

TRADE MARKS ACT 1994  
 IN THE MATTER OF APPLICATION No 2192583  
 BY ICE POPS LIMITED  
 TO REGISTER A TRADE MARK IN CLASS 29


AND IN THE MATTER OF OPPOSITION THERETO  
 UNDER NUMBER 50059  
 BY SOCIETE DES PRODUITS NESTLE SA

BACKGROUND

1) On 23 March 1999, Ice Pops Limited of Unit B3, Haslemere Industrial Estate, Wigan Road, Bryn, Wigan, BN4 0BZ applied under the Trade Marks Act 1994 for registration of the mark JELLY POPS in respect of the following goods in Class 29 “Jellies; jelly-based products”.

2) On the 11 August 1999 Societe des Produits Nestle S.A. of Vevey, Canton of Vaud Switzerland filed notice of opposition to the application. The grounds of opposition, are in summary:

a) The opponent is the proprietor of two Trade Marks (shown below).

Mark	Number	Effective Date	Class	Specification
JELLYTOTS	1200924	2.8.83	30	Non-medicated confectionery in jelly form
	1452194	10.1.91	30	Non-medicated confectionery in jelly form: all included in Class 30.

b) The mark applied for is similar to those of the opponent and is sought to be registered in respect of goods similar to those for which the opponent’s marks are registered. There exists a likelihood of confusion on the part of the public which includes a likelihood of association with the opponent’s marks contrary to the provisions of Section 5(2)(b) of the Act.

3) The applicant subsequently filed a counterstatement denying the opponent’s claims. The applicant also claims to be the registered proprietor of other marks which it claims have a reputation “in the distinctive pops element”. These marks are ICE POPS (1135112), SNOW

POPS (1290290), SNOW POPS (B1196096) and GLENVILLE ICE POPS (960194).

4) Both sides filed evidence in these proceedings. Both sides ask for an award of costs. Neither side asked for a hearing. My decision will therefore be based on the pleadings and the evidence filed.

#### OPPONENT'S EVIDENCE

5) The opponent filed a declaration, dated 17 May 2000, by Sarah Dixon a legal adviser in the Legal Department of Nestle UK a position she has held for eight years. She states that her company is the affiliate and licensee of the opponent company.

6) Ms Dixon states that the trade mark JELLY TOTS was first used in the UK by Rowntree & Company Limited in 1965. The mark has been in continuous use in the UK since this date by its successors in business. The logo mark (1452194) has been used since 1992. Sales and advertising figures for the UK are provided as follows:

Year	Sales £	Advertising £
1993	8,700,000	49,000
1994	9,300,000	57,000
1995	9,200,000	36,000
1996	9,200,000	88,000
1997	9,900,000	112,000
1998	8,900,000	188,000

7) At exhibit SD1 Ms Dixon provides samples of the packaging currently used which she states has remained substantially unchanged since 1992. These samples all show use of the "logo" trade mark (1452194). At exhibit SD2 is a copy of an advertisement which shows the packaging used prior to 1992. The pre 1992 package has the words "Rowntree's Jelly Tots" printed vertically with the print size getting larger for each word. The last word (TOTS) being approximately five times larger than the word (Rowntree's). The post 1992 logo has a similar size differential and vertical layout.

8) At exhibit SD3 a video tape of television commercials is provided. This states that it contains advertisements between the years 1965 - 1979. As the latest advertisement was screened twenty years prior to the relevant date I do not consider it relevant.

9) Ms Dixon claims that during the last eight years a number of consumer promotions have been run. A selection are provided at exhibit SD4 and show that purchasers could win various prizes. At exhibit SD5 copies of trade press articles and advertisements between 1996- 1998. These show use of the "logo" mark (1452194) and in articles reference to the product as "Jelly Tots".

10) Ms Dixon contends that as a result of its "long and extensive use" that the mark has

acquired a reputation in the UK such that confectionery sold under the mark in suit would “likely be confused or associated with the products of my company”.

11) Ms Dixon refers to the claim in the applicant’s counterstatement that it is:

- a) the proprietor of the marks ICE POPS and SNOW POPS.
- b) that these marks enjoy a reputation in particular in relation to the element POPS, and
- c) that the mark in suit would be associated with the applicant’s other marks instead of with the opponent’s mark.

12) Ms Dixon states that she understands the mark POPS to be used generically in relation the context of ice cream and confectionery as an abbreviation of the word lollipop or popsicle. At exhibit SD6 she provides a list of marks on the UK Register which include the word “pops”. The list contains four trade marks registered for both ice cream and confectionery and a further ten marks registered for confectionery.

#### APPLICANT’S EVIDENCE

13) The applicant filed a witness statement, dated 6 September 2000, by Peter Tighe a director of the applicant company. At exhibit PT1 Mr Tighe provides an example of how the applicant intends to use the mark. The exhibit shows the mark in suit with a description of the product as “jelly tubes” with the claims “No Spoon” “No mess”. Mr Tighe states that the product sold under the mark in suit is “jelly and jelly based goods being presented in the form of sachets of soft jelly”. He claims that the product is to be marketed as a snack or meal supplement and “will be targeted at what is known as the hand held snack or lunch box market in a similar manner to yoghurt pots or spicy sausage snacks.

14) Mr Tighe claims that the product will be sold as a “no-added sugar” product and so would not be a confectionery product. He states that the product would be sold in multi-packs of ten or twenty sachets and not individually. Further, he claims that the product would be stocked alongside drinks or other jelly products and not with confectionery.

15) Mr Tighe contends that the marks are quite dissimilar in that the JELLY part of each mark is descriptive and the words POPS and TOTS are visually, phonetically and conceptually dissimilar. He states that the word TOTS is associated with a small child or toddler whereas POPS has no such connotation and is a most unusual word to use with the word JELLY.

16) Regarding the other marks on the UK Register, Mr Tighe states that only four of the marks shown are registered for frozen confectionery and as such this is not sufficient to show that the mark POPS is generic for water ices.

#### OPPONENT’S EVIDENCE IN REPLY

17) The opponent filed a further statutory declaration, dated 12 April 2001, by Sarah Dixon. In this declaration Ms Dixon reaffirms her contention that the words POPS in relation to water ices is an abbreviation of the word “popsicle” which she claims is commonly used in the USA

to denote an ice lolly. At exhibit SD1 She provides an internet search which shows a number of hits which suggest that the word popsicle is a term for an ice lolly. One of the hits is from "A Dictionary of Food and Nutrition" published by the Oxford University Press.

18) Ms Dixon states:

"I accept that the primary connotation of the word popsicle and hence the abbreviation pops is American, but the term does make an appearance in a reference book published in the UK. Further, companies other than the applicant are currently selling water ices under trade marks including the word pops. Exhibit SD2 to this declaration consists of examples of packaging for FREEZEPOPS sold by Calypso Soft Drinks and BUG POPS sold by my company."

19) That concludes my review of the evidence. I now turn to the decision.

## DECISION

20) The only ground of opposition is under Section 5(2)(b) of the Act 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 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."*

21) An earlier right 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,*

*(b)...*

*(c) a trade mark which, at the date of application for registration of the trade mark in question or (where appropriate) of the priority claimed in respect of the application, was entitled to protection under the Paris Convention as a well known trade mark."*

22) In determining the question under section 5(2), I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel Bv v Puma AG* [1998 RPC 199], *Canon Kabushiki Kaisha v Metro-Goldwyn-Meyer Inc.* [1999] E.T.M.R. 1, *Lloyd Schfabrik 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 Schfabrik 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-Meyer 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-Meyer Inc.* page 9, paragraph 29.

23) The mark in suit is sought to be registered for “Jellies; jelly-based products” in Class 29. The opponent’s marks are registered for “Non-medicated confectionery in jelly form” in Class 30. Clearly the specification of the mark in suit encompasses the specification of the opponent’s marks. The goods must therefore be regarded as identical. It is clear from the above cases that in the overall assessment of a likelihood of confusion, the similarity of goods is but one aspect. Due regard should be given to the closeness of the respective marks, the reputation the earlier mark enjoys in respect of the services for which it is registered, and any other relevant factors.

24) In my view the opponent’s strongest case is provided by trade mark 1200924 which is a word mark, unlike trade mark 1452194 which contains a prominent device element.

25) Visually the marks differ in that the opponent's mark is conjoined whereas the applicant's mark is two words. However, I do not place any significance upon this as I believe that the average consumer will in viewing the mark clearly see the two words. The marks therefore share the first word JELLY. They differ in their second words (TOTS and POPS).

26) Phonetically the marks have common beginnings but different endings.

27) The "jelly" part of each word would be seen as describing the material that the product is made from. The second word in the opponent's mark, "Tots", has a clear dictionary definition and refers to young children or toddlers. In this context its other meaning of small would also be seen. Thus an overall meaning of small pieces of jelly for small or young children would be conveyed. In contrast the applicant's mark uses the word "pops". Again this is a dictionary word and would be recognised as referring to a sound. However, when conjoined with the word jelly it gives an unusual combination.

28) The opponent's product is literally the oft referred to "bag of sweets". I accept that such purchases are not lingered over or considered in particular depth. Allowance must also be made for the notion of imperfect recollection.

29) The opponent has provided evidence of its sales in the UK and also details of advertising and promotions. However, no information on the size of the confectionery market has been provided and so I am unable to judge whether the mark has a particularly distinctive character because of the use made of it. In such circumstances the opponent's mark cannot be regarded as enjoying an above average reputation at the relevant date.

30) With all of this in mind I come to the conclusion that when all factors are considered, that there was no realistic likelihood of confusion at 23 March 1999. Consequently, the opposition under Section 5(2)(b) fails.

31) The opposition having failed the applicant is entitled to a contribution towards costs. I order the opponent to pay the applicant the sum of £600. 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 5th day of December 2001

George W Salthouse  
For the Registrar  
The Comptroller General