

**O-293-15**

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION NO 3 036 389

BY MULLINS ICE CREAM LTD TO REGISTER AS A SERIES OF TWO:

MULLINS **MULLINS**




IN CLASS 30

AND OPPOSITION THERETO NO 402 128





BY MOLKEREI ALOIS MULLER GMBH & CO. JG

**Background and pleadings**

1. Mullins Ice Cream Ltd (the applicant) applied to register (as a series of two), the trade mark No 3 036 389: MULLINS **MULLINS** in the UK on 31 December 2013. It was accepted and published in the Trade Marks Journal on 7 February 2014 in respect of the following goods in Class 30: *Ice cream; goat's milk ice cream; ice cream products; ice cream confections; ice cream cakes; ice cream gateaux; ice cream cones; frozen confections; frozen desserts; frozen yoghurt; sauces and syrups for food; confectionery; toppings for desserts; toppings for ice cream; honeycomb; honeycomb pieces; preparations for making ice-cream; ices; water ices; sorbets.*
2. Molkerei Alois Muller GmbH & Co. JG (the opponent) partially oppose the trade mark on the basis of Section 5(2)(b), Section 5(3) and Section 5(4)(a) of the Trade Marks Act 1994 (the Act). The challenged goods are *frozen yoghurt* in Class 30. The opposition is on the basis of its earlier UK and Community Trade Mark, the details of which are:

Trade Mark Number	Representation of Mark	Classes of goods relied upon
UK No 2 538 380		Class 29 and Class 30
Community No 6 604 061		Class 29 and 30
UK No 2 412 518		Class 29 and 30

O-293-15

		
UK No 2 310 124		Class 29 and 30
UK No 2 208 983		Class 29 and 30
Community No 1 102 128		Class 29
Community No 1 240 092	MÜLLER	Class 29 and 30

## O-293-15

3. The above listed marks are also relied upon as the basis of the opponent's claim under Section 5(3) of the Trade Marks Act 1994.
4. The opponent argues that the respective goods are identical or similar and that the marks are similar. In respect of Section 5(3), the opponent claims that the aforementioned marks benefit from a reputation in the UK. The opponent argues that the applicant will benefit from the opponent's investment in advertising, leading to advantage. Further that the applicant will ride on its coat tails and will benefit from the power of attraction, reputation and prestige of the earlier marks.
5. In respect of Section 5(4)(a), the opponent claims to have been selling the goods: yogurt; dairy products; dairy desserts; milk; milk products; desserts; puddings; fromage frais; yogurt drinks; dairy rice; dairy drinks; jellies; jelly

MÜLLER

desserts under these signs: MULLER since 1 January 1991 and has acquired goodwill under the signs. Use of the trade mark applied for would therefore be a misrepresentation to the public and result in damage to the aforementioned goodwill.

6. The applicant filed a counterstatement denying the claims made (and requesting that the opponent provides proof of use of its earlier trade marks relied upon).
7. Both sides filed evidence. This will be summarised to the extent that it is considered necessary.
8. Both sides filed written submissions which will not be summarised but will be referred to as and where appropriate during this decision. No hearing was requested and so this decision is taken following a careful perusal of the papers.

### **Proof of use**

#### **Relevant statutory provision: Section 6A:**

“Raising of relative grounds in opposition proceedings in case of non-use

6A. - (1) This section applies where -

(a) an application for registration of a trade mark has been published,

## O-293-15

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) 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 or international trade mark (EC), 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.”

Section 100 of the Act states that:

“100. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

## O-293-15

In *Stichting BDO v BDO Unibank, Inc.*, [2013] EWHC 418 (Ch), Arnold J. stated as follows:

“51. Genuine use. In *Pasticceria e Confetteria Sant Ambroeus Srl v G & D Restaurant Associates Ltd* (SANT AMBROEUS Trade Mark) [2010] R.P.C. 28 at [42] Anna Carboni sitting as the Appointed Person set out the following helpful summary of the jurisprudence of the CJEU in *Ansul BV v Ajax Brandbeveiliging BV* (C-40/01) [2003] E.C.R. I-2439; [2003] R.P.C. 40 ; *La Mer Technology Inc v Laboratoires Goemar SA* (C-259/02) [2004] E.C.R. I-1159; [2004] F.S.R. 38 and *Silberquelle GmbH v Maselli-Strickmode GmbH* (C-495/07) [2009] E.C.R. I-2759; [2009] E.T.M.R. 28 (to which I have added references to *Sunrider v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* (OHIM) (C-416/04 P) [2006] E.C.R. I-4237):

(1) Genuine use means actual use of the mark by the proprietor or third party with authority to use the mark: *Ansul*, [35] and [37].

(2) The use must be more than merely token, which means in this context that it must not serve solely to preserve the rights conferred by the registration: *Ansul*, [36].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish the goods or services from others which have another origin: *Ansul*, [36]; *Sunrider* [70]; *Silberquelle*, [17].

(4) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, i.e. exploitation that is aimed at maintaining or creating an outlet for the goods or services or a share in that market: *Ansul*, [37]-[38]; *Silberquelle*, [18].

(a) Example that meets this criterion: preparations to put goods or services on the market, such as advertising campaigns: *Ansul*, [37].

(b) Examples that do not meet this criterion: (i) internal use by the proprietor: *Ansul*, [37]; (ii) the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle*, [20]-[21].

(5) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including in particular, the nature of the goods or services at issue, the characteristics of the market concerned, the scale and frequency of use of the mark, whether

## O-293-15

the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them, and the evidence that the proprietor is able to provide: *Ansul*, [38] and [39]; *La Mer*, [22]–[23]; *Sunrider*, [70]–[71].

(6) Use of the mark need not always be quantitatively significant for it to be deemed genuine. There is no de minimis rule. Even minimal use may qualify as genuine use if it is the sort of use that is appropriate in the economic sector concerned for preserving or creating market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor: *Ansul*, [39]; *La Mer*, [21], [24] and [25]; *Sunrider*, [72]”.

Although minimal use may qualify as genuine use, the CJEU stated in Case C-141/13 P, *Reber Holding GmbH & Co. KG v OHIM* (in paragraph 32 of its judgment), that “*not every proven commercial use may automatically be deemed to constitute genuine use of the trade mark in question*”. The factors identified in point (5) above must therefore be applied in order to assess whether minimal use of the mark qualifies as genuine use.

### Evidence filed

9. The opponent’s evidence consists of a witness statement from Gemma Louise Wisniewski, a solicitor employed by the opponent. It describes the long running use of MÜLLER in respect of yoghurts and dairy desserts and that there are a large number of sub brands available such as MÜLLER CORNER, MÜLLER CORNER DE LUXE, MÜLLER RICE, MÜLLERLIGHT. Sales figures are provided as regards MÜLLER products which are around 500 million each year for the years 2009 to 2013. This is not broken down into specific product sales, i.e. yoghurt as opposed to other products. However invoices to a number of different leading supermarkets around the UK are included which are invariably predominantly in respect of yoghurt. Advertising figures are also provided. Only once since 2010 have these figures dipped below 15 million with 2013 yielding a 22 million spend. Examples of advertising and magazine/newspaper articles regarding new product launches/new yoghurt flavour launches are also provided including an entry in the Daily Mail newspaper and Marketing Magazine. All are dated prior to the relevant date (31 December 2013). Photographs showing how the products are displayed in stores throughout the UK (during the relevant period) are also provided. Finally, copies of actual lids and side labels of the relevant products are provided.

**Conclusions on the opponent's evidence**

10. It is considered that the evidence filed demonstrates that the name MÜLLER, whether with accompanying device elements or not, has become synonymous with yoghurt in the UK and clearly was as at the relevant date in these proceedings, namely 31 December 2013. It is true that there is also use shown on other products which may arguably also demonstrate a reputation beyond yoghurts, for example, rice pudding style desserts. However, bearing in mind that the contested goods are in respect of frozen yogurts, the use and reputation shown with regards to yoghurt is considered to provide the opponent with its strongest claim, at least when considering the reputation angle and its impact. It should also be noted that the umlaut above the letter "u", is almost without exception, always displayed.
11. The applicant's evidence is a witness statement from Samuel Agnew, Company Secretary for the applicant. It describes the applicant's long standing use of MULLINS in respect of ice creams. Indeed it claims to have been operating for longer than the opponent. It also argues that it and the opponent have operated for many years without a single instance of confusion. This point will be returned to later in the decision.
12. This completes the evidence summary.

**DECISION**

**Section 5(2)(b)**

Sections 5(2)(b) of the Act is 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, or there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark".

**Comparison of goods.**

13. The contested goods, namely frozen yoghurt, also appear in the specification of the earlier trade mark UK No 2 538 380 which must be considered as filed as it is not subject to the proof of use provisions. They are identical. Further, the earlier trade marks have been found to have been used as regards yoghurt. Such products are self evidently similar to the contested goods.




## Comparison of marks

14. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

15. It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

16. The respective trade marks are shown below. It should be noted that for the sake of convenience, not all of the earlier trade are displayed below. If the opponent cannot succeed with those displayed below, it will not succeed with any of the other variants of its mark.

<p>MÜLLER</p> 	<p>MULLINS</p> <p><b>MULLINS</b></p>
<p>Earlier trade marks</p>	<p>Contested trade mark</p>

## O-293-15

17. Visually, both the earlier trade marks and the later marks contain the letters MULL which appear at the beginning. The endings differ: ER and INS respectively. There is also an umlaut appearing over the letter U in the earlier trade marks. Both of these differences have an important visual impact, though a degree of visual similarity remains. This is pitched as being fairly low.
18. Aurally, it is likely that MULL in the earlier trade marks will be pronounced like BULL whereas in the later mark it is likely to be the same as DULL. This is different. However, it cannot be discounted that the MULL in each would be pronounced in the same way (either both like BULL or both like DULL). The endings obviously differ and this does have an aural impact though similarity remains at least to a low degree.
19. Conceptually, each of the marks is a (different) surname. It is considered that MULLINS will be viewed by the UK public as a name. It is also likely that much of the same public will understand the earlier trade marks as being a German surname. However even for those who do not understand this, the earlier marks contain an umlaut which appears over the letter "u". Even if this does not immediately indicate to the British general public that the origin of the name is German, it is considered that it does communicate that its origin is foreign as umlauts are not marks used over vowels in the English language. Whether or not the earlier trade marks are understood as a German surname or simply as a non-English word, it is considered that this, coupled with the finding that MULLINS will be understood as a surname in its own right, provides a conceptual gap between the respective marks. Therefore, they are conceptually different.
20. The sum of all this is that the marks are similar to the extent that each contain the letters MULL. However, bearing in mind the differences identified and described above, the degree of overall similarity is considered to be low.

### Average consumer and the purchasing act

21. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer, Case C-342/97*.
22. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

23. These goods are inexpensive consumables and are purchased frequently. They are highly likely to be purchased by self selection visually. They would most likely not be co-located as frozen yoghurt is a frozen product and yoghurt a chilled product, though of course one of the earlier marks includes frozen yoghurt and so co-location is established in this regard. Though they are relatively inexpensive, the evidence filed demonstrates that the consumer is faced with a large choice of varieties in respect of yoghurt, for example, greek style, probiotic, low fat, low sugar versions. The relative health benefits can therefore play a role in the selection of such products. Further the evidence clearly demonstrates that there are numerous flavours of yoghurts available and the same is highly likely to be true of frozen yoghurt. It is concluded therefore that the average consumer is the public at large displaying at least an average degree of attention.

## **Distinctive character of the earlier trade mark**

24. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which,

## O-293-15

because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

25. The earlier trade marks are meaningless in respect of the relevant goods. It is prima facie highly distinctive. Further, as already stated, the evidence shows that the name MÜLLER is synonymous with yoghurt. This cements its high degree of distinctiveness inherently and through use .

### **GLOBAL ASSESSMENT – Conclusions on Likelihood of Confusion.**

26. It is noted that the Applicant claims that there have been no instances of confusion between the respective trade marks despite long standing use of the applied for trade mark. In this regard, the following guidance is helpful:

In *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220, Kitchen L.J. stated that:

“80. ....the likelihood of confusion must be assessed globally taking into account all relevant factors and having regard to the matters set out in *Specsavers* at paragraph [52] and repeated above. If the mark and the sign have both been used and there has been actual confusion between them, this may be powerful evidence that their similarity is such that there exists a likelihood of confusion. But conversely, the absence of actual confusion despite side by side use may be powerful evidence that they are not sufficiently similar to give rise to a likelihood of confusion. This may not always be so, however. The reason for the absence of confusion may be that the mark has only been used to a limited extent or in relation to only some of the goods or services for which it is registered, or in such a way that there has been no possibility of the one being taken for the other. So there may, in truth, have been limited opportunity for real confusion to occur.”

27. In *The European Limited v The Economist Newspaper Ltd* [1998] FSR 283 Millett L.J. stated that:

"Absence of evidence of actual confusion is rarely significant, especially in a trade mark case where it may be due to differences extraneous to the plaintiff's registered trade mark.”

28. In *Devinlec Développement Innovation Leclerc SA v OHIM*, Case C-171/06P, the Court of Justice of the European Union stated that:

## O-293-15

“59. As regards the fact that the particular circumstances in which the goods in question were marketed were not taken into account, the Court of First Instance was fully entitled to hold that, since these may vary in time and depending on the wishes of the proprietors of the opposing marks, it is inappropriate to take those circumstances into account in the prospective analysis of the likelihood of confusion between those marks.”

29. In the case in hand here, it is noted from the evidence filed by the Applicant that its use of the MULLINS name has thus far been in respect of ice cream rather than frozen yoghurt. It is highly plausible that this alone provides a reasonable explanation as to an absence of instances of confusion. As such, this matter will be set aside from the conclusions to be drawn as regards a likelihood of confusion.
30. As to whether there is a likelihood of confusion, the following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

### **The principles**

- (a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;
- (b) the matter must be judged through the eyes of the average consumer of the goods or services in question, 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, and whose attention varies according to the category of goods or services in question;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
- (d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when

## O-293-15

all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(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;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) 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;

(k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

31. In these proceedings, it has already been found that the name MÜLLER is synonymous with yoghurt. Further, there is an earlier trade mark which includes identical goods to those under attack. It is true that visual considerations can become more important where the goods are self selected as is the case here. See for example . *Quelle AG v OHIM*, Case T-88/05. There is a degree of visual (and indeed aural) similarity between the respective trade marks as a result of the inclusion of the letters MULL. Further, In *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02, the General Court noted that the beginnings of word tend to have more visual and aural impact than the ends. The court stated:

“81. It is clear that visually the similarities between the word marks MUNDICOLOR and the mark applied for, MUNDICOR, are very pronounced. As was pointed out by the Board of Appeal, the only visual difference between the signs is in the additional letters ‘lo’ which characterise the earlier marks and which are, however, preceded in

## O-293-15

those marks by six letters placed in the same position as in the mark MUNDICOR and followed by the letter 'r', which is also the final letter of the mark applied for. Given that, as the Opposition Division and the Board of Appeal rightly held, the consumer normally attaches more importance to the first part of words, the presence of the same root 'mundico' in the opposing signs gives rise to a strong visual similarity, which is, moreover, reinforced by the presence of the letter 'r' at the end of the two signs. Given those similarities, the applicant's argument based on the difference in length of the opposing signs is insufficient to dispel the existence of a strong visual similarity.

82. As regards aural characteristics, it should be noted first that all eight letters of the mark MUNDICOR are included in the MUNDICOLOR marks.

83. Second, the first two syllables of the opposing signs forming the prefix 'mundi' are the same. In that respect, it should again be emphasised that the attention of the consumer is usually directed to the beginning of the word. Those features make the sound very similar.

32. It is considered that the case in hand here can, however, be distinguished from the decision in MUNDICOLOR/MUNDICOLOR, in that there was no possibility in the earlier decision of a conceptual gap which had the effect of counteracting visual and aural similarities. Further, it is considered that visually and aurally the marks in the earlier decision are similar to a greater degree.

33. Despite the visual and aural similarity here, it is considered that there is an important conceptual gap between the marks. In this regard the following guidance is helpful: In *The Picasso Estate v OHIM*, Case C-361/04 P, the Court of Justice of the European Union found that:

"20. By stating in paragraph 56 of the judgment under appeal that, where the meaning of at least one of the two signs at issue is clear and specific so that it can be grasped immediately by the relevant public, the conceptual differences observed between those signs may counteract the visual and phonetic similarities between them, and by subsequently holding that that applies in the present case, the Court of First Instance did not in any way err in law."

34. These are considered to be marks with separate and quite distinct identities which work to create a gap between the ideas that the marks create in the mind of the relevant consumer. MÜLLER is a German surname and even if this would not be recognised as such by all of the relevant public, it is in any case clearly of non-English origin. In contrast, it is considered that the trade mark applied for will be understood as a (different) surname which has the effect of setting it apart from the earlier marks. It is considered highly unlikely that one will be mistaken for the other, even in respect of identical goods. Further it is considered that the opponent's reputation in respect of yoghurt

## O-293-15

does not place them in any better position. Even if, due to the extensive reputation it enjoys, the relevant public would expect to see the name MÜLLER on the later goods it is considered that the impact of the (important) differences between the marks remains. The effect being that there is no likelihood of confusion. Bearing in mind all of the aforesaid it is clear that the marks will also not be economically linked as they will be seen as having distinct identities. The later mark will not be seen as a brand variant and so there is no likelihood of indirect confusion. The ground of opposition based upon Section 5(2)(b) of the Act fails.

### Section 5(3) – Reputation

#### Legislation

35. Section 5(3) states:

“(3) A trade mark which-

(a) is identical with or similar to an earlier trade mark, 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 or international trade mark (EC), 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.”

36. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, [1999] ETMR 950, Case 252/07, *Intel*, [2009] ETMR 13, Case C-408/01, *Addidas-Salomon*, [2004] ETMR 10 and C-487/07, *L’Oreal v Bellure* [2009] ETMR 55 and Case C-323/09, *Marks and Spencer v Interflora*. The law appears to be as follows.

a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman*, paragraph 29 and *Intel*, paragraph 63.



## O-293-15

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel, paragraph 42*

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel, paragraph 68*; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel, paragraph 79*.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77*.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74*.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV, paragraph 40*.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora, paragraph 74 and the court's answer to question 1 in L'Oreal v Bellure*).

## Reputation

37. As already found, it is clear that MÜLLER enjoys a significant reputation, at least in respect of yoghurt. The first hurdle as regards Section 5(3) is therefore cleared.

## The Link

38. The analysis above has already discussed the level of similarity between the signs. It is of course the case that the level of similarity required for the public to make a link may be less than that required for a finding of likelihood of confusion: In *Intra-Press SAS v OHIM*, Joined cases C-581/13P & C-582/13P, the Court of Justice of the European Union stated (at paragraph 72 of its judgment) that:

“The Court has consistently held that the degree of similarity required under Article 8(1)(b) of Regulation No 40/94, on the one hand, and Article 8(5) of that regulation, on the other, is different. Whereas the implementation of the protection provided for under Article 8(1)(b) of Regulation No 40/94 is conditional upon a finding of a degree of similarity between the marks at issue so that there exists a likelihood of confusion between them on the part of the relevant section of the public, the existence of such a likelihood is not necessary for the protection conferred by Article 8(5) of that regulation. Accordingly, the types of injury referred to in Article 8(5) of Regulation No 40/94 may be the consequence of a lesser degree of similarity between the earlier and the later marks, provided that it is sufficient for the relevant section of the public to make a connection between those marks, that is to say, to establish a link between them (see judgment in *Ferrero v OHMI*, C-552/09 P, EU:C:2011:177, paragraph 53 and the case-law cited).”

39. It is also true that the goods are closely linked, that the relevant public is the same and that MÜLLER enjoys a strong reputation in respect of yoghurt. All of these factors weigh in the opponent's favour. However, the fact remains that the respective signs each have their own distinct identity (as discussed above). It is therefore difficult to see how the relevant public will make any connection between them or in other words, establish a link. As no link has been established, the ground of opposition based upon Section 5(3) of the Act also fails.

## Section 5(4)(a)

### Legislation

40. Section 5(4)(a) states:

## O-293-15

“A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented –

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

(b)...

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of “an earlier right” in relation to the trade mark.”

### Goodwill

41. The evidence filed clearly established that MÜLLER has established a long standing goodwill under the name in respect of yoghurt (as a minimum).
42. However the claim under this ground of opposition is also made in respect of MULLER minus the umlaut. The evidence filed overwhelmingly confirms that the earlier trade marks have, almost without exception, been used with the umlaut intact. This ground of opposition will therefore be considered in respect of the sign MÜLLER.
43. As regards misrepresentation, in *Neutrogena Corporation and Another v Golden Limited and Another*, [1996] RPC 473, Morritt L.J. stated that:

“There is no dispute as to what the correct legal principle is. As stated by *Lord Oliver of Aylmerton in Reckitt & Colman Products Ltd. v. Borden Inc.* [1990] R.P.C. 341 at page 407 the question on the issue of deception or confusion is

“is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the public will be misled into purchasing the defendants' [product] in the belief that it is the respondents'[product]”

The same proposition is stated in *Halsbury's Laws of England* 4th Edition Vol.48 para 148 . The necessity for a substantial number is brought out also in *Saville Perfumery Ltd. v. June Perfect Ltd.* (1941) 58 R.P.C. 147 at page 175 ; and *Re Smith Hayden's Application* (1945) 63 R.P.C. 97 at page 101.”

And later in the same judgment:

“.... for my part, I think that references, in this context, to “more than *de minimis*” and “above a trivial level” are best avoided notwithstanding this court's reference to the former in *University of London v. American University of London* (unreported 12 November 1993) . It seems to me that such expressions are open to misinterpretation for they do not necessarily connote the opposite of substantial and their use may be

## O-293-15

thought to reverse the proper emphasis and concentrate on the quantitative to the exclusion of the qualitative aspect of confusion.”

44. There is one possible difference between the position under trade mark law and the position under passing off law. In *Marks and Spencer PLC v Interflora*, [2012] EWCA (Civ) 1501, Lewinson L.J. cast doubt on whether the test for misrepresentation for passing off purposes came to the same thing as the test for a likelihood of confusion under trade mark law. He pointed out that it is sufficient for passing off purposes that “a substantial number” of the relevant public are deceived, which might not mean that the average consumer is confused. As both tests are intended to be normative measures intended to exclude those who are unusually careful or careless (per Jacob L.J. in *Reed Executive Plc v Reed Business Information Ltd* [2004] RPC 40), it is doubtful whether the difference between the legal tests will (all other factors being equal) produce different outcomes.
45. As already found above, these signs are considered to have distinct identities. It is therefore difficult to see how there can be any misrepresentation. This ground of opposition takes the opponent no further and so must also fail.

## CONCLUSION

46. Bearing in mind all of the aforesaid, the opposition fails in its entirety.

## COSTS

47. The applicant has been successful and is entitled to a contribution towards its costs. In the circumstances I award the applicant the sum of £500 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Preparing statement of case and considering the other side's: £100

Preparing evidence and considering the other side's: £250

Preparing written submissions: £150

TOTAL: £500

48. I therefore order Molkerei Alois Muller GmbH & Co. JG to pay Mullins Ice Cream Ltd the sum of £500. The above sum should be paid within seven days

## **O-293-15**

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 23rd day of June 2015**

**Louise White**

**For the Registrar,  
The Comptroller-General**