

O-241-05

TRADE MARKS ACT 1994

**IN THE MATTER OF
INTERNATIONAL REGISTRATION NO. 800361
AND THE REQUEST BY SÖLEN ÇİKOLATA GIDA SANAYI
VE TICARET ANONİM SİRKETİ
TO PROTECT THE TRADE MARK**



IN CLASSES 29 & 30

**AND IN THE MATTER OF OPPOSITION THERETO
UNDER No. 71048
BY GROWSEED AKTIENGESELLSCHAFT**

BACKGROUND

1) On 27 February 2003, Sölen Çikolata Gıda Sanayi ve Ticaret Anonim Şirketi (henceforth referred to as Solen) of 2 Organize Sanayi Bölgesi, No. 23 P.3, Baspınar Gaziantep, Turkey on the basis of its International Registration based upon a registration held in Turkey requested protection in the United Kingdom of the following trade mark under the provisions of the Madrid Protocol:



2) Protection was sought for the following goods:

In Class 29: Sesame oil, potato chips, chocolate nut butter, jams.

In Class 30: Halvah, candy, confectionery, chocolate, chocolate bars, cocoa, pralines, caramels, waffles, biscuits, crackers, cakes, pastries, cookies with marshmallow, Turkish delight, ice cream, roasted corn.

3) The United Kingdom Trade Marks Registry considered that the request satisfied the requirements for protection in accordance with Article 3 of the Trade Marks (International Registration) Order 1996 and particulars of the international registrations was published in accordance with Article 10.

4) On 19 September 2003 Growseed Aktiengesellschaft of Aeulestrasse 5, Vaduz, 9490, Liechtenstein filed notice of opposition to the conferring of protection on this international registration. The grounds of opposition are in summary:

a) The opponent is the proprietor of the following trade mark:

Trade Mark	Number	Effective Date	Classes	Specification
SOLANO The Spanish word "Solano" in the mark means "Easterly wind".	2151218	18.11.97	30	Chewing gum, bubble gum, candies, caramels, confectionery, chocolate; but not including frozen confections.

b) In view of the similarity between the mark applied for and the opponent's mark and the identity/similarity between the goods applied for in Class 30 and the goods for which the opponent's mark is registered the application should be refused under Section 5(2)(b) of the Trade Marks Act 1994.

5) The applicant subsequently filed a counterstatement accepting that some of the goods for which the opponent's mark is registered are identical with, and/or similar to the goods of the mark in suit, but denying that the marks were similar.

6) Both sides ask for an award of costs.

7) Neither side filed evidence in these proceedings and neither wished to be heard, although both provided written submissions which I shall refer to as and when they are relevant.

DECISION

8) The ground of opposition is under Section 5(2)(b) which reads:

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

(a)....

(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.”

9) An “earlier trade mark” is defined in Section 6, the relevant parts of which state:

“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,”

10) The opponent is relying on UK Trade Mark No 2151218 “SOLANO” registered with effect from 18 November 1997, which is plainly an “earlier trade mark”.

11) In determining the question under section 5(2)(b), I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel Bv v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Meyer 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*;
- (b) the matter must be judged through the eyes of the average consumer, of the goods / services in question; *Sabel Bv v Puma AG*, 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.*;
- (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*;
- (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*;
- (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.*;
- (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*;
- (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*;
- (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*;
- (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.*

12) In essence the test under Section 5(2)(b) is whether there are similarities in marks and goods which would combine to create a likelihood of confusion. In my consideration of whether there are similarities sufficient to show a likelihood of confusion I am guided by the judgements of the European Court of Justice mentioned above. The likelihood of confusion must be appreciated globally and I need to address the degree of visual, aural and conceptual similarity between the marks, evaluating the importance to be attached to those different elements taking into account the degree of similarity in the goods, the category of goods in question and how they are marketed. Furthermore, I must compare the mark applied for and the opponent's registration on the basis of their inherent characteristics assuming normal and fair use of the marks on a full range of the goods covered within the respective specifications.

13) The opponent's mark is said to be a Spanish word meaning "Easterly wind". However, despite the popularity of Spain as a holiday destination I do not believe that the average UK consumer will be aware of this meaning. They will view it as a meaningless made up word which is therefore inherently distinctive. Ordinarily I would also consider whether the mark has acquired distinctiveness but no evidence of use has been filed.

14) The effect of reputation on the global consideration of a likelihood of confusion under Section 5(2)(b) of the Act was recently considered by David Kitchin Q.C. sitting as the Appointed Person in *Steelco Trade Mark* (BL O/268/04). Mr Kitchin concluded at paragraph 17 of his decision:

"The global assessment of the likelihood of confusion must therefore be based on all the circumstances. These include an assessment of the distinctive character of the earlier mark. When the mark has been used on a significant scale that distinctiveness will depend upon a combination of its inherent nature and its factual distinctiveness. I do not detect in the principles established by the European Court of Justice any intention to limit the assessment of distinctiveness acquired through use to those marks which have become household names. Accordingly, I believe the observations of Mr Thorley Q.C in *DUONEBS* should not be seen as of general application irrespective of the circumstances of the case. The recognition of the earlier trade mark in the market is one of the factors which must be taken into account in making the overall global assessment of the likelihood of confusion. As observed recently by Jacob L.J. in *Reed Executive & Ors v. Reed Business Information Ltd & Ors*, EWCA Civ 159, this may be particularly important in the case of marks which contain an element descriptive of the goods or services for which they have been registered. In the case of marks which are descriptive, the average consumer will expect others to use similar descriptive marks and thus be alert for details which would differentiate one mark from another. Where a mark has become more distinctive through use then this may cease to be such an important consideration. But all must depend upon the circumstances of each individual case."

15) I will first compare the goods of the two parties. The opponent is only attacking the registration of the goods in Class 30 not those sought in Class 29. For ease of reference these are:

Applicant's goods	Opponent's Goods
Class 30: Halvah, candy, confectionery, chocolate, chocolate bars, cocoa, pralines, caramels, waffles, biscuits, crackers, cakes, pastries, cookies with marshmallow, Turkish delight, ice cream, roasted corn.	Class 30: Chewing gum, bubble gum, candies, caramels, confectionery, chocolate; but not including frozen confections.

16) In carrying out a comparison I take into account the factors referred to in the opinion of the Advocate General in *Canon*; page 127, paragraphs 45-48. In its judgement, the ECJ stated at paragraph 23:

“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.”

17) Clearly, both specifications contain a number of identical terms. The applicant in their written submissions state that “The goods in the application are items of confectionery”. The applicant does not contest the view that the goods of the two parties are for the most part identical whilst the remaining few items are similar.

18) Given that the goods are accepted by both sides as being confectionery it follows that the average consumer in the UK will be the general public including children.

19) I will now compare the marks of the two parties. For ease of reference these are as follows:

Applicant’s mark	Opponent’s mark
	<p data-bbox="810 801 970 835">SOLANO</p> <p data-bbox="810 880 1273 947">The Spanish word "Solano" in the mark means "Easterly wind"</p>

20) No evidence has been provided of either trade mark being used. Consequently, I must consider the matter on the basis of fair and notional use of the respective trade marks – as per *REACT* [2000] RPC 285 at page 288.

21) Visually the marks share the same first three letters “SOL”. In my view the average consumer would take the presence of the umlaut over the letter “O” in the applicant’s mark as simply a diamond device, identical to that which appears under the letter “S”. Clearly, both marks also have a letter “N” towards their end. The applicant’s mark also has various devices which although not particularly distinctive do add to the overall visual difference.

22) Comparing the marks aurally I first consider the effect of the umlaut in the applicant’s mark. To my mind, even if the average consumer in the UK were to recognise it as an umlaut it would not, in my view, affect their pronunciation of the mark. The opponent contends that “This letter [N] is not one which is likely to be dropped by the average consumer when referring to the marks orally”. I agree that the letter “N” is not one which is swallowed or even slurred. However, in my mind there is a considerable difference between the endings of the two words and indeed their overall composition. The applicant’s mark is a two syllable word and has a short “feel” to it as the letter “N” at the end gives a clipped finish. The opponent’s mark is a

three syllable word which, due to the presence of the letter “O” at its end is rather drawn out and therefore sounds and “feels” longer, although the difference in length between the words is actually only one letter.

23) Conceptually, I do not believe that either mark conveys an image to the average UK consumer. It was contended that the letters “SOL” would convey the image of the sun. Even if this were true I do not believe that this helps to give either mark an overall image. Nor do I accept the contention that the presence of the umlaut gives the applicant’s mark a Germanic impression.

24) I must also take into account imperfect recollection (*Wagamama* [1995] FSR 713) and also take into account the comments of Mr Hobbs Q.C. sitting as the Appointed Person in *Raleigh International* (BL O/253/00):

“Similarities between marks cannot eliminate differences between goods or services; and similarities between goods and 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.”

25) I accept that some of the goods covered by the specifications are literally a bag of sweets and that the level of attention of the average consumer will not be particularly high and have taken this factor into account in weighing up the likelihood of confusion.

26) In summary having regard to visual, aural and conceptual considerations and making due allowance for the fact that there is some identity of goods I have come to the view that there is no likelihood of confusion. I have also considered whether the public might nevertheless have reason to think that goods offered under the marks came from the same or economically linked undertakings. But again I have come to the view that this is unlikely to be the case. I have taken the views expressed by the Court of Appeal in *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32 into account in reaching this view. Accordingly the opposition under Section 5(2)(b) fails.

27) The opposition having failed, the applicant is entitled to a contribution towards costs. I order the opponent to pay the applicant the sum of £750. This sum 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 1st day of September 2005

George W Salthouse
For the Registrar
The Comptroller-General