

**O-139-16**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO 3082959  
BY  
CHRIS HOWARD**

**TO REGISTER A SERIES OF TWO TRADE MARKS**

**MONSOON ESTATES**

**&**

**Monsoon Estates**

**IN CLASSES 30 AND 40**

**AND**

**THE OPPOSITION THERETO  
UNDER NO 403981  
BY  
BRADLEY JEAN-PIERRE**

## BACKGROUND

1. On 24 November 2014, Chris Howard (the applicant) applied to register the series of two trade marks shown on the cover page of this decision. The application was made in respect of goods in classes 30 and 40 of the Nice Classification system<sup>1</sup> as follows:

### **Class 30**

Coffee; Whole coffee beans; Ground coffee; Roasted coffee; Green coffee beans; Brewed coffee; Coffee based beverages; Espresso and espresso based beverages; Tea; Loose leaf tea; Cocoa; Cocoa based beverages; Cocoa preparations; Drinking chocolate; Drinking chocolate powder.

### **Class 40**

Coffee roasting and processing; Coffee grinding; Coffee blending; Coffee brewing; Coffee cold-brewing.

2. The application was published on 12 December 2014, following which Bradley Jean-Pierre (the opponent) filed notice of opposition against the application.

3. The opposition is based on section 5(2)(b) of the Trade Marks Act 1994 (the Act) and is brought against the applicant's 'tea' and 'loose leaf tea' in class 30. The opponent relies upon the following mark:

<b>Mark details and relevant dates</b>	<b>Goods relied upon</b>
<b>TM: 3057981</b>  <b>MONSOON TEA</b>  <b>Filed:</b> 2 June 2014  <b>Entered in the register:</b> 19 September 2014	<b>Class 30</b>  Teas

4. The opponent's mark is an earlier mark which had not been registered for five years at the date of publication of the application. Consequently, the proof of use requirements, set out in s.6A of the Act, do not apply.<sup>2</sup> Accordingly, the opponent is entitled to rely on its full specification as registered for its earlier mark in these proceedings.

5. The applicant filed a counterstatement on 27 May 2015. He denies the grounds on which the opposition is based and submits that he is the owner of prior rights in the UK.

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

<sup>2</sup> *See section 6A of the Act (added by virtue of the Trade Marks (Proof of Use, etc.) Regulations 2004: SI 2004/946) which came into force on 5th May 2004.*

6. TPN 4/2009 is titled “*Trade mark opposition and invalidation proceedings – defences.*” Under the heading “*The position with regard to defences based on use of the trade mark under attack which precedes the date of use or registration of the attacker’s mark*”, the following is stated:

“4. The viability of such a defence was considered by Ms Anna Carboni, sitting as the appointed person, in *Ion Associates Ltd v Philip Stainton and Another*, BL O-211-09. Ms Carboni rejected the defence as being wrong in law.

5. Users of the Intellectual Property Office are therefore reminded that defences to section 5(1) or (2) grounds based on the applicant for registration/registered proprietor owning another mark which is earlier still compared to the attacker’s mark, or having used the trade mark before the attacker used or registered its mark, are wrong in law. **If the owner of the mark under attack has an earlier mark or right which could be used to oppose or invalidate the trade mark relied upon by the attacker, and the applicant for registration/registered proprietor wishes to invoke that earlier mark/right, the proper course is to oppose or apply to invalidate the attacker’s mark.**”

7. The applicant has not sought to cancel (or ‘invalidate’ to use the language of s.47 of the Act) the earlier trade mark on the basis of its claim to an earlier common law earlier right. Consequently, the opponent’s trade mark must be regarded as a validly registered mark. In this situation the law requires priority to be determined according to the filing dates of the applications for registration. This means that the opponent’s mark has priority and a likelihood of confusion between the marks based on their notional use throughout the UK will be enough to justify the refusal of the applicant’s later filed trade mark.

8. The opponent filed written submissions in the period allowed for the filing of evidence. The applicant filed evidence. Neither side filed written submissions in lieu of attendance at a hearing nor did they request a hearing.

### **Evidence and submissions**

9. The applicant filed evidence in the form of a witness statement by Chris Howard. Eleven exhibits were attached to the statement which is dated 16 October 2015. The evidence is filed in support of the applicant’s claim that he has prior rights in the UK. For the reasons given at paragraphs 6 and 7 above, the evidence is not relevant to the issue before me.

10. Submissions which are included with the evidence will be referred to as necessary below, as will the submissions filed by the opponent on 3 August 2015.

### **DECISION**

11. Section 5(2)(b) reads as follows:

“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.”

### **Section 5(2)(b) case law**

12. 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 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 will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

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

13. 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*. 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 word ‘average’ denotes that the person is typical. The term ‘average’ does not denote some form of numerical mean, mode or median.”

14. Tea and loose leaf tea are normal everyday goods bought by members of the general public. The selection process for the goods and services is primarily visual, though I do not discount the fact that there may be an aural element given that word of mouth recommendation may play a part. The goods may be purchased on the high street, online or by mail order. The level of attention paid will be average, the consumer paying the attention necessary to obtain, inter alia, the particular leaf or blend in their chosen form, be it leaves, bags, etc.

### **Comparison of goods**

15. In comparing the goods and services, I bear in mind the following guidance provided by the GC in *Gérard Meric v OHIM*, Case T-133/05:

“29. ...goods can be considered identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark.”

16. The opponent relies on ‘teas’. The contested mark is applied for in respect of tea and loose leaf tea. Clearly ‘tea’ is an identical term contained in both specifications. ‘Loose leaf tea’ is included in the opponent’s wider term ‘tea’ and is identical in accordance with *Meric*.

### Comparison of marks

17. It is clear from *Sabel BV v. Puma AG* (particularly at 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 (CJEU) 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.”

18. 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.

19. The marks to be compared are as follows:

Opponent’s mark	Applicant’s mark
MONSOON TEA	MONSOON ESTATES Monsoon Estates

20. The opponent’s mark consists of the two words MONSOON and TEA presented in block capitals with no form of stylisation. The overall impression of the mark is dominated by the initial word MONSOON, the second word simply being seen by the average consumer as a description of the goods.

21. The application is made for a series of two marks which differ only in the case in which they are presented. The first mark in the series is presented in upper case in plain black font, the second mark is made up of the same two words, presented in title case, with no additional stylisation. Throughout the remainder of this decision I shall refer to the applicant’s mark as ‘MONSOON ESTATES’ which should be considered to refer to both marks in the series.

22. The applicant's mark is made up of the two words MONSOON and ESTATES. The word 'ESTATES' will most likely be considered by the average consumer to be a reference to the plantation/farm where the tea is grown. The first word, MONSOON being the indication of the particular farm/plantation. The two words hang together with the overall impression being stronger in respect of the first word MONSOON.

### **Visual and aural similarities**

23. Both marks consist of two common English words which will be known to the average consumer. Any similarity between the marks rests in the fact that each contains the word 'MONSOON', it being the first word of both parties' marks. There is clear difference in the fact that the opponent's mark has the second word 'TEA' and the applicant's has the second word 'ESTATES'. These are clearly visually different, being different lengths with different beginnings and will evidently be pronounced differently.

24. Taking all of these factors into account the marks are visually and aurally similar to a medium degree.

### **Conceptual similarities**

25. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer.<sup>3</sup> Furthermore, the assessment of conceptual similarity must be made from the point of view of the average consumer who cannot be assumed to know the meaning of everything.<sup>4</sup>

26. Both parties' marks begin with the word MONSOON. The parties' goods are teas. 'MONSOON' is a well-known word in the English language and will be easily understood by the average consumer as referring to a type of weather. Even if I am wrong in this and the average consumer presumes a different meaning, any alternative will be the same in respect of both marks. The addition of the word 'TEA' in the earlier mark will not be given any origin significance since it simply describes the goods. Similarly, the second word, 'ESTATES' in the application, in the context of tea will be seen as indicating the particular farm or plantation where the tea is grown.

27. The marks are conceptually similar to a high degree.

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

28. In determining the distinctive character of a trade mark it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify its goods as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger Joined Cases C-108/97 and C-109/97* [1999] ETMR 585.

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<sup>3</sup> This is highlighted in numerous judgments of the GC and the CJEU including *Ruiz Picasso v OHIM* [2006] e.c.r.-I-643; [2006] E.T.M.R. 29.

<sup>4</sup> See the comments of Anna Carboni, sitting as the Appointed Person in *Cherokee*, BL O-048-08, paragraphs 36 and 37.

29. The opponent has not filed any evidence to show that it has used its mark, so I have only the inherent position to consider. The earlier mark consists of the words 'MONSOON TEA'. As I have already discussed, the word TEA is descriptive. The word MONSOON is not descriptive nor does it allude to the goods relied upon. Rather, the mark in its totality is a normal trade mark, possessed of a medium level of inherent distinctive character.

### **Likelihood of confusion**

30. I have found the following:

- The parties' marks are visually and aurally similar to a medium degree.
- The parties' marks are conceptually similar to a high degree.
- The earlier mark has a medium degree of inherent distinctive character in relation to the goods relied on by the opponent.
- The average consumer is a member of the general public - the degree of attention paid is likely to be at least be average, the consumer paying the attention necessary to obtain, inter alia, the particular leaf or blend in their chosen form, be it leaves, bags, etc.
- The parties' goods are identical.

31. There is a general rule, clear from decisions such as joined cases T-183/02 and T-184/0275,<sup>5</sup> that the first parts of words, and by analogy, the first words of marks catch the attention of consumers. However, it is also clear that each case must be decided on its merits considering the marks as wholes. In this case both marks begin with the word 'MONSOON'. The second word of the applicant's mark 'ESTATES' will be seen as indicating the plantation or farm where the tea is grown. The second word of the opponent's mark, 'TEA', simply describes the goods which are teas. Bearing in mind the concept of imperfect recollection, in the context of widely available and fairly low cost goods, the similarity of the marks is such that there will, in my view, be direct confusion (where one mark is mistaken for the other).

32. Even if I am found to be wrong in this, I am mindful of *L.A. Sugar Limited v By Back Beat Inc*<sup>6</sup>, in which Mr Iain Purvis Q.C. sitting as the Appointed Person noted that:

"16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious

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<sup>5</sup> *El Cortes Inglés v OHIM - González Cabello and Iberia Lineas Aéreas de España (MUNDICOR)* [2004] ER II - 965, paragraph 81

<sup>6</sup> *Case BL-O/375/10*



but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

33. In this case, if the average consumer notices the differences between the parties’ marks, the common element is such that it would lead to the average consumer making a connection between them that would result in a belief that the goods are being provided by an economically linked undertaking. An average consumer familiar with MONSOON ESTATES as a brand which sells tea would, upon encountering MONSOON TEA, simply presume it to be tea from that estate. The same is true where the consumer is familiar with MONSOON TEA as a brand of tea. Upon encountering MONSOON ESTATES used in respect of tea, they are likely to conclude it to be the originator of the tea with which they are familiar.

**34. The opposition succeeds under section 5(2)(b) of the Act.**

## **CONCLUSION**

**35. This was a partial opposition being brought only in respect of tea and loose leaf tea in class 30 of the application. The application can proceed to registration for the following goods and services:**

### **Class 30**

Coffee; Whole coffee beans; Ground coffee; Roasted coffee; Green coffee beans; Brewed coffee; Coffee based beverages; Espresso and espresso based beverages; Cocoa; Cocoa based beverages; Cocoa preparations; Drinking chocolate; Drinking chocolate powder.

### **Class 40**

Coffee roasting and processing; Coffee grinding; Coffee blending; Coffee brewing; Coffee cold-brewing.

## **COSTS**

36. The opposition having succeeded, the opponent is entitled to a contribution towards its costs. I take into account that the opponent filed submissions which were brief and duplicated the statement of grounds. I make the award on the following basis:

Official fee:	£100
Preparing a statement and considering the other side's statement	£200
<b>Total:</b>	<b>£300</b>

37. I order Chris Howard to pay Bradley Jean-Pierre the sum of £300. 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 16th day of March 2016**

**Ms Al Skilton  
For the Registrar,  
The Comptroller-General**