

O-490-17

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO 3141992 BY  
PROSPECT IF LIMITED

TO REGISTER THE TRADE MARK:

**PINGPERFECT**

IN CLASSES 11, 16, 29 AND 30  
AND THE OPPOSITION THERETO UNDER NO 406425 BY  
KARSTEN MANUFACTURING CORPORATION

## **BACKGROUND**

1. On 23 December 2015, Prospect If Limited (the applicant) applied to register the above trade mark. The relevant parts of the specification stand as follows:<sup>1</sup>

### **Class 11**

Apparatus for heating, cooking, refrigerating and water supply; Apparatus for keeping food warm; Food warmers; Food display units [refrigerated or heated]; Appliances for heating; Apparatus for refrigerating; Thermoelectric apparatus for the preparation of beverages; Apparatus for keeping hot drinks warm; Coffee roasting machines; Coffee machines; Parts and fittings for all the aforesaid goods.

### **Class 16**

Adhesive labels; Adhesive paper; 3D decals for use on any surface; Absorbent sheets of paper or plastic for foodstuff packaging; Bags [envelopes, pouches] of paper or plastics, for packaging; Bags for microwave cooking; Bags made of paper for packaging; Bags of paper for foodstuffs; Bags of paper for roasting purposes; Bags made of plastics for packaging; Baking paper; Boxes of cardboard or paper; Brown paper for wrapping; Cardboard cake boxes; Cardboard containers; Cardboard packaging; Cling film plastics for packaging; Coffee filters of paper; Film (Plastic cling -) extensible, for palletisation; Films for wrapping foodstuffs; Foils of plastic for packaging; Food wrappers; Greaseproof paper; Microwave cooking bags; Paper baking cups; Paper impregnated with oil for wrapping purposes; Paper take-out cartons for food; Paper wipes; Paperboard trays for packaging food; Plastic materials for packaging (not included in other classes); Price tags.

### **Class 29**

Cheese; Soups.

### **Class 30**

Microwavable ready pasta; pasta containing fillings.

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<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).*

2. The application was published on 15 January 2016, following which Karsten Manufacturing Corporation (the opponent) filed notice of opposition against all of the goods at paragraph 1 of this decision.

3. The opponent bases its case on section 5(2)(b) of the Trade Marks Act 1994 (the Act) and relies upon the following trade marks and goods:

Mark details and relevant dates	Goods relied upon
<p>EU TM: 10437804</p> <p><b>PING</b></p> <p>Filed: 23 November 2011 Registered: 11 April 2012</p>	<p><b>Class 11</b> Lamps; lanterns; lighting apparatus.</p> <p><b>Class 30</b> Candy; confectionery; ice cream.</p> <p><b>Class 32</b> Drinking water; non-alcoholic drinks.</p>
<p>EU TM: 14920318</p> <p><b>PING</b></p> <p>Filed: 17 December 2015 Registered: 12 May 2016</p>	<p><b>Class 11</b> Lamps; lanterns; lighting apparatus.</p> <p><b>Class 16</b> Printed matter; brochures; catalogues; books, including comic-books; magazines; songbooks, posters; photographs; postcards; pens; pencils; stationery; adhesives for stationery or household purposes; artists' materials; paint brushes; instructional and teaching material (except apparatus).</p> <p><b>Class 21</b> Household or kitchen containers; plastic water bottles.</p> <p><b>Class 29</b> Meat, fruit and vegetable based snack foods; prepared nuts; potato chips and potato crisps.</p> <p><b>Class 30</b> Biscuits; cakes; cereal-based snack food; confectionery; cocoa-based beverages; coffee; tea; cookies; salad dressings; sauces; ice, ices and ice cream; marinades; prepared meals; pastries; pasties; pizzas; sandwiches; rice-based snack foods; sweets; frozen yoghurt.</p> <p><b>Class 32</b> Drinking water; non-alcoholic drinks.</p>

4. With regard to the parties' goods the opponent submits:

*"4...the goods covered by the later trade mark in Classes 11, 16, 29 and 30 are identical or similar to the goods covered by the earlier trade marks. When the goods are not identical or are not immediately obviously similar, there is a very strong element of complementarity. For example, some of the goods in Classes 11 and 16 of the later trade mark relate to the packaging, treatment or preparation of the goods in Classes 29, 30 and 32..."*

5. With regard to the respective marks the opponent submits that the marks are similar due to the fact that the entirety of the opponent's mark, 'PING', which is 'inherently unusual and distinctive' is a significant distinctive element of the later mark. It states:

*"5... The addition of the adjective 'PERFECT' at the end of the PING element is a non-distinctive alteration that does not distinguish the trade mark message of the latter mark from the earlier trade marks. The word 'perfect' is simply used as an adjective to refer back to, and describe in a laudatory fashion, the products sold under the PING trade mark."*

6. The opponent concludes that there is a likelihood of confusion including a likelihood of association between the earlier and later trade marks.

7. The applicant filed a counterstatement in which it denies the ground on which the opposition is based.

8. The opponent filed evidence. The applicant filed written submissions. Both parties filed skeleton arguments. A hearing subsequently took place before me, by video conference, at which the applicant was represented by Mr Phillip Johnson of Counsel. The opponent was represented by Mr Edmund Harrison of Mewburn Ellis LLP.

## **EVIDENCE**

9. The opponent's evidence is provided by the witness statement of Mr Edmund Stephen Harrison and exhibits ESH1-ESH26. I do not intend to summarise the evidence here but will refer to it as necessary throughout this decision.

## **DECISION**

10. Section 5(2)(b) 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.”

11. 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.”

12. The opponent's earlier mark is not subject to proof of use because, at the date of publication of the application, it had not been registered for five years.<sup>2</sup>

### **Preliminary issue**

13. The opponent relies upon two earlier marks. One is presented PING in plain block capitals, the other is the same word presented in a round edged typeface. In terms of the comparison with the applicant's mark, nothing hangs on this slight difference in typeface.

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

14. 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.

(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;

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<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.

(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 greater 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.

## Comparison of goods

15. The goods to be compared are as follows:

The opponent's goods:	The applicant's goods:
<p><b>Class 11 (both earlier marks)</b> Lamps; lanterns; lighting apparatus.</p>	<p><b>Class 11</b> Apparatus for heating, cooking, refrigerating and water supply; Apparatus for keeping food warm; Food warmers; Food display units [refrigerated or heated]; Appliances for heating; Apparatus for refrigerating; Thermoelectric apparatus for the preparation of beverages; Apparatus for keeping hot drinks warm; Coffee roasting machines; Coffee machines; Parts and fittings for all the aforesaid goods.</p>
<p>Class 16 (14920318) Printed matter; brochures; catalogues; books, including comic-books; magazines; songbooks, posters; photographs; postcards; pens; pencils; stationery; adhesives for stationery or household purposes; artists' materials; paint brushes; instructional and teaching material (except apparatus).</p>	<p>Class 16 Adhesive labels; Adhesive paper; 3D decals for use on any surface; Absorbent sheets of paper or plastic for foodstuff packaging; Bags [envelopes, pouches] of paper or plastics, for packaging; Bags for microwave cooking; Bags made of paper for packaging; Bags of paper for foodstuffs; Bags of paper for roasting purposes; Bags made of plastics for packaging; Baking paper; Boxes of cardboard or paper; Brown paper for wrapping; Cardboard cake boxes; Cardboard containers; Cardboard packaging; Cling film plastics for packaging; Coffee filters of paper; Film (Plastic cling -) extensible, for palletisation; Films for wrapping foodstuffs; Foils of plastic for packaging; Food wrappers; Greaseproof paper; Microwave cooking bags; Paper baking cups; Paper impregnated with oil for wrapping purposes; Paper take-out cartons for food; Paper wipes; Paperboard trays for packaging food; Plastic materials for packaging (not included in other classes); Price tags.</p>
<p><b>Class 21 (14920318)</b> Household or kitchen containers; plastic water bottles.</p>	



<b>Class 29 (14920318)</b> Meat, fruit and vegetable based snack foods; prepared nuts; potato chips and potato crisps.	<b>Class 29</b> Cheese; Soups.
<b>Class 30 (10437804)</b> Candy; confectionery; ice cream.  <b>Class 30 (14920318)</b> Biscuits; cakes; cereal-based snack food; confectionery; cocoa-based beverages; coffee; tea; cookies; salad dressings; sauces; ice, ices and ice cream; marinades; prepared meals; pastries; pasties; pizzas; sandwiches; rice-based snack foods; sweets; frozen yoghurt.	<b>Class 30</b> Microwavable ready pasta; pasta containing fillings.
<b>Class 32 (both marks)</b> Drinking water; non-alcoholic drinks.	

16. When making the comparison, all relevant factors relating to the goods and services in the specification should be taken into account. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*, the Court of Justice of the European Union (CJEU) stated at paragraph 23 of its judgment:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary”.

17. Guidance on this issue has also come from Jacob J. (as he then was) in the *Treat* case,<sup>3</sup> where he identified the factors for assessing similarity as:

- a) The respective users of the respective goods or services;

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<sup>3</sup> [1996] R.P.C. 281

- b) The physical nature of the goods or acts of services;
- c) The respective trade channels through which the goods or services reach the market;
- d) 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;
- e) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

18. In *Gérard Meric v Office for Harmonisation in the Internal Market*,<sup>4</sup> the General Court (GC) stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM- Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

19. I also remind myself of the guidance given by the courts on the correct approach to the interpretation of specifications. In *YouView TV Ltd v Total Ltd*,<sup>5</sup> Floyd J. (as he then was) stated that:

“[...] 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

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<sup>4</sup> *Case T- 133/05*

<sup>5</sup> [2012] EWHC 3158 (Ch)

[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”.

20. In *Kurt Hesse v OHIM*,<sup>6</sup> the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods and services. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the GC stated that “complementary” means:

“...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”.

21. In *Sanco SA v OHIM*,<sup>7</sup> the GC indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL O/255/13:

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<sup>6</sup> Case C-50/15 P

<sup>7</sup> Case T-249/11

“18. [...] 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.”

22. In the same case, Mr Alexander also warned against applying too rigid a test when considering complementarity:

“20. In my judgment, the reference to “legal definition” suggests almost that the guidance in *Boston* is providing an alternative quasi-statutory approach to evaluating similarity, which I do not consider to be warranted. It is undoubtedly right to stress the importance of the fact that customers may think that responsibility for the goods lies with the same undertaking. However, it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together. I therefore think that in this respect, the Hearing Officer was taking too rigid an approach to *Boston*”.

23. For the purposes of considering the issue of similarity of goods and services, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way and for the same reasons.<sup>8</sup>

#### The applicant’s goods in class 11

24. In relation to the respective goods in class 11 the opponent states:

*“The earlier marks cover ‘lamps’, a word that has more than one meaning, In class 11, this word covers both lamps for lighting purposes, and also*

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<sup>8</sup> see *Separode Trade Mark BL O/399/10 and BVBA Management, Training en Consultancy v. Benelux-Merkenbureau* [2007] ETMR 35 at paragraphs [30] to [38].

*lamps for heating...it is clearly unnatural to artificially exclude one of the natural meanings of the word 'lamp'."*

25. The applicant submits in its skeleton argument:

*"7 While it is accepted that a heat lamp can warm food, 'lighting apparatus' on any normal reading would relate to lights for providing illumination (i.e. conventional lighting). Such lights are not designed to heat food (and with the prohibition of selling many higher-powered bulbs cannot practically do so)."*

26. The applicant concludes that lighting would be sold to the general public and businesses through a range of trade channels including DIY shops, homeware shops, department stores and supermarkets, while apparatus for heating food, other than standard domestic cookers, would be sold by specialist retailers. As a result, it states the "respective goods in class 11 are not at all similar".

27. The opponent's goods in this class are 'lamps; lanterns; and lighting apparatus'. The opponent submits that the term 'lamps' will include 'heat lamps' and, at ESH3, it provides examples of catering heat lamps. The pages of the exhibit date from after the relevant date but appear to relate to products which, in my experience, have been available for some time and I have no reason to conclude that the situation was materially different at the relevant date. The product descriptions contained within the exhibit show that such catering lamps are used to warm food. Consequently, I find that the opponent's 'lamps' include and are therefore identical to the applicant's apparatus for heating, apparatus for keeping food warm and food warmers.

28. I note that the opponent claims that its lighting apparatus could be used to light a room or, just as easily, a food display unit, be it refrigerated or heated. In my experience, many goods can include a light but that does not mean that those goods will always be similar to lighting. For example, the majority of refrigerators include a light which is activated when the door is opened but this does not mean that lighting and refrigerators are similar goods. The users may overlap but the uses, purpose and trade channels differ and they are not complementary goods nor are they in

competition. For these reasons, I find there is no similarity between the opponent's goods and the applicant's 'Food display units [refrigerated]; Apparatus for refrigerating, apparatus for water supply'.

29. The applicant's 'Apparatus for cooking' are self-evidently, goods which enable the user to cook food. It will include equipment, such as a stove or range cooker, which will keep food warm until ready to be eaten. To this extent there is some similarity with the applicant's Food display units [heated] and apparatus for cooking though the level of similarity is very low.

30. The evidence filed by the opponent shows that heat lamps are used to keep food warm but there is no evidence before me to suggest that the same is true in respect of beverages. I find there is no similarity between the opponent's goods and the applicant's 'Apparatus for keeping drinks warm'.

31. Whilst it is possible there is some overlap in the users of the opponent's goods and the applicant's 'Thermoelectric apparatus for the preparation of beverages; Coffee roasting machines, Coffee machines', this is not of itself sufficient for me to find that the goods are similar. The uses and natures of the respective goods are manifestly different as are their respective trade channels. The respective goods are not complementary nor are they in competition. I find these goods to be dissimilar.

32. I note that in the table of goods attached to its skeleton argument the opponent claims that 'ice cream', 'drinks' and 'confectionery' in class 30 of its earlier specification are similar to apparatus for refrigeration. In the absence of any further explanation I can find no areas of similarity between the uses, nature or trade channels for these goods and conclude that they are dissimilar.

33. The opponent also submits that 'coffee' and 'tea' in class 30 are similar to thermoelectric apparatus for the preparation of beverages, coffee roasting machines and coffee machines.

34. Starting with 'coffee roasting machines', these are machines generally used by professionals and are not part of the average domestic kitchen. They are also fairly

expensive, whereas coffee is an inexpensive general consumer product. Coffee is used, for the most part, to create a coffee beverage. Roasting machines are used in the process of creating coffee. The trade channels are completely different and they are clearly not in competition. However, there is a degree of complementarity to the extent that coffee is essential for coffee roasting. I can see no areas of similarity between tea and these machines, whereas coffee is the product of the coffee roasting process and to that extent, I find it to be similar to a very low degree.

35. Coffee machines are increasingly found in a domestic setting and are used by members of the general public as well as by professionals in coffee shops, restaurants and so on. They are used to make coffee beverages. The trade channels for these goods are different and they are not in competition. Clearly coffee has a complementary relationship to coffee machines since it is impossible to use the machine without it. In addition, it is not, in my experience, uncommon to find the same brand being used for the pod style coffee machines as the coffee pods which are used in them. Bearing this in mind, I find coffee machines and coffee to share a low degree of similarity.

36. Thermoelectric apparatus for the preparation of beverages can include some coffee machines but may relate to any number of other hot or cold beverage making apparatus. To the extent that the beverages being prepared are tea and coffee the similarity will be very low, for the reasons outlined above.

37. With regard to the term 'parts and fittings for the aforesaid goods' in this class, to the extent that the parts and fittings relate to goods where I have found similarity then there will be a degree of similarity between the parts and fittings and the opponent's goods.

#### The applicant's goods in class 16

38. With regard to the comparison to be made between printed matter in the opponent's specification and a range of food packaging goods in the applicant's specification, the opponent submits the following:

*“26. In this case it is relevant therefore to look at what the producer of food packaging or wrapping will feel, and exhibit ESH5 gives several examples of food packaging companies where the ability to print on the product is as prominent as the more functional aspects of the product. The printed aspect is not ancillary to the other functions of the product, but is one of the main selling points.”*

39. Further, with regard to the comparison between the opponent’s stationery goods and the applicant’s specification for packaging goods, the opponent submits that both sides have provided different definitions for the term ‘stationery’ with different meanings. It concludes that the term does not have a single meaning and, as a consequence:

*“...it is entirely reasonable for the Registrar to be guided by a company such as WHSmith as to what products are viewed as stationery, taking account of which of these fall into Class 16.”*

40. The applicant states:

*“8. The Opponent’s second mark covers the usual range of goods related to printed matter goods and stationery. The Applicant’s Mark covers goods relating to packaging and preparation of food. Once more these are dissimilar goods and have completely different channels of trade.”*

41. With regard to the applicant’s food packaging goods, the opponent’s position appears to be that as these goods are often printed and the printing is important, (as shown in the opponent’s evidence at ESH5 and ESH6) these goods are similar to the opponent’s printed matter. It also submits that I should consider the feelings of producers of such packaging when making a finding. This is clearly not a relevant consideration. I will apply the relevant tests which I have outlined earlier in this decision.

42. It is clearly not the case that everything which has been printed can be classed as printed matter for the purposes of this comparison. Printed matter in this context refers



to published material such as, inter alia, books, newspapers, magazines, comic books, catalogues, leaflets and so on. Clearly, the purpose and uses of food packaging is to protect and/or preserve food products and in the case of some of the goods listed here, to enable the food to be cooked<sup>9</sup> and is not the same as printed matter per se. The trade channels for these goods are completely different and they are neither complementary nor in competition. For these reasons, I find the following goods to be dissimilar to any goods in the opponent's specification:

Absorbent sheets of paper or plastic for foodstuff packaging; Bags [envelopes, pouches] of paper or plastics, for packaging; Bags for microwave cooking; Coffee filters of paper; Bags of paper for roasting purposes; Baking paper; Microwave cooking bags; Paper baking cups; Bags made of paper for packaging; Bags of paper for foodstuffs; Bags made of plastics for packaging; Boxes of cardboard or paper; Brown paper for wrapping; Cardboard cake boxes; Cardboard containers; Cardboard packaging; Cling film plastics for packaging; Film (Plastic cling -) extensible, for palletisation; Films for wrapping foodstuffs; Foils of plastic for packaging; Food wrappers; Greaseproof paper; Paper impregnated with oil for wrapping purposes; Paper take-out cartons for food; Paper wipes; Paperboard trays for packaging food; Plastic materials for packaging (not included in other classes); 3D decals for use on any surface; Price tags.

43. I find the applicant's 'adhesive labels' and 'adhesive paper' to be included within the opponent's term 'stationery'. In accordance with the decision in *Meric*, these are identical goods.

#### The applicant's goods in class 29

44. The applicant states:

*"10. A snack food is not the same as food which can be eaten as a snack. For example, a person might have a steak sandwich as a snack, but that person would not call it snack food. It is submitted that a snack food is*

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<sup>9</sup> For example, 'bags for microwave cooking' and 'bags of paper for roasting purposes'.

*characterised by individual packaging, the lack of preparation and its sub-meal proportions as in most instances it is a supplement to the usual three meals eaten a day. Snack foods are usually placed in a different section of the grocery store or supermarket from other foods. Indeed, snack foods are often near tills in a shop to encourage people to make impulse purchases. The nature of these purchases further sets snack foods apart from other sorts of food.”*

45. The applicant submits that ‘cheese’ is normally used as an ingredient and requires further preparation. It concludes that cheese is not a ‘snack food’ and even if the opponent had cheese based snacks in its specification (which it does not), these would be different to cheese itself.

46. In its table of goods comparison the opponent submits that the applicant’s ‘cheese’ in class 29 is similar to its own ‘meat fruit and vegetable based snack foods’ in class 29 and its ‘ice cream’ and ‘frozen yoghurt’ in class 30.

47. Cheese will be sold from a refrigerator or chilled counter where it may be in packaged blocks or sold from larger blocks where the consumer may select a specific quantity. In addition, it can be sold already sliced, grated or in small or individual portions. Cheese is a versatile product which may be consumed directly (though more usually would be eaten alongside other food products) or may be used as an addition to a wide range of cold or cooked meals.

48. The opponent’s snack foods are ‘meat’, ‘vegetable’ and ‘fruit’ based snack foods which are likely to include other ingredients and would normally be prepared in some way to enable them to be ready to eat. They are also likely to be packaged for convenience, such as in individual wrappers.

49. Both parties’ goods are foodstuffs, but in the absence of any evidence to the contrary, I find their natures and trade channels are different. They are unlikely to be sold in close proximity to each other. And in my view, are unlikely to be substituted for one another. The goods are not in competition, nor are they complementary. Taking all of these factors into account, I find these goods to be dissimilar.

50. The opponent has not provided any submissions as to why 'ice cream' and 'frozen yoghurt' in its specification are similar to the applicant's cheese. Frozen yoghurt and ice cream are generally sweet goods which are sold in tubs or containers from the freezer section of a shop (whether an online shop or a bricks and mortar store). Cheese is sold, as I have already identified above, from a fridge or counter and is more generally a savoury item which may require further preparation before it is used. The trade channels are different and the goods are neither complementary nor in competition. I find these goods to be dissimilar.

51. With regard to soup, the applicant states that it is not a 'snack food' for the reasons outlined in paragraph 10 of its skeleton argument, which I have detailed above.

52. The opponent claims that the applicant's 'soup' in class 29 is similar to its 'prepared meals' in class 30.

53. Both soup and prepared meals allow the consumer to eat a meal quickly with little preparation, other than perhaps heating. Prepared meals and soups are available refrigerated, frozen or dried and may be sold in reasonably close proximity to each other. They are not complementary but are in competition, as one may reasonably selected as an alternative to the other. I find these goods to be similar to a fairly high degree.

#### The applicant's goods in class 30

54. The applicant submits that the opponent's goods in class 29 of EUTM 10437804, 'confectionery' and 'ice cream' might be sold in the same supermarket as the applicant's 'microwavable ready pasta' and 'pasta containing fillings', but that is where the similarity ends. I agree. These are dissimilar goods.

55. The opponent claims that the applicant's 'microwavable ready pasta' and 'pasta containing fillings' in class 30 are similar to its own 'prepared meals' in the specification of EUTM14920318.

56. The term 'pasta' can refer to complete meals which contain pasta and also to the plain pasta itself. The applicant's 'microwavable pasta' and 'pasta containing fillings' may also take either of these forms. Where the respective terms are complete meals then they are identical to the opponent's prepared meals in this class. Where they relate to the plain pasta or plain filled pasta, such as ravioli or tortellini, to which a sauce or other element must be added then both parties' goods are used by the general public to provide a convenient meal, quickly. The trade channels are likely to coincide and they may be sold in similar areas of supermarkets and food stores. The respective goods may be in competition to the extent that pasta which can be cooked quickly and only requires a sauce to be added to it may be bought as an alternative to a prepared meal. The goods are not complementary in the sense that pasta is indispensable to a prepared meal, though it may be part of it. Overall, I find these goods to be highly similar to the opponent's goods.

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

57. In accordance with the above cited case law, I must determine who the average consumer is for the goods at issue and also identify the manner in which they will be selected in the course of trade.

58. 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*,<sup>10</sup> 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

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<sup>10</sup> [2014] EWHC 439 (Ch)

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."

59. The applicant states:

*"18. In relation to the goods in class 11...the relevant consumer would be a trader in heated or prepared foods, such as café, garage or similar. As apparatus for heating food can be a very expensive and substantial purchase for a small business owner it is submitted that they would spend some time considering their purchase of such goods.*

*19. In relation to all the other goods, it is suggested that the relevant consumer would be the general public or businesses. It is accepted that in relation to these purchases the decision would involve the usual amount of consideration connected to purchasing fast moving consumer goods."*

60. The opponent states in its skeleton argument:

*"15. It is agreed that the products of the later trade mark in classes 29 and 30 are of an everyday nature. The average consumer, purchasing process and channels of trade will therefore be the same as for the opponent's products in classes 29 and 30.*

*16. In class 11 the wording of the goods encompasses products sold in specialist electrical and catering shops, but also smaller domestic items sold in larger supermarkets. There may therefore be two types of consumers, one which is more specialist and one which is more general in nature. Regardless, the consumers, purchasing process and channels of trade will be the same as and/or will overlap with the opponent's consumers for other relevant products.*



*17. For class 16, the end result is the same as for class 11. There are some products that are more specialist in nature, but some that are general..."*

61. The parties' specifications cover a range of goods in a number of classes. The goods in classes 11 and 16 can be aimed at an ordinary member of the public and/or at a more specialised commercial customer or business. For example goods such as 'lamps' in class 11 and 'comic books' in class 16 are likely to be bought by members of the general public, whereas, 'food display units' in 11 and 'plastic for foodstuff packaging' in 16 are far more likely to be purchased by businesses. The remaining goods in classes 21, 29, 30 and 32 are all general consumer goods and foodstuffs, which will be bought by members of the general public. The level of attention paid to the purchase will vary according to, inter alia, the nature of the goods, cost and frequency of purchase.

62. In all cases the purchase is likely to be a primarily visual one with the goods being selected from a shelf, a website or brochure, though I do not rule out an aural element altogether.

### **Comparison of marks**

63. The marks to be compared are as follows:

<b>The opponent's marks</b>	<b>The applicant's mark</b>
	

64. In making a comparison between the marks, I refer to my earlier finding at paragraph 13, that there is only a slight difference in the typeface between the

opponent's two earlier PING marks. I will refer to the opponent's marks as 'PING' by which I mean to include both of the earlier rights relied upon.

65. I must consider the respective marks' visual, aural and conceptual similarities with reference to the overall impressions created by them, bearing in mind their distinctive and dominant components,<sup>11</sup> but without engaging in an artificial dissection of the marks, because the average consumer normally perceives a mark as a whole and does not analyse its details.

66. The opponent relies on the word 'PING', presented in capital letters. The overall impression rests in the totality of the mark.

67. The applicant's mark is presented as a single word but naturally breaks down into the two component parts 'PING' and 'PERFECT'. The opponent submits:

*"7. The opponent is happy to rely on the standard precedents to establish the correct test for comparison of the trade marks, but the opponent notes in particular the requirement to look at the distinctive and dominant components of the marks and that the average consumer will generally not consider a descriptive element forming part of a complex mark as the distinctive and dominant element of the overall impression conveyed by that mark, and that the same applies to elements which have a very general meaning suggesting a positive quality attributable to a large range of different goods or services".<sup>12</sup>*

*8. The opponent argues therefore that in all comparisons between the marks PING and PINGPERFECT the dominant and distinctive component of the complex mark (PINGPERFECT) is the word PING. The word 'perfect' in the later mark is subsidiary to, describes and refers to the word 'Ping'."*

68. The joining of the two words PING and PERFECT does not prevent each of them being identified by the average consumer. I accept that the word PERFECT is largely

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<sup>11</sup> *Sabel v Puma AG, para.23*

<sup>12</sup> *para 52 of Vitakraft Werke v OHIM — Case T-356/02 (upheld on appeal in C-512104*

laudatory, but its combination with the word PING is not a natural one and it is not so lacking in distinctiveness as to be ignored altogether by the average consumer. The word PING plays a larger role in the overall impression of the mark than the word PERFECT.

### **Visual comparison**

69. The opponent submits that PING is prominent being the initial element of the applicant's mark. The applicant submits that the first four letters of its mark, which are the same as the opponent's mark, make up just over a third of its mark. It continues:

*"...The combination of the two words, PING and PERFECT create a lexicological invention – PING PERFECT – quite different from PING simpliciter."*

70. Similarity rests in the fact that the first word of the application, PING, is the entirety of the opponent's mark. The obvious difference is the addition of the conjoined word PERFECT in the application.

71. Overall, I find these marks to be visually similar to a medium degree.

### **Aural comparison**

72. The opponent submits that the initial PING element (in the application) will retain greater phonetic significance for the average consumer overall.

73. The applicant submits in its skeleton argument:

*"24. In relation to the aural comparison, the Applicant notes that the word PING is said abruptly with emphasis on the G at the end; the addition element in PINGPERFECT negates any emphasis on the G and leads to a much longer and more balanced word."*



74. Both marks contain the single syllable word PING, which is the entirety of the opponent's mark and the first of the two conjoined words in the applicant's mark. The applicant's mark contains the additional word 'PERFECT' which follows (and is joined to) the word 'PING' and adds an additional two syllables to its mark, resulting in an alliterative mark which is somewhat longer than the earlier mark. Both words which make up the application will be easily understood and pronounced by the average consumer. Taking these factors into account, the marks are aurally similar to a medium degree.

### **Conceptual similarity**

75. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer.<sup>13</sup> The assessment must be made from the point of view of the average consumer who cannot be assumed to know the meaning of everything.<sup>14</sup>

76. The opponent states:

*"12. The combination of two known words (one being distinctive and one being descriptive) into one word PINGPERFECT, does not remove, disguise or dilute the original meanings or significance of the words PING and PERFECT.*

*13. Conceptually, therefore, the opponent claims that the marks are the same, or at least very similar. Whatever conceptual significance the average consumer attaches to the word PING, will also attach to PINGPERFECT. The word 'perfect' adds little to the conceptual impression since it merely creates a generic positive image associated with the word PING."*

77. The applicant states:

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<sup>13</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>14</sup> BL O-048-08

*“25. The conceptual meaning of the word ping is usually a sound whereas the addition of the element ‘perfect’ suggests multiple concepts including quality or performance rather than merely a sound.”*

78. In my view the average consumer will be familiar with the words ‘PING’ and ‘PERFECT’ and will know their respective meanings. ‘PING’ is an example of onomatopoeia and will be seen as identifying the sound which it phonetically mimics. Furthermore, it is a word associated with microwave cooking, due to it being the sound made by a microwave cooker when the cooking/heating/defrosting time has elapsed. ‘PERFECT’ is likely to be considered to be a descriptive term being seen as something ‘faultless’ or ‘exemplary’. The conjoining of the two words in the application does nothing to alter their meanings and does not create a new concept. Both words retain their independent meanings, which I have identified above.

79. Taking these factors into account, to the extent that both marks contain the word PING, the conceptual message will be the same for both marks, namely, a sound, particularly associated with a microwave. The addition of ‘PERFECT’ in the application provides a second laudatory concept which does not diminish or alter the first meaning. Overall, these marks are conceptually similar to a fairly high degree.

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

80. 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 and services for which it has been used as coming from a particular undertaking and thus to distinguish those goods and services from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger*.<sup>15</sup> 81. The opponent has not made a claim to enhanced distinctive character due to the use made of its ‘PING’ marks. Consequently, I have only the inherent distinctiveness to consider.

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<sup>15</sup> *Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.*

82. The word 'PING' is a normal English word denoting a sound, which is often associated with microwave cooking. For most of the opponent's goods, it does not describe or allude to the goods at issue and as such is a normal trade mark possessed of an average degree of inherent distinctive character. With regard to kitchen containers, which may include containers for use in a microwave and prepared meals, which will include microwave meals, it has a lower degree of inherent distinctive character.

### **Likelihood of confusion**

83. In assessing the likelihood of confusion, I must adopt the global approach advocated by case law and take into account the fact that marks are rarely recalled perfectly, the consumer relying instead on the imperfect picture of them he has kept in his mind.<sup>16</sup> I must also keep in mind the average consumer for the goods, the nature of the purchasing process and have regard to 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.

84. The parties' goods are, in some cases, identical, similar in some areas and dissimilar in part. I have found that the average consumer may be a member of the general public, a commercial customer or business. The purchase will be primarily visual, though I do not rule out an aural element. The level of attention paid will vary according to the goods, which range from expensive catering equipment, which will require a higher degree of attention to be paid, to cheese and adhesive labels, which are cheaper, more frequent purchases, likely to attract a lower level of attention.

85. The respective marks are visually and aurally similar to a medium degree and conceptually similar to a fairly high degree.

86. With regard to whether or not there is a likelihood of confusion, the applicant submits that the purchase of goods will be primarily visual which means that the differences between the applicant's mark and the opponent's earlier marks will be

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<sup>16</sup> *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27

noticed, so there would be no likelihood of direct confusion. The applicant submits that there is also no likelihood of indirect confusion, of the type identified in *LA Sugar*<sup>17</sup> because:

*“30...it is submitted that the fact the combination of words is a lexicological invention rather than the addition of a new word to PING is significant. The structure suggests away from a sub-brand. Furthermore, the figurative nature of the Opponent’s Second Mark means that it does not invite sub-brands which do not use the figurative form.”*

87. The opponent relies on the decisions in *LA Sugar v By Back Beat Inc.* and *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another*,<sup>18</sup> to support its view that the addition of the word ‘PERFECT’ would be seen as an extension to the PING brand. In the second of these cases Arnold J. considered the impact of the CJEU’s judgment in *Bimbo*<sup>19</sup> on the court’s earlier judgment in *Medion v Thomson*. The judge said:

*18 The judgment in Bimbo confirms that the principle established in Medion v Thomson is not confined to the situation where the composite trade mark for which registration is sought contains an element which is identical to an earlier trade mark, but extends to the situation where the composite mark contains an element which is similar to the earlier mark. More importantly for present purposes, it also confirms three other points.*

*19 The first is that the assessment of likelihood of confusion must be made by considering and comparing the respective marks — visually, aurally and conceptually — as a whole. In Medion v Thomson and subsequent case law, the Court of Justice has recognised that there are situations in which the average consumer, while perceiving a composite mark as a whole, will also perceive that it consists of two (or more) signs one (or more) of which has a distinctive significance which is independent of the significance of the*

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<sup>17</sup> *L.A. Sugar Limited v By Back Beat Inc.* BL O/375/10

<sup>18</sup> [2015] EWHC 1271 (Ch)

<sup>19</sup> Case C-591/12P

*whole, and thus may be confused as a result of the identity or similarity of that sign to the earlier mark.*

*20 The second point is that this principle can only apply in circumstances where the average consumer would perceive the relevant part of the composite mark to have distinctive significance independently of the whole. It does not apply where the average consumer would perceive the composite mark as a unit having a different meaning to the meanings of the separate components. That includes the situation where the meaning of one of the components is qualified by another component, as with a surname and a first name (e.g. BECKER and BARBARA BECKER).*

*21 The third point is that, even where an element of the composite mark which is identical or similar to the earlier trade mark has an independent distinctive role, it does not automatically follow that there is a likelihood of confusion. It remains necessary for the competent authority to carry out a global assessment taking into account all relevant factors.*

88. I have already concluded that the combination of the words PING and PERFECT do not create a mark whose meaning is any different from its constituent parts. I note that the applicant submits that the structure of its mark suggests away from a sub-brand. I disagree. A consumer seeking, for example, a quick meal, being already familiar with PING as a brand which provides prepared meals, is likely to believe, when encountering PINGPERFECT in respect of microwavable pasta or soup, that this is the 'PERFECT' range provided by PING. The nature of the applicant's mark is such that this will be the effect on the average consumer for all of the goods where I have found there to be a degree of similarity.

## **CONCLUSION**

89. The opposition succeeds under section 5(2)(b) of the Act in respect of the following:

Class 11

Apparatus for heating; Apparatus for keeping food warm; Food warmers; Appliances for heating; Food display units [heated]; Coffee roasting machines; Coffee machines; Thermoelectric apparatus for the preparation of beverages;

Class 16

Adhesive labels; Adhesive paper;

Class 29

Soups

Class 30

Microwavable ready pasta; pasta containing fillings.

90. Consequently, the application may (subject to the outcome of any other proceedings) proceed to registration for the following:

Class 11

Apparatus for cooking; Apparatus for refrigerating; Food display units [refrigerated]; water supply;

Class 16

3D decals for use on any surface; Absorbent sheets of paper or plastic for foodstuff packaging; Bags [envelopes, pouches] of paper or plastics, for packaging; Bags for microwave cooking; Bags made of paper for packaging; Bags of paper for foodstuffs; Bags of paper for roasting purposes; Bags made of plastics for packaging; Baking paper; Boxes of cardboard or paper; Brown paper for wrapping; Cardboard cake boxes; Cardboard containers; Cardboard packaging; Cling film plastics for packaging; Coffee filters of paper; Film (Plastic cling -) extensible, for palletisation; Films for wrapping foodstuffs; Foils of plastic for packaging; Food wrappers; Greaseproof paper; Microwave cooking bags; Paper baking cups; Paper impregnated with oil for wrapping purposes; Paper take-out cartons for food; Paper wipes; Paperboard trays for packaging

food; Plastic materials for packaging (not included in other classes); Price tags.

Class 29

Cheese;

## **COSTS**

91. Both parties have achieved a measure of success. As a consequence, the parties should bear their own costs.

**Dated this 10<sup>th</sup> day of October 2017**

**Ms Al Skilton**

**For the Registrar,**

**The Comptroller-General**