

O/006/19

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION UK3266963

BY

THOMSON'S COFFEE COMPANY LIMITED  
TO REGISTER THE FOLLOWING TRADE MARK  
IN CLASSES 30, 35, 37,40 and 43

**THOMSON'S**

AND

THE OPPOSITION UNDER NO. 411688 THERETO

BY

PUNJANA LIMITED

## **Background and Pleadings**

1. Thomson's Coffee Company Limited (the Applicant) applied to register the word only mark THOMSON'S on the 30 October 2017 for the goods and services in classes 30, 35, 37 and 40 and 43 shown below. It was accepted and published on the 17 November 2017.

Class 30: Coffee; tea; instant coffee; coffee flavourings; coffee capsules and pods; coffee beans; ground coffee; decaffeinated coffee; iced coffee; roasted coffee; unroasted coffee; coffee extracts and essences; flavoured coffee; coffee-based preparations and beverages; coffee oils; coffee bags; tea extracts, preparations and beverages made with tea; iced tea; tea bags; herbal and fruit teas; malt-based preparations for human consumption; cocoa and cocoa-based preparations and beverages; chocolate drink preparations; drinking chocolate; chocolate beverages; hot chocolate.

Class 35: Retail services including online retail services connected with the sale of coffee, tea, cocoa and drinking chocolate; wholesale services in relation to coffee, tea, cocoa and drinking chocolate.

Class 37: Installation, repair and maintenance of beverage preparation, brewing, storage and serving equipment to homes and businesses; installation, cleaning, repair and maintenance of coffee machines, coffee grinders, coffee roasters, coffee percolators, electric coffee machines, espresso machines, tea machines, tea making facilities, cocoa machines and tea, coffee and hot beverage dispensing machines.

Class 40: Coffee-grinding; coffee roasting and processing; tea processing.

Class 43: Restaurant, bar, cafe and catering services; provision of food and drink; coffee shop services; tea room services; office catering services for the provision of tea and coffee; rental of tea and coffee machines.

2. Punjana Limited (the Opponent) opposes the application under sections 5(1), 5(2)(a) and 5(2)(b) of the Trade Marks Act 1994 (the Act), relying on its earlier UK registered mark THOMPSON'S FAMILY TEAS EVERYDAY BLEND number UK3052460 which was filed on the 23 April 2014 and registered on the 1 August 2014.

3. For the purposes of this opposition the Opponent is relying on all its goods in class 30, listed below, for which the mark is registered, claiming that there is a likelihood of confusion because under section 5(1), 5(2)(a) and 5(2)(b) the trade marks are identical or similar and are to be registered for goods and services identical or similar to those for which the earlier mark is protected.

Class 30: Tea; infusions for making beverages; tea based beverages; preparations for making tea beverages.

4. The Applicant filed a defence and counterstatement denying the claims made. It states that the earlier mark

“contains additional elements which would not go unnoticed by the relevant public and would allow the marks to be easily distinguished from each other.”

5. Both parties are represented, the Applicant by Lincoln IP and the Opponent by Murgitroyd & Company. Neither party filed evidence nor submissions in lieu of a hearing.

## Decision

6. Section 5(1) and 5(2)(a) of the Act require the respective marks to be identical. The Act states:

“5(1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.

5(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

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

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

7. In *S.A. Société LTJ Diffusion v. Sadas Vertbaudet SA, Case C-291/00*, the Court of Justice of the European Union (“CJEU”) held that:

“54... a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer.”

8. The Applicant’s trade mark constitutes the word mark “THOMSON’S” whereas the Opponent’s trademark comprises of the mark “THOMPSON’S FAMILY TEAS EVERYDAY BLEND”. I take note that a word trade mark protects the word itself

irrespective of font, capitalisation or otherwise and therefore a trade mark in capitals covers use in lower case and vice versa.<sup>1</sup>

9. There are obvious visual differences between the marks, namely the Applicant's word only mark versus the Opponent's five word mark. However, I must consider whether the additional elements in the Opponent's mark contribute to the mark or are purely descriptive. Taking into account the decision in *Reed Executive plc v Reed Business Information Ltd*, Court of Appeal [2004] RPC 767, Jacob L.J. found that 'Reed' was not identical to 'Reed Business Information' even for information services. He stated that:

"40. It was over "Reed Business Information" that battle was joined. The composite is not the same as, for example, use of the word "Reed" in the sentence: "Get business information from Reed". In the latter case the only "trade-marky" bit would be "Reed". In the former, the name as a whole is "Reed Business Information". The use of capital letters is of some visual significance – it conveys to the average user that "Business Information" is part of the name. If the added words had been wholly and specifically descriptive – really adding nothing at all (eg "Palmolive Soap" compared to "Palmolive") the position might have been different. But "Business Information" is not so descriptive – it is too general for that."

10. Taking this case into account I must consider whether the additional use of "FAMILY TEAS EVERYDAY BLEND" is wholly and specifically descriptive of tea, adding nothing at all to the mark. I conclude as in *Reed* that in its totality it is far too general a phrase and cannot be considered as adding nothing to the mark and so on this basis the Applicant's mark is not identical to the Opponent's mark as the differences between them cannot be discounted or considered insignificant. The

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<sup>1</sup> *Bentley Motors Limited v Bentley 1962 Limited* BL O/159/17

Opponent's opposition therefore fails under section 5(1) and 5(2)(a) as the marks are not identical.

11. I will therefore go on to consider the opposition under section 5(2)(b), which states:

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

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

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

12. An earlier trade mark is defined in section 6 of the Act, which states:

“6. - (1) In this Act an “earlier trade mark” means –

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

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

13. In these proceedings, the Opponent is relying upon its UK trade mark registration, shown above, which qualifies as an earlier mark under section 6 of the Act. As the earlier mark had been registered for less than five years at the date the application

was published it is not subject to the proof of use provisions contained in section 6A of the Act. Consequently, the Opponent is entitled to rely upon all its Class 30 goods of its registration, as specified, without having to establish genuine use.

14. 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 greater degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings to mind the earlier mark, 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 will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

### **Comparison of goods and services**

15. When conducting a goods and services comparison, all relevant factors should be considered as per the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon Kabushiki Kaisha v Metro Goldwyn Mayer Inc* Case C-39/97, where 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”.

16. I am also guided by the relevant factors for assessing similarity identified by Jacob J in *Treat*, [1996] R.P.C. 281 namely:

- (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.

17. In addition, in *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), Floyd J 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."

18. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court ("GC") stated that:

"29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut fur Lernsysteme v OHIM- Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark".

19. I note the brief submissions in relation to the identicality or similarity of the goods and services in question. In my view there is an overlap between the parties' specifications within class 30 where the identical wording is used as per the table below and on the *Meric* principle.

<b>Applicant</b>	<b>Opponent</b>
Class 30: Tea; tea extracts, preparations and beverages made with tea; iced tea; tea bags; herbal and fruit teas;	Class 30 Tea; infusions for making beverages; tea based beverages; preparations for making tea beverages.

20. I must consider a number of factors when comparing the remaining respective goods and services as per the general principles as set out by the caselaw above namely the nature and purpose of the goods and services, the distribution channels, the producers, method of use and whether they are in competition with each other or are complementary.

21. The GC in the case of *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-325/06* defined "complementary":

"82 It is true that goods are complementary if 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...".

22. The contested goods in Class 30 "*Coffee; instant coffee; coffee flavourings; coffee capsules and pods; coffee beans; ground coffee; decaffeinated coffee; iced coffee; roasted coffee; unroasted coffee; coffee extracts and essences; flavoured coffee; coffee-based preparations and beverages; coffee oils; coffee bags;*" are all hot or cold caffeinated beverages, or components used to enhance the flavour of beverages, they share uses and physical nature. There is a substantial overlap of the respective users as many hot/cold beverage drinkers will enjoy both tea and coffee. Both products would appear in the same aisle of the supermarket or be ordered in a cafe and may share the same trade channels. These coffee-based goods are therefore highly similar to the Opponent's "*Tea; infusions for making beverages; tea based beverages; preparations for making tea beverages*"

23. On the same basis I would conclude that "*malt-based preparations for human consumption; cocoa and cocoa-based preparations and beverages; chocolate drink preparations; drinking chocolate; chocolate beverages; hot chocolate*" are similar to "*Tea; infusions for making beverages; tea based beverages; preparations for making tea beverages*". They are sold in the same sections of the supermarket, they are in competition but have a similar method of use and end users. I accept that not all coffee and tea drinkers would consume hot chocolate or cocoa based beverages and that their nature is different in so far as their manufacturing process however they are inevitable sold in proximity to each other on supermarket shelves. Water would normally be added to tea to complete the infusion process and to make tea beverages, whereas cocoa based drinks can either be made by the addition of water or milk. Taking all these matters into account and the principles set out by the above caselaw there is sufficient similarity between them for me to conclude that they are similar to a medium degree.

24. I take into consideration the decision in *Tony Van Gulck v Wasabi Frog Ltd*, Case BL O/391/14, Mr Geoffrey Hobbs Q.C. as the Appointed Person reviewed the law concerning retail services compared to goods. He said (at paragraph 9 of his judgment) that:

“9. The position with regard to the question of conflict between use of **BOO!** for handbags in Class 18 and shoes for women in Class 25 and use of **MissBoo** for the Listed Services is considerably more complex. There are four main reasons for that: (i) selling and offering to sell goods does not, in itself, amount to providing retail services in Class 35; (ii) an application for registration of a trade mark for retail services in Class 35 can validly describe the retail services for which protection is requested in general terms; (iii) for the purpose of determining whether such an application is objectionable under Section 5(2)(b), it is necessary to ascertain whether there is a likelihood of confusion with the opponent’s earlier trade mark in all the circumstances in which the trade mark applied for might be used if it were to be registered; (iv) the criteria for determining whether, when and to what degree services are ‘*similar*’ to goods are not clear cut.”

25. “*Retail services including online retail services connected with the sale of tea; wholesale services in relation to tea*” have some degree of connectivity to tea. The goods and services are closely related, they share trade channels and are complementary. The average consumer would consider the retailing or wholesale distribution services as originating from the same undertaking as the actual goods. Therefore, I consider there to be to an average degree of similarity between them.

26. The contested “*tea processing*” services are similar to a low degree with “*tea*”. Tea processing involves picking and drying the fresh tea leaves and packaging it into loose leaves or tea bags for sale. It is not unreasonable for consumers to perceive that those businesses processing tea also sell the end product. In fact, many fair

trade companies process, supply, distribute and sell tea to an extent that the services and goods originate from the same trade source. “*Tea processing*” and “*tea*” are complementary even though they are dissimilar in method of use, they are similar to a low degree.

27. The contested “*Retail services including online retail services connected with the sale of coffee, cocoa and drinking chocolate; wholesale services in relation to coffee, cocoa and drinking chocolate*” and the Opponent’s tea related goods share a low degree of similarity, they are different in their nature, purpose and method of use, however similarly to the retailing of tea, they are beverages and likely to be sold through the same trade channels. The purpose of retail services in relation to tea, coffee and cocoa beverages is in bringing together and offering for sale a variety of products thus allowing consumers to conveniently satisfy different shopping needs at one stop. They are similar to a low degree.

28. “*Coffee-grinding; coffee roasting and processing*” services would also be similar to a low degree to *tea*. The process of grinding, roasting and processing coffee produces a similar end product to tea in that both are used to make hot beverages. They are similar to a low degree.

29. The contested “*Tea room services*” and “*tea*” also share some similarity. There is a degree of complementarity between the services and the goods because the provision of tea in a cafe cannot occur without the goods. There is also similarity in purpose because tea room services and tea both enable the user to drink tea. “*Tea room services*” are similar to “*tea*” to a low degree. Since it is usual to find tea in establishments and catering services which provide food and drink, particularly coffee shop services, there is also a low degree of similarity with “*Restaurant, bar, cafe and catering services; provision of food and drink; coffee shop services; office catering services for the provision of tea and coffee*”.

30. The contested *“Installation, repair and maintenance of beverage preparation, brewing, storage and serving equipment to homes and businesses; installation, cleaning, repair and maintenance of coffee machines, coffee grinders, coffee roasters, coffee percolators, electric coffee machines, espresso machines, tea machines, tea making facilities, cocoa machines and tea, coffee and hot beverage dispensing machines”* and all of the Opponent’s tea based products are dissimilar they do not share nature or purpose. They are not in competition and cannot be considered complementary. The repair and servicing of tea, coffee and hot beverage machines share no similarity with *tea*. Repairing machines or installing machines are undertaken by engineers whereas tea is a consumable beverage. They are therefore dissimilar.

31. Similarly, the contested services *“rental of tea and coffee machines”* share no similarity to *“tea”* the main purpose of these services is the rental of the machines. The product for which the machine is used is irrelevant to the rental service. They share no similarity in method of use, they are not in competition nor complementary to each other. The *“rental of tea and coffee machines”* are therefore dissimilar to *“tea”*.

32. The opposition therefore fails in relation to the following as I have found no similarity between the Applicant’s goods and services and the Opponent’s goods:

Class 37: Installation, repair and maintenance of beverage preparation, brewing, storage and serving equipment to homes and businesses; installation, cleaning, repair and maintenance of coffee machines, coffee grinders, coffee roasters, coffee percolators, electric coffee machines, espresso machines, tea machines, tea making facilities, cocoa machines and tea, coffee and hot beverage dispensing machines.

Class 43: Rental of tea and coffee machines.

## Average consumer

33. The average consumer is deemed to be reasonable well informed and reasonably observant and circumspect. When considering the opposing trade marks, I must bear in mind that the level of attention is likely to vary according to the category of goods and services in question.<sup>2</sup>

34. 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.”

35. Neither party has made submissions regarding the average consumer or the purchasing process. The average consumer of the goods at issue is a member of the general public who is likely to choose the goods from a shop or supermarket through self-selection or from a website or purchase the beverages over the counter in a cafe, restaurant or tea room. This purchasing process is therefore likely to be both visual and aural.

36. I consider that they will pay a low to average degree of attention in their selection process as the goods in question are casual purchases, inexpensive in nature.

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<sup>2</sup> *Lloyd Schuhfabrik Meyer*, C-342/97



## Comparison of the marks

37. 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 Court of Justice of the European Union 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.”

38. It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to consider 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.

39. The respective trade marks are shown below:

Applicant's mark	Opponent's mark
THOMSON'S	THOMPSON'S FAMILY TEA EVERYDAY BLEND

40. The Applicant's mark consists of the single word only mark THOMSON'S presented in conventional font. There are no other elements to contribute to the overall impression, and therefore the distinctive and dominant component is contained in the word itself.

41. The Opponent's mark consists of five words namely the name/surname THOMPSON'S followed by the phrase FAMILY TEA EVERYDAY BLEND presented in conventional font. The role of the words FAMILY TEA EVERYDAY BLEND within the mark are limited as they are simply descriptive of the nature of the goods provided by the undertaking; it is the name/surname Thompson which plays the greater role in the overall impression created by the mark and it is THOMPSON which is the distinctive element.

### **Visual Comparison**

42. The only point of visual similarity between the marks is in the word THOMSON'S/ THOMPSON'S which are highly similar, the only difference being the addition of the letter "p" in the Opponent's mark. As a general rule, the beginnings of marks tend to have more focus<sup>3</sup> and it is the first word in the earlier mark which is highly similar visually to the application. I find the marks share a medium degree of visual similarity.

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<sup>3</sup> El Corte Ingles, SA v OHIM, cases T-183/02 and T 184/02

## **Aural**

43. The competing marks are aurally similar to the extent that the entirety of the applied for mark shares commonality with the first word of the Opponent's mark. The common aural element will be pronounced almost identically, as the p in THOMPSON'S is very soft when pronounced. The Opponent's mark consists of further verbal elements namely "FAMILY TEA EVERYDAY BLEND" but I do not consider that these remaining elements will even be articulated. If they are not articulated then the marks are aurally almost identical otherwise they will be aurally similar to a medium degree.

## **Conceptual**

44. Both the Applicant's mark and the first word of the Opponent's mark will be understood as surnames. The average consumer is likely to regard Thomson and Thompson as different versions of the same family name, and therefore they are conceptually almost identical. The remainder of the Opponent's mark will simply describe the products on offer namely an "everyday blend of tea".

## **Distinctive character of the earlier mark**

45. 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).”

46. Registered trade-marks possess varying degrees of inherent distinctive character, some being suggestive or allusive of a characteristic of the goods and services on offer to those with high inherent characteristics such as invented words which have no allusive qualities.

47. The Opponent has not filed any evidence to show that its mark has enhanced its distinctiveness through use, and therefore I am only able to consider the position based on inherent characteristics. The earlier mark consists of five words with Thompson’s being considered a fairly common surname and the remaining words “family tea everyday blend” being descriptive of the goods in question namely ordinary day to day tea. Thompson’s is of average inherent distinctive character with the remaining words being non-distinctive in relation to tea.

## Likelihood of confusion

48. When considering whether there is a likelihood of confusion between the two marks I must consider whether there is direct confusion, where one mark is mistaken for the other or whether there is indirect confusion where the similarities between the marks lead the consumer to believe that the respective goods or services originate from the same or related source.

49. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, explained that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognised that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark, I conclude that it is another brand of the owner of the earlier mark.”

50. In determining whether there is a likelihood of confusion there are a number of factors to bear in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods or services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the Opponent’s trade mark, the average consumer for the goods and services and the nature of the purchasing process. In doing so, I must consider that the average consumer rarely has the opportunity to make direct comparisons between trade marks

and must instead rely upon the imperfect picture of them that he has retained in his mind.

51. In *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, 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. He said:

“38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that ‘the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion’. This is indeed what was said in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically.

39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything, it will reduce it.”

52. In *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch), Arnold J. considered the impact of the CJEU’s judgment in *Bimbo*, Case C-591/12P, on the court’s earlier judgment in *Medion v Thomson*. The judge said:

“18 The judgment in *Bimbo* confirms that the principle established in *Medion v Thomson* is not confined to the situation where the composite trade mark for which registration is sought contains an element which is identical to an earlier trade mark, but extends to the situation where the composite mark contains an element which is similar to the earlier mark. More importantly for present purposes, it also confirms three other points.

19 The first is that the assessment of likelihood of confusion must be made by considering and comparing the respective marks — visually, aurally and conceptually — as a whole. In *Medion v Thomson* and subsequent case law, the Court of Justice has recognised that there are situations in which the average consumer, while perceiving a composite mark as a whole, will also perceive that it consists of two (or more) signs one (or more) of which has a distinctive significance which is independent of the significance of the whole, and thus may be confused as a result of the identity or similarity of that sign to the earlier mark.

21 The third point is that, even where an element of the composite mark which is identical or similar to the earlier trade mark has an independent distinctive role, it does not automatically follow that there is a likelihood of confusion. It remains necessary for the competent authority to carry out a global assessment taking into account all relevant factors.”

53. I have found the marks to be visually similar to a medium degree and aurally and conceptually similar to a high degree. I have found the earlier mark to have an average degree of inherent distinctiveness. I have identified the average consumer to be a member of the general public selecting the goods and services primarily through visual means paying a low to average level of attention. I have found a good proportion of the goods and services to be identical or similar from low to high.

54. Due to the nature of the goods and services and the purchasing process if consumers only focus their attention on the word Thompson's/Thomson's and ignore the remainder of the Opponent's components because of their descriptiveness, the marks will be directly confused with each other because the consumer will mistake one for the other. If, however I am wrong in this conclusion and the average consumer registers all the elements of the Opponent's mark when undertaking the purchasing process then I still consider that there will be indirect confusion as there is sufficient

commonality between the marks for Thompson's to be regarded as a house mark and for the remaining elements "family tea everyday blend" to be classed as a descriptor. The consumer when comparing the marks may well recognise the difference with the absence of the descriptive elements but discount them as believing that they come from the same economically linked undertaking. On this basis I consider there is a likelihood of confusion.

## **Outcome**

55. The opposition succeeds under section 5(2)(b) for the goods and services in classes 30, 35, 40 and 43 outlined below. The application is refused for

Class 30: Coffee; tea; instant coffee; coffee flavourings; coffee capsules and pods; coffee beans; ground coffee; decaffeinated coffee; iced coffee; roasted coffee; unroasted coffee; coffee extracts and essences; flavoured coffee; coffee-based preparations and beverages; coffee oils; coffee bags; tea extracts, preparations and beverages made with tea; iced tea; tea bags; herbal and fruit teas; malt-based preparations for human consumption; cocoa and cocoa-based preparations and beverages; chocolate drink preparations; drinking chocolate; chocolate beverages; hot chocolate.

Class 35: Retail services including online retail services connected with the sale of coffee, tea, cocoa and drinking chocolate; wholesale services in relation to coffee, tea, cocoa and drinking chocolate.

Class 40: Coffee-grinding; coffee roasting and processing; tea processing.



Class 43: Restaurant, bar, cafe and catering services; provision of food and drink; coffee shop services; tea room services; office catering services for the provision of tea and coffee.

56. The opposition having failed for the goods and services that I have determined are dissimilar the application may proceed to registration for the following goods and services:

Class 37: Installation, repair and maintenance of beverage preparation, brewing, storage and serving equipment to homes and businesses; installation, cleaning, repair and maintenance of coffee machines, coffee grinders, coffee roasters, coffee percolators, electric coffee machines, espresso machines, tea machines, tea making facilities, cocoa machines and tea, coffee and hot beverage dispensing machines.

Class 43: Rental of tea and coffee machines.

### **Costs**

57. As the Opponent has had the greater share of success in the application it is entitled to a contribution towards its costs. Award of costs in proceedings are based upon the scale as set out in Tribunal Practice Notice 2 of 2016. However, I take note that the Opponent only filed very brief submissions within its TM7 and determine that the costs awarded should reflect this, I therefore award costs to the Opponent on the reduced basis as follows:

Preparing a Notice of Opposition  
and reviewing Counter Statement

£100

Official fee<sup>4</sup>: £100

Total: £200

58. I order THOMSON'S COFFEE COMPANY LIMITED to pay PUNJANA LIMITED the sum of £200. The sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 3rd day of January 2019

Leisa Davies

For the Registrar

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<sup>4</sup> Although the Opponent originally paid £200 for instigating proceedings, its section 5(3) and 5(4) grounds were struck out as it had failed to file any evidence in support of its opposition. I determine that the Applicant should not bear these additional costs and award the lower amount.