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TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2145779 IN THE NAME OF
ADAMS FOOD INGREDIENTS LIMITED**

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NUMBER 48260 IN THE NAME OF
ALPRO NV**

TRADE MARKS ACT 1994

**IN THE MATTER OF application No 2145779 in the name of
Adams Food Ingredients Limited**

and

**IN THE MATTER OF opposition thereto under No 48260
in the name of Alpro NV**

Background

On 19 September 1997, Adams Food Ingredients Limited of Leek, Staffordshire, ST13 6EN, applied to register the trade mark ADPRO in Class 29 in respect of the following goods:

Milk, milk products, milk powder; preparations containing milk or milk products; dairy products; eggs; edible oils and edible fats.

On 26 February 1998, Alpro NV filed notice of opposition to this application in which they say that they are the authorised user of the following trade mark registered in their name:

Number	Mark	Class	Specification
1219342	ALPRO	29	Proteins included in Class 29 of vegetable origin and in liquid or powder form.

The grounds of opposition are in summary:

- 1. Under Section 5(2)(b)** because of the opponent's earlier trade mark.
- 2. Under Section 5(3)** because the opponent's earlier trade mark has a reputation in the UK.
- 3. Under Section 5(4)** by virtue of the law of passing-off.

The opponents say that prior to filing the opposition they had drawn the applicant's attention to their objections.

The applicants admit the existence, but not the validity of the opponent's earlier trade mark. They deny all of the grounds of opposition and ask that the Registrar exercise his discretion and allow the application to proceed.

Both sides ask for an award of costs in their favour.

Both sides filed evidence in these proceedings. The matter came to be heard on 26 March 2001, when the applicants were represented by Mr John Lewis of Trade Mark Owners Association Limited, their trade mark attorneys, the opponents were represented by Mr Richard Arnold of Her Majesty's Counsel, instructed by Marks & Clerk, their trade mark attorneys.

Opponent's evidence

This consists of a Statutory Declaration dated 5 May 1999, and executed by Robert Witherington, the Sales and Marketing Director of Vandemoortele UK Limited, a wholly owned subsidiary of Vandemoortele NV. Mr Witherington confirms that Alpro NV (the opponents) is also a wholly owned subsidiary of Vandemoortel NV. He says he has been associated with his company for almost five years and that the facts set out in his Declaration are from his own personal knowledge or have been obtained from company records of Vandemoortele UK Limited and Alpro NV.

Mr Witherington begins by confirming that Alpro NV has used the trade mark ALPRO on sweetened soya milk and soya flavoured drinks in the UK since 1983. He lists the turnover in respect of these goods for the years 1991 to 1997, which are as follows:

1991	£250,000
1992	£250,000
1993	£339,000
1994	£417,000
1995	£285,000
1996	£325,000
1997	£275,000

The cost of one unit of the product is currently £1.00 per litre.

Mr Witherington continues saying that Alpro NV has spent approximately £10,000 per year over the period 1991-1997 in promoting the products sold under the ALPRO trade mark.

He refers to exhibit RW1 which consists of two customer orders for the ALPRO product which he says show that customers use the trade mark ALPRO when ordering. Mr Witherington says that ALPRO is supplied to, amongst others, the supermarket chains Asda and Waitrose and that it is stocked in all of their branches throughout the UK.

Mr Witherington refers to the specification for 1219342, the earlier trade mark relied upon by the opponents, saying that the specification of goods for which it is registered covers proteins derived from soya beans and which in liquid form is often called soya milk.

Mr Witherington says that the trade marks ADPRO and ALPRO are confusingly similar since they are virtually identical, or extremely similar, differing only in respect of one letter which does not affect the pronunciation of the two marks. He asserts that there is a strong possibility of confusion or likelihood of association, especially when used in connection with identical or similar products. Mr Witherington gives his view that soya milk and ordinary milk are similar

products because one can be used as a substitute for the other.

Applicant's evidence

This consists of a Statutory Declaration dated 25 July 1999 and comes from Aaron Forde, the Managing Director of Adams Food Ingredients Limited (the applicants), a position he says he has held since 1998.

Mr Forde says that his company first used the trade mark ADPRO in the UK in 1996 in respect of milk proteins. He refers to exhibit AF1 which consists of an example of labels showing use of the mark applied for in connection with four different version of the product; ADPRO C, ADPROS/S, ADPRO 75 and ADPRO 400. He goes on to list the turnover and unit sales figures for the years 1996 to 1998, which are as follows:

Year	Turnover £	Units
1996	356,430	204.63
1997	171,824	50.33
1998	190,522	110.71

Mr Forde next refers to exhibit AF2 which consists of copies of four invoices dating from June to September 1997 relating to the sale of 25 kg packs of ADPRO S to three United Kingdom companies. He goes on to say the goods sold under the mark in the UK are specialised products which are sold in bags of 20 and 25 kilograms

Mr Forde says that goods sold under the ADPRO mark are not widely advertised or promoted, and although used by the customer when ordering, it is not referred to in the end product because it is an ingredient for various food products such as ice cream, yogurt etc. He concludes his declaration saying that the applicant's customers are food manufacturers who are knowledgeable and would not confuse the trade marks or the products.

That concludes my review of the evidence insofar as it is relevant to these proceedings.

Decision

In a letter dated 23 march 2001, the applicant's trade mark attorneys made a request that in the event of the Registrar finding there to be a likelihood of confusion, that they wished the scope of the application to be limited to the effect that the goods shall not be offered for sale to retail customers. I gave my preliminary views on this request at the hearing and will address this later in my decision.

In his skeleton argument submitted prior to the hearing, Mr Arnold stated that the ground founded under Section 5(3) would not be pursued. This leaves the grounds of opposition as being under Section 5(2)(b) and Section 5(4)(a).

Turning first to the ground under Section 5(2)(b) of the Act. That section 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 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.

The term earlier trade mark is itself defined in Section 6 as follows:

6 (1) In this Act an earlier trade mark means -

(a) a registered trade mark, international trade mark (United Kingdom) 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,

In determining the likelihood of confusion I look to the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] E.T.M.R. 2, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] E.T.M.R. 1, *Lloyd Schufabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] 45 F.S.R. 77 and *Marca Mode CV v Adidas AG* [2000] E.T.M.R. 723. It is clear from these that:-

a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*, paragraph 22;

(b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v Puma AG*, paragraph 23, 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 Schufabrik Meyer & Co. GmbH v Klijsen Handel B.V.* 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*, paragraph 23;

(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*, paragraph 23;

(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*, 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*, 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*, paragraph 26;

(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*, 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*, paragraph 29.

In deciding whether the respective goods are similar I look to the guidance of Jacob J. in *British Sugar Plc v James Robertson & Sons Ltd* (1996) RPC 281 and in the judgement of the European Court of Justice in *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* Case C-39/97 case. With these cases in mind I propose to consider the question of similarity by a consideration of the following factors:

- (a) The nature of the goods or services;
- (b) The end-users of the goods or services;
- (c) The way in which the goods or services are used
- (d) Whether the respective goods or services are competitive or complementary. This may take into account how those in trade classify goods and the 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) In determining whether similarity between the goods or services covered by two trade marks is sufficient to give rise to the likelihood of confusion, the distinctive character and reputation of the earlier mark must be taken into account.

Whilst I acknowledge that in the view of the *CANON - MGM* judgement by the European Court of Justice (3-39/97), the *TREAT* case may no longer be wholly relied upon, the ECJ said the factors identified by the UK government in its submissions, which are the factors listed in *TREAT*, are still relevant.

The opponents contend that even though the applicants say that they use the mark in connection with milk proteins for use as an ingredient in the manufacture of foodstuffs, the specification of the application is much broader covering milk products at large, and that the ordinary and usual meaning of the word “milk” would include the same sweetened soya milk and soya flavoured drinks for which their earlier mark is used and registered.

The opponent's earlier mark is registered in respect of proteins of vegetable origin in liquid or powder form, the exact scope of which is not entirely clear; does it cover proteins as a material or go wider to include products that are made from proteins? Taking the only meaning of the words of the specification into account, it must be both, the consequence of which is that the opponent's earlier mark would cover soya milk and soya flavoured drinks, both in liquid and powder form. The opponent's contention that the terms milk and milk products covers not only milk from cows, goats and other animals, but also such goods derived from plants, and notionally soya milk is, in my view correct, and consequently, I find that identical goods are involved.

The specification of the application clearly covers goods other than soya milk so my finding that the opponent's earlier trade mark and the application both cover soya milk is not the end of the matter as I need to go on consider whether there is identity in respect of any of the other goods for which the applicants seek registration.

Although there is nothing to say how the trade classifies the respective goods or whether a manufacturer or trader in dairy and non-soya milk products would also trade in the same products made from proteins such as soya, I believe it is reasonable to infer that companies operating in this industry could provide both non-soya milk and soya milk products. At the very least I would consider that producers of goods made from proteins of vegetable origin (which would include soya milk products) should be regarded as trading in close proximity to producers of milk and dairy products at large.

Apart from the statement by Mr Witherington, there is nothing in the evidence to say whether products derived from proteins such as soya would be considered to be complementary or an alternative to non-soya products, and whilst I have not been put in a position to reach an informed view in respect of the activities of manufacturers, I see no reason why a company making products from one type of material, dairy, vegetation or otherwise, should not also make the same product from other raw materials.

From my own knowledge I am aware that non-dairy milks, be it in liquid or powdered form are often used as alternatives to dairy milks. In his evidence Mr Witherington says that his company's product ALPRO is supplied to and sold by supermarket chains which must mean that such goods are sold in the same establishments. Although there is nothing to say whether these goods are sold alongside one another, it seems logical to me that having accepted that products made from proteins, be they in liquid or powdered form, may be used as an alternative to dairy milk and dairy milk products (again in liquid or powdered form) that they would be sold in close proximity. On this assessment I find that vegetable proteins of the opponent's earlier trade mark to be the same in nature, purpose and channels of trade, and consequently, that the similarity in the goods of the application goes beyond soya milk.

What is not clear is the range of goods that are capable of being covered by the term vegetable proteins and evidence to this effect would have been useful in determining the overlap in the respective specifications. Although the opponent's attack was primarily directed towards milk and milk products they did not concede that the other goods covered by the application were not similar. With some unease I find the similarity notionally to extend to all goods covered by the application.

It is appropriate at this stage to consider the effect of the limitation of the specification proposed by the applicants. The exclusion of sales to retail customers would, in my view, have no impact on my findings in respect of the similarity of the goods. It is ambiguous because it does not define the retail customers and could be taken to exclude any retailer in any part of the retail chain, be it manufacturer, wholesaler or supermarket, but more significantly, as the opponent's specification is not limited in any way it would still notionally cover the same customer base. Consequently a limitation of the specification along the lines suggested would be of no assistance.

Turning to the respective marks. Whilst it is clear that marks must be compared as a whole with due regard given to any dominant distinctive elements (although in this case I do not consider that any one element of either mark could be said to be more distinctive or dominant than any other) it is inevitable that in any comparison reference will be made to the individual components, distinctive or otherwise. The applicant is seeking to register the mark ADPRO which is self evidently not identical to the opponents earlier trade mark, ALPRO. As far as I am aware both are invented words with no obvious relevance for the goods. Placed side by side the similarities are plain to see. They are of the same length and differ only in respect of their second letter although being short words small differences can have a disproportionate effect on the similarity. Both consist of two syllables and would naturally be pronounced with emphasis on the common suffix "pro". That both marks have the same initial letter creates a strong visual similarity although the difference in the second letter has a significant effect on their sound when referred to in speech, but it must be borne in mind that words are not usually pronounced with regard to every letter or syllable. Other than the fact that they are invented words which share a common suffix, I do not see that there is much in the way of conceptual similarity.

Although the applicants say that they sell goods under their trade mark to food manufacturers, this is not reflected in the specification, and on a notional assessment I see no reason why the respective users should not be the same. I have already given my view that I consider the respective goods to complement or possibly be alternatives for one another. It is relevant that the respective goods are likely to be self-serve consumer items which means that the visual similarity of the respective marks is of primary importance. Although these may well be regarded as commonplace goods, given the range of milks available, for example, skimmed, whole, semi-skimmed, UHT, non-dairy, etc, the potential purchaser is likely to exercise a degree of care in the selection, particularly so in the case of a consumer looking for non-dairy milk for medical or ethical reasons. Whilst I acknowledge that the assessment of a likelihood of confusion should properly be made on the basis consumer who is "deemed to be reasonably well informed and reasonably circumspect and observant", where inexpensive goods are involved a consumer will probably pay less attention, and expecting a product to be in a familiar location, such as the chiller cabinet or supermarket shelf, is more likely to select one in mistake for the other. This is particularly so where there is strong visual similarity in the marks, as in this case.

At the date of application the opponents had been using their mark for around 14 years, although not in respect of vegetable proteins at large, but only sweetened soya milk and soya flavoured drinks. As an invented word it has a high degree of distinctiveness. Turnover figures show the trade to be significant but I have nothing by which to gauge how significant in

relation to the market for non-dairy milks, or if such goods are an alternative to other types of milk, the market for milk as a whole. In the absence of evidence by which to gauge the extent of the likely reputation or the uniqueness or otherwise of the opponent's mark in the market place, I am unable to consider it to warrant a wider penumbra of protection than would otherwise be the case. But in any event, given that the opponent's reputation is likely only to subsist in respect of goods which I have already found to be identical or similar to those capable of being covered by the application, this is of little consequence.

Taking all of the factors into account, and in particular, the distinctiveness and long standing use of the opponent's mark, its similarity to the mark tendered for registration and the identity in respect of the goods, I find there to be a real and definite likelihood of confusion on the part of the public should the applicants use their mark in respect of the goods for which they seek registration, and that the ground under Section 5(2)(b) succeeds.

My decision under Section 5(2)(b) effectively decides the matter and I therefore do not need to go on to give full consideration to the ground of opposition under Section 5(4)(a). Had I done so I do not consider that the opponent's would have been in any better position than under Section 5(2)(b). From the evidence it appears that they have used the mark ALPRO in the form in which it is registered, and based on their use which has been in respect of sweetened soya milk and soya flavoured drinks, that any reputation and goodwill would be in respect of these goods and would not extend to all goods covered by the application. Having concluded that the respective marks are similar and that there is identity in respect of the aforementioned goods, a finding that the public will be led to believe that the goods of the applicant are those of the opponent or that the two undertakings are associated, would, I believe have followed.

As the opponents have been successful they are entitled to a contribution towards their costs. I order the applicants to pay the opponents the sum of £835 in respect of this opposition. This to be paid within seven days of the expiry of the period allowed for filing an appeal or, in the event of an unsuccessful appeal, within seven days of this decision becoming final.

Dated this 14 day of September 2001

**Mike Foley
for the Registrar
The Comptroller General**