

O/579/21

TRADE MARKS ACT 1994

**IN THE MATTER OF:
TRADE MARK APPLICATION NO. 3462442
BY SHIREEN KHAN TO REGISTER**



IN CLASS 9

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO.420909
BY MAPLEBEAR INC.**

BACKGROUND AND PLEADINGS


1. Shireen Khan ('the applicant') applied to register trade mark No. 3462442



in the United Kingdom ('UK') (the 'contested mark') on 30 January 2020. It was accepted and published in the Trade Marks Journal on 28 February 2020 in respect of the following goods:

Class 9: *Mobile apps for connecting goods and services providers and freelancers with customers in their local area.*


2. On 30 July 2020, Maplebear Inc. ('the opponent') opposed the trade mark on the basis of section 5(2)(b) of the Trade Marks Act 1994 ('the Act'). This is on the basis of its earlier trade marks listed in the table below and the opposition is directed against all goods in the application. Given the dates of their filing, these marks qualify as an 'earlier mark' in accordance with section 6 of the Act. The earlier marks are not, however, subject to the proof of use provisions in section 6A of the Act. The details of the earlier marks and the goods and services relied upon are as follows:

First Earlier Trade Mark	European Union ('EU') Trade Mark no. 018010293 ¹ for 
Goods relied upon	Class 9: <i>Downloadable software for browsing and purchasing consumer goods of others; downloadable software featuring recipes and information in the field of food, cooking, wine, and beverages.</i>

¹ Although the UK has left the EU and the transition period has now expired, EUTMs, and International Marks which have designated the EU for protection, are still relevant in these proceedings given the impact of the transitional provisions of The Trade Marks (Amendment etc.) (EU Exit) Regulations 2019 – please see Tribunal Practice Notice 2/200 for further information.

Class 35: *Online retail store services relating to consumer goods of others, namely prepared foods, fresh produce, meats, seafood, deli products, baked goods, alcoholic beverages, non-alcoholic beverages, dairy products and eggs, canned food, dry food, frozen food, breakfast foods, snack foods, food storage products, cosmetics, personal care items, health care products, baby and child care products, pet goods, cleaning products, household supplies, namely household utensils, kitchen supplies, kitchen utensils, serveware, including plates, bowls, cups and cutlery, laundry supplies, office supplies, media and entertainment products, namely books, magazines, CD's, goods made of paper, namely stationery, clothing items, sporting goods, trash bags; online wholesale store services for prepared foods, fresh produce, meats, seafood, deli products, baked goods, alcoholic beverages, non-alcoholic beverages, dairy products and eggs, canned food, dry food, frozen food, breakfast foods, snack foods, food storage products, cosmetics, personal care items, health care products, baby and child care products, pet goods, cleaning products, household supplies, namely household utensils, kitchen supplies, kitchen utensils, serveware, including plates, bowls, cups and cutlery, laundry supplies, office supplies, media and entertainment products, namely books, magazines, CD's, goods made of paper, namely stationery, clothing items, sporting goods, trash bags; advertising and promoting the goods and services of others via a global computer network, namely, advertising and promoting the availability of goods for selection, ordering, purchase, and/or delivery; comparison shopping services; promoting the goods and services of others, namely, providing special offers and online catalogs featuring a wide variety of consumer goods of others; online ordering services featuring groceries and other supermarket products; promoting the goods and services of others, namely, providing online recipes featuring the consumer goods of others.*

	<p>Class 39: <i>Transport and delivery of consumer goods; grocery delivery services.</i></p> <p>Class 42: <i>Providing online non-downloadable software featuring technology that allows users to search, browse, and purchase consumer goods of others, via a website; providing temporary use of non-downloadable software for browsing, comparing, and purchasing consumer goods of others; providing temporary use of non-downloadable software for ordering delivery services.</i></p> <p>Class 45: <i>Personal shopping services for others.</i></p>
Relevant dates	<p>Filing date: 15 January 2019</p> <p>Date of entry in register: 22 May 2020</p>

Second Earlier Trade Mark	<p>International Registration No. 1393266 designating the EU for</p> 
Goods relied upon	<p>Class 9: <i>Downloadable software for browsing and purchasing consumer goods of others; downloadable software featuring recipes and information in the field of food, cooking, wine, and beverages.</i></p> <p>Class 35: <i>Online retail store services featuring consumer goods of others, namely foodstuffs, prepared foods, fresh produce, meats, seafood, deli products, baked goods, alcoholic beverages, non-alcoholic beverages, dairy products and eggs, canned foods, dry foods, frozen foods, breakfast goods, snack foods, sauces, syrups, jams, jellies, condiments, food storage products, bathroom accessories, beauty products, toiletries, cosmetics, personal care items, health care products, prescription drugs, non-prescription drugs, baby and child care products, pets goods,</i></p>

cleaning products, household supplies, namely household utensils, kitchen supplies, kitchen utensils, kitchen accessories, serveware, including plates, bowls, cups and cutlery, laundry supplies, office supplies, books, magazines, CD's, DVDs, domestic electrical and electronic equipment, jewelry, clocks, watches, clothing items, sporting goods, trash bags, umbrellas, luggage, bags, furniture, gardening equipment and utensils, furnishings, textiles footwear, headgear, haberdashery, toys and games, flowers, plants, lighting devices, tools, bicycles and accessories therefor, car accessories, stationery and office supplies, bed covers, cushions, bed linen, tobacco products; online retail or wholesale services for foodstuffs, prepared foods, fresh produce, meats, seafood, deli products, baked goods, alcoholic beverages, non-alcoholic beverages, dairy products and eggs, canned foods, dry foods, frozen foods, breakfast goods, snack foods, sauces, syrups, jams, jellies, condiments, food storage products, bathroom accessories, beauty products, toiletries, cosmetics, personal care items, health care products, prescription drugs, non-prescription drugs, baby and child care products, pets goods, cleaning products, household supplies, namely household utensils, kitchen supplies, kitchen utensils, kitchen accessories, serveware, including plates, bowls, cups and cutlery, laundry supplies, office supplies, books, magazines, CD's, DVDs, domestic electrical and electronic equipment, jewelry, clocks, watches, clothing items, sporting goods, trash bags, umbrellas, luggage, bags, furniture, gardening equipment and utensils, furnishings, textiles footwear, headgear, haberdashery, toys and games, flowers, plants, lighting devices, tools, bicycles and accessories therefor, car accessories, stationery and office supplies, bed covers, cushions, bed linen, tobacco products; advertising and promoting the goods and services of others via a global computer network; price comparison services; promoting the goods and services of others,

namely, providing special offers and online catalogs featuring a wide variety of consumer goods of others; online ordering services featuring groceries and other supermarket products, namely for foodstuffs, prepared foods, fresh produce, meats, seafood, deli products, baked goods, alcoholic beverages, non-alcoholic beverages, dairy products and eggs, canned foods, dry foods, frozen foods, breakfast goods, snack foods, sauces, syrups, jams, jellies, condiments, food storage products, bathroom accessories, beauty products, toiletries, cosmetics, personal care items, health care products, prescription drugs, non-prescription drugs, baby and child care products, pets goods, cleaning products, household supplies, namely household utensils, kitchen supplies, kitchen utensils, kitchen accessories, serveware, including plates, bowls, cups and cutlery, laundry supplies, office supplies, books, magazines, CD's, DVDs, domestic electrical and electronic equipment, jewelry, clocks, watches, clothing items, sporting goods, trash bags, umbrellas, luggage, bags, furniture, gardening equipment and utensils, furnishings, textiles footwear, headgear, haberdashery, toys and games, flowers, plants, lighting devices, tools, bicycles and accessories therefor, car accessories, stationery and office supplies, bed covers, cushions, bed linen, tobacco products; promoting the goods and services of others, namely, providing online recipes featuring the consumer goods of others.

Class 39: *Transport and delivery of consumer goods; grocery delivery services.*

Class 42: *Providing online non-downloadable software featuring technology that allows users to search, browse, and purchase consumer goods of others, via a website; providing temporary use of non-downloadable software and applications for browsing, comparing, and purchasing consumer goods of others; providing*

	<i>temporary use of non-downloadable software for ordering delivery services.</i>
Relevant dates	Filing date: 2 November 2017, claiming priority from 4 May 2017 Date of entry in register: 4 January 2019

3. The opponent contends that the contested mark is similar to their earlier marks, and that the goods covered are identical or highly similar. The opponent submits that as there exists a likelihood of confusion, the contested mark should be refused in its entirety and they are awarded costs.
4. The applicant filed a counterstatement denying the grounds of opposition, stating that the respective marks and goods are either dissimilar or similar to only a very low degree.
5. In accordance with Rule 19 of the Trade Mark Rules 2008 and Tribunal Practice Notice ('TPN') 3/2007, another Hearing Officer issued a preliminary indication on the current matter on 16 November 2020. In light of the papers before them, they considered there was a likelihood of indirect confusion, within which all of the goods applied for should be refused registration. The applicant nonetheless wished to proceed with the application and filed a notice of intention to proceed on 3 December 2020.
6. Neither party filed evidence nor requested a hearing in these proceedings. However, the opponent filed final written submissions instead of a hearing. These will not be summarised but will be referred to as and where appropriate during this decision.
7. Both parties are professionally represented. The opponent is represented by Beck Greener LLP, whilst the applicant is represented by Briffa.
8. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Trade Marks Act relied on in these proceedings are derived from

an EU Directive. This is why this decision continues to make reference to the trade mark case law of EU courts.

DECISION

Section 5(2)(b)

9. The opposition is based upon section 5(2)(b) of the Act which reads as follows:

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

...

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

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

10. The opponent has based their opposition on two earlier marks. I will analyse the opponent's Second Earlier Trade Mark to begin with, before analysing the merits of the First Earlier Trade Mark relied upon.

11. 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 Office for Harmonization in the Internal Market (Trade Marks and Designs) ('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, 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 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 and services

12. The opponent contends that the contested mark covers identical and highly similar goods to the opponent. They state that the applicant's goods are "*focussed [sic] on connecting goods and service providers with customers and such goods are identical to the class 9 goods of the Opponent's Registrations*". Further, inter alia, "*if to any extent they are not identical, they manifestly are highly similar ... Products cannot be "browsed" and "purchased" without the customer being connected with the goods of the provider, freelancer, supplier or retailer in question. ... To put it colloquially, the software in question in both cases is for shopping*". The opponent also submits that the applied for goods are similar to the opponent's services, "*both of which cover services relating to the supply and delivery goods and services to customers [sic]*".
13. The applicant states that the "*goods/services are dissimilar or similar to a very low degree only*". They do not substantiate this much further.
14. In the judgment of the Court of Justice of the European Union ('CJEU') in *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer*, Case C-39/97, the court stated at paragraph [23] of its judgment that:

“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”.

15. The relevant factors for assessing similarity were identified by Jacob J. (as he then was) in *British Sugar Plc v James Robertson & Sons Limited (“Treat”)* [1996] RPC 281. At paragraph [296], he identified the following:

“(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.”

16. In *Gérard Meric v OHIM*, Case T- 133/05, the General Court 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 fur 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”.

17. When construing words in specifications, I find it useful to highlight the following two excerpts. In *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch), 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 [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.”

18. More recently, in *Sky v Skykick* [2020] EWHC 990 (Ch), Lord Justice Arnold considered the validity of trade marks registered for, amongst many other things, the general term “*computer software*”. In the course of his judgment he set out the following summary of the correct approach to interpreting broad and/or vague terms:

“...the applicable principles of interpretation are as follows:

(1) General terms are to be interpreted as covering the goods or services clearly covered by the literal meaning of the terms, and not other goods or services.

(2) *In the case of services, the terms used should not be interpreted widely, but confined to the core of the possible meanings attributable to the terms.*

(3) *An unclear or imprecise term should be narrowly interpreted as extending only to such goods or services as it clearly covers.*

(4) *A term which cannot be interpreted is to be disregarded.”*

19. With the above factors in mind, the goods and services for comparison are as follows:

Opponent's goods and services	<p>Class 9: <i>Downloadable software for browsing and purchasing consumer goods of others; downloadable software featuring recipes and information in the field of food, cooking, wine, and beverages.</i></p> <p>Class 35: <i>Online retail store services relating to consumer goods of others, namely prepared foods, fresh produce, meats, seafood, deli products, baked goods, alcoholic beverages, non-alcoholic beverages, dairy products and eggs, canned food, dry food, frozen food, breakfast foods, snack foods, food storage products, cosmetics, personal care items, health care products, baby and child care products, pet goods, cleaning products, household supplies, namely household utensils, kitchen supplies, kitchen utensils, serveware, including plates, bowls, cups and cutlery, laundry supplies, office supplies, media and entertainment products, namely books, magazines, CD's, goods made of paper, namely stationary, clothing items, sporting goods, trash bags; online wholesale store services for prepared foods, fresh produce, meats, seafood, deli products, baked goods, alcoholic beverages, non-alcoholic beverages, dairy products and eggs, canned food, dry food, frozen food, breakfast foods, snack foods, food storage products,</i></p>
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	<p><i>cosmetics, personal care items, health care products, baby and child care products, pet goods, cleaning products, household supplies, namely household utensils, kitchen supplies, kitchen utensils, serveware, including plates, bowls, cups and cutlery, laundry supplies, office supplies, media and entertainment products, namely books, magazines, CD's, goods made of paper, namely stationery, clothing items, sporting goods, trash bags; advertising and promoting the goods and services of others via a global computer network, namely, advertising and promoting the availability of goods for selection, ordering, purchase, and/or delivery; comparison shopping services; promoting the goods and services of others, namely, providing special offers and online catalogs featuring a wide variety of consumer goods of others; online ordering services featuring groceries and other supermarket products; promoting the goods and services of others, namely, providing online recipes featuring the consumer goods of others.</i></p> <p>Class 39: <i>Transport and delivery of consumer goods; grocery delivery services.</i></p> <p>Class 42: <i>Providing online non-downloadable software featuring technology that allows users to search, browse, and purchase consumer goods of others, via a website; providing temporary use of non-downloadable software for browsing, comparing, and purchasing consumer goods of others; providing temporary use of non-downloadable software for ordering delivery services.</i></p> <p>Class 45: <i>Personal shopping services for others.</i></p>
Applicant's goods	Class 9: <i>Mobile apps for connecting goods and services providers and freelancers with customers in their local area.</i>

20. The applied for specification is for mobile applications that specifically connect local customers with service providers, freelancers and goods. This is most similar to the opponent's coverage of "*Downloadable software for browsing and purchasing consumer goods of others*". Mobile applications are a form of downloadable software and, therefore, the nature and trade channels overlap. The uses and users of the goods are also similar. This is insofar as the applicant's application facilitates consumers and suppliers to connect with each other and their goods and, likewise, the opponent's software allows consumer goods to be purchased and would likely involve a supplier-consumer relationship. I acknowledge that the applicant's goods may be slightly wider than the opponent's goods to the extent that the applications may allow more than just browsing and purchasing goods – for instance, also including chatrooms and the purchase of services. Although the applied for goods are limited to customers in a local area, as the opponent's goods are not limited by location – the goods cover all proximities, including local areas.

21. Whilst I also bear in mind that the applicant's "*customer*" could similarly be the opponent's purchaser of "*consumer goods*", I consider that the applicant's mobile application could fall within the remit of the opponent's downloadable software. Therefore, there is identity between the goods under the principle outlined in *Meric* (above).

22. Nevertheless, upon a more restrictive interpretation of the opponent's goods, I realise the purpose of the respective goods differ slightly. Thus, if I am incorrect in finding the goods identical, due to the overall similarities, there is still a high degree of similarity between them. I do not consider that any of the opponent's other goods and services improve this position – any similarity is of a lesser (or no) degree.

Average consumer and the purchasing act

23. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods. I must then decide the manner in which these goods are likely to be selected by the average consumer in the course of trade.

24. 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 in question². 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.”

25. The goods at issue are mobile applications designed for connecting service providers and freelancers with local customers (i.e. the general public). Therefore, each of the latter will be deemed average consumers. Mobile applications are available on online mobile application stores, though the marks used in relation to them may also be seen in both physical and online advertisements. The average consumer will take some care in their selection as they will check the price and will wish to ensure they are compatible, functional and suitable for the desired purpose. Depending on the exact function of the application, I consider that they will be purchased on a relatively infrequent basis, especially if the application requires the service providers and freelancers to expend time upfront on the application (for instance, listing their offerings). Overall, I consider that the selection process will be largely visual, though aural considerations may feature to some extent (for instance, via verbal recommendations). Whilst service providers and freelancers may take slightly more care and consideration since the application is for business purposes, I still consider that both they and the general public will pay a medium degree of attention.

² See *Lloyd Schuhfabrik Meyer & Co. GmbH*



Comparison of marks

26. 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.”

27. 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.

28. The respective trade marks are shown below:

Second Earlier Trade Mark	Contested trade mark
	

29. The opponent submits that the carrot device (and the word “*instacart*” in its First Earlier Trade Mark) has “*no connection or resonance*” and, therefore, the carrot device has an “*independent distinctive role*”³. They submit that the applied for mark is visually similar, conceptually identical and both “*referred to orally as “carrot marks” [sic]*”. They state the orange colour compounds the similarity.

30. The applicant stated that the marks are “*visually, phonetically and conceptually dissimilar or similar to a very low degree only*”. No further reasoning is provided.

Overall impression

The applicant’s contested mark

31. The applied for mark is a device mark with an orange background and a white font reading “*Carrott*” in light stylisation, alongside the graphical silhouette of an upright carrot in white. The carrot device reinforces the word “*Carrott*”. The device and word are equally memorable and distinctive elements in the overall impression of the contested mark. The colourway carries the least weight.

The opponent’s Second Earlier Trade Mark

32. The earlier mark is a black silhouette of a diagonal triangular device with two smaller triangular teardrop shapes above. As a black and white device, it protects various colourways; for instance, including depiction in a similar orange colourway to the applicant and other colours (such as blue, purple, grey etc). When the device is in an orange colourway, the average consumer will view it as a carrot. Though when it is shown in other colours, I accept that some average consumers will view it as a carrot, others may not. The overall impression lies in the device as a whole.

³ “*within the meaning of judgments of the CJEU in Case C-120/04 Medion v Thomson and Case C-591/12P, Bimbo*”.

Visual comparison

33. The two marks both share a pointed device with a two pronged element above, though the angling of the pointed device differs. Whilst the earlier mark is diagonal, the contested mark is upright. The contested mark additionally contains a small circle within the pointed device, in addition to the word “Carrott” to the right. The overall visual similarity is of a low to medium degree.

Aural comparison

34. Although the opponent submits the marks “*would both be perceived and referred to orally as “carrot marks”*”, I highlight the decision of the General Court in *Dosenbach-Ochsner AG Schuhe und Sport v OHIM*, Case T-424/10. Here the General Court stated:

“45. ... contrary to what the applicant submits, a phonetic comparison is not relevant in the examination of the similarity of a figurative mark without word elements with another mark (see, to that effect, Joined Cases T-5/08 to T-7/08 Nestle v OHIM – Master Beverage Industries (Golden Eagle and Gold Eagle Deluxe) [2010] ECR II-1177, paragraph 67).

46. A figurative mark without word elements cannot, by definition, be pronounced. At the very most, its visual or conceptual content can be described orally. Such a description, however, necessarily coincides with either the visual perception or the conceptual perception of the mark in question. Consequently, it is not necessary to examine separately the phonetic perception of a figurative mark lacking word elements and to compare it with the phonetic perception of other marks”.

Thus, whilst the contested mark will be articulated as ‘ca-rut’, the earlier mark is a figurative element that cannot be assessed aurally.

Conceptual comparison

35. When the earlier mark is depicted in orange (and potentially other colourways), both marks will be viewed as sharing a carrot device and, therefore, a conceptual reference to a carrot, as a type of vegetable. The orange colouring and word “Carrott” in the contested mark reinforces this concept. Although the additional ‘t’ in the word is not the traditional way of spelling the vegetable, due to the carrot device – the conceptual reference to a carrot remains. I consider there is a high degree of conceptual similarity between the marks.

Distinctive character of the earlier trade mark

36. The degree of distinctiveness of the earlier mark must be assessed. This is because the more distinctive the earlier mark, the greater the likelihood of confusion (see *Sabel*). In *Lloyd Schuhfabrik Meyer & Co. GmbH* 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)."

37. Registered trade marks can possess various degrees of inherent distinctive character, ranging from low, because they are suggestive or allusive of a characteristic of the goods, to those with high inherent distinctive character, such as invented words. The distinctiveness of a mark can be enhanced by virtue of the use made of it. Since no evidence has been filed, I only have the inherent characteristics of the mark to consider. The opponent submits that "*the carrot devices featured in its registrations, are fully distinctive of the goods and services concerned*". Whilst the earlier mark is depicted on goods and services largely affiliated with food and produce, whether the device is viewed as a carrot or not, the mark is not allusive of them. I find the mark has a reasonably high level of inherent distinctiveness.

Likelihood of Confusion

38. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. I point particularly to the principles I referred above in paragraph 11. One of these is 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. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier trade mark, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that they have retained in their mind.

39. There are two types of possible confusion: direct (where 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). The distinction between these was explained by Mr Iain Purvis Q.C (sitting as the

Appointed Person) in *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C.:

“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).”*

For the avoidance of doubt, I acknowledge that these three categories are just illustrative – Mr Iain Purvis QC stated that indirect confusion ‘tends’ to fall in one of them.

40. When viewing the contested mark, I consider there is a greater proportion of average consumers who will view the device a carrot, than not. Whilst the average consumer may not articulate the earlier mark (since it is a device without a word), I nevertheless consider that the mark will mostly be remembered as a ‘carrot device’, which has a high degree of conceptual similarity to the opponent’s earlier mark. When I bear in mind that the goods are identical (or else, highly similar) and the average consumer (whether a freelance, service provider or general public) will be paying a medium level of attention when selecting the goods in a most likely visual way, I consider the differences between the marks may be overlooked by way of imperfect recollection. In doing so, I consider the average consumer would see the word in the contested mark as a misspelling of ‘*carrot*’ that merely reinforces the carrot device alongside it. It follows that I find there is a likelihood of direct confusion in which the average consumer imperfectly recollects the marks and may mistake them for one another.

41. Even if the average consumer can distinguish between the marks, I nonetheless find a likelihood of indirect confusion. As I consider the majority of average consumers will view the earlier mark as a carrot, as it has a reasonably high degree of distinctiveness and evokes an unusual concept on the goods concerned, I find the average consumer may still link the two marks. For example, they may think the one mark is a brand variation of the other, or that there is a new ‘carrot’ app from the same or a linked entity.

The opponent’s First Earlier Trade Mark

42. The opposition based on the opponent’s First Earlier Mark has succeeded, though for the record, and in case of appeal, I will briefly consider whether its second registration puts it in a better position. I will state the position shortly, namely that the opposition on the basis of the first registration would succeed for similar reasons as the first. For the record, my findings are that:

- The opponent's mark is a device mark that consists of a graphic orange and green carrot and the word "*Instacart*" in a green lowercase bold and rounded font. The carrot device is angled so that the corner of the carrot faces to the left, whilst the green top faces closest to the word. The device and word have an independent distinctive role, though play an equal role in the overall impression. The colourway is of less prominence.
- Both marks contain a stylised device of a carrot vegetable, though the exact device differs. The contested mark is white and upright whereas the earlier mark is in green and orange and diagonally placed. The words in the respective marks are both placed to the right of the carrot devices; however, the words differ. The earlier mark contains the word "*instacart*" in a green rounded lowercase stylisation whilst the contested mark contains "*Carrott*" in sentence case. The marks have a low similarity.
- Devices are not articulated. The earlier mark will be articulated as 'in-sta-car-tuh' whilst the contested mark will be articulated as 'ca-rut'. There is a shared articulation of 'car', however the placement of this syllable differs. The similarity is very low.
- Both marks share a carrot device and, therefore, a conceptual reference to a carrot, as a type of vegetable. The orange colouring and word "*Carrott*" in the contested mark reinforces this concept. The word "*instacart*" in the earlier mark is not part of the English dictionary, so is conceptually neutral, though the "*cart*" element alongside the carrot and on the goods (and services) concerned may resonate with some average consumers as a reference to a shopping cart. There marks have a medium degree of conceptual similarity.
- The average consumer analysis is the same.

- The distinctiveness of the earlier mark is the same, when one bears in mind that it is the distinctiveness of the common element that is key⁴.
- The goods and services covered by the earlier mark are slightly different, albeit the most similar term is the same. My analysis from earlier remains.
- Whilst the additional differing elements in the respective marks push them slightly further apart, I still find the carrot devices play an independent distinctive role in both of the marks. The earlier mark in this case is also clearly a carrot, so the conceptual similarity between the marks is heightened for all consumers. When I bear in mind the identity or high similarity between the goods, I find that the average consumer would still link the two marks and consider that they are from related economic entities. Although the overall differences between this earlier mark and the contested mark lead to me finding no likelihood of direct confusion (even by imperfect recollection), my earlier analysis and finding of indirect confusion is very similar and remains.

CONCLUSION

43. The opposition under section 5(2)(b) of the Act has been successful. Subject to any successful appeal against my decision, the application will be refused for the full range of goods applied for.

COSTS

44. The opponent has been successful and is entitled to a contribution towards its costs. Awards of costs in proceedings commenced after 1 July 2016 are governed by Annex A of TPN 2 of 2016. Using that TPN as a guide, I award the applicant the sum of £600 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

⁴See Mr Iain Purvis Q.C, particularly at paragraphs [38-39] in *Kurt Geiger v A-List Corporate Limited*, BL O-075-13

Official fees: £100

Preparing a statement and considering the other side's statement: £200

£300

Preparation of submissions:

45. I therefore order Shireen Khan to pay Maplebear Inc. the sum of £600. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 4th day of August 2021

**B Wheeler-Fowler
For the Registrar**