:** 13.7.1994
- Goods (*)** 30 - Rice; pasta; cereals and cereal preparations; cakes, pies, gateaux and mixes therefor; non-medicated confectionery; candies; ice-cream, ice cream confections, water ices, frozen confections; preparations for making all the aforesaid goods; puddings and desserts; biscuits; prepared meals; bread, pastry; snack-foods, meals and constituents for meals; sauces, ketchup; spices, spice preparations; seasoning preparations; salt; mustard, vinegar; salad dressings; all included in Class 30.
32 - Beers; mineral and aerated waters and non-alcoholic drinks; fruit drinks and fruit juices; syrups and preparations for making beverages; all included in Class 32.

No: 2027470

Mark: DANONE

Date: 18.7.1995

Goods: 29 - Milk and milk products; milk desserts, yogurts, cream, cheese, fresh cheese, cottage cheese; meat, fish, ham, poultry, game, delicatessen; ready dishes, partially or totally made of the aforesaid products; preserved, dried and cooked fruits and vegetables, jam and jelly, soup, stewed fruits; canned food partially or totally made of the aforesaid products; frozen milk products; preserved, dried, cooked, frozen or canned ready dishes.

(*) indicates a multiple class registration in which only the relevant classes have been identified.