

O-102-11

**TRADE MARKS ACT 1994**

**IN THE MATTER OF INTERNATIONAL REGISTRATION NO. 1008893 IN THE  
NAME OF COMOBAR 2000 INC**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER NO. 72072 BY SOCIÉTÉ DES PRODUITS NESTLÉ S.A.**

## BACKGROUND

1. On 17 June 2009, Comobar 2000 Inc (“Comobar”) requested protection in the United Kingdom of the international registration (IR) of the trade mark **COMOBAR**.

2. The United Kingdom Trade Marks Registry (“TMR”) considered that the request satisfied the requirements for protection and particulars of the IR were published in Trade Marks Journal No. 6803 on 18 September 2009 for the following goods in class 11:

Electric espresso and cappuccino makers for domestic and commercial use.

3. On 14 December 2009, Société des Produits Nestlé SA (“Nestlé”) filed a notice of opposition. While this originally consisted of grounds based upon sections 5(2)(b) and 5(4)(a) of the Trade Marks Act 1994 (as amended) (the Act), the ground based upon section 5(4)(a) was subsequently abandoned. Nestlé indicate that the opposition is directed against all of the goods in the request for protection; they rely upon one earlier Community trade mark registration:

Trade Mark	No.	Application Date	Registration Date	Goods
<b>KOMO</b>	3074002	27.02.2003	24.11.2005	<b>7</b> - Electromechanical beverage and/or food preparation machines; associated refillable elements, cartridges and spare parts therefor. <b>9</b> - Automatic beverage and/or food distribution machines, vending machines; associated refillable elements, cartridges and spare parts therefor. <b>11</b> - Electric coffee machines, associated refillable elements, cartridges and spare parts therefor; coffee filters, electric; coffee percolators, electric. <b>30</b> - Coffee, tea, cocoa. <b>32</b> - Preparations for making non-alcoholic beverages.

4. In the statement of grounds accompanying their opposition Nestlé said, inter alia;

“Due to [Comobar’s] trade mark incorporating the visually similar and phonetically identical prefix word COMO...and having regard to the low distinctive character of the suffix word...BAR, the respective trade marks are similar.”

And:

“[Comobar’s] trade mark is similar to [Nestlé’s] trade mark and is to be registered for goods that are either identical with, highly similar or complementary to those covered by [Nestlé’s] trade mark.”

5. On 18 February 2010, Comobar filed a counterstatement which consisted, in essence, of a denial of the grounds of opposition.

6. Both parties filed evidence and written submissions both during the course of proceedings and in lieu of attendance at a hearing; I will refer to these submissions as necessary below.

#### **Nestlé’s evidence**

7. This consists of a witness statement, dated 24 May 2010, from Dale Carter who is an Intellectual Property Adviser in the Legal Department of Nestlé UK Ltd. Mr Carter explains that Nestlé UK Limited is a member of the Nestlé group of companies and a licensee of the opponent in these proceedings.

8. Mr Carter explains that on 20 May 2010 he consulted the Collins English Dictionary (Complete and Unabridged version, Eighth Edition 2006) for:

“the purpose of obtaining a definition of the word BAR.”

Exhibit DC1 consists of three pages from the dictionary mentioned. In relation to the entry for the word “bar” the following text has been underlined:

“6. A counter, room, or establishment where a particular range of goods, food, services etc are sold: a coffee bar; a heel bar.”

9. Mr Carter goes on to say that on 20 and 21 May 2010 he undertook Google® internet searches (limited to the United Kingdom) for the words “juice bar” and “coffee bar”, in order to establish that English speaking consumers are familiar with the concept of bars for obtaining or purchasing a variety of items. He adds that he also visited [www.crussh.com](http://www.crussh.com) in order to clarify the nature of the products and services offered by this undertaking and to confirm a list of its outlets in the United Kingdom. The results of the searches are provided as exhibit DC2.

10. Mr Carter states than on 20 and 21 May 2010 he visited [www.comobar.com](http://www.comobar.com) in order to clarify the precise nature and purpose of the goods and/or services offered by

Comobar; exhibits DC3 and DC4 comprise pages downloaded from the website mentioned.

11. Finally, Mr Carter explains that on 12 May 2010 he visited [www.jede.co.uk](http://www.jede.co.uk) (which is a website operated by Nestlé's business partner in the United Kingdom, Jede UK), in order to clarify the nature of the beverage machine sold under the KOMO trade mark; the results are provided as exhibit DC5.

### **Comobar's evidence**

12. This consists of a witness statement, dated 26 July 2010, from Ryan Pixton who is a trade mark attorney at Kilburn & Strode, Comobar's professional representatives in these proceedings.

13. Mr Pixton explains that on 20 July 2010 he visited [www.gocoffee.co.uk](http://www.gocoffee.co.uk) which describes itself as: "The UK's No 1 Online Coffee Specialists". Exhibit REP1 consists of two pages from the website mentioned under the heading "Commercial Espresso Coffee Machines". Mr Pixton states that the website lists 27 commercial coffee machines for sale under the following brands: Fracino, Gaggia, Elegance, Iberital, L'Adri, Expobar and Delonghi. He adds that on the same date he visited [www.fracino.com](http://www.fracino.com), [www.gaggia.uk.com](http://www.gaggia.uk.com), [www.creminternational.co.uk](http://www.creminternational.co.uk) (manufacturers of the Elegance and Expobar branded machines), [www.iberital.com](http://www.iberital.com) (manufacturers of the L'Adri branded machines) and [www.delonghi.co.uk](http://www.delonghi.co.uk). The results of these searches are provided as exhibit REP2 of which Mr Pixton says:

"None of the websites indicate that these manufacturers also offer coffee shop services under their respective marks."

14. Finally, Mr Pixton states that on the date mentioned above, he also visited [www.jede.co.uk](http://www.jede.co.uk). Exhibit REP3 is, he explains, a copy of the brochure for the KOMO machine together with an extract taken from the home page. Of these documents he says:

"There was no reference to any establishment selling beverages under the KOMO mark, or any use of the mark BAR in a descriptive sense."

### **Nestlé's evidence-in-reply**

15. This consists of two witness statements. The first, dated 25 November 2010, is from the same Dale Carter mentioned above. Exhibit DC1 consists of another extract from the dictionary mentioned in paragraph 8 above. Against the word "bar", Mr Carter has highlighted the following definition:

"n. a cgs unit of pressure equal to  $10^6$  dynes per square centimetre. 1 bar is equivalent to  $10^5$  newtons per square metre."

16. Mr Carter explains that on 6 September 2010 he carried out a Google® internet search (limited once again to the United Kingdom) for the words “pressure” and “quality coffee”. At exhibit DC2 he provides pages from [www.coffeeresearch.org](http://www.coffeeresearch.org), <http://hypertextbook.com/facts>, [www.miele-kitchen-appliances.co.uk](http://www.miele-kitchen-appliances.co.uk) and [www.nuovasimonelli.co.uk](http://www.nuovasimonelli.co.uk), which he says show:

“the effect of various parameters (including pressure) on the final quality of espresso coffee.”

17. Exhibit DC3 consists of an extract obtained on 25 November 2010 from [www.insidefood.eu](http://www.insidefood.eu) which Mr Carter explains is the website of Nestlé’s Product Technology Centre in Switzerland whose main focus is:

“scientific and technical research and development linked to powdered beverages and cereal products.”

18. The second witness statement, dated 25 November 2010, is from Marc Dreyer who is the Departmental Head of Coffee Technology in the Centre mentioned above. Mr Dreyer explains that he has held this position for nearly ten years, prior to which he was Manager of a coffee factory in both Germany and China; he was also the Production Manager of a multi-product factory in Canada. Mr Dreyer holds a PhD in Chemical Engineering from the Swiss Institute of Technology in Zurich. In his current role Mr Dreyer is responsible for the development of products and technologies for coffee and their industrialisation. Attached to his witness statement as exhibit MD1 is a publication entitled “Influence of Water Pressure on the Final Quality of Arabica Espresso Coffee. Application of Multivariate Analysis” which appeared in the Journal of Agricultural and Food Chemistry; a footnote indicates the article was published on the web on 30 October 2002 by the American Chemical Society. Mr Dreyer states, inter alia:

“8. Pressure is an important parameter for a better capturing of volatile aromatic components from roast-and-ground coffee...”

And:

“9...the pressure under which coffee is extracted is an important parameter in determining the overall quality of espresso...”

19. That concludes my summary of the evidence provided to the extent I consider it necessary.

## **DECISION**

20. The opposition is now based solely upon section 5(2)(b) of the Act which reads as follows:

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

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

21. 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) or 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,

(2) References 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.”

22. Nestlé’s registration is an earlier trade mark and is not subject to proof of use, as per The Trade Marks (Proof of Use, etc) Regulations 2004, as it had not been registered for five years at the time of the publication of Comobar’s trade mark application.

### **Section 5(2)(b) – case law**

23. In reaching a decision I must take into account the guidance provided by the European Court of Justice (ECJ) in a number of judgments. The principal cases are: *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 117, *Lloyd Schuhfabrik Mayer & 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* (Case C-120/04) and *Shaker di L. Laudato & Co. Sas* (C-334/05),

It is clear from all these cases that:

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

(b) the matter must be judged through the eyes of the average consumer of the good/services in question; *Sabel BV v. Puma AG*, paragraph 23, who is deemed to be reasonably well informed and 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*, paragraph 23;

(d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v. Puma AG*, paragraph 23;

(e) when considering composite marks, it is only if all the other components of the mark are negligible that the assessment of the similarity can be carried out solely on the basis of the dominant element; *Shaker di L. Laudato & Co. Sas* (C-334/05), paragraph 42;

(f) an element of a mark may play an independent distinctive role within it without necessarily constituting the dominant element; *Medion AG V Thomson multimedia Sales Germany & Austria GmbH*, paragraph 30;

(g) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17;

(h) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v. Puma AG*, paragraph 24;

(i) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v. Puma AG*, paragraph 26;

(j) 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 + Adidas Benelux BV*, paragraph 41;

(k) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 29.

## **The average consumer and the nature of the purchasing process**

24. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods. I must then determine the manner in which these goods are likely to be selected by the average consumer in the course of trade. The goods at issue in these proceedings are electric coffee machines. These are goods which will, as Comobar's specification reflects, be utilised in both domestic and commercial settings and for whom the average consumer will be either a member of the general public buying for domestic use, or a business user buying for commercial purposes. As to how the goods will be selected by the average consumer this is, as the evidence, shows (see for example exhibits DC3 ,DC4, DC5, REP 1 and REP 2), most likely to consist of a visual act made on the basis of self selection in either a retail setting, from a catalogue or on-line (see the comments of the Appointed Person in *React Trade Mark* [2000] RPC 285). As to the nature of the purchasing act, I note that in their written submission dated 26 November 2010, Nestlé said, inter alia:

“1.13 It is submitted that consumers who ordinarily utilise espresso and cappuccino makers in the context of a commercial setting would be particularly knowledgeable...”

25. As the evidence shows (see exhibit REP1) the cost of commercial espresso machines can be substantial. Given their potential cost and the need to ensure that the machine chosen meets the specific needs of the business concerned, I am led to conclude that the average consumer will pay a high level of attention when selecting an electric coffee machine for commercial use. While my own experience tells me that the cost of non-commercial electric coffee machines is likely to be somewhat less, the not insubstantial cost of a domestic electric coffee machine combined with the desire to ensure one selects the most appropriate machine (in terms of appearance and technical features) for one's purposes, leads me to conclude that even in those circumstances the average consumer will pay a reasonably high level of attention to the selection of the goods.

### **Comparison of goods**

26. Nestlé's earlier trade mark is registered in, inter alia, class 11 for “electric coffee machines”. This phrase is broad enough to include all of the goods contained in Comobar's request for protection i.e. “electric espresso and cappuccino makers for domestic and commercial use”; the goods are identical.

### **Comparison of trade marks**

27. For the sake of convenience, the trade marks to be compared are as follows:

<b>Nestlé's trade mark</b>	<b>Comobar's trade mark</b>
<b>KOMO</b>	<b>COMOBAR</b>

28. The average consumer is considered to be reasonably well informed, circumspect and observant but perceives trade marks as wholes and does not pause to analyse their various details. In addition, he/she rarely has the chance to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he/she has kept in his/her mind. In reaching a conclusion on similarity I must identify what I consider to be the distinctive and dominant elements of the respective trade marks and, with that conclusion in mind, I must then compare the respective trade marks from the visual, aural and conceptual perspectives.

### **Distinctive and dominant elements**

29. Nestlé's trade mark consists of the word KOMO presented in upper case. It has no distinctive or dominant element; the distinctiveness lies in the totality.

30. Comobar's trade mark consists of the word COMOBAR also presented in upper case. In their written submissions Nestlé have drawn my attention to the following comments of the General Court in *Vitakraft-Werke Wührmann & Sohn GmbH & Co. KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (Case T-356/02):

“51. The requested sign consists, for a Spanish-speaking consumer, of a word composed of two elements, the first of which is the term ‘vita’ and the second the term ‘kraft’. The Board of Appeal rightly held that a consumer, perceiving a verbal sign, will break it down into elements which, for him, suggest a concrete meaning or which resemble words known to him. Thus the term ‘vita’ will be perceived, by a Spanish-speaking consumer, as alluding to words such as ‘vitality’ or ‘vital’ (‘vitalidad’ or ‘vital’ in Spanish). However, although the term ‘kraft’ means ‘strength’ in certain languages, including German, it has no concrete meaning in the Spanish language.”

31. In their written submissions dated 4 January 2011 Nestlé say:

“11. In applying the same considerations to [the trade mark] COMOBAR, we submit that the average English speaking consumer would divide the mark into the elements COMO and BAR on account of BAR being a word which holds a concrete meaning and is known to the said consumer.”

And:

“14. For example, BAR could be perceived by the average consumer as being an indication of [Comobar's] goods being offered through a bar-like establishment. In addition or in the alternative, BAR would be understood by the average consumer of [Comobar's] goods as being a reference to pressure, a feature which has an important bearing on the quality of coffee.

15. In view of the descriptiveness and/or non-distinctive nature of the word BAR, the more distinctive and dominant element of [Comobar's] trade mark is, we submit, COMO.

16. [Comobar] has stated that its mark holds no conceptual significance for the goods...

17. ...we submit that the BAR element of [Comobar's] trade mark does in fact refer to a characteristic of the goods. COMO on the other hand, is inherently distinctive of the goods..."

32. At this point I should perhaps say that in their written submissions dated 4 January 2011, Comobar objected to that part of Nestlé's evidence which related to the word bar being a reference to a unit of pressure. They did so, because in their view, this evidence was new and ought not to have been filed as evidence in reply; this evidence should, they said, be deemed inadmissible or they should be given an opportunity to reply to it. In a letter dated 5 January 2011, Nestlé responded to this allegation pointing out that the evidence in question was filed in response to comments contained in Comobar's written submissions dated 26 July 2010 namely:

"[Comobar] do not deny that the word BAR is commonly understood in the English language, with a number of different meanings. This is self-evidently true. However, this mark has no descriptive relevance of this word to the goods at issue, which are espresso and cappuccino makers."

And:

"[Nestlé] have not shown that the word is descriptive of coffee machines..."

33. In my view, the evidence filed by Nestlé was in reply to the comments contained in Comobar's written submissions. But even if that were not the case, the appropriate time for Comobar to raise the issue was when it received Nestlé's evidence (in November 2010) and not some six weeks later in its written submissions. Comobar have, however, commented on what they consider to be the new evidence in their written submissions of 4 January; they say inter alia:

"In its submissions and evidence [Nestlé] has gone to lengths to try to establish that the English word BAR is descriptive in relation to the goods at issue. However, even by [Nestlé's] own arguments it is unclear how this is so..."

And:

"[Nestlé] seems unclear as to the meaning of the letters BAR in [Comobar's] trade mark. Given [Nestlé's] apparent confusion on this point, it seems far-fetched to conclude that consumers' perception would be any clearer and that

they would immediately perceive the suffix BAR as descriptive of [Comobar's] goods.”

34. Comobar's trade mark is presented in upper case; no part of it is emphasised or accentuated in any way. It is well established, of course, that the average consumer perceives trade marks as wholes and does not pause to analyse their details. In those circumstances it is doubtful, in my view, that the average consumer would immediately identify the word BAR as an element within the integrated whole. However, if as Nestlé argue the average consumer does notice this element within the COMOBAR trade mark and then go on and ascribe it one of the two descriptive meanings for which Nestlé argue, is it correct to say that the average consumer would then, in effect, disregard the BAR element of Comobar's trade mark and focus on the letters COMO? In their written submissions of 4 January 2011 Comobar say:

“...it was submitted that manufacturers of coffee machines simply do not operate coffee shop services. As a result, there is no support for [Nestlé's] arguments that the word would be recognised as descriptive of [Comobar's] goods being offered through a bar-like establishment. Equally, when one reviews [the machines shown in exhibit REP1] none uses the word BAR as part of its trade mark. Furthermore, the word BAR does not appear as part of any secondary or model name applied to these goods. There is, therefore, no support for [Nestlé's] assertions regarding the alleged descriptiveness of the letters BAR.”

35. Comobar state that the word BAR does not appear as part of a trade mark or as part of a secondary or model name; that of course is wrong. Exhibit REP1 contains a reference to the Expobar brand, and Mr Pixton specifically mentions the brand in paragraphs 3 and 4 of his witness statement. However, that is but one isolated example of use of the word BAR in relation to electric coffee machines and does little to advance Nestlé's case.

36. The first arm of Nestlé's argument is that the average consumer would construe the word BAR appearing in the trade mark COMOBAR as an indication that the goods at issue were being offered through a bar-like establishment. In support, Nestlé have provided evidence relating to the meaning of the word BAR in the context of an establishment where goods are sold, together with evidence that the average consumer would be familiar with the word being used in that context. While I accept that the term “coffee bar” is well known, as Comobar point out there is no evidence that manufacturers of electric coffee machines also provide coffee shop services, and no evidence that electric coffee machines are sold through bar like establishments. As a consequence it is unlikely, in my view, that an average consumer noticing the word BAR as an element of Comobar's trade mark, would ascribe it this meaning.

37. The second arm of Nestlé's argument is that the average consumer who notices the word BAR as an element of Comobar's trade mark would, given its meaning as a unit of pressure, consider it to be descriptive in relation to electric coffee machines; I accept that Nestlé's evidence establishes that the word BAR relates to a unit of pressure and

that water pressure is an important factor in determining the quality of espresso coffee. However, even if the average consumer does notice the word BAR as part of Comobar's trade mark, and does recognise it as a unit of pressure and consequently meaningful in relation to electric coffee machines, given the manner in which Comobar's trade mark is presented, this falls some way short of allowing me to conclude that the BAR element of Comobar's trade mark would simply be disregarded by the average consumer leaving the letters COMO as the distinctive and dominant element.

38. In summary, I have concluded that neither of the competing trade marks has a distinctive or dominant element, the distinctiveness of both trade mark lies in their totalities; I will approach the visual, aural and conceptual comparison with that conclusion in mind.

39. In their written submissions dated 24 May 2010 Nestlé say:

“17. The letters K and C possess the same hard K sound when pronounced. The respective words KOMO and COMO consist of two syllables (KO-MO and CO-MO) neither of which is emphasised more over the other when KOMO and COMO are referred to aurally. Accordingly, the words KOMO and COMO are phonetically identical.

18. Visually, the words KOMO and COMO are similar. Both marks comprise four letters, the final three of which are identical. The letters K and C are often used interchangeably and the phonetic identity of the letters and also the words KOMO and COMO only serves to strengthen the visual similarity of the marks.

19. Conceptually, [Nestlé's] mark holds no meaning in relation to the goods covered by the registration. [Nestlé] is not aware that the word COMO holds any meaning in relation to the goods covered by the contested application. Accordingly, the respective marks cannot be regarded as being conceptually similar or dissimilar.”

40. In their written submissions dated 4 January 2011 Comobar say:

“[Comobar's] mark consists of seven letters whereas [Nestlé's] mark consists of four letters. [Comobar's] mark consists of three syllables, but [Nestlé's] mark consists of two syllables. Indeed, the only shared characteristics of the marks are their second, third and fourth letters OMO. The suffix composed of the letters BAR in [Comobar's] mark is simply not found in [Nestlé's] mark. [Comobar's] mark begins with the letter C whereas [Nestlé's] mark begins with the letter K.

Both sides are in agreement that neither mark as a whole has any conceptual meaning in relation to the goods...

Visually, the marks simply do not present a similar appearance since they differ so much in length and, crucially, in their first letter. A consumers' perception of

marks can be shaped by the beginning of the marks, in particular their first letters. Visually there is simply no similarity between a C and a K. The additional three letters BAR at the end of [Comobar's] mark are not found in [Nestlé's] mark. They render the opposed mark far longer than [Nestlé's] mark, and play a role in the mark's visual appearance. The respective marks differ at their beginnings and at their ends....

Phonetically, the additional letters BAR make the mark applied for a three-syllable mark rather than a two-syllable mark as registered by [Nestlé]. These letters are not found in [Nestlé's] mark. They render the opposed mark far longer than [Nestlé's] mark, and play a role in the mark's sound. ...”

41. Nestlé's submissions proceed on the assumption that the BAR element of Comobar's trade mark is descriptive, leaving the word COMO as the distinctive and dominant element; I have already explained why I disagree with that approach. Turning first to visual similarity, as Comobar point out it is only the letters OMO which the competing trade marks have in common. In my view, the differences between the respective trade marks far outweigh their similarities, rendering them overall visually similar to only a low degree.

42. Insofar as aural similarity is concerned, I agree that the competing trade marks consist of two (KO-MO) and three (CO-MO-BAR) syllables respectively. In my view the first two syllables of both trade marks are likely to be pronounced in an identical fashion i.e. with the letters K and C being pronounced with a hard K sound. Although Comobar's trade mark contains a third syllable, in my view, the identical manner in which the first two syllables will be pronounced renders the competing trade marks aurally similar to a reasonable degree.

43. As far as I am aware the words KOMO and COMOBAR have no meaning in relation to the goods at issue. Consequently, I agree with the parties that the competing trade marks are neither conceptually similar nor conceptually different.

### **Distinctive character of Nestlé's earlier trade mark**

44. I must now assess the distinctive character of Nestlé's trade mark. The distinctive character of a trade mark must be appraised first by reference to the goods in respect of which it has been registered and, second, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods for which it has been registered as coming from a particular undertaking and thus to distinguish those services from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

45. In their written submissions dated 24 May 2010 Nestlé said:

“6. KOMO is a made-up word that, in the context of the English speaking consumer, holds no direct or indirect meaning in relation to the goods covered by [Nestlé’s] registration.

7. Accordingly, [Nestlé’s] trade mark possesses a high degree of inherent distinctive character, and consequently, enjoys a broader scope of protection than is afforded to marks of a descriptive/semi descriptive nature, or from which consumers are able to derive a meaning.”

46. As Nestlé have not provided evidence of any use they may have made of their KOMO trade mark I have only its inherent characteristics to consider. Comobar accepts that Nestlé’s earlier trade mark has no meaning in relation to the goods for which it stands registered. It is, In effect, an invented word and as such is possessed (as Nestlé correctly argue) of a high degree of inherent distinctive character.

### **Likelihood of confusion**

47. In determining whether there is a likelihood of confusion, I need to bear a number of factors in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. It is also necessary for me consider the distinctive character of Nestlé’s trade mark, as the more distinctive this trade mark is the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods, the nature of the purchasing process and that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he/she has retained in his/her mind.

48. I have concluded: (i) the respective goods are identical, (ii) that as neither trade mark has a distinctive or dominant element the competing trade marks share a low degree of visual similarity, a reasonable degree of aural similarity and are neither conceptually similar nor dissonant, and (iii) that Nestlé’s KOMO trade mark is possessed of a high degree of inherent distinctive character. Based on those conclusions I must now decide if there is a likelihood of either direct confusion (where the average consumer mistakes one trade mark for the other) or indirect confusion (where the similarities would lead the average consumer to assume that the parties were economically linked). I have no doubt that the differences in the competing trade marks are more than sufficient to avoid any direct confusion. Insofar as indirect confusion is concerned, I am satisfied that the nature of both the average consumer and the manner in which the goods at issue are likely to be selected, are more than sufficient to offset the potential for indirect confusion resulting from the visual and aural similarities present in the first two syllables of each trade mark, and the opposition under section 5(2)(b) of the Act is dismissed accordingly.

## **Costs**

49. As Comobar have been successful they are entitled to a contribution towards their costs. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 4 of 2007. Using that TPN as a guide, I award costs to Comobar on the following basis:

Preparing a statement and considering the other side's statement:	£300
Preparing evidence and considering and commenting on the other side's evidence:	£700
Written submissions:	£300
<b>Total:</b>	<b>£1300</b>

50. I order Société des Produits Nestlé SA to pay to Comobar 2000 Inc the sum of **£1300**. This sum is 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 14 day of March 2011**

**C J BOWEN**  
**For the Registrar**  
**The Comptroller-General**