

O-028-11

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 2531783
BY SAGA FOODS LTD
TO REGISTER A TRADE MARK IN CLASS 32**

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 100022 BY CLIFFORD JAMES MOSS**

BACKGROUND

1. On 16 November 2009, Saga Foods Ltd (“Saga”) applied to register the word GORILLA as a trade mark for the following goods in class 32:

Beers, mineral and aerated waters and other non-alcoholic drinks;
energy drinks; fruit drinks and fruit juices.

The application was accepted and published for opposition purposes on 1 January 2010 in Trade Marks Journal No.6817.

2. On 20 January 2010, Clifford James Moss filed a notice of opposition. This consisted of a single ground based upon section 5(2)(b) of the Trade Marks Act 1994 (as amended) (the Act). Mr Moss indicates that the opposition is directed against the following goods in Saga’s application:

Mineral and aerated waters and other non-alcoholic drinks; energy drinks; fruit drinks and fruit juices.

Mr Moss relies upon one earlier trade mark registration:

Trade Mark	No.	Application date	Registration date	Goods
GRUMPY GORILLA	2493772	26/7/08	16/1/09	Although also registered in classes 5, 29 and 30, the goods in class 32 i.e. “Non-alcoholic beverages; beverages adapted to boost energy” are the most relevant.

3. In his Statement of Grounds Mr Moss states:

“1. The mark GORILLA of the subject application is phonetically similar to the mark GRUMPY GORILLA...The word GORILLA is highly prominent in [Mr Moss’] trade mark and the marks are similar to one another as a result when an overall comparison is made between them. Conceptually, the marks GORILLA and GRUMPY GORILLA are similar to one another as the latter looks like an abbreviation of the former i.e. the “grumpy” version of the GORILLA mark.

2. The goods of class 32 of the subject application are identical and/or similar to the goods of class 32 of [Mr Moss’] trade mark....”

4. On 13 April 2010 Saga filed a counterstatement. In their counterstatement Saga state, inter alia:

“1. [Saga] would like to point out that it is the registered proprietor of the earlier community trade mark GORILLA GUARANA (No. E6628069), which was filed on 31/01/2008 and subsequently registered.

2. The community mark GORILLA GUARANA was filed on behalf of [Saga]...It is therefore an earlier mark to the mark GRUMPY GORILLA, of which [Mr Moss] is the proprietor, and on which [Mr Moss] is basing his opposition.

3. As the word GUARANA is a descriptive term that could not be registered as a one-word trade mark and that refers to contents of the product itself, and as the GORILLA element of the mark GORILLA GUARANA is the principal distinguishing feature, [Saga] submits that any opposition against its new application to register the mark GORILLA should be dismissed in its entirety.

4. The mark GORILLA GUARANA is currently being used by [Saga] for a guarana-based beverage or guarana drink. Therefore, when examining an opposition to [Saga's] new application for registration of the mark GORILLA, there is merit in considering whether an opposition to an application for registration of the mark PEPSI by the proprietor of the registered trade mark PEPSI COLA would have any foundation.

5. Aside from the fact that [Saga] is already the proprietor of an even earlier mark GORILLA GUARANA, when comparing [Mr Moss'] mark GRUMPY GORILLA, we have to consider both elements of the trade mark as in this case they are both relevant to the overall impression conveyed to the relevant public. It is argued by [Mr Moss] that the mark GORILLA could appear to be an abbreviation of GRUMPY GORILLA. However, it is submitted that GRUMPY is at the very least equally important as one of the components of [Mr Moss'] composite mark. In fact, it is submitted any abbreviation would likely be GRUMPY and not GORILLA. This is supported by the link to [Mr Moss'] website (address provided) which as of 12/4/2010 explicitly abbreviates the mark GRUMPY GORILLA to GRUMPY (writing "ABOUT GRUMPY").

6. If the mark applied for...is considered to be confusingly similar to [Mr Moss'] earlier trade mark...then it is submitted that this would set a strong precedent for the invalidation of the mark GRUMPY GORILLA based on [Saga's] earlier community trade mark..."

5. Although neither party filed evidence or asked to be heard, on 8 June Mr Moss' professional representatives William A Shepherd & Son filed written submissions: I will refer to these submissions as necessary below.

6. I note that the official letter of 31 August 2010 (sent to the parties at the conclusion of the evidence rounds) contained the following sentence:

"The Hearing Officer has requested that the applicant's attention is drawn to TPN 4/2009 and that as a consequence of this the applicant's even earlier registered trade mark has no relevance to the conflict in these proceedings."

7. In their counterstatement Saga explain they own a community trade mark registration for the trade mark GORILLA GUARANA which has an application date prior to that of the registration upon which Mr Moss relies in these proceedings; that is correct. They also say that this trade mark is being used. These circumstances were dealt with in the Tribunal Practice Notice (TPN) mentioned, the relevant paragraphs of which read:

“Defences including a claim that the applicant for registration/registered proprietor has a registered trade mark that predates the trade mark upon which the attacker relies for grounds under sections 5(1) and 5(2) of the Act.

1. A number of counterstatements in opposition and invalidation actions have sought to introduce as a defence that the applicant for registration/registered proprietor has a registered trade mark (or trade mark application) for the same or a highly similar trade mark to that which is the subject of the proceedings that predates the earlier mark upon which the attacker relies.

2. Sections 5(1) and 5(2) of the Act turn upon whether the attacker has an earlier trade mark compared to the mark under attack, as defined by section 6 of the Act. Whether the applicant for registration/registered proprietor has another registered trade mark (or trade mark application) that predates the earlier mark upon which the attacker relies cannot affect the outcome of the case in relation to these grounds.

3. The position was explained by the Court of First Instance in *PepsiCo, Inc v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) T-269/02*:

"24 Nor did the applicant claim, and even less prove, that it had used its earlier German mark to obtain cancellation of the intervener's mark before the competent national authorities, or even that it had commenced proceedings for that purpose.

25 In those circumstances, the Court notes that, quite irrespective of the question whether the applicant had adduced evidence of the existence of its earlier German mark before OHIM, the existence of that mark alone would not in any event have been sufficient reason for rejecting the opposition. The applicant would still have had to prove that it had been successful in having the intervener's mark cancelled by the competent national authorities.

26 The validity of a national trade mark, in this case the intervener's, may not be called in question in proceedings for registration of a Community trade mark, but only in cancellation proceedings brought in the Member State concerned (Case T 6/01 *Matratzen Concord v OHIM - Hukla Germany (MATRATZEN)* [2002] ECR II 4335, paragraph 55). Moreover, although it is for OHIM to ascertain, on the basis of evidence which it is up to the opponent to produce, the existence of the

national mark relied on in support of the opposition, it is not for it to rule on a conflict between that mark and another mark at national level, such a conflict falling within the competence of the national authorities."

The position with regard to defences based on use of the trade mark under attack which precedes the date of use or registration of the attacker's mark

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

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

8. The comments above make it clear that the existence of Saga's earlier trade mark is irrelevant and I shall make no further mention of it in this decision.

DECISION

9. The only ground of 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 -

(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, or

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

10. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

"6.-(1) In this Act an "earlier trade mark" means -

(a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

11. Mr Moss’ trade mark is an earlier trade mark and is not subject to proof of use, as per The Trade Marks (Proof of Use, etc) Regulations 2004, as it had not been registered for five years at the time of the publication of Saga’s trade mark application.

Section 5(2)(b) – case law

12. In reaching a decision I must take into account the guidance provided by the European Court of Justice (ECJ) in a number of judgments. The principal cases are: *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 117, *Lloyd Schuhfabrik Mayer & Co. GmbH v. Klijsen Handel B.V* [2000] F.S.R. 77 and *Marca Mode CV v. Adidas AG + Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG V Thomson multimedia Sales Germany & Austria GmbH* (Case C-120/04) and *Shaker di L. Laudato & Co. Sas* (C-334/05),

It is clear from all these cases that:

(a) the likelihood of confusion must be appreciated globally, taking account of all the relevant factors; *Sabel BV v. Puma AG*, paragraph 22;

(b) the matter must be judged through the eyes of the average consumer of the good/services in question; *Sabel BV v. Puma AG*, paragraph 23, who is deemed to be reasonably well informed and 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; *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v. Puma AG*, paragraph 23;

(d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v. Puma AG*, paragraph 23;

(e) when considering composite marks, it is only if all the other components of the mark are negligible that the assessment of the similarity can be carried out solely on the basis of the dominant element; *Shaker di L. Laudato & Co. Sas* (C-334/05), paragraph 42;

(f) an element of a mark may play an independent distinctive role within it without necessarily constituting the dominant element; *Medion AG V Thomson multimedia Sales Germany & Austria GmbH*, paragraph 30;

(g) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17;

(h) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v. Puma AG*, paragraph 24;

(i) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v. Puma AG*, paragraph 26;

(j) further, 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; *Marca Mode CV v. Adidas AG + Adidas Benelux BV*, paragraph 41;

(k) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 29.

The average consumer and the nature of the purchasing process

13. As the case law above indicates, it is necessary for me to determine who the average consumer is for the goods; I must then determine the manner in which these goods are likely to be selected by the average consumer in the course of trade. The goods at issue are all non-alcoholic drinks of one sort or another. In his written submissions Mr Moss says:

“All of the respective parties’ goods are everyday consumer goods bought by the general public. They may be bought in a variety of ways e.g. in a retail store, bar, café, hotel or restaurant...one can infer that in all probability, they originate from the same manufacturing sector and travel through the same channels of trade to the same consumer group. These are goods that will be bought with some, but not the highest, degree of care. The purchase of each of the respective goods is likely to be made primarily on the basis of the name selection.”

14. I agree with Mr Moss that the goods in issue are the sort of goods which will be bought by the general public from the type of outlets identified. The average consumer will acquire the goods either by self selection from a shelf in, for example, a supermarket, or by asking for them by name in, for example, a bar. Given the relatively inexpensive nature of the goods, I also agree that the average consumer is likely to pay only a moderate level of attention to the selection of the goods.

Comparison of goods

15. The opposed goods in Saga’s application are:

Mineral and aerated waters and other non-alcoholic drinks; energy drinks; fruit drinks and fruit juices”.

All of these terms would be included in the following terms appearing in Mr Moss’ registration:

Non-alcoholic beverages; beverages adapted to boost energy.”

16. In view of the following comments of the General Court (previously the Court of First Instance) in *Gérard Meric v OHIM*, Case T-133/05, the goods must be regarded as identical.

“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 the trade mark application (Case T-388/00 Institut für Lernsysteme v OHIM – Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 Oberhauser v OHIM – Petit Liberto (Fifties) [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 Vedial v OHIM – France Distribution (HUBERT) [2002] ECR II-5275, paragraphs 43 and 44; and Case T- 10/03 Koubi v OHIM – Flabesa (CONFORFLEX) [2004] ECR II-719, paragraphs 41 and 42).

Comparison of trade marks

17. For the sake of convenience, the trade marks to be compared are as follows:

Mr Moss’ trade mark	Saga’s trade mark
GRUMPY GORILLA	GORILLA

18. The average consumer is considered to be reasonably well informed, circumspect and observant but perceives trade marks as wholes and does not pause to analyse their various details. In addition, he rarely has the chance to make direct comparisons

between trade marks and must instead rely upon the imperfect picture of them he has kept in his mind. In reaching a conclusion on similarity I must identify what I consider to be the distinctive and dominant elements of the respective trade marks and, with that conclusion in mind, I must then go on and compare the respective trade marks from the visual, aural and conceptual perspectives.

Distinctive and dominant components

19. In his written submissions Mr Moss says:

“In this case the first element of [Mr Moss’] earlier mark, GRUMPY does not stand alone as a dominant and distinctive part of that mark but is used in an adjectival sense and thus directly relates to the word it precedes, namely GORILLA. The word “grumpy” in context describes the preceding word GORILLA. The dominant element within the mark is therefore the word GORILLA with the word GRUMPY being more of a descriptor in context.”

20. In their counterstatement Saga said:

“We have to consider both elements of the trade mark as in this case they are both relevant to the overall impression conveyed to the relevant public.... However, it is submitted that GRUMPY is at the very least equally important as one of the components of [Mr Moss’] composite mark. In fact, it is submitted any abbreviation would likely be GRUMPY and not GORILLA...”.

21. Saga’s trade mark consists exclusively of the well know dictionary word GORILLA presented in upper case; there is no dominant element, the distinctiveness lying in the totality. Insofar as Mr Moss’ trade mark is concerned, this consists of the well known dictionary words GRUMPY and GORILLA presented as two separate words, again in upper case; both words considered in isolation constitute distinctive elements. While the word GRUMPY could (by virtue of its positioning) be said to have a degree of dominance over the word GORILLA, as the word GRUMPY qualifies the word GORILLA, I consider that it is the word GORILLA which is the dominant element of Mr Moss’ trade mark.

Visual/aural similarity

22. In his written submissions Mr Moss says:

“As the word GORILLA is common to each of the respective trade marks there is a reasonable degree of visual and aural similarity between them.”

23. I have described the competing trade marks above. As they either consist of or contain the word GORILLA, I agree with Mr Moss conclusions on the degree of visual and aural similarity between them.

Conceptual similarity

24. In his written submissions Mr Moss said:

“As the most prominent element in the earlier mark of [Mr Moss] is the word GORILLA (albeit a “grumpy” one), there is a degree of similarity between the respective marks from a conceptual viewpoint.”

25. The fact that both trade marks converge on the word GORILLA, results, in my view, in a high degree of conceptual similarity between them.

Distinctive character of Mr Moss’ earlier trade mark

26. I must also assess the distinctive character of Mr Moss’ trade mark. The distinctive character of a trade mark must be appraised first by reference to the goods in respect of which it has been registered and, second, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods for which it has been registered as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

27. As Mr Moss has not filed evidence of any use he may have made of his trade mark, I have only the distinctive character arising from its inherent characteristics to consider. As far as I am aware, neither word considered in isolation or the combination they create have any meaning in the context of the goods at issue in these proceedings. Consequently, Mr Moss’ trade mark possesses a high degree of inherent distinctive character.

Likelihood of confusion

28. In determining whether there is a likelihood of confusion, 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 vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of Mr Moss’ trade mark, as the more distinctive this trade mark is the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods, the nature of the purchasing process and 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 he has retained in his mind. I have concluded that the respective goods are identical, that there is a reasonable degree of visual and aural similarity and a high degree of conceptual similarity. Applying the global approach advocated to those findings, I have concluded

that the differences between the respective trade marks are sufficient to avoid direct confusion i.e. where one trade mark is mistaken for the other. More likely, in my view, is that the average consumer will assume, given the relatively low cost of the goods, the moderate level of attention they will pay when selecting the goods and the presence of the highly distinctive word GORILLA in both trade marks, that Saga's goods come from an undertaking economically linked to Mr Moss i.e. there will be indirect confusion. The ground of opposition under section 5(2)(b) succeeds accordingly.

29. Mr Moss' opposition has succeeded in respect of all the goods he opposed i.e. mineral and aerated waters and other non-alcoholic drinks; energy drinks; fruit drinks and fruit juices. Saga's application will be refused in respect of these goods, but may proceed to registration in respect of the goods that were not opposed i.e. beers.

Costs

30. As Mr Moss has been successful, he is entitled to a contribution towards his costs. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 4 of 2007. Using that TPN as a guide, I award costs to Mr Moss on the following basis:

Preparing a statement and considering the other side's statement:	£200
Preparation of written submissions:	£300
Official fee:	£200
Total:	£700

31. I order Saga Foods Ltd to pay to Clifford James Moss the sum of £700. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 01 day of February 2011

C J BOWEN
For the Registrar
The Comptroller-General