

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION No. 2466269  
BY EUROSNAKS UK LIMITED TO REGISTER THE  
TRADE MARK  
MUNCHIPS  
IN CLASSES 29, 30 & 35**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER NO. 96738 BY  
LORENZ BAHLSEN SNACK-WORLD HOLDING GMBH & CO. KG**

## BACKGROUND

1) On 7 September 2007 Eurosnacks UK Limited applied to register the trade mark MUNCHIPS. It also claimed a priority date of 9 August 2007 based on an OHIM registration, number 6184956. After examination, the trade mark was accepted and subsequently published for opposition purposes on 15 February 2008 in Trade Marks Journal No.6701 for the following goods and services:

Class 29: Meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies, jams, fruit sauces; eggs, milk and milk products; edible oils and fats.

Class 30: Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, pastry, ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice.

Class 35: Retail services connected with the sale of meat, fish, poultry and game, meat extracts, preserved, dried and cooked fruits and vegetables, jellies, jams, fruit sauces, eggs, milk and milk products, edible oils and fats, coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee, flour and preparations made from cereals, bread, pastry and confectionery, ices, honey, treacle, yeast, baking-powder, salt, mustard, vinegar, sauces (condiments), spices, ice.

2) On 31 March 2008 Lorenz Bahlsen Snack-World Holding GmbH & Co. KG (the opponent) filed a notice of opposition. In summary the opposition is based upon the following:

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

Mark	Number	Filing date / registration date	Class	Specification
CRUNCHIPS	1034439	22.08.74/ 19.05.76	29	Preserved, dried and/or cooked potato products for food, all in the form of chips.
CRUNCHIPS	1512273	08.09.92 / 11.08.95	29	Potato chips included in Class 29.
CRUNCHIPS	CTM52548	01.04.96 / 26.11.98	29	Potato crisps.

b) The opponent states that the goods and services in Classes 29, 30 and 35 are identical and/or similar and that the marks are similar. They contend that the last seven letters of each mark (UNCHIPS) are identical. Further, that the initial part of each mark “MUNCH” and “CRUNCH” are similar as both are onomatopoeic words for eating noises.

c) Copies of the relevant entries in Collins Concise Dictionary (Third Edition) are provided which give the following definitions for each word:

“CRUNCH: to bite or chew with a crushing or crackling sound.” And  
“MUNCH: to chew (food) steadily, esp. with a crunching noise.”

d) Copies from Roget’s Thesaurus show that “Crunch” and “Munch” are considered synonyms.

e) The opponent claims to have a reputation in its marks in the UK. The mark in suit is said to offend Sections 5(2)(b) and 5(3) of the Trade Marks Act 1994.

3) On 16 June 2008 the applicant filed a counterstatement denying the opponent’s contentions.

4) Only the opponent filed evidence in these proceedings which to the extent that I consider it necessary I have summarised below. Neither side wished to be heard but both provided written submissions which I shall refer to as and when necessary.

#### **OPPONENT’S EVIDENCE**

5) The opponent filed two witness statements. The first, dated 8 December 2008, is by Mathias Roeper the Senior Export Manager of Lorenz Bahlsen Snack-World GmbH & Co KG, a wholly owned subsidiary of the opponent company. He has held this position since 1999 and is authorised to make the statement and has used his own knowledge and also company records.

6) He states that the mark CRUNCHIPS was first used by the opponent in the UK in 1998 on potato crisps. The goods have been sold under the marks CRUNCHIPS X-CUT (since 1998) CRUNCHIPS STACKERS (since summer 2002) and CRUNCHIPS LIGHT (since 2007), all in a variety of flavours. At exhibit MR1 he provides photographs of packaging for crisps which shows use of the three marks mentioned, but these are undated. At exhibit MR2 he provides copies from the opponent’s website which also shows use of these marks on packaging for crisps, dated October 2008. He also provides the following annual sales figures (all in Euros) for each of the three marks as follows:

Year	Crunchips X-cut	Crunchips Light	Crunchips Stackers
2004	€5,000		€18,000
2005	€4,000		
2006	€3,000		
2007	€4,000	€4,000	
2008 (till Sept)	€8,000	€1,000	

7) Mr Roeper does not state which country the above sales figures relate to. At exhibit MR3 he provides a number of samples of actual packaging which shows use of the three marks on potato crisps, all of which are dated 2008/09, after the relevant date.

8) The second witness statement, dated 15 January 2009, is by Claire Louise Mounteney the opponent’s Trade Mark Attorney. She states that her information has been provided by the

opponent company, and in particular its UK sales manager. She states that although some of the packaging supplied by Mr Roeper is in German, these items were sold in this packaging in the UK. Profit margins are very low on these items and so repackaging and advertising is not something which the applicant has been able to fund. The only advertising has been via the company website and point of sale advertising.

9) Ms Mounteney confirms that the products are sold throughout the UK, in particular she mentions they are sold through Spar and Budgens outlets. At exhibit CLM1 she provides a list of outlets supplied by the opponent which is said to cover the whole of the UK, but no addresses are listed. She also confirms that the sales figures provided by Mr Roeper were for the UK, and are in Euros as the opponent is a German company. At exhibit CLM2 she provides copies of invoices dated 17 June 2003- 20 October 2008. All of these are addressed to a single company, G Costa & Co Ltd of Aylesford, which after the relevant date appears to change its name to AB World Foods.

10) That concludes my summary of the evidence filed.

## **DECISION**

11) The opposition is based upon sections 5(2)(b) and 5(3). I shall first deal with the opposition under Section 5(2)(b) which reads:

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

(a) ....

(b) it is similar to an earlier 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, 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), 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,”

13) In these proceedings the opponent is relying upon three earlier marks. these were registered on 19 May 1976, 11 August 1995 and 26 November 1998 respectively and are therefore subject to The Trade Marks (Proof of Use, etc) Regulations 2004, paragraph six of which states:

“6A Raising of relative grounds in opposition proceedings in cases of non-use.

- (1) This section applies where-
  - (a) an application for registration of a trade mark has been published,
  - (b) there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and
  - (c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.
- (2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.
- (3) The use conditions are met if-
  - (a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or
  - (b) the earlier trade mark has not been so used, but there are proper reasons for non-use.
- (4) For these purposes-
  - (a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and
  - (b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.
- (5) In relation to a Community trade mark, any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.
- (6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.
- (7) Nothing in this section affects –
  - (a) the refusal of registration on the grounds mentioned in section 3 (absolute grounds for refusal) or section 5(4) (relative grounds of refusal on the basis of an earlier right),  
or

(b) the making of an application for a declaration of invalidity under section 47(2) (application on relative grounds where no consent to registration).”

14) In the instant case the publication date of the application was 15 February 2008. Therefore, the relevant period for the proof of use is 16 February 2003- 15 February 2008. I must first consider whether the opponent has fulfilled the requirement to show that genuine use of the marks has been made. The guiding principles to be applied in determining whether there has been genuine use of a mark are *Ansul BV v Ajax Brandbeveiliging BV* [2003] R.P.C. 40 and *Laboratoire de la Mer Trade Mark* [2006] F.S.R. 5. From these cases I derive the following main points:

- genuine use entails use that is not merely token. It must also be consistent with the essential function of a trade mark, that is to say to guarantee the identity of the origin of goods or services to consumers or end users (*Ansul*, paragraph 36);
- the use must be ‘on the market’ and not just internal to the undertaking concerned (*Ansul*, paragraph 37);
- it must be with a view to creating or preserving an outlet for the goods or services (*Ansul*, paragraph 37);
- the use must relate to goods or services already marketed or about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns (*Ansul*, paragraph 37);
- all the facts and circumstances relevant to determining whether the commercial exploitation of the mark is real must be taken into account (*Ansul*, paragraph 38);
- the assessment must have regard to the nature of the goods or services, the characteristics of the market concerned and the scale and frequency of use (*Ansul*, paragraph 39);
- but the use need not be quantitatively significant for it to be deemed genuine (*Ansul*, paragraph 39);
- an act of importation could constitute putting goods on the market (*Laboratoire de la Mer*, paragraph 25 referring to the earlier reasoned order of the ECJ);
- there is no requirement that the mark must have come to the attention of the end user or consumer (*Laboratoire de la Mer*, paragraphs 32 and 48);
- what matters are the objective circumstances of each case and not just what the proprietor planned to do (*Laboratoire de la Mer*, paragraph 34);

- the need to show that the use is sufficient to create or preserve a market share should not be construed as imposing a requirement that a significant market share has to be achieved (*Laboratoire de la Mer*, paragraph 44).

15) I must also keep in mind the guidance in *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32 in relation to determining what constitutes a fair specification, namely:

“29 I have no doubt that Pumfrey J. was correct to reject the approach advocated in the Premier Brands case. His reasoning in paras [22] and [24] of his judgment is correct. Because of s.10(2), fairness to the proprietor does not require a wide specification of goods or services nor the incentive to apply for a general description of goods and services. As Mr Bloch pointed out, to continue to allow a wide specification can impinge unfairly upon the rights of the public. Take, for instance, a registration for "motor vehicles" only used by the proprietor for motor cars. The registration would provide a right against a user of the trade mark for motor bikes under s.10(1). That might be understandable having regard to the similarity of goods. However, the vice of allowing such a wide specification becomes apparent when it is envisaged that the proprietor seeks to enforce his trade mark against use in relation to pedal cycles. His chances of success under s.10(2) would be considerably increased if the specification of goods included both motor cars and motor bicycles. That would be unfair when the only use was in relation to motor cars. In my view the court is required in the words of Jacob J. to "dig deeper". But the crucial question is--how deep?

30 Pumfrey J. was, I believe, correct that the starting point must be for the court to find as a fact what use has been made of the trade mark. The next task is to decide how the goods or services should be described. For example, if the trade mark has only been used in relation to a specific variety of apples, say Cox's Orange Pippins, should the registration be for fruit, apples, eating apples, or Cox's Orange Pippins?

31 Pumfrey J. in *Decon* suggested that the court's task was to arrive at a fair specification of goods having regard to the use made. I agree, but the court still has the difficult task of deciding what is fair. In my view that task should be carried out so as to limit the specification so that it reflects the circumstances of the particular trade and the way that the public would perceive the use. The court, when deciding whether there is confusion under s.10(2), adopts the attitude of the average reasonably informed consumer of the products. If the test of infringement is to be applied by the court having adopted the attitude of such a person, then I believe it appropriate that the court should do the same when deciding what is the fair way to describe the use that a proprietor has made of his mark. Thus, the court should inform itself of the nature of trade and then decide how the notional consumer would describe such use.”

16) The comments of Mr Justice Jacob (as he then was) in *Animal Trade Mark* [2004] FSR 19 are also relevant.

“20 The reason for bringing the public perception in this way is because it is the public which uses and relies upon trade marks. I do not think there is anything technical about

this: the consumer is not expected to think in a picky way because the average consumer does not do so. In coming to a fair description the notional average consumer must, I think, be taken to know the purpose of the description. Otherwise they might choose something too narrow or too wide. Thus, for instance, if there has only been use for three holed razor blades imported from Venezuela (Mr T.A. Blanco White's brilliant and memorable example of a narrow specification) "three-holed razor blades imported from Venezuela" is an accurate description of the goods. But it is not one which an average consumer would pick for trade mark purposes. He would surely say "razor blades" or just "razors". Thus the "fair description" is one which would be given in the context of trade mark protection. So one must assume that the average consumer is told that the mark will get absolute protection ("the umbra") for use of the identical mark for any goods coming within his description and protection depending on confusability for a similar mark or the same mark on similar goods ("the penumbra"). A lot depends on the nature of the goods--are they specialist or of a more general, everyday nature? Has there been use for just one specific item or for a range of goods? Are the goods on the High Street? And so on. The whole exercise consists in the end of forming a value judgment as to the appropriate specification having regard to the use which has been made."

17) The opponent has the word CRUNCHIPS registered for the following goods in Class 29: "Preserved, dried and/or cooked potato products for food, all in the form of chips"; "Potato chips included in Class 29" and "Potato crisps". Although the evidence of use is limited it is quite clear that the opponent has used the marks "Crunchips X-Cut", "Crunchips Light" and "Crunchips Stackers" on crisps and/or potato products in the UK in the relevant period. This evidence is unchallenged and even in the applicant's submissions no reference is made regarding this issue. In my opinion, the additions to the mark Crunchips, would be seen as being purely descriptive of the product ie the potatoes are cross cut, are less fattening, or are formed so that each is exactly the same and can be stacked on top of each other. The word Crunchips is the trade mark. I therefore do not intend to amend the specifications of the opponent's marks as they appear to accurately reflect the usage shown.

18) In my consideration of a likelihood of confusion, I take into account the guidance from the settled case law provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs)(OHIM)* C-334/05 P (LIMONCELLO). It is clear from these cases that:

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

(b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v Puma AG*, who is deemed to be reasonably well informed and reasonably circumspect and observant - but who rarely has the chance to make direct comparisons between



marks and must instead rely upon the imperfect picture of them he has kept in his mind; *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*,

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v Puma AG*,

(d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v Puma AG*,

(e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*,

(f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v Puma AG*,

(g) 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; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*,

(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*,

(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 and Adidas Benelux BV*,

(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.*,

(k) assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark; the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components; *Medion AG v. Thomson Multimedia Sales Germany &*

*Austria GmbH*

(l) it is only when all other components of a complex mark are negligible that it is permissible to make the comparison on the basis of the dominant element; *Shaker di L. Laudato & C. Sas v OHIM*

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

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

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

21) The opponent contends that it has shown reputation in its mark with regard to savoury potato snack products including crisps and potato chips. However, the evidence in support of this contention is very sparse. They claim to have sold to Spar and Budgens, although these names do not appear on the, admittedly lengthy, list of purchasers. The list provided at first glance appears substantial, but no addresses are provided, nor are any details of the number of outlets each customer has, or whether they were customers prior to the relevant date. The invoices provided

are all addressed to a single customer and the overall sales figures provided are paltry, such that the opponent chooses not to put them in context with regard to the UK market for such items. I accept that the opponent has shown that it has some reputation but it is quite minor. The fact that the evidence has not been challenged does not mean that I should accept all the opponent's contentions at face value even if there is no corroborating evidence to back them up. The applicant contended that the opponent's mark was lacking in inherent distinctiveness as a number of marks are registered for goods in Class 30 that have the prefix "CRUN" or the suffix "CHIPS". But even if such marks are registered, "state of the Register" evidence is not conclusive. To my mind all three of the opponent's marks are inherently distinctive enough to achieve registration but this has not been enhanced by use. Neither side commented upon the average consumer but it would seem clear that this must be the average citizen of the UK.

22) I shall first consider the specifications of both parties which are as follows:

Applicant's specification	Opponent's specification
<p>Class 29: Meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies, jams, fruit sauces; eggs, milk and milk products; edible oils and fats.</p> <p>Class 30: Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, pastry, ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice.</p> <p>Class 35: Retail services connected with the sale of meat, fish, poultry and game, meat extracts, preserved, dried and cooked fruits and vegetables, jellies, jams, fruit sauces, eggs, milk and milk products, edible oils and fats, coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee, flour and preparations made from cereals, bread, pastry and confectionery, ices, honey, treacle, yeast, baking-powder, salt, mustard, vinegar, sauces (condiments), spices, ice.</p>	<p>1034439: Preserved, dried and/or cooked potato products for food, all in the form of chips.</p> <p>1512273: Potato chips included in Class 29.</p> <p>CTM52548: Potato crisps.</p>

23) The opponent contends that 'preserved, dried and cooked fruits and vegetables' in Class 29 and 'retail services connected with the sale of preserved, dried and cooked fruits and vegetables and preparations made from cereals, bread, pastry and confectionery' in Class 35 are identical and/or similar to the opponent's specifications. The opponent further contends that "the broad wording in classes 29 and 35 would interfere with the earlier use and registrations of the opponent as the goods and services in question would be competitive with one another". I do not accept these contentions in their entirety. There is clearly an overlap between the opponent's goods, broadly "preserved, dried, cooked potato products in the form of chips/crisps" and "preserved, dried and cooked fruits and vegetables" in class 29 and "Retail services connected with the sale of preserved, dried and cooked fruits and vegetables" in Class 35 of the applicant's specification. The former being identical goods the latter being similar services to the goods of

the opponent. None of the other goods or services in the applicant's specification are identical or even similar.

24) The goods in question, broadly speaking crisps, are not a considered purchase. They are very close to being the "bag of sweets" type of good. It is the type of product which is often placed out in bowls in pubs or parties and consumed with little concern, other than flavour.

25) I now turn to consider the marks of the two parties. Although the opponent has three marks registered, two are identical whilst the third (CTM52548) has a degree of stylisation so marginal as to be effectively none existent. For the purposes of my comparison I shall treat the opponent as having a single mark, the word CRUNCHIPS, and compare this to the applicant's mark MUNCHIPS.

26) Visually, the beginnings of the marks differ. However, they share the last seven letters "UNCHIPS". The opponent contends, correctly in my view, that both are "portmanteau" words with the words "crunch" and "munch" being combined in each case with the word "chips" which is a common alternative for the word "crisps". Both "crunch" and "munch" are onomatopoeic, being imitative of the sound of the noise or action designated. In my opinion, the average consumer will pronounce the marks as "CRUN-CHIPS" and "MUN-CHIPS". In doing so, they will be aware of the words "CRUNCH" and "MUNCH" in each mark. I believe that they will view the "CHIPS" part of each mark as entirely descriptive of the product. Because each mark is so obviously made up of two words the average consumer will be left considering the "CRUNCH" and "MUNCH" elements of both marks. There are clear visual and aural similarities between the marks of the two parties and also clear differences.

27) Conceptually, neither mark requires much imagination. The goods are crisps or chips and when eaten they "crunch" or are "munched". The marks therefore have a degree of conceptual similarity.

28) Overall, I believe that the differences, crucially at the beginning of the marks, outweigh the similarities.

29) Taking account of all of the above when considering the marks globally, I believe there is not a likelihood of consumers being confused into believing that the goods provided by the applicant are those of the opponent or provided by some undertaking linked to them. The opposition under Section 5(2)(b) therefore fails.

30) I now turn to consider the ground of opposition under Section 5(3) of the Trade Marks Act 1994 which, in its original form, reads:

"5-(3) A trade mark which -

(a) is identical with or similar to an earlier trade mark, and

(b) is to be registered for goods or services which are not similar to those for which the earlier mark is protected,

shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community trade mark, in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark."

31) By virtue of regulation 7 of the Trade Mark (Proof of Use, etc) Regulations 2004, Section 5(3)(b) has now been repealed. The equivalent provision in Section 10 of the Act dealing with infringement has also been amended. As the explanatory note indicates:

"These amendments implement the decision of the European Court of Justice in *Davidoff & Cie SA and Zino Davidoff SA v Gofkid Ltd* of 9th January 2003 (C-292/00) which was confirmed by its decision in *Adidas-Salomon AG and Adidas Benelux BV v Fitnessworld Trading Ltd* of 23rd October 2003 (C-408/01). Those decisions determined that Article 5(2) of the Directive, which on the face of it, grants a right to the proprietor of a trade mark to prevent third parties from using an identical or similar trade mark in relation to goods or services which are *not similar* where the earlier trade mark has a reputation and use of that sign takes unfair advantage or is detrimental to the distinctive character of that earlier trade mark, also applies to goods or services which are similar or identical to those for which the earlier trade mark is registered."

32) The scope of the Section has been considered in a number of cases notably *General Motors Corp v Yplon SA (Chevy)* [1999] ETMR 122 and [2000] RPC 572, *Premier Brands UK Limited v Typhoon Europe Limited (Typhoon)* [2000] RPC 767, *Daimler Chrysler v Alavi (Merc)* [2001] RPC 42, *C.A. Sheimer (M) Sdn Bhd's TM Application (Visa)* [2000] RPC 484 *Valucci Designs Ltd v IPC Magazines (Loaded)* O/455/00 and, more recently *Mastercard International Inc and Hitachi Credit (UK) Plc* [2004] EWHC 1623 (Ch) and *Electrocoin Automatics Limited and Coinworld Limited and others* [2005] FSR 7.

33) It is clear from these cases that the earlier mark must be known by a significant part of the public concerned by the products covered by the earlier trade mark and that consideration must be given to all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.

34) This test sets out a high threshold in my view and the onus is upon the opponent to prove that its trade mark, CRUNCHIPS, enjoys a reputation or public recognition. In the present case there are obvious deficiencies in the opponent's evidence on this point as I set out earlier in this decision at paragraph 21. While I am prepared to accept that there is likely to be some awareness and recognition of the opponent's trade mark in relation to crisps, I am unable to say with any confidence that the opponent's CRUNCHIPS mark is known by a significant part of the public concerned given the size of the potential market for such goods.

35) Taking into account the strict requirements which need to be satisfied under Section 5(3) to expand the parameters of “normal” trade mark protection I cannot find that the opponent has shown reputation in Section 5(3) of the Act and the opposition under Section 5(3) must fail on this basis.

### **COSTS**

36) As the applicant has been successful it is entitled to a contribution towards its costs. I order the opponent to pay the applicant the sum of £800. 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 22<sup>nd</sup> day of September 2009**

**G W Salthouse  
For the Registrar  
The Comptroller-General**