

O-339-14

TRADE MARKS ACT 1994

IN THE MATTER OF

APPLICATION NO 3005147

BY JOSEPH KOUMI

**TO REGISTER THE FOLLOWING TRADE MARK
IN CLASSES 16 AND 35:**



AND

**OPPOSITION THERETO (UNDER NO 400834)
BY PK FOOD CONCEPTS LIMITED**

BACKGROUND

1) On 08 May 2013 Joseph Koumi ('the applicant') applied to register the following trade mark in respect of the goods and services shown below:



Class 16: Packaging boxes of card; Packaging containers of paper.

Class 35: Advertising and marketing.

2) The application was published on 14 June 2013 in the Trade Marks Journal and notice of opposition was subsequently filed by PK Food Concepts Limited ('the opponent').

3) For the benefit of the applicant who does not appear to have had legal representation, I will explain that proceedings before the Tribunal are governed by the Trade Marks Act 1994 ('the Act'). The Act implements, inter alia, Directive 2008/95/EC of the European Parliament and of the Council of 22 October 2008 to approximate the laws of the Member States relating to trade marks ('the Directive') (as it is now). Consequently, interpretation of the Act is made on the basis of judgments of the Court of Justice of the European Union ('CJEU') and the General Court ('GC'), both with their seats in Luxembourg, as well as those of the courts in the United Kingdom. All of the judgments of the GC (previously known as the Court of First Instance) and the CJEU can be found at the following url:

<http://curia.europa.eu/jurisp/cgi-bin/form.pl?lang=en>

Judgments preceded by the letter C are from the CJEU and judgments preceded by the letter T are from the GC. The former is the higher court.

Decisions of the appointed persons, who are one of the two fora for appeal from decisions of the registrar, can be found on the website of the Intellectual Property Office at the following url:

<http://www.ipo.gov.uk/types/tm/t-os/t-find/t-challenge-decision-results.htm>

Decisions of the appointed persons can be identified by the prefix BL (decisions of the registrar also have this prefix). (The other fora of appeal are the High Court of England and Wales, the High Court of Northern Ireland and the Court of Session (in Scotland).)

The acronyms RPC, FSR and ETMR refer to Reports of Patent, Design and Trade Mark Cases, Fleet Street Reports and European Trade Mark Reports respectively. These are publications in which various decisions and judgments in relation to intellectual property and the law of passing-off are reported.

4) The opponent relies on the two UK trade mark registrations, as shown in the table below:

Registration details	Goods and services relied upon
<p>Registration No: 2626038</p> <p>STREET HEATS</p> <p>Filing date: 26 June 2012 Date of entry in the register: 28 September 2012</p>	<p>Class 29: <i>Snacks and prepared meals.</i></p> <p>Class 30: <i>Flour and preparations made from cereals, bread, pastry and confectionery; sandwiches; toasted sandwiches; wraps; pizza; bread rolls; filled rolls; paninis; ciabattas; artisan breads; cakes; fillings for sandwiches; salads; salad dressings; chilled foodstuffs; snack food.</i></p>
<p>Registration No: 2658104</p> <p>STREATS</p> <p>Filing date: 27 March 2013 Date of entry in the register: 19 July 2013</p>	<p>Class 29: <i>Snacks and prepared meals.</i></p> <p>Class 30: <i>Flour and preparations made from cereals, bread, pastry and confectionery; sandwiches; toasted sandwiches; wraps; pizza; bread rolls; filled rolls; paninis; ciabattas; artisan breads; cakes; fillings for sandwiches; salads; salad dressings; chilled foodstuffs; snack food.</i></p>

5) The trade marks relied upon by the opponent have filing dates of 26 June 2012 and 27 March 2013 and completed their registration procedures on 28 September 2012 and 19 July 2013 respectively. The consequences of these dates, in relation to the applicant's mark, are that i) the opponent's marks are earlier marks in accordance with section 6 of the Act and ii) they are not subject to the proof of use conditions contained in section 6A of the Act.

6) On behalf of the applicant, Mr Richard Harris (see preliminary point at paragraph 9 below) filed Form TM8 and counterstatement, denying with explanation, the grounds of opposition.

7) The opponent filed evidence and submissions during the evidential rounds; the applicant filed submissions only. Neither party requested to be heard. I therefore make this decision following a thorough review of all of the papers including all evidence and submissions. I will refer to certain of the parties' submissions as, and when, appropriate.

EVIDENCE

8) The opponent's evidence comes from Mr Malcolm Stephen Davies, partner at Berry Davies LLP (the opponent's legal representative in these proceedings) and Lesley Treeby, sales and marketing administrator, at the opponent's company. For reasons which will become apparent, there is no need for me to summarise the content of this evidence; it has no bearing on the outcome of these proceedings.

DECISION

Preliminary issue

9) In its submissions filed during the evidential rounds, the opponent states:

“5. Form TM8 and counterstatement has been filed by Richard Harri[e]s. Mr Harries is neither the applicant, owner nor recorded representative for trade mark application no.3005147. It is a requirement in opposition proceedings that the Form TM8 and counterstatement are submitted by a recorded representative for the applicant or the owner or holder. As this requirement has not been met we respectfully request that Form TM8 and counterstatement are found inadmissible.”

10) The official letter of 28 February 2014 stated, inter alia, the following:

“The Registry notes the opponent's comments with respect to the applicant's TM8 and counterstatement. However, the amended TM8 was deemed acceptable by the Registry and admitted into the proceedings.”

11) I note that the letter did not provide the opponent with the opportunity to be heard on the matter. Whilst the opponent did not make any further submission on the issue, for the sake of good order, I will deal briefly with this matter as a preliminary point.

12) The recorded applicant of the contested trade mark is Joseph Koumi. The address for service provided on the trade mark application was Chicken Joes Ltd, Empire Industrial Park, Aldridge, Walsall, WS9 8UR and the contact e-mail address given was richard@chickenjoes.co.uk (I note that this appears to be the e-mail address of Mr Richard Harries). Having regard for the requirements of rule 11 of the Trade Marks Rules 2008, and bearing in mind that the address for service and e-mail address provided by Mr Harries on the amended Form TM8 and counterstatement is identical to that provided by the applicant when filing its application, and that Mr Harries confirms he is acting as representative for Mr koumi, I am satisfied that the Form TM8 and counterstatement was correctly admitted by the registry.

Section 5(2)(b)

13) This section of the Act states:

“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.”

14) The leading authorities on the assessment of the likelihood of confusion under this section of the Act are from the CJEU. These are *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, *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 for 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) 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*,

f) 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*,

(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*,

(h) there is a greater likelihood of confusion where the earlier 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*,

(i) 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*,

(j) 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*,

(k) 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*,

(l) 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*.

Comparison of goods and services

15) The goods and services to be compared are shown in the table below:

Opponent's goods	Applicant's goods and services
<p>Class 29: Snacks and prepared meals.</p> <p>Class 30: Flour and preparations made from cereals, bread, pastry and confectionery; sandwiches; toasted sandwiches; wraps; pizza; bread rolls; filled rolls; paninis; ciabattas; artisan breads; cakes; fillings for sandwiches; salads; salad dressings; chilled foodstuffs; snack food.</p>	<p>Class 16: Packaging boxes of card; Packaging containers of paper.</p> <p>Class 35: Advertising and marketing.</p>

16) The leading authorities as regards determining similarity between goods and services are considered to be *British Sugar Plc v James Robertson & Sons Ltd* ('*Treat*') [1996] R.P.C. 281 and *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 117 ('*Canon*'). In the latter case, the CJEU accepted that all relevant factors should be taken into account including the nature of the goods/services, their intended purpose, their method of use and whether they are in competition with each other or are complementary. The criteria identified in the *Treat* case were:

(a) The respective uses of the respective goods or services;

(b) The respective users of the respective goods or services;

- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive.

17) In *Beautimatic International Ltd v. Mitchell International Pharmaceuticals Ltd and Another* ('*Beautimatic*') [2000] FSR 267 Neuberger J held that the words must be given their natural meaning, subject to their being construed within their context; they must not be given 'an unnaturally narrow meaning simply because registration under the 1994 Act bestows a monopoly on the proprietor'.

18) Further, in *YouView TV Ltd v Total Ltd* ('*YouView*') [2012] EWHC 3158 (Ch) Floyd J said:

"... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."

19) Whether goods/services are complementary (one of the factors referred to in *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*), will depend on whether there exists a close connection or relationship such that one is important or indispensable for the use of the other. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* ('*Boston Scientific*') Case T-325/06 it was stated:

"It is true that goods are complementary if there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking (see, to that effect, Case T-169/03 *Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI)* [2005] ECR II-685, paragraph 60, upheld on appeal in Case C-214/05 *P Rossi v OHIM* [2006] ECR I-7057; Case T-364/05 *Saint-Gobain Pam v OHIM – Propamsa (PAM PLUVIAL)* [2007] ECR II-757, paragraph 94; and Case T-443/05 *El Corte Inglés v OHIM – Bolaños Sabri (PiraÑAM diseño original Juan Bolaños)* [2007] ECR I-0000, paragraph 48)."

On the matter of complementarity, I also bear in mind the comments of Mr Daniel Alexander QC, sitting as the appointed person, in *Sandra Amalia Mary Elliott v LRC Products Limited* BL O/214/13 when he said:

“17. First, the starting point for the analysis of similarity is the wording of the Act and the Directive. These require the tribunal to determine whether or not the respective goods are “identical or similar” but they do not specify the criteria by reference to which similarity is to be assessed. In the well-established guidance from the Court of Justice on this issue originating in *Canon*, to which the Hearing Officer referred, the Court has not suggested that every case requires assessment of whether the respective goods or services are complementary. To the contrary, the Court has regularly made it clear that all relevant factors relating to the goods or services themselves should be taken into account, of which complementarity is but one (see e.g. in *Boston*).

18. Second, the concept of complementarity is itself not without difficulty. In a number of cases, reference to it does not make the assessment of similarity easier. If tribunals take the explanation of the concept in *Boston* as akin to a statutory definition, it can lead to unprofitable excursions into matters such as the frequency with which certain goods are used with other goods and whether it is possible for one to be used without the other. That analysis is sometimes of limited value because the purpose of the test, taken as a whole, is to determine similarity of the respective goods in the specific context of trade mark law. It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes.”

20) The opponent states, inter alia, the following:

“6. The goods are similar insofar that the class 16 packaging goods are designed to contain, identify and promote food products which are specifically protected under the opponent’s earlier trade mark registrations. Snack foods in particular are sold in card boxes and paper containers. The class 35 advertising and marketing services clearly seek to promote the sale of street food products, which are identical to the opponents goods.

7.The applicant’s website is www.lovejoes.co.uk and promotes the applicant’s range of goods and services. The news section of that website contains a reference to the applicant’s mark claiming that the “...Street Eats range has been introduced to satisfy students growing love for international flavours.” This clearly indicates that the mark is used in respect of selling, packaging and promoting food products.

8. In *Canon v MGM* [1999] RPC it was made clear that when considering similarity of goods or services all factors relating to the goods or services themselves must be taken into account.

The uses of the respective goods and services are confusingly similar. Food products, particularly snack food products, are convenience foods often sold in branded, disposable packaging. Consumers using packaging bearing the applicants mark would assume that the food contained in that packaging was from the applicant leading to a likelihood of confusion.

The users of the respective goods and services would be consumers of foods including snack foods, suppliers of foods including snack foods and food outlets. These are both the general public and owners of food service businesses. Such users would expect that the packaging and marketing were provided by the same entity as the food served in it or promoted by the marketing service. Users would suffer confusion if packaging and advertising bearing a similar mark were used to package and advertise food products.

The respective goods and services are provided by food service businesses which not only supply the food products but also supply packaging, marketing materials and promote such products through advertising.

The respective goods and services are complementary in the sense that the opponents food products are often served in branded packaging which is common method of serving snack foods in particular. Promotion of sales through marketing and advertising is an integral service in establishing and growing a successful food brand.”

It further states:

“The application was made in respect of goods and services in Classes 16 and 35 and the Statement of Grounds filed by the opponent describes why these goods and services should be considered similar to those of the opponent. The assertion by the opponent that the goods and services mask the true use of the applicant’s mark is supported by the applicant’s own comparison of goods which concedes that the products are similar in so far as they are edible...”

21) In making an assessment of the similarity between the respective goods and services, I remind myself that I must do so objectively on the basis of the actual specifications before me i.e. on the basis of the applicant’s goods and services, as applied for, and the opponent’s goods, as listed, in the earlier registration. That is the approach required under Section 5(2)(b) of the Act.

22) I will deal firstly with the applicant’s goods in class 16. These are ‘packaging boxes of card; packaging containers of paper’. The main thrust of the opponent’s argument is that there is similarity between the respective goods on the basis that the opponent’s food products are commonly served in packaging and therefore the respective uses and users are the same and the goods are complementary.

23) I disagree with the opponent that there is similarity between the goods. Firstly, as regards respective uses/intended purpose, packaging is used to hold goods for easy transport/handling whereas the opponent’s foodstuffs are used to relieve hunger. The use and intended purpose of the goods is therefore different. Secondly, the

opponent's foodstuffs will be bought mainly, in my view, by the general public whereas the applicant's packaging (insofar as the terms cover packaging for food) is likely to be purchased primarily by food producers who wish to use boxes/containers to place the food into before it is delivered to its customers. The users are, to that extent, not the same. Thirdly, foodstuffs are edible and packaging is not. Accordingly, and despite the applicant's own statement to the contrary, the respective nature is clearly not the same. Fourthly, a consumer will not choose between buying foodstuffs on the one hand and packaging on the other; they are not in competition. Fifthly, the trade channels are unlikely to be the same. Sixthly, whilst it is true that foodstuffs are commonly sold in packaging to enable easy transport and handling of the food or to preserve freshness, and therefore the respective goods are complementary in that sense, this factor alone is not sufficient to reach a finding that the respective goods are similar for trade mark purposes. Taking all of these factors into account, I find no similarity between the applicant's goods in class 16 and the opponent's goods.

24) I now turn to the applicant's services in class 35. These are 'advertising and marketing' services. The opponent's arguments in support of its claim to similarity between these services and its food products seem to be based on the mistaken premise that 'advertising and marketing' services means (or, at least, includes within its meaning) the promotion of one's own goods and services and therefore an undertaking advertising/marketing its own food products is similar to food products themselves. This is misconceived. 'Advertising and marketing' does not mean the activity of advertising/marketing one's own goods/services; it means the activity of advertising/marketing the goods/services of others. These are primarily business to business services in which X will advertise/promote Y's goods/services for the purpose of attracting custom for Y; it is these services which are covered by the applicant's term 'advertising and marketing'. Such services are plainly different in nature and intended purpose to the opponent's food products, the users of the respective goods and services is not the same, the trade channels are different and the respective goods and services are not in competition or complementary. There is no similarity between the opponent's goods and the applicant's services in class 35.

25) As there cannot be a likelihood of confusion where there is no similarity between the respective goods and services (see, for example, *Waterford Wedgwood v OHIM* Case C-398/07), the opponent has no prospect of success. **The opposition fails.**

COSTS

26) In approaching the matter of costs, I bear in mind that costs may only be awarded to a party to proceedings (rule 67 of The Trade Marks Rules 2008 refers). There is no power under the rules to make an award in respect of costs incurred by a non-party¹ (there is therefore no power to award costs to Mr Harries who, whilst acting as the applicant's representative, is not a party to the proceedings). The successful party in the case before me is Mr Kuomi. I have considered whether it is appropriate to make an award in his favour as a contribution towards the costs he is likely to have incurred in these proceedings. Any such award would be minimal

¹ See, to this end, the comments of Mr Geoffrey Hobbs QC sitting as the Appointed Person in BL 0/323/14 at paragraph [62].

given that no evidence was filed, no hearing took place and the submissions filed were fairly brief. However, I do not consider that an award to Mr Koumi is appropriate. The reasons for this are that the Form TM8 and counterstatement and written submissions both appear to have been prepared and filed on his behalf by Mr Harries. Mr Koumi therefore does not appear to have incurred costs associated with the time spent preparing the documents and nor has he incurred legal fees given that Mr Harries does not appear to be a legal professional. It appears to me that any costs incurred, through the preparation and filing of documents, have been incurred by Mr Harries who is not a party to these proceedings. I therefore do not consider that an award is appropriate in these particular circumstances.

Dated this 1st day of August 2014

**Beverley Hedley
For the Registrar,
the Comptroller-General**