

**O-186-18**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF**

**TRADE MARK APPLICATION 3225930**

**IN THE NAME OF LABERIT LTD**

**FOR THE TRADE MARK:**

**LABERIT**

The logo consists of the word "LABERIT" in a bold, black, sans-serif font. The letter 'A' is replaced by a stylized character's face. The character has large, dark, almond-shaped eyes, a small nose, and a wide, open mouth showing a tongue. The character's head is integrated into the shape of the letter 'A'.

**AND**

**OPPOSITION THERETO (UNDER No 409574)**

**BY LABEYRIE**

## **Background and pleadings**

1. These opposition proceedings are based on section 5(2)(b) of the Trade Marks Act 1994 (“the Act”) with the opponent relying on a single trade mark which it owns. Consequently, the conflict boils down to whether there is a likelihood of confusion between the following marks:

<b>Applicant’s mark</b>	<b>Opponent’s mark</b>
<p data-bbox="204 689 767 891">UK trade mark application 3225930 which was filed by Laberit Ltd (“the applicant”) on 20 April 2017 and published on 28 April 2017:</p>  <p data-bbox="204 1140 507 1173"><b>Class 30:</b> Ice cream.</p>	<p data-bbox="793 689 1391 891">EU registration 3886967 which is owned by Labeyrie (“the opponent”) having been filed on 15 June 2004 and registered on 19 October 2005:</p>  <p data-bbox="793 1178 1391 1267">The colours black, gold and beige are claimed in relation to the mark.</p> <p data-bbox="793 1341 1391 1444"><b>The following class 30 goods are relied upon by the opponent:</b> Pastry, confectionery and ices.</p>

2. The opponent’s mark was filed before that of the applicant and, so, constitutes an earlier trade mark in accordance with section 6 of the Act. The opponent’s mark was registered more than 5 years before the publication of the applicant’s mark, so meaning that the use conditions set out in section 6A of the Act are applicable to it. The opponent states that the marks are highly similar, the goods identical and similar, and that there exists a likelihood of confusion.

3. The applicant filed a counterstatement denying the grounds of opposition. It did not put the opponent to proof of use, so meaning that the earlier mark may be relied upon (to the extent set out above) without having to establish genuine use. The applicant

does not agree that the marks are similar. It also states that the goods which the opponent actually sells do not conflict with ice cream.

4. Neither side filed evidence. Neither side requested a hearing, although, the opponent did file written submissions in lieu. The opponent is represented by Dolleymores. The applicant is represented by Iman Manteghi.

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

5. Section 5(2)(b) of the Act states that:

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

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

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

6. The following principles are gleaned from the judgments 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;

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

## **Comparison of goods**

7. When making a comparison of goods, all relevant factors relating to them should be taken into account. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the Court of Justice of the European Union (“the 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.”

8. Guidance on this issue has also come from Jacob J where, in *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281, the following factors were highlighted as being relevant:

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

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

(c) The physical nature of the goods or acts of service;

(d) The respective trade channels through which the goods or services reach the market;

(e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;

(f) The extent to which the respective goods or services are competitive. 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.”

9. In terms of being complementary (one of the factors referred to in *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*), this relates to close connections or relationships that are important or indispensable for the use of the other. In *Boston Scientific Ltd v OHIM* Case T- 325/06 it was stated:

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

10. In relation to complementarity, I also bear in mind the guidance given by Mr Daniel Alexander QC, sitting as the Appointed Person, in case B/L O/255/13 *LOVE* where he warned against applying too rigid a test:

“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.”

11. In relation to understanding what terms used in specifications mean/cover, the case-law informs me that “in construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of the trade”<sup>1</sup> and that I must also bear in mind that words should be given their natural meaning within the context in which they are used; they cannot be given an unnaturally

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<sup>1</sup> See *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281

narrow meaning<sup>2</sup>. I also note the judgment of Mr Justice Floyd (as he then was) in *YouView TV Limited v Total Limited* where he stated:

“..... 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) (IPTRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of "dessert sauce" did not include jam, or because the ordinary and natural description of jam was not "a dessert sauce". Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question.”

12. In its counterstatement, the applicant states that the parties trade in relation to different things. This is not pertinent to my assessment because the task required is to consider what has been applied for and compare that to the goods covered (and relied upon) by the earlier mark.

13. Although the opponent relies upon “pastry”, this term does not improve its position over and above its reliance on “confectionery” and “ices”. To this extent, the opponent considers that the goods are identical to the applicant’s ice cream because i) confectionery is a broad term and includes “ice cream confectionery”, and ii) ices is also a broad term and includes ice cream within its ambit. If ice cream does fall within either of the terms relied upon then identity can be found as per the decision in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05 (“*Meric*”):

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<sup>2</sup> See *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267

“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”.

14. In terms of ices, there is no evidence to show how the trade or the public view such a term. However, in my experience, it can be taken as a catch all term encompassing various frozen confections. For example, a product consisting of ice cream covered by chocolate is often called a choc ice, showing that ice or ices is a term used not just in relation to frozen confections based upon water. I, therefore, agree that ice cream falls within ices and is to be regarded as identical. If this were wrong then what is certainly clear is that ices would include goods such as sorbets, which have a similar nature, identical purpose and methods of use, are sold through the same trade channels (often next to each other) and have a competitive relationship, with the result that there is a very high degree of similarity.

15. In terms of confectionery, the opponent highlights that the TM Class Classification systems lists “ice cream confectionery” as a term, so showing that ice cream is a confectionery item. I agree. The term is broad enough to include ice cream and the goods are identical on this basis also.

### **Average consumer and the purchasing act**

16. 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 words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

17. The opponent submits that the average consumer is a member of the general public. I agree. The opponent also submits that the goods include low cost items and, as such, the level of attention used by the average consumer is likely to be low to moderate. I agree that the conflicting goods are, generally speaking, low costs items. They will not be subject to a great deal of consideration, but some attention will be paid, for example, to the flavour of the goods. Whilst I accept that the degree of care and attention may be lower than the norm, some care will clearly still be applied. The goods will routinely be self-selected so the visual impacts of the marks take on more significance, although, not to the extent that the aural impacts should be ignored completely.

### **Comparison of marks**

18. 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 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.”

19. 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. The marks to be compared are:



20. In terms of the overall impression, both marks comprise a word (LABERIT/LABEYRIE) together with a particular form of presentation. However, in both cases I take the view that the respective words comprise the element with greatest relative weight in their respective overall impressions. In relation to the LABEYRIE mark, the presentation, whilst noticeable, is not particularly striking. The relative weight of the stylisation is fairly minimal, so meaning that the word itself strongly dominates the mark. In terms of LABERIT, the presentation is more striking (with elements within the letters A and B being reminiscent of a cow) and it plays a reasonable role in the overall impression. Whilst the word has greater relative weight than the graphic element, it does not dominate the mark as strongly as LABEYRIE does in the conflicting mark.

21. The differences created by the differing forms of presentations are striking. They look quite different. That said, the eye may recognise that the marks share the same first four letters, and a common letter R towards the end. The opponent submits that because the shared letters are at the beginnings of the marks, this takes on more significance, and that because the differences are at the middles and ends, this is more likely to go unnoticed. Whilst I accept that, as a rule of thumb, the beginnings of marks may take on more significance, in this case, due to the overall construction and the look/feel of the respective marks, I do not consider this point to be particularly

significant. Weighing the differences and similarities, I consider any visual similarity to be low.

22. Aurally, LABEYRIE will most likely be articulated as three syllables LA-BAY-REE or LAB-AY-REE (or close variations thereof). The applied for mark will also be articulated as three syllables. The opponent submits that because the consumer may have previously encountered the opponent's mark and its French origin, under imperfect recollection they may then pronounce the applied for mark with a French inflection. Whilst imperfect recollection is something to bear in mind when it comes to considering the likelihood of confusion, it would be improper to bring that to the equation here. I must consider the average consumer encountering the applied for mark and assessing how it will ordinarily be pronounced. I see no real reason why the average consumer would ordinarily give it a French inflection. The most likely articulation of LABERIT will be LAB-ER-IT or LA-BER-IT. Weighing the similarities and differences, I consider there to be a medium degree of aural similarity.

23. Conceptually, neither of the words which comprise the dominant elements have any meaning of which the average consumer will be aware, so meaning that there is neither conceptual dissimilarity or similarity between those components. The average consumer may partially conceptualise the LABERIT mark with reference to the cow elements which appear within it, something which is not present in the earlier mark, however, as this does not relate to the elements of the marks with greatest relative weight then this difference in concept should not be overplayed.

### **Distinctiveness of the earlier mark**

24. The degree of distinctiveness of the earlier mark must be assessed. This is because the more distinctive the earlier mark, based either on inherent qualities or because of use made, the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 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, 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. I have only the inherent character of the mark to consider. LABEYRIE will be seen, essentially, as an invented word. It is entitled to a high degree of inherent distinctive character.

### **Likelihood of confusion**

26. The factors assessed so far have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17), a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). However, there is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused. Confusion can be direct (which effectively occurs when the average consumer mistakes one mark for the other) or indirect (where the average consumer realises the marks are not the same, but puts the similarity that exists between the marks/goods down to the responsible undertakings being the same or related). In terms of indirect confusion,

this was dealt with by Mr Iain Purvis QC, sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10 where he 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 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).”

27. There are a number of factors which go in the opponent’s favour. The goods are identical (or if not highly similar). The earlier mark is highly distinctive. The concept of imperfect recollection is important because i) the purchasing process is less

considered than the norm and, ii) neither mark has a concept which underpins the elements with most relative weight, meaning there is nothing to assist the consumer with fixing the mark in their mind. That being said, there is only a low degree of visual similarity, with there being a medium degree of aural similarity. This is a true multi-factorial assessment. However, notwithstanding the points that go in the opponent's favour, my view is that there is no likelihood of confusion. The visual differences created by the forms of presentation are themselves sufficient for the average consumer not to mistake one for the other. I accept that if the words LABERIT and LABEYRIE within the marks were misrecalled for each other through the effects of imperfect recollection then the average consumer would put the commonality of those words down to the goods coming from the same or related undertaking. However, in my view, the average consumer will recall the marks with a sufficient degree of precision that this would not occur. The ground under section 5(2)(b) fails.

### **Conclusion**

28. Subject to appeal, the opposition is dismissed and the application may proceed to registration.

### **Costs**

29. The applicant has been successful, so it is entitled to a contribution towards its costs. My assessment, based on the published scale, is that the applicant is entitled to £200 for preparing a counterstatement and considering the statement of case. No other scale costs were incurred. I order Labeyrie to pay Laberit Limited the sum of £200 within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 22<sup>nd</sup> day of March 2018**

**Oliver Morris**  
**For the Registrar**  
**the Comptroller-General**