

O/0561/23

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003625741

BY FAERCH UK LTD

TO REGISTER THE FOLLOWING MARK:

Tray 2 Tray by Faerch

IN CLASSES 16, 20, 21 AND 42

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. OP000426395

BY KLOCKNER PENTAPLAST EUROPE GMBH & CO. KG

Background and pleadings

1. On 13 April 2021, Faerch UK Ltd (“the applicant”) applied to register the trade mark shown below and the application was published for opposition purposes on 25 June 2021.

Tray 2 Tray by Faerch

2. The registration is sought for the following goods and services:

Class 16 Bags and articles for packaging, wrapping and storage of paper, cardboard or plastics; Multifunctional packaging containers of paper, cardboard or plastic; Packaging boxes of cardboard; Packaging bags of paper, cardboard or plastic; Packaging trays of paper or cardboard; Plastic materials for packaging; Airtight packaging of paper; Airtight packaging of cardboard; Packaging materials.

Class 20 Multifunctional packaging containers of plastic; containers (non-metallic) in form of kegs; non-metallic bins (other than dust bins); packaging trays of plastic; packaging lids of plastic, plastics material and/or synthetic materials, Including for transport and storage; Fasteners, holders and parts for the aforesaid goods, not of metal.

Class 21 Tableware, cookware and containers; Food storage containers; Containers for liquids; Meal trays; Bakeware; Heat-insulated containers; Foil food containers; Household containers for storing pet food; dishes (household utensils); disposable lids for household containers; disposable table plates.

Class 42 Packaging design.

3. Klockner Pentaplast Europe GmbH & Co. KG (“the opponent”) opposes the trade mark on the basis of section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opposition is directed against all the goods and services in the application and is reliant upon the mark and the goods detailed below.
4. UK00918161865, filed 4 December 2019, registered 22 May 2020.

kp Tray2Tray

Class 16 Packaging materials made of plastic.

Class 17 Plastics in extruded form for use in manufacture; plastic film other than for wrapping.

5. The opponent filed a Form TM7 and an accompanying statement of grounds. Its section 5(2)(b) claim means that it considers the applicant’s mark to be similar to its mark and that registration is sought for identical or similar goods and services by comparison to its goods.
6. The applicant filed a Form TM8 and a counterstatement denying the claims made.
7. Neither party requested to be heard, but both parties filed written submissions in lieu of being heard. The opponent also filed a short submission when filing evidence. The applicant also filed evidence.
8. The applicant is represented by Barker Brettell LLP and the opponent is represented by Hoffmann Eitle PartmbB.

Evidence

9. The opponent filed evidence in the form of a witness statement from Debra Louise Lewis, Trade Mark Attorney for the opponent’s representatives, signed

and dated 20 September 2022. The witness statement is accompanied by exhibits DLL1 to DLL5.

10. The applicant filed evidence in the form of witness statements from Spencer Johnston and Louis Pittortou. Mr Johnston is the regional CEO of the applicant and his witness statement, signed and dated 18 November 2022, is accompanied by exhibits SJ1 to SJ8. Mr Pittortou is a Trade Mark Attorney for the applicant's representatives and his witness statement, signed and dated 21 November 2022, is accompanied by exhibits LP1 to LP2.
11. The opponent filed evidence in reply in the form of a witness statement from Ben Elkington, the opponent's Marketing Director – Trays. His witness statement, signed and dated 20 January 2023, is accompanied by exhibits BE1 to BE2.

DECISION

12. Section 5(2)(b) of the Act reads as follows:

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

(a) ...

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

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

13. 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) a European Union 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.”

14. Given its filing date, the trade mark upon which the opponent relies qualifies as an earlier mark as defined above. As it had not been registered for five years or more before the filing date of the application, the opponent’s mark is not subject to the use requirements specified within section 6A of the Act.

Case law

15. 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. That is why this decision continues to make reference to the trade mark case-law of EU courts.

16. 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;

(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 to mind the earlier mark, 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 the trade marks

17. 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.”

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

19. The marks are shown below:

Opponent's mark	Applicant's mark
kp Tray2Tray	Tray 2 Tray by Faerch

20. The opponent's mark is a word mark – "kp Tray2Tray". The first part of the mark is very short and consists of two lower case letters, "k" and "p". The second part is "Tray", "2", and "Tray" as all one word. The words in the opponent's mark are the only things that contribute to the overall impression, and I find them to carry equal weight.

21. The applicant's mark is a word mark – "Tray 2 Tray by Faerch". The words in the opponent's mark are the only things that contribute to the overall impression, and I find them to carry equal weight.

22. Because the marks share the same phrase but are preceded/succeeded by the different words "kp" and "by Faerch", I find them to be of medium visual similarity overall.

23. Aurally, the opponent's mark is "KAY-PEE TRAY-TOO-TRAY" and the applicant's mark is "TRAY TOO TRAY BYE FAIRSH". The marks are of medium aural similarity.

24. The respective marks share the phrase "Tray2Tray"/"Tray 2 Tray". A tray, according to the Collins online dictionary, is "a flat piece of wood, plastic, or metal, which usually has raised edges and which is used for carrying things, especially food and drinks¹". In the phrase as a whole (where the number 2 stands for the word "to"), the idea of a tray-based product is brought to mind.

¹ www.collinsdictionary.com/dictionary/english/tray

25. The applicant has filed evidence with a view to demonstrating that, “The term Tray2Tray (and equivalents such as Bottle2Bottle) are widely used in relation to recycling, particularly the recycling of plastics, and will be regarded by consumers as a direct reference to recyclable products, recycling processes and associated services.”² There are exhibits from trade journals and websites which quote the phrase “Tray2Tray” and variants thereof. However, while this may show that the phrase is seen as a generic term for the recycling process within the recycling industry, it does not demonstrate that the *consumers* of plastic packaging, even those who buy it in bulk, would be aware of such an interpretation and I do not consider that such a concept would be derived from the respective marks by a significant proportion of average consumers.

26. In the opponent’s mark, the phrase that the parties’ marks share is preceded by “kp” which would be seen as a set of initials. In the applicant’s mark, “by Faerch” follows the shared phrase. This would be seen as a person’s or a company’s name (albeit an unusual name). Neither the preceding nor the succeeding elements in the respective marks would bring to mind any particular concept beyond their being perceived as the names responsible for the tray products.

27. Overall, I find the respective marks to be highly similar conceptually.

Distinctive character of the earlier mark

28. 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

² paragraph 10, Spencer Johnston witness statement

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).”

29. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities.

30. The first word in the earlier mark – “kp” – would be seen as a set of initials and is not suggestive of the goods for which the mark is registered. However, in respect of the phrase which follows the initials, “Tray2Tray”, while a tray can be used to carry food and drinks from place to place, trays are also used for packaging in supermarkets such as when meat and fish are sold shrink-wrapped, or for microwaveable meals. Consequently, noting that the earlier mark holds a registration for “packaging materials made of plastic”, I consider the mark as a whole to be suggestive of the goods for which it is registered, and find that it is of a low inherent distinctive character.

31. I bear in mind that the degree of distinctiveness of the earlier mark is only likely to be significant to the extent that it relates to the point of commonality between the marks³, the phrase “Tray2Tray”/“Tray 2 Tray”. To that extent, I confirm that my view is that that the phrase alone is inherently distinctive to a low degree.
32. The opponent has also filed evidence of use of its mark, albeit it has not made a claim to an enhanced distinctive character acquired through use. I will consider whether the evidence provided is such that the mark has acquired enhanced distinctive character.
33. I must concern myself with evidence of use in the UK.
34. Debra Louise Lewis filed evidence of references to “kp Tray2Tray” in various trade journals. However, only *The Grocer* is a UK publication, and no readership figures are supplied.
35. Ben Elkington’s witness statement refers to the opponent having “introduced their new recycling initiative under the marks “kp Tray2Tray” and “Tray2Tray” in 2019.” It refers to promotion of its marks through trade journals and at various exhibitions. There is no breakdown of any UK readership of the trade journals referred to, nor were any of the exhibitions held in the UK.
36. Yearly advertising expenditure of between £125,000 and £130,000 is quoted, but this is for the UK/European market with no separate figures for the UK provided.
37. At paragraph 7 of his witness statement, Mr Elkington says the following: “KP’s initiative under their “Tray2Tray”/“kp Tray2Tray” marks has been very successful. In Europe, 3200 tons of trays were recycled in 2020 following the launch of our initiative. In 2021, this figure rose to 9762 tons and in 2022 10074 tons. Approximately a third of these recycled trays are related to the UK alone.” While a UK-level breakdown is provided in this instance, this

³ See *Kurt Geiger v A-List Corporate Limited*, BL O-075-13

recycling activity does not necessarily equate to sales under the mark. Furthermore, the opponent refers to activity under two marks – “kp Tray2Tray” and “Tray2Tray” and I can only concern myself with the former for which no separate data is supplied.

38. No information is provided as to market share and there are no corroborating invoices.

39. Overall, I do not find that the evidence shows use of the mark such that the level of distinctiveness can be raised above the finding that I have made for the mark’s inherent distinctive character, that of a low degree.

Comparison of the goods and services

40. When making the comparison, all relevant factors relating to the goods in the specification should be taken into account. In *Canon*, 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.”

41. Guidance on this issue has also come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

(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.

42. The General Court (“GC”) confirmed in *Gérard Meric v Office for Harmonisation in the Internal Market (“OHIM”)*, Case T-133/05, that, even if goods are not worded identically, they can still be considered identical if one term falls within the scope of another (or vice versa):

“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”.

43. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods/services. In *Boston Scientific Ltd v OHIM*, Case T-325/06, the GC stated that “complementary” means:

“...there is 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”.

44. In *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch) at [12] Floyd J said:

“... 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.”

45. I also note section 60A of the Act as follows:

“Similarity of goods and services

(1) For the purposes of this Act goods and services—

(a) are not to be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification;

(b) are not to be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification.”

46. The competing goods and services are as follows:

Opponent's goods	Applicant's goods and services
<p><u>Class 16</u> Packaging materials made of plastic.</p>	<p><u>Class 16</u> Bags and articles for packaging, wrapping and storage of paper, cardboard or plastics; Multifunctional packaging containers of paper, cardboard or plastic; Packaging boxes of cardboard; Packaging bags of paper, cardboard or plastic; Packaging trays of paper or cardboard; Plastic materials for packaging; Airtight packaging of paper; Airtight packaging of cardboard; Packaging materials.</p>
<p><u>Class 17</u> Plastics in extruded form for use in manufacture; plastic film other than for wrapping.</p>	
	<p><u>Class 20</u> Multifunctional packaging containers of plastic; containers (non-metallic) in form of kegs; non-metallic bins (other than dust bins); packaging trays of plastic; packaging lids of plastic, plastics material and/or synthetic materials, Including for transport and storage; Fasteners, holders and parts for the aforesaid goods, not of metal.</p> <p><u>Class 21</u> Tableware, cookware and containers; Food storage containers; Containers for</p>

	liquids; Meal trays; Bakeware; Heat-insulated containers; Foil food containers; Household containers for storing pet food; dishes (household utensils); disposable lids for household containers; disposable table plates.
	<u>Class 42</u> Packaging design.

Class 16

47. The applicant's "Plastic materials for packaging" are identical to the opponent's "packaging materials made of plastic".
48. The applicant's "Bags and articles for packaging, wrapping and storage [made] of ... plastics" is *Merit* identical to the opponent's "packaging materials made of plastic" in that the goods designated by the earlier mark are included in a more general category designated by the trade mark application.
49. The applicant's "Multifunctional packaging containers of ... plastic" and "Packaging bags of ... plastic" are *Merit* identical to the opponent's "packaging materials made of plastic" in that the goods designated by the trade mark application are included in a more general category designated by the earlier mark.
50. The applicant's "Packaging materials" is *Merit* identical to the opponent's "packaging materials made of plastic" in that the goods designated by the earlier mark are included in a more general category designated by the trade mark application.

51. I compare the applicant's "Bags and articles for packaging, wrapping and storage [made] of paper, cardboard ...", "Multifunctional packaging containers of paper, cardboard ...", "Packaging boxes of cardboard", "Packaging bags of paper, cardboard ...", "Packaging trays of paper or cardboard", "Airtight packaging of paper" and "Airtight packaging of cardboard" with the opponent's "packaging materials made of plastic". The respective goods differ in nature in that the applicant's goods are made of paper or cardboard, whereas the opponent's goods are made of plastic. However, all the goods being forms of packaging, they share the same purpose and methods of use. They will also be used by the same groups of users, whether that be individual consumers or companies. They will also have the same trade channels – supermarkets and stationers for individual purchasers, and suppliers of packaging materials in bulk to companies. The respective goods are not complementary, but there would be meaningful competition in that consumers would weigh up the relative merits and price of paper, cardboard, and plastic packaging and choose between them. Overall, I find the respective goods to be highly similar.

Class 20

52. The applicant's "Multifunctional packaging containers of plastic" and "packaging trays of plastic" are *Merici* identical to the opponent's "packaging materials made of plastic" in that the goods designated by the trade mark application are included in a more general category designated by the earlier mark.

53. The applicant's "packaging lids of plastic, plastics material and/or synthetic materials, including for transport and storage" would also be *Merici* identical save for the term extending to packaging lids made of synthetic materials (which could be non-plastic). The applicant's term, by comparison with the opponent's "packaging materials made of plastic" is highly similar.

54. I compare the applicant's "containers (non-metallic) in form of kegs" and "non-metallic bins (other than dust bins)" with the opponent's "packaging materials made of plastic". While the respective goods might be made from the same material, in that non-metallic kegs and bins are typically made of plastic, the applicant's goods have very specific functions as containers for beer and rubbish respectively, whereas packaging generally comes in the form of boxes, trays and wrapping. They differ to that extent and also diverge in respect of purpose and method of use. The trade channels would also be different in that kegs would be bought from home brew or commercial brewery suppliers, and bins from hardware stores, while packaging would be obtained from stationers, and where the respective goods are sold in supermarkets, they would be on different shelves. The respective goods are not complementary, nor are they in competition. I find the goods to be dissimilar (and any possible connection with the opponent's extruded plastic as a potential raw material for the applicant's goods is too tenuous any finding other than that of dissimilarity).

Class 21

55. The applicant's "Foil food containers" are a form of packaging and only differ from the opponent's "packaging materials made of plastic" in respect of what they are made out of. I find these goods to be highly similar.

56. The applicant's "disposable lids for household containers" are a form of packaging, which could be made of plastic, but could also be made of cardboard, and I find these goods to be highly similar to the opponent's "packaging materials made of plastic".

57. The applicant's "Food storage containers", "Meal trays", "Heat-insulated containers" and "Household containers for storing pet food" have something in common with the opponent's "packaging materials made of plastic", plastic packaging being commonly used for food and beverages. While the applicant's goods may be more than single use, the respective goods can all

be made of plastic, and can have similar purposes and methods of use. In terms of trade channels, all could be purchased from the same bulk commercial supplier and might be found in the same section of a supermarket. They are not complementary, but they could be in competition as between single-use and more durable options for the storage and serving of food and beverages. I find the respective goods to be of medium similarity.

58. Given that I have found the applicant's "Food storage containers" and "Heat-insulated containers" to be of medium similarity to the opponent's goods, the opponent's broad term "... containers" is also caught by this finding.

59. The applicant's "disposable table plates" are not packaging, but they share the property of being single use with the opponent's "packaging materials made of plastic". However, the former are eaten from whereas the latter has the general purpose of packaging. In respect of trade channels, both sets of goods could be sourced from the same bulk commercial suppliers and might be shelved relatively close together in a supermarket. The respective goods are not complementary, nor are they in competition. I find these goods to be of very low similarity.

60. I compare the applicant's "Tableware ..." and "dishes (household utensils)" with the opponent's "packaging materials made of plastic". Tableware – such as cutlery, plates, and glasses – and dishes are generally made from metal, china, or glass, and so differs in that respect from the opponent's plastic packaging. These goods are also durable, as opposed to packaging which tends to be single use. The respective goods also differ in purpose and method of use. The trade channels would also diverge in that tableware would be bought from a department store or kitchenware shop, while packaging would be obtained from a stationers or bulk commercial supplier, and the respective goods would be found in different parts of a supermarket. The goods are not complementary, nor are they in competition. I find the goods to be dissimilar.

61. I compare the applicant's "... cookware ..." with the opponent's "packaging materials made of plastic". Cookware – such as pots and pans – is generally made from metal and so differs in that respect from the opponent's plastic packaging. These goods are also durable, as opposed to packaging which tends to be single use. The respective goods also differ in purpose and method of use. The trade channels would also diverge in that cookware would be bought from a kitchenware shop, while packaging would be obtained from a stationers or bulk commercial supplier, and the respective goods would be found in different parts of a supermarket. The goods are not complementary, nor are they in competition. I find the goods to be dissimilar.

62. I compare the applicant's "Bakeware" with the opponent's "packaging materials made of plastic". Bakeware – such as roasting trays and oven-proof dishes – is generally metal, ceramic, or heat-proof glass, and so differs in that respect from the opponent's plastic packaging. These goods are also durable, as opposed to packaging which tends to be single use. The respective goods also differ in purpose and method of use. The trade channels would also diverge in that bakeware would be bought from a kitchenware shop, while packaging would be obtained from a stationers or bulk commercial supplier, and the respective goods would be found in different parts of a supermarket. The goods are not complementary, nor are they in competition. I find the goods to be dissimilar.

Class 42

63. I compare the applicant's "Packaging design" with the opponent's "packaging materials made of plastic". Given that the applicant's term is a service, it differs in nature and method of use from the opponent's goods, but the respective service and goods share the same broad purpose – that of packaging. The same corporate consumers may purchase packaging in bulk as well as a packaging design service and, in that context, the trade channels would coincide. The service and the goods are not in competition, but they are complementary. Packaging design is important to packaging itself and customers may think that the responsibility for the service and the goods lies

with the same undertaking. I find the service and the goods to be similar to a medium degree.

64. As some degree of similarity between the goods and services is required for there to be a likelihood of confusion⁴, the opposition fails in respect of the following goods:

Class 20 containers (non-metallic) in form of kegs; non-metallic bins (other than dust bins); Fasteners, holders and parts for the aforesaid goods, not of metal.

Class 21 Tableware, cookware; Bakeware.

The average consumer and the nature of the purchasing act

65. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods and services. I must then determine the manner in which the goods and services are likely to be selected by the average consumer. 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.”

⁴ *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA

66. The average consumer of the competing goods will be an individual wanting to buy some packaging or food containers or a company wanting to buy such goods in bulk. In either case, these items are relatively cheap, and they are also functional, so the purchase would not require much thought except when price became a consideration for a very large order. The level of attention required during the purchasing process would be medium at most.
67. Visual considerations would predominate when selecting from the shelves of a physical shop, or when purchasing online, with verbal factors playing a minor role.
68. When it comes to purchasing a packaging design service, the average consumer would be a company whereby some thought would need to be given to specifications and a contract would probably need to be entered into. As such, the level of attention paid would be at least medium.
69. While the initial contact with the packaging design company would involve a visual encounter with the company's trade mark on its website, verbal factors might also play a part in subsequent discussions about the company's service.

Likelihood of confusion

70. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods down to the responsible undertakings being the same or related. 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. The first 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 services and vice

versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the opponents' trade mark, the average consumer for the goods and services 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.

71. I have found the respective marks to be of medium visual and aural similarity, and to be highly similar conceptually. The average consumer will pay a medium level of attention at most in respect of the competing goods, but the service at issue will require at least a medium level of attention. Visual considerations will predominate when it comes to the goods, with verbal factors playing a minor role. While the initial contact with the service would involve a visual encounter with the company's trade mark on its website, verbal factors might also play a part in subsequent discussions.

72. Except where I have found them to be dissimilar, the goods and services are identical, highly similar, of medium similarity, or of very low similarity. The earlier mark is of a low level of inherent distinctiveness, and the evidence of use that I have reviewed has not resulted in a finding of an enhanced level of distinctiveness acquired through use.

73. While the two marks – “kp Tray2Tray” and “Tray 2 Tray by Faerch” – share the phrase “Tray2Tray”/“Tray 2 Tray”, they differ in that the earlier mark begins with the letters “kp” and the applicant's mark ends with “by Faerch”. As such, given that the beginnings of the respective marks are manifestly different, I am conscious of *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02 where the General Court noted that the beginnings of words tend to have more visual and aural impact than the ends. The differences between the marks are very noticeable and therefore there is no likelihood of direct confusion in this case.

74. It now falls to me to consider the likelihood of indirect confusion. Indirect confusion was described in the following terms by Iain Purvis Q.C., sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10:

“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 recognised 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.”

75. In *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch), Arnold J. considered the impact of the CJEU’s judgment in *Bimbo*, Case C-591/12P, 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 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.”

76. While the average consumer would notice the differences between the marks, I must consider whether they would see one as a brand variation of the other, or whether there is some other reason why they would conclude that the goods come from the same or an economically linked undertaking.

77. The form of words in the two marks is not indicative of brand consistency: the different elements in the marks are at the beginning and the end respectively. Furthermore, while they share the phrase “Tray2Tray”/“Tray 2 Tray”, I must guard against finding that there is a likelihood of indirect confusion merely

due to the presence of a common element (see *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17). The shared phrase is lowly distinctive and is suggestive of the products offered by the respective parties – tray-based products – whereas “kp” and “by Faerch” (using the preposition “by” as in “made by”) would be seen as the respective companies responsible for the trade marks.

78. The average consumer would see these entirely different names used within the marks as those of separate companies which have coincidentally chosen a formulation which is suggestive of the products that they offer. They would not see an economic connection between the two marks and so there is no obvious basis by which the marks would be seen as brand variations of each other. At most, one mark might be called to mind by the other, but that is not a sufficient basis for a finding of indirect confusion, it being mere association (as noted in the *Duebros Limited* case).

79. I am also conscious of the examples referred to in the *L.A. Sugar* case:

“17. Instances where one may expect the average consumer to reach such a conclusion [that the later mark is another brand of the owner of the earlier mark] 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).”

80. Looking at the examples given above, the common element is lowly distinctive, the additional words in the later mark do not add a non-distinctive element consistent with a sub-brand, and this case does not involve a logical and consistent change of elements.

81. Overall, even when considering the fact that some of the goods at issue are identical, I find no likelihood of indirect confusion between the marks in this case.

82. While I have reached my decision on the basis of a notional comparison of the marks, I note that the opponent itself bears out my analysis of the contribution that “kp” makes to the overall consumer perception of its mark i.e. that that part of the mark is the company name: “KP often uses its house mark “kp” in conjunction with other trade marks specific to its products. For example, kp produces and markets various food packaging products such as “kp Eternal”, “kp Evoke”, “kp Evolve”; “kp Kapture”; “kp Zapora”, kp Volta”, kp Aspect”, and “kp Jewel”, amongst others. This way the customers know that “kp” refers to our company and that the mark following “kp” refers to the particular product from our company.”⁵

CONCLUSION

83. The opposition has failed. The application will proceed to registration, subject to appeal.

COSTS

84. The applicant has succeeded. In line with Annex A of Tribunal Practice Notice 2 of 2016, I award costs to the applicant as below.

⁵ paragraph 8, witness statement of Ben Elkington

Preparing a statement	
and considering the other side's statement:	£200
Preparing evidence	
and considering the other side's evidence:	£750
Preparing submissions:	£300
Total:	£1250

85. I order Klockner Pentaplast Europe GmbH & Co. KG to pay Faerch UK Ltd £1250. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 16th day of June 2023

JOHN WILLIAMS
For the Registrar