

O-159-10

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2498434
BY MR NEVID AHMED & MR OZGUR SONER KANAL
TO REGISTER IN CLASS 32 THE TRADE MARK:**

élan

AND

**IN THE MATTER OF OPPOSITION NO 98981 BY
DANONE WATERS (UK & IRELAND) LIMITED**

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In the matter of application no 2498434
by Mr Nevid Ahmed & Mr Ozgur Soner Kanal
to register in class 32 the trade mark:

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Danone Waters (UK & Ireland) Limited

Background

1. On 24 September 2008 Mr Nevid Ahmed & Mr Ozgur Soner Kanal (hereafter “the applicants”) applied to register the above trade mark. I will refer to the trade mark as the word “élan” but will, of course, bear in mind throughout this decision that the word is presented in a particular form of presentation. The mark is sought to be registered in class 32 of the Nice classification system¹ in respect of:

Mineral and aerated waters; natural spring water and other non-alcoholic drinks.

2. On 23 April 2009 Danone Waters (UK & Ireland) Limited (“the opponent”) opposed the registration of the above trade mark. Its grounds of opposition are under sections 3(1)(b), 3(1)(c) & 5(2)(b) of the Trade Marks Act 1994 (“the Act”). In relation to its grounds under sections 3(1)(b) & 3(1)(c) the opponent’s pleaded case is identical, namely:

“it [the applicants’ trade mark] consists of a word meaning “energy and flair” and thus indicates characteristics of the goods, for example waters or drinks which have the ability to energise or provide other positive benefits to the consumer”.

3. In relation to its ground under section 5(2)(b) the opponent relies on its own trade mark (UK registration 2368980) for the mark ELYN. The opponent’s mark was filed on 24 July 2004 (thus making it an earlier mark under the provisions of section 6 of the Act) and it completed its registration procedure on 21 January 2005. The opponent’s earlier mark is registered in class 32 in respect of:

Still and sparkling water; mineral water; spring water; fruit flavoured waters; soft drinks made with mineral and/or spring waters; flavoured

¹ International Classification of Goods and Services for the Purposes of the Registration of Marks under the Nice Agreement (15 June 1957, as revised and amended).

waters; fruit or vegetable juices, fruit or vegetable drinks; lemonades, sodas, sorbet drinks, drink preparations; syrups for drinks; fruit or vegetable extracts; beverages comprising lactic fermenting agents.

4. In relation to the opponent's earlier mark, although now registered, it did not complete its registration procedure before the period of five years ending with the date of publication of the applicants' trade mark². Consequently, the proof of use provisions contained in section 6A³ of the Act do not apply. The earlier trade mark may, therefore, be taken into account in these proceedings for its specification as registered.

5. The applicants filed a counterstatement denying the grounds of opposition. I note, though, that it accepts that the respective goods are identical.

6. Neither side filed evidence. Neither side requested a hearing. Neither side filed formal written submissions in lieu of a hearing, but I note that both sides have made written submissions in the respective statements and counterstatements and in some further written material. All submissions will be duly considered in reaching a decision.

Section 3(1)(c) of the Act

7. Section 3(1)(c) of the Act states that the following shall not be registered:

“trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering services, or other characteristics of goods or services”

8. The European Court of Justice (“ECJ”) has issued a number of judgments germane to this issue. A helpful summary of the position was given in *Wm. Wrigley Jr. Company v. Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case C-191/01 P (“*Doublemint*”), where it was stated:

“32. In order for OHIM to refuse to register a trade mark under Article 7(1)(c) of Regulation No 40/94, it is not necessary that the signs and indications composing the mark that are referred to in that article actually be in use at the time of the application for registration in a way that is descriptive of goods or services such as those in relation to which the application is filed, or of characteristics of those goods or services. It is

² The applied for mark was published on 23 January 2009, the earlier mark completed its registration procedure on 21 January 2005.

³ Section 6A of the Act was added to the Act by virtue of the Trade Marks (Proof of Use, etc.) Regulations) 2004 (SI 2004/946) which came into force on 5th May 2004.

sufficient, as the wording of that provision itself indicates, that such signs and indications could be used for such purposes. A sign must therefore be refused registration under that provision if at least one of its possible meanings designates a characteristic of the goods or services concerned.”

9. Similarly, in *Koninklijke KPN Nederland NV and Benelux-Merkenbureau*, Case C-363/99 (“*Postkantoor*”) the ECJ stated:

“54. As the Court has already held (*Windsurfing Chiemsee*, paragraph 25, *Linde*, paragraph 73, and *Libertel*, paragraph 52), Article 3(1)(c) of the Directive pursues an aim which is in the public interest, namely that such signs or indications may be freely used by all. Article 3(1)(c) therefore prevents such signs and indications from being reserved to one undertaking alone because they have been registered as trade marks.

55. That public interest requires that all signs or indications which may serve to designate characteristics of the goods or services in respect of which registration is sought remain freely available to all undertakings in order that they may use them when describing the same characteristics of their own goods. Therefore, marks consisting exclusively of such signs or indications are not eligible for registration unless Article 3(3) of the Directive applies.

56. In those circumstances, the competent authority must, under Article 3(1)(c) of the Directive, determine whether a trade mark for which registration is sought currently represents, in the mind of the relevant class of persons, a description of the characteristics of the goods or services concerned or whether it is reasonable to assume that that might be the case in the future (see to that effect *Windsurfing Chiemsee*, paragraph 31). If, at the end of that assessment, the competent authority reaches the conclusion that that is the case, it must refuse, on the basis of that provision, to register the mark.”

10. I also note that in *Matratzen Concord AG v Hukla Germany SA*, (Case C-421/04) (“*Matratzan*”) the ECJ stated:

“In fact, to assess whether a national trade mark is devoid of distinctive character or is descriptive of the goods or services in respect of which its registration is sought, it is necessary to take into account the perception of the relevant parties, that is to say in trade and or amongst average consumers of the said goods or services, reasonably well-informed and reasonably observant and circumspect, in the territory in respect of which registration is applied for (see Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee* [1999] ECR I-2779, paragraph 29; Case C-363/99 *Koninklijke KPN Nederland* [2004] ECR I-1619, paragraph 77; and Case C-218/01 *Henkel* [2004] ECR I-1725, paragraph 50).”

11. Each ground of refusal has independent scope and each must be interpreted in light of the general interest underlying it. In *SAT.1 SatellitenFernsehen GmbH v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case C-329/02 P the ECJ stated:

“25 Thirdly, it is important to observe that each of the grounds for refusal to register listed in Article 7(1) of the regulation is independent of the others and requires separate examination. Moreover, it is appropriate to interpret those grounds for refusal in the light of the general interest which underlies each of them. The general interest to be taken into consideration when examining each of those grounds for refusal may or even must reflect different considerations according to the ground for refusal in question (Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* [2004] ECR I-0000, paragraphs 45 and 46).”

12. In relation to the underlying interest, section 3(1)(c) pursues an aim which reflects the public interest in ensuring that descriptive signs or indications may be freely used by all (see, for example, *Doublemint* and *Postkantoor*).

13. I set out the opponent's pleaded case earlier as:

“it [the applicants' trade mark] consists of a word meaning “energy and flair” and thus indicates characteristics of the goods, for example waters or drinks which have the ability to energise or provide other positive benefits to the consumer”.

14. In terms of the meaning given by the opponent for the word in question, it refers to the Compact Oxford English Dictionary which states that the word “élan” is a noun meaning “energy and flair” and that its origin derives from the French word “élancer” meaning “to dart”. The dictionary definition was not put in evidence, however, a hearing officer is entitled to refer to standard dictionaries and works of reference to supplement his own knowledge of the language⁴. To that extent, and to provide a fuller picture, I note that the Collins English Dictionary defines “élan” as:

“A combination of style and vigour”

15. The opponent submits that the word is intended to convey to customers that the ownership of the goods will imply that the consumer possesses flair and that the consumption of the goods will give the consumer energy. The applicants submit that the word “élan”, being of French origin, will not be understood by the relevant public as having the meaning accorded to it by the opponent.

⁴ See, for example the decision of Mr Hobbs QC (sitting as the Appointed Person) in *Forex* (BL O-100-09)

16. The word “élan” is of French origin but is an English dictionary word. However, that does not necessarily mean that the word is one known by average consumers of the goods in question. It is not as though the word is a blatantly obvious one which members of the public (or those in the trade) will undoubtedly be aware of. For words such as this, it is reasonable to expect an opponent to show that the word is known and the context in which it is known. In view of this, I do not consider the word in question to be one where its meaning is generally known. As highlighted earlier, the ECJ, in *Matratzen*, held that an assessment of this matter must take into account the perception of the trade and of average consumers of the goods in question. The mere presence of a word in a dictionary of the type of word concerned does not assist in demonstrating such perception. I am, therefore, with the applicants when they say that word may not be understood by the relevant public.

17. If I am wrong on my assessment on the understanding of the word by the relevant public, or, perhaps, that I should also consider the position further because some parts of the relevant public (albeit a smaller proportion not representative of average consumers) will know of its meaning, then I will give my views on the word itself and the likelihood of it being perceived as a description and the necessity for it to be kept free for other traders. Both dictionary references refer to two characteristics (energy/flair & style/vigour). The opponent refers to the word as indicating that owning the goods will imply that the consumer has flair and that drinking the goods will give them energy. To say that such a word describes a characteristic of the goods is stretching its meaning well beyond its definition. Firstly, to say that it is a characteristic of the goods that it will convey that the purchaser has flair is not describing a characteristic of the goods themselves. It is a characteristic of the person. Whilst the intended effect of the goods on a person could be a possible description under section 3(1)(c), such a word does not strike me as one likely to be used in relation to a bottle of water or other non-alcoholic beverage. I do not see how such a product can give a person flair. Furthermore, the defined flair/energy meaning is simply two words used to indicate the word's meaning, to give the reader an indication of the circumstances in which the word should be used. The opponent breaks down these words separately, e.g. the user has flair and then drinking gives energy. This is not, it seems to me, what the definition has in mind. The definition from Collins supports this (a combination of style and vigour) and when one bears this in mind I struggle to see how the goods will give “élan” to a consumer of the goods. For the sake of completeness, I see no possibility that the goods themselves (waters and other drinks) would ever be described with reference to the word “élan”. Therefore, even if I am wrong on my assessment of the perception (or lack of) of the word, it is not, in any event, a word that can be said to describe a characteristic of the goods. **The ground of opposition under section 3(1)(c) of the Act fails.**

Section 3(1)(b) of the Act

18. Section 3(1)(b) of the Act states that the following shall not be registered:

“trade marks which are devoid of any distinctive character”

19. The test to be applied under this ground has been dealt with by the ECJ in a number of its judgments, notably in Joined Cases C-53/01 to C-55/01 *Linde AG, Winward Industries Inc and Rado Uhren AG* (8 April 2003). The test equates to assessing the impact that the sign will have on the average consumer when used in relation to the goods at issue and then deciding whether they will see it as something that is identifying to them goods originating from a particular undertaking. The test is, essentially, whether the sign will perform the essential distinguishing function of a trade mark.

20. Given my finding that the word “élan” is not a word generally known by the relevant public then the opponent is no better position under section 3(1)(b) because the average consumer will not attribute any specific meaning to the word and, thus, there is no reason why it will not perform the essential distinguishing function. Furthermore, I have found that if I am wrong on that assessment the mark is not descriptive. To that extent, I note that the opponent’s pleading under section 3(1)(b) is identical to 3(1)(c) based upon indicating characteristics of the goods. Although section 3(1)(b) has independent scope, if the objection is that the mark is incapable of distinguishing because it indicates characteristics of the goods (which I have already found it does not) then, again, the opponent is in no better position. For sake of completeness, I should say that even if the average consumer was aware of the meaning of the word “élan” and even if they did not perceive a descriptive message, I see no reason why the mark would not perform the essential distinguishing function. At the very most the mark may give an allusive yet imprecise message but not one which would be taken as any form or promotional or other non-distinctive message. I consider the mark to be a perfectly good trade mark for the goods at issue. **The objection under section 3(1)(b) fails.**

Section 5(2)(b) of the Act

21. Section 5(2)(b) reads:

5.-(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.

22. In reaching my decision I have taken into account the guidance provided by the ECJ in a number of judgments: *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 117, *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* [2000] F.S.R. 77, *Marca Mode CV v. Adidas AG + Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG V Thomson multimedia Sales Germany & Austria GmbH* (Case C-120/04) and *Shaker di L. Laudato & Co. Sas* (C-334/05).

23. The existence of a likelihood of confusion must be appreciated globally, taking into account all relevant factors (*Sabel BV v Puma AG*). As well as assessing whether the respective marks and the respective goods are identical or similar (and in the case of similarity to what degree), other factors are relevant including:

The nature of the average consumer of the goods in question and the nature of his or her purchasing act. This is relevant because it is through such a person's eyes that matters must be judged (*Sabel BV v Puma AG*);

That the average consumer rarely has the chance to make direct comparisons between trade marks and must, instead, rely upon the imperfect picture of them he or she has kept in mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*) This is often referred to as the concept of "imperfect recollection";

That the degree of distinctiveness of the earlier trade mark (due either to its inherent qualities or through the use made of it) is an important factor because confusion is more likely the more distinctive the earlier trade mark is (*Sabel BV v Puma AG*);

That there is interdependency between the various factors, for example, a lesser degree of similarity between the marks may be offset by a greater

degree of similarity between the respective goods, and vice versa (*Canon Kabushiki Kaisha v Metro- Goldwyn-Mayer Inc*).

The average consumer and the purchasing act

24. As matters must be judged through the eyes of the average consumer, I will begin with an assessment of who this is. The respective goods cover waters and other types of non-alcoholic drinks. In their counterstatement the applicants argue that the goods in question are specialised and, therefore, that the consumer should be deemed to be reasonably well informed in such an industry. It is further argued that this leads to the consumer paying more attention when selecting the goods, especially as the goods are to be consumed. The claim that the goods are specialised is not repeated in their written submissions but they do submit that the goods are to be purchased to refresh and re-hydrate a person's body and, as such, will be approached with great care and attention. It submits that a consumer will not simply grab any bottle of water from a shelf but will ensure that the product is (for example) sourced well, filtered, bottled at source etc. The opponent, on the other hand, considers that the goods are the sort of things likely to be purchased in a hurry.

25. The case-law informs me that the average consumer is reasonably observant and circumspect (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27). The degree of care and attention the average consumer uses at the point of purchase will, however, vary depending on the particular goods in question (see, for example, the decision of the General Court⁵ ("GC") in *Inter-Ikea Systems BV v OHIM* (Case T-112/06)). In this case the goods are relatively low cost ones, and despite the applicants initially describing the goods as specialist, they are general consumer items purchased by the public at large. Not all members of the general public buy bottled water (or other non-alcoholic drinks), but for those that do the purchase of such goods will be undertaken relatively frequently. Whilst for some consumers the issue of source/filtration etc. may be important, I do not consider that the average consumer will be that attentive. All of this leads me to the conclusion that the degree of care and attention likely to be displayed by the average consumer is closer to the opponent's perspective than the applicants'. Whilst this does not mean that no attention will be displayed at all (the average consumer is still reasonably observant and circumspect), the degree of care and attention displayed will not be high and, instead, will be at the lower end of the spectrum. The knock-on effect of this is that imperfect recollection may have a greater role to play in the case before me. Had the goods been ones selected with a great deal of care and attention then the propensity for confusion to be caused through an imperfect recollection is mitigated to a large extent. This is not the case here.

26. In terms of how purchases are made, there is no evidence to guide me. The goods are, though, general consumer ones and I can therefore draw from my

⁵ Previously known as the Court of First Instance of the European Communities.



own experiences. The goods will routinely be selected from a shelf such as in a supermarket or perhaps in a food and drink retail establishment. This suggests that the purchasing act is visual one. Although the goods may be orally requested in restaurants, bars or snack food establishments, this is still likely to be in a context where the goods are also visible (behind a counter for example)⁶ so, overall, whilst oral considerations are not ignored, the visual considerations may have a greater role to play.

Comparison of the goods

27. The applicants' accept that the goods are identical. In view of this I need say little more. The one thing I should record is that the applicants' specification includes the broad term "other non-alcoholic drinks" whereas the opponent's earlier mark does not have a broad term such as this but, instead, lists numerous drinks that would fall within the ambit of such a broad term. The consequence of this is that the broad term may include within it goods which are not identical, but in the absence of a fall-back specification, the goods must still be regarded as identical. This is because if a term falls within the ambit of another then identical goods are in play⁷.

Comparison of the marks

28. When assessing this factor I must do so with reference to the visual, aural and conceptual similarities between the respective marks bearing in mind their distinctive and dominant components (*Sabel BV v. Puma AG*, paragraph 23). For ease of reference, the marks under comparison are set out below:

Applicants' mark	Opponent's mark
	

29. In terms of visual similarity, both marks consist of four letters and both contain the letters E, L & N in the same order as each other. The respective marks have, though, a different penultimate letter A/Y, and, furthermore, the letter "e" in élan has an accent. The "élan" mark is also presented in a particular lower case script and it is in blue. Whilst the stylization will not be completely ignored, I do not consider that this creates a marked difference that significantly reduces any inherent similarity between the words élan and ELYN. The difference in the penultimate letter is of more significance, the accent above the e in élan less so (but still forms a factor). The marks, though, are relatively short and, therefore,

⁶ See, for example, the GC in *Simonds Farsons Cisk plc v OHIM* (Case T-3/04).

⁷ See *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs)(OHIM)* Case T-133/05.

these differences are likely to have more weight than had they been the only difference in a much longer word. All things considered, it is my view that there is moderate or reasonable (neither high nor low) degree of visual similarity.

30. In terms of aural similarity, there is no evidence to suggest how the respective marks will be pronounced. The opponent's say that the marks are aurally similar and the applicants say that there is little similarity based, it submits, on the fact that their mark will be pronounced as a French word. French word/pronunciation or not, it is still necessary to consider how the respective marks will be pronounced by the average consumer in the UK. I believe there are two possible variations for both marks. "élan" will be pronounced as either E-LAN (the E element pronounced in the same way as the letter itself) or, alternatively as EH-LAN. "ELYN" will be pronounced as either E-LYN or EH-LYN. Either way, it seems to me that the aural similarities outweigh the differences to a large extent. The only real difference resides in the pronunciation of the A and the Y in the second syllable of the respective words. The letters are vowels and in the context of the respective pronunciations do not create a marked clearly noticeable difference. From an aural perspective the marks are similar to a high degree.

31. In terms of conceptual similarities/differences, if a mark has a conceptual meaning it must be one capable of immediate grasp⁸. I must, though, be conscious of not accepting too readily the degree of knowledge that an average consumer may or may not possess⁹. In terms of the meaning of "élan", I have already dealt with this in terms of my assessment under section 3(1) of the Act. I found that despite it having a meaning in English it should not be regarded as a commonly known word. This brings into play the *Cherokee* case concerning the word CHEROKEE, which, despite having a dictionary meaning, and despite some consumers no doubt being aware of its meaning, it was held by Ms Carboni that it was not safe to assume that the average consumer would be aware of its meaning. Each case must, of course, be considered on its own merits. As I stated earlier there is no evidence to inform as to the degree to which the word "élan" is used or known. Evidence could have come not just from the drinks field but from any field which would have supported the general awareness or knowledge of the word by the average consumer (who I have already identified as the public at large). The word is not one, in my view, that should be treated as an everyday word with an obvious meaning. In view of all this, the word "élan" must be regarded as one with no meaningful concept. It may be regarded as a French word in view of the accent above the "e", but this does not give the mark

⁸ This is highlighted in numerous judgments of the GC and the ECJ including *Ruiz Picasso v OHIMi* [2006] e.c.r. –I-643; [2006] E.T.M.R. 29.

⁹ See, for example, the decision of Anna Carboni (sitting as the Appointed Person) in *Cherokee* BL-O-198-08.

a conceptual hook that will assist in the average consumer's recall/distinguishing process.

32. In terms of the word ELYN, the applicants submit that it could be seen as the name of a person. The opponent's make no submission on its meaning. The word has no meaning according to the Collins English Dictionary. The applicants may be right when they say that it could be the name of a person, but there is no evidence to suggest that it is. As stated earlier, the matter is one of immediate grasp. Absent evidence to the contrary, all I can say is that from the perspective of the average consumer, the word has no meaning.

33. The consequence of the respective concepts, or more accurately the lack of them, is that there is neither conceptual similarity nor difference. In terms of the overall assessment of mark similarity, the neutral impact regarding concept means that the similarities between the marks are not offset by a conceptual difference. Likewise, the lack of conceptual similarity does not strengthen the similarities.

Distinctive character of the earlier trade mark

34. The distinctiveness of the earlier mark is another factor to consider because the more distinctive it is (based either on inherent qualities or because of the use made of it), the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24). No evidence of use of the earlier mark has been filed so the assessment must be based purely on its inherent characteristics. The earlier mark consists of the word ELYN. I have found this word to have no meaning from the perspective of the average consumer. Neither does it have a suggestive or evocative quality in relation to any goods or services, let alone the goods of interest here. This means that the mark must be assessed as having a high degree of distinctive character.

Likelihood of confusion

35. It is clear that the relevant factors have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17) and that a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). However, there is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused.

36. The earlier mark has a high degree of distinctive character. I have found the respective marks to be aurally similar to a high degree and visually similar to a moderate/reasonable degree. There is no real conceptual difference to counteract the similarity that I have found. The goods are also identical and, therefore, this strengthens the possibility of confusion. I must also consider the

concept of imperfect recollection which, applied to the circumstances here, also strengthens the likelihood of confusion. I have found that the degree of care and attention when the goods are purchased is at the lower end of the spectrum. Even bearing in mind my earlier comments that visual considerations may have more significance, I consider that confusion is likely. The nature of the purchasing act coupled with the concept of imperfect recollection will make this likely when identical goods are being selected under the respective moderately/reasonably similar (visually) trade marks in question. **The opposition under section 5(2)(b) is successful.**

Costs

37. The opponent has been successful and is entitled to a contribution towards its costs. I hereby order Mr Nevid Ahmed & Mr Ozgur Soner Kanal (being jointly and severally liable) to pay Danone Waters (UK & Ireland) Limited the sum of £900. This sum is calculated as follows:

Preparing a statement and considering the other side's statement
£400

Submissions (contained in its letter dated 9 November 2009)
£300

Expenses (opposition fee)
£200

38. The above sum should 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 21 day of May 2010

**Oliver Morris
For the Registrar
The Comptroller-General**