

O-058-04

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION
NO. 2292369 IN THE NAME OF
MOY PARK LTD
TO REGISTER A TRADE MARK IN CLASSES 29 AND 30**

AND

**IN THE MATTER OF OPPOSITION
THERE TO UNDER
NO. 90694 BY
WIESENHOF GEFLÜGEL-KONTOR GMBH**

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Application No. 2292369
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Wiesenhof Geflügel-Kontor GmbH**

Background

1. On 9 February 2002 Moy Park Ltd applied to register the mark CHICKEN POPS. Following amendment the specification of goods is as follows:

Class 29: Chickens (not live) and food products made wholly or substantially wholly from chicken all for human consumption; prepared meals and snack foods and ingredients therefor.

Class 30: Prepared meals and ingredients therefor; snack foods, except snack foods containing breakfast cereals as a principal ingredient; cereals, except for breakfast cereals and cereals sold as breakfast foodstuffs.

2. The application is numbered 2292369.

3. On 13 June 2002, Wiesenhof Geflügel-Kontor GmbH filed notice of opposition. In the statement of grounds the opponent says it is the owner of the following Community Trade Mark:

1522283 chicken-popcorn

for the following specification of goods:

Class 29: Slain poultry and parts of poultry, as well as food-specialities made of poultry, also including convenience goods; poultry breaded or marinated, also as ready-to-be-served meals, prepared dishes, deep-frozen food and soups, the latter including instant soup.

Class 30: Life (sic) poultry, animal foodstuffs made of poultry or parts thereof.

4. The opponent says it is also the owner of the following Community Trade Marks:

1524222 hähnchen-popcorn
1523158 turkey-popcorn

1524156 puten-popcorn

and that as “hähnchen” is the German word meaning Chicken and “puten” the German word meaning Turkey these three marks are “on all fours” with its chicken-popcorn mark.

5. The opponent says that because all of its marks are earlier and similar marks and are for identical or similar goods to the applicant’s mark, there exists a likelihood of confusion which includes the likelihood of association and that the application should be refused under section 5(2)(b) of the Act. Attached to the notice of opposition are printouts of the opponent’s marks from the Community Trade Mark Office database.

6. The applicant filed a counterstatement in which it admitted the opponent is the registered proprietor of Community trade mark No. 1522283 but makes no admission as to whether it constitutes an earlier mark under Section 6(1)(a) and 6(2) of the Act. The applicant denies the marks are confusingly similar. The applicant refers to two other registrations, namely No. B1513226 for POPCORN CHICKEN in the name of Kentucky Fried Chicken (Great Britain) Ltd and No. 1522283 for PIC ‘N’ POPPIN CHICKEN in the name of Plusfood (UK) Ltd registrations which, it submits shows the public can be expected to differentiate between the applicant’s and opponent’s respective marks. They also say that because of the registration of B1513226 the opponent’s mark is fatally flawed, implying, I assume, that the opponent’s mark will not achieve registration.

7. Both parties request an award of costs.

8. In line with current registry practice, the registrar wrote to the parties and advised that having reviewed all the papers filed, there was sufficient information available to enable a decision to be reached without recourse to a hearing. The parties were, however, reminded of their right to be heard or to make written submissions in lieu thereof. Neither party requested a hearing in this matter and no further submissions were filed. After a careful study of all the papers and acting on behalf of the Registrar, I now give this decision.

Opponent’s evidence

9. This takes the form of a witness statement dated 12 November 2002 by Victor Ivan Caddy. Mr Caddy says he is the registered trade mark attorney representing the opponent in these proceedings.

10. Mr Caddy states that the opponent is the proprietor of Community trade mark application No. 1522283 for the mark “chicken-popcorn” and exhibits details of this mark. He states that he is informed by his instructing German lawyers that the opponent has not yet used its mark in the UK although it intends to do so and does use it in other parts of the European Union.

11. Much of the rest of Mr Caddy’s witness statement is submission and commentary and for that reason I do not intend to summarise it here although I have read it carefully and will make reference to it as necessary in this decision. Suffice to say that Mr Caddy exhibits printouts from a variety of websites showing the use of the

words “pop” and “popcorn” to show that they are, as he puts it, “closely associated and even interchangeable”. He comments on the similarity or otherwise of the two third party registrations the applicant mentions in its counterstatement and adds that registration No. B1513226 is subject to an invalidity action filed by the opponent to the current proceedings. Finally, he observes that the goods covered by the application are identical to those covered by the opponent’s marks.

Applicant’s evidence

12. This takes the form of a statutory declaration dated 10 February 2003 by Charles Henry Edward Jennings. Mr Jennings says he is the registered trade mark attorney representing the applicant in these proceedings.

13. Mr Jennings says the applicant admits the opponent has applied to register the mark “chicken-popcorn” as a Community trade mark under No. 1522283. He says that it is subject to an opposition by Kentucky Fried Chicken (Great Britain) Ltd on the grounds of conflict with their prior UK registration No. 1513226 POPCORN CHICKEN.

14. Mr Jennings says the applicant has made substantial use of the mark CHICKEN POPS in the UK since December 2001 but does not give any details of this use.

15. Much of the rest of Mr Jennings’ declaration is again submission and commentary which I will not summarise but have read and will refer to as necessary. Mr Jennings does, however, attach two exhibits to his evidence. These are:-

- CJ1 – POPCORN CHICKEN packaging which he says he “recently” bought from his local KFC outlet in Surrey but which he understands is available in other KFC branches throughout the country.
- CJ2 –a variety of printouts from the Internet to show that a number of companies and hotels use the words POPCORN CHICKEN and/or CHICKEN POPCORN.

Applicant’s evidence in reply

16. This takes the form of a second witness statement from Victor Ivan Caddy this time dated 8 May 2003. The statement is short and merely serves to clarify the position as regards the internet search carried out by him and reported in his earlier witness statement.

17. That completes my summary of the evidence.

Decision

18. The single ground of opposition is based on Section 5(2)(b) of the Act. This reads:

“(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.”

The term “earlier trade mark” is defined in Section 6 of the Act as follows:

“6.- (1) In this Act and “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)....

(2) Reference 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.”

19. The application in suit was applied for on 9 February 2002. Each of the opponent’s marks were applied for on 24 February 2000 and claim priority from 23 October 1999. CTM 1523158 and CTM 1524156 have been registered and are earlier marks. CTM 1522283 and CTM 1524222 have not reached registration, however, subject to their being so registered, would be earlier marks.

20. As I indicated earlier in this decision, in its counterstatement the applicant makes reference to two existing third party registrations. The applicant implies that one of these registrations would be likely to prevent the opponent’s own application achieving registration and that the other shows how the consumer differentiates between marks. I have not been directed to any authority which supports my considering these other registrations and the effect they may have on the opponent’s own application for registration in this way. The existence of other registrations is no more than state of the register evidence. As Mr Justice Jacob commented in *British Sugar Plc v James Robertson & Sons Ltd* [1996] RPC 281:

“Both sides invited me to have regard to the state of the register. Some traders have registered marks consisting of or incorporating the word “Treat”. I do not think this assists the factual enquiry one way or the other, save perhaps to confirm that this is the sort of word in which traders would like a monopoly. In particular the state of the register does not tell you what is actually

happening out in the market and in any event one has no idea what the circumstances were which led the registrar to put the marks concerned on the register. It has long been held under the old Act that comparison with other marks on the register is in principle irrelevant when considering a particular mark tendered for registration, see e.g. *Madam Trade Mark* and the same must be true under the 1994 Act. I disregard the state of the register evidence.”

21. The process of examination of the applications for registration of the opponent’s marks is a separate issue to the decision I have to make in the instant case and cannot form part of my considerations. I will therefore say no more about these two third party registrations. I have to compare the applicant’s mark to those of the opponent, whilst recognising the status of the opponent’s marks.

22. I therefore take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] E.T.M.R. 1, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] E.T.M.R. 1, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG* [2000] E.T.M.R. 723.

23. 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*, 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 Schuhfabrik 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*, page 224;
- (d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v. Puma AG*, page 224;
- (e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, page 132, 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 224;

- (g) account should be taken 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 was registered; *Lloyd*, paragraph 29;
- (h) 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;
- (i) 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;
- (j) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, page 333, paragraph 29.

24. There is no dispute that the application in suit and the opponent's mark cover identical goods.

25. The respective marks must be compared as a whole and by reference to their overall impression but, as recognised in *Sabel BV v Puma AG*, in any comparison reference will inevitably be made to the distinctiveness and prominence of individual elements. It is, of course, possible to over analyse marks and in doing so shift away from the real test which is how marks would be perceived by consumers in the normal course of trade and I bear this in mind when making the comparison.

26. The mark in suit comprises the words CHICKEN POPS. The word CHICKEN merely describes the main ingredient or intended flavour of a product. The word POPS is an ordinary dictionary word which, I believe, would be recognised as referring to either a light explosive sound (e.g. it went "pop") or the placing of something with a sudden movement (e.g. he popped it into his mouth). The word CHICKEN is not distinctive for the goods in question but there is a degree of distinctiveness in the word POPS and in the combination of the two words.

27. The first mark the opponent relies on, CTM 1522283, comprises the hyphenated words CHICKEN and POPCORN. Again the word CHICKEN merely describes the main ingredient or intended flavour of a product. The word POPCORN is an ordinary dictionary word. It is defined in the Collins Dictionary 3rd Ed. as "the hard kernels of maize which puff up when heated" or "the puffed up kernels of this plant". Attached to Mr Jennings' evidence are a number of printouts from various websites. These printouts show use of the word POPCORN by a number of third parties in relation to poultry products of a particular nature. Some of the printouts bear representations of these goods and show them to bear a resemblance to cooked popcorn. From these exhibits it appears to me that use of the word popcorn has a semi-descriptive meaning for small, irregular-shaped, crunchy pieces of coated chicken. The word POPCORN and the combination of the words CHICKEN and POPCORN have a degree of

distinctiveness but again, the combination is not one that is particularly high for these goods. The opponent's mark is unused in the UK.

28. Making a visual comparison of the respective marks, it is clear that both marks share the descriptive first word CHICKEN. The applicant's mark has the second word POPS whilst the opponent's mark has the second word POPCORN. Whilst each of these second words share a common beginning in the letters POP, the endings of each of the marks is different as is the length of the two words. In addition, the opponent's mark also contains a hyphen. The visual impact of each of the two marks is quite distinct.

29. Aurally, similar considerations apply. The beginnings of the two marks are the same as they share the first word CHICKEN. The second word of the applicant's mark (POPS) is a single syllable, which is short and somewhat alliterative. The second word of the opponent's mark (POPCORN) is longer and is made up of two separate and aurally distinct syllables. The two syllables make up a well known word in its own right, one which, I believe, would be recognised easily by the vast majority of English speakers.

30. On the conceptual comparison, Mr Caddy submits that the words POPS and POPCORN are closely associated and even interchangeable and that they are therefore conceptually similar. He exhibits a number of printouts from a variety of websites to support his claim. Mr Jennings disagrees with Mr Caddy's submissions. He says there is no evidence that the words POPS and POPCORN are closely associated and they are not interchangeable. The word POPS is, he says, often used to convey a sound and not the concept of fluffy popcorn.

31. I do not find the documents exhibited by Mr Caddy to be persuasive. They are all dated as being downloaded well after the relevant date although some bear earlier copyright dates or release dates. I do not intend to go through each document separately here. Suffice to say that whilst some show the words pop and pops used in close proximity with the word popcorn I do not find this surprising given that pop or pops are words with alliterative references to the sound popcorn produces either when being cooked or being eaten. I am prepared to accept that the words pop or pops are commonly used when referring to popcorn but I do not accept the words are interchangeable. For example, in relation to comestibles I believe that someone asking for pop or pops would most likely be served with a soft drink. And if someone wanted popcorn, they would not get it by asking for pop or pops; they would have to ask specifically for popcorn. But in any event all of this is somewhat of a spurious argument because the goods in question here are not pop or popcorn. In this context I believe the words CHICKEN POPS brings to mind a chicken (flavoured) product that one "pops" into something else e.g. into a microwave oven to cook or into one's mouth to eat. In contrast the words CHICKEN POPCORN suggests a chicken product made using popcorn as an ingredient or which resembles (cooked) popcorn. I find the respective marks to be conceptually different.

32. Where one element of a mark is purely descriptive, it will reduce (but not extinguish) the impact of that element and highlight the other elements of the mark. The element "chicken" is purely descriptive of the opponent's goods. But I bear in mind that the average consumer perceives a mark as a whole and does not analyse its

component parts. Comparing the marks as wholes, they have some visual and aural similarities but they also have significant visual, aural and conceptual differences.

33. In assessing the degree of similarity between the respective marks and whether this is likely to give rise to a likelihood of confusion, I must consider the average consumer of the goods. In this case, the average consumer is likely to be one who eats chicken, snacks or ready meals or who buys and prepares these food items for others to eat. These are not gourmet ingredients but an everyday product and the consumer here is not a specialist or sophisticated one. But that is not to say that the goods will be bought with no thought. The average consumer is likely to take some degree of care in making his/her choice.

34. There is no dispute that identical goods are involved. I have found that there are some visual and aural similarities between the applicant's mark and the opponent's CHICKEN-POPCORN mark but I have also found that there are significant differences, particularly conceptual differences between them. In respect of each of the opponent's other three marks the differences are even greater, visually, aurally and conceptually, in view of the difference between the first element of each of the respective marks and the mark in suit. On a global appreciation I consider there to be greater differences than there are similarities in respect of each of the marks the opponent relies on, such that I do not consider there to be any likelihood of confusion in respect of any of the opponent's marks even allowing for imperfect recollection. The opposition fails under Section 5(2)(b).

Implementation of this decision and appeal

35. Whilst I have found the opponent to be unsuccessful in respect of each of the four marks it relies upon, only two of those marks have completed the registration process. Two marks are still pending before the Community Trade Mark Office (OHIM) and therefore are not, at this time, earlier marks within the meaning of Section 6(2).

36. Should the opponent wish to appeal my decision little would be gained by either party for this to be done in respect of the opponent's pending applications before their fates have been determined by OHIM. Consequently, this decision is a provisional one as far as the opponent's pending marks are concerned. I hereby direct the opponent to inform the registry once the applications in question have been determined. At that point a supplementary decision will be issued confirming the rejection of the opposition in respect of those marks.

37. The period for appeal in respect of the opposition based on the opponent's pending applications CTM 1522283 and CTM 1524222 will commence from the date of that supplementary decision. In respect of the opposition based on the opponent's registered marks CTM 1523158 and CTM 1524156, the period for appeal begins from the date of this decision.

Costs

38. I make no order for costs at this stage. The matter of costs in respect of the

opposition as a whole will be covered in the supplementary decision.

Dated this 3rd day of March 2004

Ann Corbett
for the Registrar
the Comptroller General