

**O/128/20**

**TRADE MARKS ACT 1994  
(AS AMENDED)**

**IN THE MATTER OF**

**TRADE MARK REGISTRATION No. 3234974**

**IN THE NAMES OF ANGUS GAUDIE AND SUE GAUDIE**

**AND**

**APPLICATION NO. CA502502**

**BY TROMPENBURG HOLDINGS B.V.**

**FOR A DECLARATION OF INVALIDITY**

## BACKGROUND AND PLEADINGS

1. Angus and Sue Gaudie (herein “**the Proprietors**”) are the registered proprietors of a UK trade mark registration as detailed:

<b>The Proprietors’ contested registered trade mark (No. 3234974) (word mark)</b>
“Yorg”
<b>Registered for goods in Class 29:</b> <i>Milk products</i>
<b>Date of filing application:</b> 2 June 2017
<b>Published for opposition purposes:</b> 9 June 2017
<b>Registration date:</b> 18 August 2017

2. On 15 March 2019, Trompenburg Holdings B.V. (herein “**the Applicant**”) filed an application, on Form TM26(I), to invalidate the Proprietors’ registration, relying on grounds under section 5(2)(b)<sup>1</sup> of the Trade Marks Act 1994 (“**the Act**”). The Applicant relies for its claim on its EU trade mark registration as detailed:

<b>The Applicant’s earlier registered EU trade mark (No. 014773683)</b>
“YOR”
<b>Date of filing application:</b> 6 November 2015
<b>Registration date:</b> 14 July 2016

3. The Applicant relies only on some of the goods under its registration, namely:  
**Class 29:** *Milk; Milk products; Drinks made from dairy products; Dairy-based beverages; Drinks based on yogurt.*
4. The Applicant claims that the respective marks are highly similar and that the parties’ goods are similar or identical, such that there exists a likelihood of confusion on the part of the public, including the likelihood of association with the earlier trade mark. Based on points made in communications between the parties before the Applicant filed its Form TM26(I), the Applicant’s statement of case in its invalidity application also addressed points of counterargument raised by the Proprietors, notably as to (i) the Proprietors’

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<sup>1</sup> Applicable by virtue of section 47(2)(a) of the Act.

etymological thinking behind their choice of trade mark, (ii) that, to the Proprietors' knowledge, there has been no factual confusion (iii) that the Proprietors' goods were high-end goods sold mainly in farm-stores and delicatessens and (iv) the Proprietors' view that no likelihood of confusion arose as the Applicant has not yet sold goods under the mark YOR in the UK. I shall deal with these points in the round in my paragraph below that emphasises the notional nature of the assessments under section 5(2)(b).

### **The Proprietors' counterstatement**

5. The Proprietors filed a Form TM8 notice of defence. Among other points, the counterstatement claimed that both visually and phonetically the marks are different, and it was denied that there was a likelihood of confusion. The Proprietors argued that although the competing marks share the same first three letters, in short trade marks such as these, the inclusion of an additional letter (even at the end of a trade mark) can have a significant impact.

### **Representation, papers filed and hearing**

6. The Applicant is represented in these proceedings by Bastion IP. During the evidence rounds the Applicant filed no evidence or submissions. The Proprietors did file evidence (including points of submission), comprising a Witness Statement by Susan Gaudie, dated 29 October 2019, with Exhibits SG1 - SG21, but for reasons again related to the notional nature of the assessments under section 5(2)(b), the evidence filed (concerning, for example, background on the Proprietors' business, the development of their mark and the marketing of the goods) is of little or no relevance and I shall not refer further to it.
7. The Proprietors attended an oral hearing on 6<sup>th</sup> February 2020; the Applicant chose not to attend, nor to file submissions in lieu, relying instead on the full points that it had made in its statement of case as at 15 March 2019. I have read all the papers filed and shall refer to the parties' competing submissions only as I consider it appropriate to do so.

### **Notional nature of the legal considerations**

8. At the hearing I explained the following points to the Proprietors, chiming with the Applicant's submissions in addressing the points of counterargument - (i) – (iv) above. The task of determining a likelihood of confusion under section 5(2)(b) requires an approach based on the perspective of the notional average consumer (as I further detail

later in this decision), and on notional fair and ordinary use that either party may make of their respective trade marks. Thus, while background information about the Proprietors' business, the development of their mark, the profile and marketing of its products may (quite understandably) be significant in the minds of the Proprietors (who have acted largely without professional representation), such matters can have no bearing in the assessment task before me. Any comparison of the marks must be on the basis of how they appear on the register; since they are both word marks, ordinary use allows for changes of case and typeface, but it is not relevant that the packaging for their goods might feature surrounding patterns. Likewise, the goods to be compared are those as specified. It is of no relevance that the Applicant's mark is currently in use for a line of candies containing real yoghurt, whereas the Proprietors' product is an organic yoghurt drink. A registered trade mark generally affords its owner an initial period of five years from the date of registration to put the mark to genuine use in relation to its specified goods or services (and indeed the Applicant stated that it plans to launch yoghurt-based beverages).

## **DECISION**

### **Relevant legislation**

9. Section 47 of the Act provides for invalidity of a UK registered trade mark. Section 47(2)(a) states:

*(2) The registration of a trade mark may be declared invalid on the ground—*

*(a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or*

*(b) [...],*

*unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.*

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

*“... 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.”*

11. Since the Applicant’s trade mark has a date of application for registration earlier than that of the Proprietors’ trade mark, it is clearly an “earlier trade mark” as defined by section 6(1)(a) of the Act. In the present case, because the earlier mark had not been registered for more than five years at the date of application for invalidation, nor at the date on which the Proprietors’ trade mark application was filed, it is not subject to proof of use<sup>2</sup>. The Applicant is thus able to rely on its specified registered goods without having to show that it has used its mark at all.

12. The following decisions of the EU courts provide the principles to be borne in mind when considering section 5(2)(b) of the Act:

*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.

13. The principles are that:

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors;
- (b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

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<sup>2</sup> See section 47(2A) and (2B) of the Act.

- (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**

Goods relied on by the Applicant:	<b>Class 29:</b> <i>Milk; Milk products; Drinks made from dairy products; Dairy-based beverages; Drinks based on yogurt.</i>
The Proprietors' goods:	<b>Class 29:</b> <i>Milk products</i>

14. The relevant comparison to be made is on the basis of the respective specifications that the parties can rely on. The Proprietors' registration is simply for *Milk products* in Class

29. The goods relied on by the Applicant include *Milk products* in Class 29. Those goods are **plainly identical**.

### **The average consumer and the purchasing process**

15. It is necessary to determine who is the average consumer for the respective goods and how the consumer is likely to select them. It must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question<sup>3</sup>. In *Hearst Holdings Inc*<sup>4</sup>, Birss J. described the average consumer in these terms:

*“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect ... the 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 word “average” denotes that the person is typical... [it] does not denote some form of numerical mean, mode or median.”*

16. Milk products are sold and purchased very widely and the relevant average consumer in this case will be members of the general public. In selecting and purchasing such goods the average consumer will pay enough attention to ascertain the flavour and maybe fat content of the goods; the goods are not expensive and may be purchased not infrequently, and in my view the average consumer will exercise a degree of attention between low and medium (certainly no higher than medium). Visual considerations will be particularly influential in the purchasing act because the goods at issue are likely to be selected visually after perusal of shelves or refrigerators in supermarkets, delicatessens and other retail outlets, or potentially from information on websites. However, aural considerations may also play a part, such as on the basis of word of mouth recommendations, so the way the marks are said is also relevant.

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<sup>3</sup> *Lloyd Schuhfabrik Meyer*, Case C-342/97

<sup>4</sup> *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)

### Distinctive character of the earlier trade mark

17. The distinctive character of the earlier mark must be considered. The more distinctive an earlier mark, either by inherent nature or by use, the greater the likelihood of confusion (*Sabel*). In *Lloyd Schuhfabrik*<sup>5</sup> 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 ...*

*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).”*

18. The distinctive character of a trade mark can be appraised only, first, by reference to the goods specified in the registration and, secondly, by reference to the way it is perceived by the relevant public<sup>6</sup>. With this in mind, I note the following:
19. The distinctiveness of a mark refers to its ability to distinguish its goods as originating from a particular source. The Applicant submitted that the earlier mark in this case has a “normal” degree of distinctiveness. In my view, since the word “YOR” is not a standard word in the English language and will be seen by the average consumer as an invented, meaningless word, it may be considered to have a **high level of distinctiveness** per se. Since the Applicant filed no evidence as to the use of its earlier mark, there is no possibility

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<sup>5</sup> *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97

<sup>6</sup> *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91



of considering whether the Applicant's trade mark may have an enhanced level of distinctiveness in the perception of the UK consumer through use.

### **Comparison of the marks**

20. It is clear from *Sabel*<sup>7</sup> 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 Court of Justice of the European Union (CJEU) stated in *Bimbo*<sup>8</sup> 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.”
21. It would therefore be wrong to dissect the trade marks artificially, but it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features that are not negligible and therefore contribute to the overall impressions created by the marks. The marks to be compared are shown below:

<b>The Applicant's earlier registered mark:</b>	<b>YOR</b>
<b>The Proprietors' contested trade mark:</b>	<b>Yorg</b>

22. The Applicant's earlier trade mark consists of the word-only registration “YOR”. There are no other elements to contribute to the overall impression which lies in the single word itself. Likewise, the Proprietors' trade mark consists only of the word registration “Yorg”; no other elements contribute to the overall impression which lies in the word itself.

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<sup>7</sup> *Sabel BV v Puma AG*, Case C-251/95

<sup>8</sup> *Bimbo SA v OHIM*, Case C-591/12P (paragraph 34)

### Visual similarity

23. In line with assumptions about how consumers perceive marks, courts have tended towards a general principle that in determining whether marks are similar, particular attention should be paid to the beginnings of marks, although this is not a hard-and-fast rule. In the present case the three letters that make up the Applicant's mark feature in the same order at the start of the Proprietors' mark, so there is clearly a visual overlap between the words; the marks are, in some degree, visually similar. The visual difference between the marks is that the Proprietors' mark has an additional letter, ending as it does with the letter "G". The Applicant's mark involves just three letters, whereas the Proprietors' mark has four letters. Given just how short is the Applicant's mark, I find that the additional letter has a notable visual impact, with the three-letter word striking the average consumer as 'slighter' by comparison. Even though the earlier mark in its entirety appears at the start of the Proprietors' mark, I bear in mind both that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details, and that it would be wrong to dissect the trade marks artificially. In my view, the differences in word length and spelling are readily apparent and I find the marks are **visually similar only to a degree between low and medium.**

### Aural similarity

24. It is clear how the marks will be referred to in speech: as "YOR" and "YORG". Although the Applicant's mark is spelled unlike any standard English word, it will be said and heard in a way that is identical or virtually identical to more than one standard English word; in particular, it sounds very like the extremely common English word "your" (as well as like the far less common "yore" and "yaw"). The Proprietors' mark ends with a hard "G" that produces a word that sounds like no standard English word - at the hearing Mr Gaudie suggested that the mark sounds like a Scandinavian word or name. In my view, the hard G ending has a significant aural impact and produces a quite different overall impression from an aural perspective. Despite the overlap of the "yor" sound, I find the marks are **aurally similar only to a degree between low and medium.**

### Conceptual similarity

25. Although in considering the aural similarity I have acknowledged that the Applicant's mark sounds like various English words – e.g. it may sound like “your” yoghurt-based drinks/milk products - the Applicant's mark is spelled like no standard English word and I agree with both parties that no immediately graspable concept correctly attaches to it. The Proprietors' submissions included an explanation of the genesis of their mark, with an etymological basis reflecting references to “Yorkshire”, “yoghurt” and “organic”. However, as I explained at the hearing, matters must be viewed from the perspective of the average consumer and no immediately graspable concept attaches to the word “Yorg”. Since neither mark has a relevant concept, the position is **neutral in relation to their conceptual similarity**.

### Conclusion as to likelihood of confusion

26. I now turn to reach a conclusion as to the likelihood of confusion between the marks YOR and YORG if they were used in relation to the goods I have considered in classes 29. Confusion can be direct or indirect. Whereas direct confusion involves the average consumer mistaking one trade mark for the other, indirect confusion is where the average consumer realises that the trade marks are not the same but puts the similarity that exists between the trade marks/goods down to the responsible undertakings being the same or related. Deciding whether there is a likelihood of confusion is not scientific; it is a matter of making a global assessment of all relevant factors in accordance with case law principles, especially those outlined at paragraph 13 above.
27. There are notable factors that favour the Applicant's claim:
- the respective goods are identical (or at least highly similar) and case law allows that a great degree of similarity between goods may offset a lesser degree of similarity between the marks;
  - there is a greater likelihood of confusion where the earlier mark has a highly distinctive character and I have found the Applicant's mark to have, on an inherent basis, a high level of distinctiveness;
  - the average consumer (the public at large), will exercise a degree of attention between low and medium (certainly no higher than medium); and

- there is also some similarity between the marks, as I shall consider further below and there is no relevant conceptual dissimilarity.

28. The question is whether there is a likelihood of confusion amongst a significant proportion of the relevant public<sup>9</sup>; occasional confusion by a small minority is not sufficient to find a likelihood of confusion. The relative weight of the factors is not laid down by law, but is a matter of judgment for the tribunal on the particular facts of each case<sup>10</sup>. The legal test 'likely to cause confusion amongst the average consumer' is inherently imprecise, not least because the average consumer is not a real person; it involves a prediction as to how the public might react to the presence of two trade marks in ordinary use in trade and, it is often very difficult to make such prediction with confidence<sup>11</sup>.
29. Visual considerations will be particularly influential in the purchasing act and my primary finding is that the marks are visually similar only to a degree between low and medium. These are not complex or composite marks; they are single words and notwithstanding that the sequence of three letters that make the earlier mark feature too in the Applicant's four-letter mark, I do not believe that a significant proportion of the public will see the Applicant's mark in the Proprietors' mark. I have considered the notion of imperfect recollection, where the average consumer does not have the chance to make a direct comparison of the marks, but instead relies on the imperfect picture of them that they have kept in their mind. However, in my view, taking all of the relevant factors into account, including the overall impression of each word, the marks are not confusingly similar. Even allowing for imperfect recollection, and notwithstanding my findings on the level of attention and the distinctiveness of the earlier mark, I am satisfied that the differences between the marks are sufficient to rule out the likelihood of direct confusion on the part of the average consumer (deemed reasonably well informed and reasonably circumspect and observant). Visual selection will dominate in the purchasing process and the Proprietors' longer, four-letter mark, will not be mistaken for the three-letter mark of the Applicant, nor vice versa. (And aurally, the necessary hard G sound in the voicing of the Proprietors' mark creates an overall impression that will not be directly mistaken

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<sup>9</sup> Kitchin L.J. in *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation* [2016] EWCA Civ 41 at §34

<sup>10</sup> See paragraph 33 of the decision of Iain Purvis QC sitting as the Appointed Person in Case No. O-079-17, (*Rochester Trade Mark*).

<sup>11</sup> Again see comments of Iain Purvis as the Appointed Person, *ibid*.

for the Applicant's mark, notwithstanding that the marks share a degree of aural similarity between low and medium).

30. Indirect confusion, was considered by Mr Iain Purvis QC, sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*,<sup>12</sup> where he noted that the average consumer “taking account of the common element in the context of the later mark as a whole” may conclude that it is another brand of the owner of the earlier mark. However, no likelihood of confusion arises where a later mark merely calls to mind the earlier mark (mere association). As emphasised by James Mellor QC, sitting as the Appointed Person in *Eden Chocolat*<sup>13</sup>: “... it is important to stress that a finding of indirect confusion should not be made merely because the two marks share a common element.” As I do not consider that a significant proportion of consumers will perceive the Proprietors' mark as containing the Applicant's mark, I see no reason why use of the marks would result in indirect confusion. There is no obvious reason, such as a natural brand extension, that leads me to a finding of indirect confusion.

## **OUTCOME**

31. **There is no likelihood of confusion and the application for a declaration of invalidity fails. The Proprietors' trade mark remains registered intact.**

## **COSTS**

32. The Proprietors are entitled to a contribution towards their costs in defending their registration against the application for invalidity. The Proprietors are litigants in person (having no professional legal representation) and ahead of the hearing they had completed and filed a costs pro-forma which covered:
- (a) an outline of the time spent on the various tasks;
  - (b) legal fees paid in relation to initial correspondence between the parties;
  - (c) travel costs arising from attendance at the hearing.
33. Costs to a litigant in person are payable at £19 per hour in relation to the same categories of work and disbursements which would have been allowed had they been legally

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<sup>12</sup> Case BL-O/375/10

<sup>13</sup> Case BL O-547-17 *Duebros Limited v Heirler Cenovis GmbH* (27 October 2017) at paragraph 81.4.

represented. In relation to (b) in the paragraph above, while I accept the reality of the £1100 spent on legal representatives, such pre-action correspondence is not a category of work recoverable in proceedings before the trade mark tribunal<sup>14</sup>. Although the Proprietors also dedicated considerable time to gathering and filing evidence, I have explained that such material was not relevant for the matter to be decided; as such, it attracts no award in costs. In line with the information provided in the completed proforma, I consider the following to be reasonably recoverable by an individual unfamiliar with trade mark law and procedure, in relation to the tasks referenced at (a) in the paragraph above:

- Considering the cancellation application form, researching the law, considering and preparing a notice of defence: **12 hours**
- Preparation for and attendance at hearing: **10 hours**

TOTAL for tasks = 22 hours @ £19 per hour = **£418**

Plus, in relation to the costs of travel to the hearing referenced at (c) in the paragraph above: 540 miles @ 45 pence per mile = **£243**

TOTAL payable = £418 + £243 = **£661**

34. I therefore order Trompenburg Holdings B.V. to pay Angus and Sue Gaudie the sum of £661 (six hundred and sixty-one pounds) to be paid within 21 days of the expiry of the appeal period, or within 21 days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 28<sup>th</sup> day of February 2020**

**Matthew Williams**  
**For the Registrar**

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<sup>14</sup> See the guidance and annex of costs in the Tribunal practice notice (2/2016): Costs in proceedings before the Comptroller.