

**DECISION OF THE CONTROLLER OF PATENTS, DESIGNS AND TRADE MARKS
IN PROCEEDINGS UNDER THE TRADE MARKS ACT, 1996**

In the matter of an application for registration of Trade Mark No. 245957 and in the matter of an Opposition thereto.

RAZNECK LIMITED
(Represented by Denis I. Finn Solicitors)

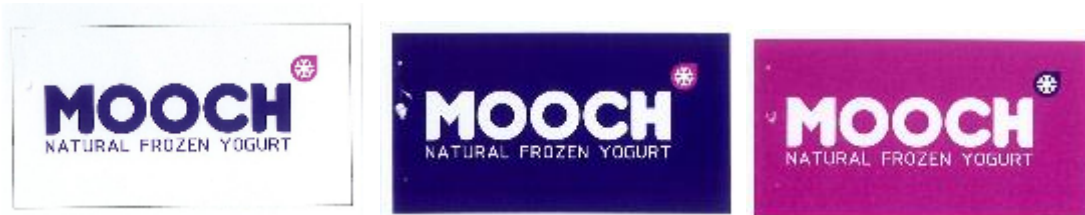
Applicant

DAIRYGLEN PRODUCTS LIMITED
(Represented by MacLachlan & Donaldson)

Opponent

The Application

1. On 14 July, 2011 (the “relevant date”) Razneck Limited, of Rossanagh, Rathnew, Co. Wicklow, Ireland made application (No. 2011/01278) under Section 37 of the Trade Marks Act, 1996 (“the Act”) to register these marks



as a series of three distinct trade marks in respect of the following goods and services:

Class 29:

Prepared meals consisting predominantly of soups; milk and milk products, milkshakes, milk drinks, milk based drinks containing fruit (milk predominating), non-alcoholic milkshakes (milk predominating) containing fruit juices, yoghurt, preparations for making yoghurt, dairy products; fruits all being preserved

Class 30:

Coffee, coffee drinks, tea, tea drinks, cocoa, chocolate drinks, bread, pastry, cakes, sweets and confectionery, ices; honey; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice; frozen yoghurt and frozen yoghurt based desserts combined with fruit and sauces

Class 43:

Services for providing food and drink; restaurant; milk bar; catering services; cafeteria


services; snack bar services; bar services; information services regarding the provision of food and drink; information services regarding catering, booking and reservation services for restaurants or milk bars; consultancy services associated with operating restaurants, cafes, cafeterias, coffee shops, bars, milk bars, restaurants, snack bars, catering or other establishments or facilities engaged in providing food or drinks

2. The application was accepted for registration and advertised accordingly under No. 245957 in Journal No. 2189 dated 9 November, 2011.
3. Notice of Opposition to the registration of the mark, pursuant to Section 43 of the Act, was filed on 6 February, 2012 by Dairyglen Products Limited, of Unit 6, Sounthern Cross Business Park, Boghall, Bray, Co. Wicklow, Ireland. The Applicant filed a counter-statement on 13 February, 2012. Evidence was then filed under Rules 20, 21 and 22 of the Trade Mark Rules, 1996 (“the Rules”). Both parties filed written submissions in lieu of attending at a hearing of the matter, with the Opponent alone filing written submissions in reply.
4. Acting for the Controller, I decided to uphold the opposition in respect “*confectionery; ices; frozen yoghurt and frozen yoghurt based desserts combined with fruit and sauces*” in Class 30, but to allow the application to proceed to registration in respect of all other goods and services. The parties were informed of my decision by way of letter dated 31 July, 2014. I now state the grounds of my decision and the materials used in arriving thereat in response to a request by both parties in that regard pursuant to Rule 27(2) of the Trade Mark Rules 1996.

Grounds of the Opposition

5. In its Notice of Opposition the Opponent identifies itself as manufacturers and merchants of ice cream, preparations for making ice cream, confectionery and related products. The Opponent attached to its Notice of Opposition details of the following 2 trade marks, which the Opponent states it has used in relation to the aforementioned products.

Trade Mark	Mark Details	Class, goods and services
SMOOCH	Irish trade mark no. 227689 registered as of 22 July 2003	Class 30: Ice cream, frozen confectionery, preparations in this class for making the aforesaid goods.

 <p>(SMOOCH logo)</p>	<p>Community trade mark no. 009390071 registered as of 21 September 2010</p>	<p>Class 29: Milk and drinks containing milk and/or milk products; milk shakes; milk shakes containing confectionery and/or other ingredients, the milk predominating; smoothies consisting predominately of yoghurt and/or milk; preparations for making milk shakes; ingredients for milk shakes; preparations and ingredients in class 29 for making smoothies; desserts in Class 29.</p> <p>Class 30: Ice cream; confectionery including frozen confectionery; frozen yoghurt; preparations for making ice cream, frozen confectionery and frozen yoghurt; smoothies consisting predominately of ice cream and/or frozen yoghurt; ingredients in class 30 for making smoothies; drinks containing chocolate, coffee and/or other ingredients, all being drinks in Class 30; desserts in Class 30.</p> <p>Class 43: Milk shake bars; ice cream parlours; cafes; establishments selling ice cream, milk shakes and/or smoothies.</p>
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The Opponent raises objection to the present application under various Sections of the Act, which I shall summarise as follows:

- Section 6(1) – *the marks are not capable of distinguishing goods or services of one undertaking from those of another;*
- Section 8(1)(b) – *the marks are devoid of any distinctive character;*
- Section 8(3)(b) – *the marks are of such a nature as to deceive the public;*
- Section 10(2)(b) – *likelihood of confusion on the part of the public, and likelihood of association with the Opponent’s trade marks;*
- Section 10(3) – *use of marks would take unfair advantage of, or be detrimental to, distinctive character or reputation of the Opponent’s marks;*
- Section 10(4)(a) - *use of marks is liable to be prevented by virtue of any rule of law protecting an unregistered trade mark or other sign.*

Counter-Statement

6. In its Counter-Statement the Applicant denies all the claims made by the Opponent in the Notice of Opposition. The Applicant pleads the Opponent only became the proprietor of the trade mark SMOOCH pursuant to a deed of Assignment dated 7 October 2011 (i.e. after the relevant date).

7. The Applicant states it is the proprietor of Community Trade Mark Registration No. 008774127 in respect of MOOCH, with a date of registration of 5 July 2010 (i.e. before the date of registration of the Opponent's Community Trade Mark), for "*Services for providing food and drink; restaurant; milk bar; catering services; cafeteria services; snack bar services; bar services; information services regarding the provision of food and drink; information services regarding catering, booking and reservation services for restaurants or milk bars; consultancy services associated with operating restaurants, cafes, cafeterias, coffee shops, bars, milk bars, restaurants, snack bars, catering or other establishment or facilities engaged in providing food or drinks*" in Class 43.

Rule 20 Evidence

8. Evidence submitted by the Opponent under Rule 20 consisted of a Statutory Declaration, dated 2 November, 2012 of Philip Delaney, Managing Director of Dairyglen Products Limited and 4 accompanying exhibits marked "PD1" to "PD4".

9. Mr. Delaney states the business currently conducted by his Company is centred on, what was then a new machine for dispensing ice cream and related products, which was invented and patented by a Mr. John Levins. The application for the patent was lodged in the Patents Office on 30 October 2003. Subsequent to that filing an application was made for a European patent to the European Patent Office. He attaches at Exhibit "PD1" details of the European patent specification as published by that office.

10. Mr. Delaney provides details of the history of the trade mark SMOOCH and the various entities that owned or used the mark prior to his Company becoming successor in title to the mark by way of an assignment recorded in this office on 7 October, 2011. He attaches at Exhibit "PD2" promotional material used by Eaglecroft (a predecessor in title to the

Applicant), trading as Smooch Ireland. At Exhibit “PD3” he attaches sample material used by the Applicant to promote its mark.

11. He says the mark has been used continuously and extensively in the State since 2003. His Company has established outlets for its ice cream products in more than 180 locations throughout the State and he names 22 counties where his Company’s products are sold. Turnover at retail level in ice cream and related products over the 6-year period 2006-2011 amounted to over €9 million with over €125,000 spent on advertising and promotion of the brand during the same period.
12. Mr. Delaney provides samples of his Company’s promotion of its SMOOCH trade mark at Exhibit “PD4”, which contains copies of an advertisement placed in the March/April 2010 edition of Forecourt & Convenience Retailer magazine, an article published in the Sunday Tribune in May 2010 and an undated article in the Sunday Business post.

Rule 21 Evidence

13. Evidence submitted by the Applicant under Rule 21 consists of a Statutory Declaration, dated 1 May, 2013 of Declan Clarke, Managing Director of Raznek Limited, and 12 exhibits marked “DC1” to “DC12”.
14. Mr. Clarke states the Applicant’s business was developed in February 2009, the concept being to create a distinct and original frozen yoghurt franchise throughout Ireland. The name MOOCH came about when, during a get-together of the Directors of the company and a group of friends, one of them suggested they go into town for a “mooch around”. It was decided thereafter that MOOCH was the appropriate name for the brand.
15. Following this an application for a Community Trade Mark was filed in December 2009 for goods and services in Classes 29, 30, 32 and 43. Following opposition proceedings that application proceeded to registration in respect of Class 43 alone. Evidence associated with the application for the Community Trade Mark was attached at Exhibit “DC1”.
16. Mr. Clarke states, that in October 2009, the Applicant spent over €5,500, exclusive of VAT, on the design of the logo, and attaches at Exhibits “DC2” and “DC3” materials relating to the design. He says that, in and around the same time, in the course of his Company’s due diligence, he became aware that a company named Fusion owned the trade mark “Smooch”.

Having carefully considered this the Directors of the Applicant were satisfied the names were sufficiently distinctive and different that there would not be any confusion in the market. The Directors considered the marks were visually, aurally and conceptually different and that the respective products of the two companies were distinct. Having received accounting advice the Applicant incorporated its business and applied for a business name for MOOCH in October 2010. The Certification of Registration of the business name was attached at Exhibit “DC4”.

17. He says the MOOCH flagship standalone store, in Blanchardstown Shopping Centre in Dublin, began trading in August 2011 and he attaches at Exhibit “DC5” invoices in respect of the design and layout of the store, as well as images depicting the store. He states that between August 2011 and December 2012 turnover exceeded €236,000.
18. As well as the store his Company also purchased a mobile unit which attends festivals and he attaches at Exhibit “DC6” images of the mobile unit and an invoice in respect of the branding of the unit. Exhibit “DC7” consists of an image of the Blanchardstown store decorated in the national colours for St. Patrick’s Day. At Exhibit “DC8” Mr. Clarke attaches images of yoghurt cups branded with his Company’s MOOCH Natural Frozen Yoghurt trade mark and invoices relating to the purchase of MOOCH cups, napkins and the like. At Exhibit “DC9” he attaches images of staff wearing MOOCH branded t-shirts and an invoice in respect of the purchase of the garments.
19. The remaining evidence consists of an invoice in respect of advertisements (Exhibits “DC10” and “DC11”) and extracts from The Oxford Dictionary (Exhibit “DC12”) defining what the words MOOCH and SMOOCH mean.
20. Mr. Clarke states his company’s core business is frozen yoghurt which is different to ice-cream. The main difference being in respect of the health benefits of frozen yoghurt. He says that frozen yoghurt and ice-cream have different consumers and have physical differences in texture and taste.
21. He states that Lola the Cow appears on all literature and branding to do with the Opponent’s SMOOCH mark. Lola the Cow is a very strong element of the Opponent’s mark and it is unlikely that consumers would be confused by the respective marks. Furthermore, no evidence of any confusion has been advanced by the Opponent.

22. He also states that were the opposition to be upheld it would have a devastating impact on the Applicant's business. He finishes by emphasising that the claimed long association between the Opponent and its SMOOCH trade mark only dates back to 13 September, 2011 (after the relevant date for these proceedings) and that on that date the Opponent was fully aware of the Applicant's Community Trade Mark, having written to the Applicant's solicitors on 20 July, 2011.

Rule 22 Evidence

23. Evidence submitted by the Opponent in reply to the Applicant's Rule 21 evidence consists of a second Statutory Declaration, dated 30 September, 2013 of Philip Delaney and a single exhibit labelled "PD5". Mr. Delaney notes that while Mr. Clarke stated in his declaration that the Applicant's core business is frozen yoghurt, which he claims is different to ice-cream, the application at issue covers a wide range of goods in Classes 29 and 30, including ice-cream. Mr. Delaney states that, contrary to what Mr. Clarke suggests, frozen yoghurt and ice-cream are in competition with one another.

24. In reply to Mr. Clarke's statement regarding the devastating effect the loss of the MOOCH trade mark would have on the Applicant's business, Mr. Delaney states that, as a longer-established company with ten times the turnover of the Applicant, should the opposition be rejected it would do very serious damage to Dairyglen.

25. He points out that his Company's Irish Trade Mark Registration No. 227689 is not limited to ice-cream but is also in respect of frozen confection, which includes frozen yoghurt. Also his Company's Community Trade Mark Registration No. 9390071 includes frozen yoghurt.

26. He attaches at Exhibit "PD5" a letter dated 3 June, 2013 from Brian Sweeney of The People Group (a sales and marketing recruitment specialist), wherein it mentions that certain candidates were confused between the Opponent's brand SMOOCH and the Applicant's brand MOOCH during the selection process for the role of Marketing Manager with the Opponent. Also attached as part of the exhibit is an e-mail, dated 12 September 2013, from a Clara Woolhead (a friend of a staff member of the Opponent) addressed to Philip Delaney with the salutation "*To whom it may concern*" and claiming that when she encountered the Applicant's MOOCH trade mark she thought it was the SMOOCH brand for whom her friend worked and that, as such, she was definitely confused.

Written Submissions

- 27. Both parties elected to file written submissions in lieu of attending at a Hearing, with the Opponent furnishing written submissions in reply to the Applicant’s submissions.

- 28. The Opponent’s submissions provide a summary of the background to these proceedings, an analysis of the evidence, a comparison of the marks and their respective goods and services, and an assessment of the likelihood of confusion. The Opponent argues that, due to the high degree of similarity between the marks and the identity or highly similar nature of the respective goods and services, it is inevitable that confusion would arise in the minds of consumers.

- 29. In its submissions the applicant also provides a summary of the background to the proceedings, a comparison of the marks, arguments highlighting what the Applicant views as deficiencies in the Opponent’s evidence and extensive references to the legal principles which should be applied. Not surprisingly, the Applicant reaches different conclusions in its assessment of a likelihood of confusion arising between the respective marks.

- 30. The Opponent lodged a detailed submission in reply to the Applicant’s submissions, wherein it countered many of the arguments made by the Applicant. I will address the respective positions below.

- 31. Turning now to the individual grounds of opposition and starting with Section 6(1) (*the mark is not capable of distinguishing goods or services of one undertaking from those of another*), Section 8(1)(b) (*the mark is devoid of any distinctive character*) and Section 8(3)(b) (*the mark is of such a nature as to deceive the public*). No evidence was submitted or arguments advanced as to why the application should be refused on any of these three grounds. Therefore, without further ado, I dismiss the opposition on these grounds.

Section 10(2)(b)

32. The relevant part of Section 10(2) of the Act, insofar as the present application is concerned, reads as follows:

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

(b) it is similar to an earlier trade mark and would 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 of the later trade mark with the earlier trade mark.

33. As is evident from the wording of Section 10(2), the four basic requirements that must be met in order for an objection under it to succeed are that, (i) there must be “an earlier trade mark”, (ii) the mark applied for must be similar to that earlier trade mark, (iii) the goods/services of the application must be identical with or similar to those in respect of which the earlier trade mark is protected, and, (iv) there must be a resultant likelihood of confusion on the part of the public.

34. The first requirement is met as the Opponent’s Irish trade mark no. 227689 has a registration date of 22 July 2003 and its Community Trade Mark no. 009390071 was registered as of 21 September 2010, both dates being prior to application date of the disputed mark (14 April, 2011) and by virtue of Section 11(1)(b) of the Act, are earlier trade marks for the purposes of Section 10.

Comparison between the Applicant’s marks and the Opponent’s SMOOCH logo mark

35. I have compared the respective marks of the parties on the criteria of visual, aural and conceptual similarity and have attempted to make an overall assessment of the extent to which they should be regarded as similar or different. I stress that this is an assessment of the overall impression the marks make on me, having put myself in the shoes of the average consumer of the goods and services for which the Applicant is seeking protection. In conducting the comparison I am mindful that I must bear in mind that, according to the European Court of Justice in *Sabel BV v Puma AG and Rudolf Dassler Sport*¹, the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. For this reason, the appreciation of the visual, aural and conceptual similarity of the marks must be based on the overall impressions given by them, rather than on specific points of detail that are likely to go unnoticed by the average consumer.

¹ *Sabel BV v Puma AG and Rudolf Dassler Sport (Case C-251/95 at Paragraph 23 of decision dated 11 November, 1997*

36. As well as MOOCH the Opponent's trade marks also contain the words "Natural Frozen Yoghurt" which is descriptive of many of the goods traded under the Applicant's mark. These words have no distinctiveness in relation to certain of goods for which the Applicant seeks registration and will be disregarded by consumers when seen on frozen yoghurt and similar goods. Therefore, in terms of comparing the respective goods in order to assess any likelihood of confusion I must ignore the term "Natural Frozen Yoghurt" for any goods that are apt to be described by that term. While the term "Natural Frozen Yoghurt" does have distinctiveness in relation to some goods and services, I have allowed the application to proceed to registration in respect of all of these. So, in order not to confuse matters by sometimes referring to the Applicant's mark as "MOOCH" and other times as "MOOCH NATURAL FROZEN YOGHURT", from here on I will refer to the Applicant's mark as simply MOOCH.
37. A likelihood of confusion should not be inferred from the inclusion in the Applicant's trade mark of elements that are also descriptive of the goods in question as such a finding would serve to bestow on the Opponent an unjustified monopoly in relation to such descriptive terms.
38. In the instant case the Opponent relies upon two earlier marks, one being the plain-text, single-word mark SMOOCH, the other a more complex mark containing figurative and colour elements with text in two colours. Each of the Opponent's marks is registered in respect of different specifications of goods and services. Looking first at the Opponent's SMOOCH logo mark, I find there is some visual similarity between the respective marks, but this is restricted to the word elements SMOOCH and MOOCH. However, it will not go unnoticed by the average consumer that the "MOO" part of the word SMOOCH is emphasised in bold lettering and stands out from the other letters. There are other and more substantial differences between the Applicant's MOOCH NATURAL FROZEN YOGHURT marks. Most notably, the depiction of the animated character 'Lola the Cow' is not to be found in the Applicant's marks. The emphasis of the "MOO" in SMOOCH creates the visual impression that Lola the Cow is mooing amorously as she conspicuously radiates love and affection towards the viewer. The inclusion of love-hearts floating skywards reinforces that image. Visually, in my opinion, the Opponent's SMOOCH logo mark shares a very low level of similarity with the Applicant's marks.

39. Aurally the marks share a high level of similarity. The Applicant's mark is wholly contained within the Opponent's mark and in pronouncing them, I find, they sound very similar. However, I find the marks to be completely different from a conceptual perspective. The word SMOOCH, while slang, has only one meaning – kissing and cuddling. The Opponent's mark conveys the message of a lovey-dovey female cow, whereas the concept behind the Applicant's MOOCH mark will be understood to be a slang word that would convey different meanings to different people. I have heard it used in respect of strolling around town or the shops to see what's on offer, looking in the fridge to see if there is something appetising to eat, stealing, begging, loitering or sponging (cigarettes for example). No matter what the average consumer understands MOOCH to mean it will have nothing to do with a kissing and cuddling cow.
40. I would assess the overall level of similarity between the Applicant's mark and the Opponent's SMOOCH logo mark as very low. However, much of the respective goods and services are identical or at least very similar. In that respect I must be mindful that, the Court of Justice of the European Union has ruled, a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa². It is also settled case law, in *Sabel BV v. Puma AG*³, that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. In *Sabel* the court also ruled 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. Bearing in mind the perception of the average consumer and having undertaken the necessary assessment I am satisfied the marks share such an overall low level of similarity that I consider them to be very different.
41. In *Canon*⁴ the Court of Justice of the European Union (CJEU) ruled the global assessment of the likelihood of confusion implies some interdependence between the relevant factors, and in particular a similarity between the trade marks and between the goods or services. Accordingly, the court found 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. I have not conducted an in-depth assessment of the similarity between the respective goods and services, but even on cursory inspection there is clearly a high degree of identity in respect

² *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, (Case C-39/97 at paragraph 17)

³ *Sabel BV v. Puma AG, Rudolf Dassler Sport* (C-251/95 at paragraph 23)

⁴ *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, (Case C-39/97 paragraph 17)

of some goods and services and similarity with respect to others. However, in this case I find the differences between the Opponent's SMOOCH logo mark and the Applicant's marks are so striking and obvious they cannot be off-set by the level of identity and similarity that exists between the respective goods and services. I am satisfied that consumers would not be confused or believe the marks emanate from economically-linked undertakings. I find there is no likelihood of confusion between the Applicant's marks and the Opponent's SMOOCH logo mark, and therefore I must reject the opposition grounded on Section 10(2)(b) of the Act.

Comparison between the Applicant's marks and the Opponent's SMOOCH word mark

42. Turning now to the comparison between the disputed marks and the Opponent's word only mark SMOOCH. In defence of its application the Applicant focuses predominantly on the difference between its mark and the Opponent's SMOOCH logo mark. This is not surprising given the evidence furnished by the Opponent in respect of its use of its marks is dominated by the Opponent's SMOOCH logo mark. However, I must adjudicate between the disputed marks and the marks relied upon by the Opponent in terms of their construct as they appear on the Register and not whether or not the Opponent uses its marks in an altered state.

43. As already stated I find there is a high degree of aural similarity between the words MOOCH and SMOOCH. When I speak each word I find the shared element MOOCH is clearly audible in both and is the dominant sound. The addition of the "S", albeit at the start of the Opponent's mark, does not, in my opinion, create a particularly striking aural difference between the respective marks. Visually the whole of the word MOOCH is contained within the Opponent's mark. In the Applicant's marks MOOCH is not in standard black type and is framed within a solid rectangle of a colour different to the colour of the text. The Applicant's marks also contain a very small (in relational to the size of the other elements of the marks) snowflake, which is likely to go unnoticed but which very observant viewers may understand to be a symbol used in relation to frozen products. The mix of colours, the geometric shape of the mark and the snowflake are not, in my opinion, particularly distinctive. The only visual difference between the respective word elements is the single letter "S". Notwithstanding these differences, in my opinion, it is the word MOOCH that dominates the Applicant's marks and bestows upon them a degree of distinctiveness. As regards the overall visual comparison I find the marks share a medium level of visual similarity.

44. I have already found the words MOOCH and SMOOCH are conceptually different. Having completed my aural, visual and conceptual comparison of the respective marks I find they share an overall medium degree of similarity.

Comparison of the goods and services

45. The Opponent is the proprietor of the mark SMOOCH simpliciter in respect of “*Ice cream, frozen confectionery, preparations in this class for making the aforesaid goods*”. The Applicant has applied for its marks in respect of various goods and services in Classes 29, 30 and 43. Firstly, looking at the services in Class 43, namely, “*services for providing food and drink; restaurant; milk bar; catering services; cafeteria services; snack bar services; bar services; information services regarding the provision of food and drink; information services regarding catering, booking and reservation services for restaurants or milk bars; consultancy services associated with operating restaurants, cafes, cafeterias, coffee shops, bars, milk bars, restaurants, snack bars, catering or other establishments or facilities engaged in providing food or drinks*”. I am satisfied the provision of information, consultancy and booking services in relation to the provision of food and drink are not in any way similar to the goods for which the Opponent’s marks are registered.

46. The remainder of services in Class 43 are in respect of the provision of food and drink in a variety of outlets. There are ample decisions of the courts that deal with the question of whether goods are similar or dissimilar to retail services of the same goods. In Oakley⁵, which concerned, on the one hand the mark “THE O STORE” in respect of retail services for identified goods, and on the other, specific goods bearing the mark “O STORE” the Court found the following:

“54. Clearly, in the present case, the relationship between the retail services and the goods covered by the earlier trade mark is close in the sense that the goods are indispensable to or at the very least, important for the provision of those services, which are specifically provided when those goods are sold. As the Court held in paragraph 34 of Praktiker Bau- und Heimwerkermärkte, paragraph 17 above, the objective of retail trade is the sale of goods to consumers, the Court having also pointed out that that trade includes, in addition to the legal sales transaction, all activity carried out by the trader for the purpose of encouraging the conclusion of such a transaction. Such services, which are provided with the aim of selling certain specific goods, would make no sense without the goods.”

⁵ Oakley Inc. v. Office for Harmonisation in the Internal Market (CFI Case T-116/06),

55. Furthermore, the relationship between the goods covered by the earlier trade mark and the services provided in connection with retail trade in respect of goods identical to those covered by the earlier trade mark is also characterised by the fact that those services play, from the point of view of the relevant consumer, an important role when he comes to buy the goods offered for sale.

56. It follows that, because the services provided in connection with retail trade, which concern, as in the present case, goods identical to those covered by the earlier mark, are closely connected to those goods, the relationship between those services and those goods is complementary within the meaning of paragraphs 54 and 55 above. Those services cannot therefore be regarded, as the applicant claims, as being auxiliary or ancillary to the goods in question.

47. Therefore, goods may be considered similar to retail services for the goods in question.

However, in the instant case the services for which the Applicant seeks registration in Class 43 are not retail services *per se* (which are proper to Class 35), but restaurant services and the like. In my opinion this is an important difference. Each of restaurant-type services the Applicant has applied for serve a multitude of different types of food and drink. While most providers of food and drink serve or sell ice-cream and frozen desserts, in my opinion, most ice-creams and frozen desserts are not sold in restaurants and the like, but in retail outlets such as supermarkets, convenience stores, newsagents or kiosks. While no doubt there is a link between providers of food and drink services and ice-cream and frozen confectionary goods, I would not go as far as to say that the link is sufficient to such a degree that it would be a significant factor in the context of assessing a likelihood of confusion between the goods bearing the Opponent's mark and the services delivered under the Applicant's marks. I find the level of similarity between the Applicant's services in Class 43 and the Opponent's goods to be low. I note the Applicant has not sought registration for ice-cream parlours, which specialise in and predominantly sell ice-creams and the like, and which I may have assessed somewhat differently.

48. So, in terms of the services for which the Applicant seeks registration in Class 43, I find there is a very low level of similarity between the goods for which the Opponent's MOOCH word mark is registered and the Applicant's services related to the provision of food and drink, with no similarity at all between the goods and the other services in Class 43 relating to the provision of information, booking or consultancy services. Having reached these conclusions regarding the similarity of the respective goods and services, and having found there is a medium level of similarity between the respective marks, I am satisfied that there

is no real likelihood that consumers, having been exposed to the Opponent's mark in respect of ice-cream, frozen confectionery or preparations for making either, would, on encountering the Applicant's mark, in respect of any of the services in Class 43, be confused or believe the two marks were economically linked. Accordingly I reject the opposition in respect of Section 10(2)(b) in terms of the services in Class 43.

49. Turning now to the Applicant's goods in Class 29, namely "*prepared meals consisting predominantly of soups, milk and milk products, milkshakes, milk drinks, drink flavoured with fruit bases and having a milk base, milk based drinks containing fruit (milk predominating), fruit juices, yoghurt, preparations for making yoghurt, dairy products, fruits, all being preserved, all included in Class 29*". I am satisfied that, other than milkshakes and yoghurt, none of the other goods are similar to the goods in Class 30 for which the Opponent's mark is registered. Conceivably anything edible in Class 29 could be regarded as a preparation for making yogurt and likewise anything edible in Class 30 could be used for making ice-cream and frozen confectionery. Without a more defined description of each of these classes of goods it is difficult to declare whether or not they share any similarity. I must judge the similarity between the specified goods, not whether the finished goods of the Applicant and Opponent share common ingredients. For instance, while milk is used as a preparation for both ice-cream and yoghurt, milk is only in Class 29. So therefore, for the purposes of these proceedings, it cannot be considered a preparation common to both specifications. On the basis that there is very low level of cross-over between ingredients listed in Class 29 and ingredients listed in Class 30, I must conclude that preparations in Class 30 for making ice-cream and frozen confectionery share a very low level of similarity with preparations in Class 29 for making yoghurt.

50. In terms of the Applicant's goods in Class 29 that leaves milkshakes and yogurt. In my opinion these goods share a medium level of similarity to the Opponent's ice-cream. I will return to the similarity between these goods in my determination of a likelihood of confusion.

51. Finally, as regards the comparison between the respective goods and service, I turn to Class 30. I am happy that there is no similarity between coffee, coffee drinks, tea, tea drinks, cocoa, chocolate drinks, bread, pastry, cakes, sweets, honey, yeast, baking-powder, salt, mustard, vinegar, sauces (condiments), spices and ice, and the Opponent's ice-cream, frozen

confectionery and preparations for making same. That leaves confectionery, ices, frozen yoghurt and frozen yoghurt based desserts combined with fruit and sauces.

52. The Applicant argued that its frozen yoghurt is considerably different to the Opponent's ice-cream, the principle difference being in relation to the health benefits of frozen yoghurt, because of the lower fat content and the presence of probiotics that boost the immune system. The Applicant also argued that ice-cream and frozen yoghurt attract different types of consumers. However, these proceedings are not limited to the comparison between ice-cream and frozen yoghurt. My determination must be made in respect of the goods and services for which the Opponent's mark stands protected and cannot be restricted to a comparison between the goods and services for which the Applicant and the Opponent primarily use, or intend to use, their marks.

53. In that regard I am satisfied that ices are identical to ice-cream. Frozen confectionery products are a sub-category of confectionery and these must be considered identical also. Frozen yoghurt, unlike yoghurt which is proper to Class 29, is proper to Class 30 because it is classified as a frozen confectionery (in the international Nice Classification). Therefore frozen yoghurt must be considered identical to frozen confectionery. For the same reason frozen yoghurt based desserts, combined with fruit and sauces, must also be considered identical to frozen confectionery.

54. The question is whether the level of identity and similarity that exists is sufficient to come within the meaning of Section 10(2)(b) of the Act? The criteria against which that assessment should be made have been enunciated in a number of decisions of the European Court of Justice⁶ in this area and they include the following:

- a. A lesser degree of similarity between the goods may be offset by a greater degree of similarity between the marks, and vice versa,
- b. The more distinctive the earlier mark, the greater will be the likelihood of confusion,
- c. In determining the distinctive character of the earlier mark, it is necessary to make an overall assessment of its capacity to identify the goods for which it is registered as

⁶ Sabel BV –v- Puma AG and Rudolph Dassler Sport (Case C-251/95) [1998] 1 CMLR 445; Canon Kabushiki Kaisha –v- Metro-Goldwyn-Mayer Inc. (Case C-39/97) [1999] 1 CMLR 77; Lloyd Schuhfabrik Meyer & Co. GmbH –v- Klijsen Handel BV (Case C-342/97) [1999] 2 CMLR 1343

coming from a particular undertaking and thus to distinguish those goods from those of other undertakings,

- d. In making that assessment, account should be taken of the inherent characteristics of the mark; the market share held by it; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested in its promotion; the proportion of the relevant public which, because of the mark, identifies the goods as originating from a particular undertaking; and statements from chambers of commerce and industry and other trade and professional associations,
- e. A global appreciation of the likelihood of confusion must, as regards the visual, aural and conceptual similarity of the marks in question, be based on the overall impression created by them, and the importance to be attached to each of those elements must take account of the category of goods and the way in which they are marketed,
- f. The assessment must be made from the perspective of the average consumer who is deemed to be reasonably well-informed, observant and circumspect but who rarely has the chance to make a direct comparison of the marks and must rely on the imperfect picture that he has of them in his mind,
- g. The likelihood of confusion must be appreciated globally, taking into account all of the factors relevant to the circumstances of the case.

55. In applying those criteria to the facts of the present case, I find the Opponent's SMOOCH mark has an average degree of inherent distinctiveness. The Opponent's mark has been used since 2003 in connection with ice-cream in more than 180 locations in the State, generating retail turnover of around €1.5 million per annum in recent years. Use of the term "retail turnover" casts doubt over whether the figure quoted was the Opponent's income in respect of ice-cream, as the evidence suggests the Opponent trades at wholesale level. There is the possibility the term may have been used to inflate the Opponent's actual revenue figures. In its own evidence the Opponent provided brochures that claim a "*whooping 70-80% profit margin*" for the retailer. This would indicate that the actual annual revenue generated by the Opponent is more likely to be around €1 million. In any event, in my opinion, in terms of the overall ice-cream market in Ireland either figure does not indicate a significant market share, but, nonetheless, I am satisfied the mark has acquired additional distinctiveness through the use made of it. Such use has also earned the Opponent some degree of reputation for its SMOOCH trade mark in the State. Ice-cream and frozen confectionery products are purchased by the public generally and it is the likely perception of the average member of

the public that I shall consider. For the reasons set out above, I regard the marks in question as having a medium level of similarity. However, some of the goods for which the disputed mark seeks registration are identical or similar to the goods of the Opponent's earlier registration.

Overall assessment of likelihood of confusion:

56. In light of the foregoing factors, I am required to make an overall assessment of the likelihood of confusion that may exist between the Opponent's earlier SMOOCH word mark and the Applicant's MOOCH marks. The confusion in question may be direct confusion, whereby the Applicant's services are mistaken for those of the Opponent, or indirect confusion, whereby the Applicant's services are associated in the mind of the consumer with that of the Opponent and a common commercial origin is inferred. I must look at the question of likelihood of confusion from a practical perspective in the context of the marketplace and put myself in the shoes of the average consumer. In that regard I must judge the matter of the assessment of likelihood of confusion in accordance with ECJ guidance to decision-makers, which can, for the purpose of these proceedings, be summarised as follows: *Imagine a typical purchasing scenario involving the average person who already knows products sold under the earlier trade mark and ask yourself whether it is likely that, on encountering the Applicant's mark when shopping, he will purchase the Applicant's goods in the mistaken belief that the goods are being provided by the undertaking he knows by the earlier mark (direct confusion) or that the goods are linked economically to the undertaking he identifies by the earlier mark (indirect confusion by association).*

57. It is not necessary to find that every consumer would be confused and nor is it sufficient to find that some consumers might be confused in order to refuse registration of a trade mark under the section. The question is whether it is likely or unlikely that the average person would be confused in the course of the typical purchasing scenario.

58. I have already decided that MOOCH and SMOOCH share a medium level of similarity and that milkshakes and yoghurt are similar to ice-cream and frozen yoghurt to an average extent. Yoghurts and milkshakes are low value goods and consumers would not be inclined to pay much attention before purchasing either item. However the goods covered by the Opponent's SMOOCH mark are all stored in the freezer section of the retail outlet, whereas

yoghurts and milkshakes are stored in the cooler section. This means the respective goods are not to be found side-by-side in the retail outlet. This may be a subtle difference but nonetheless it is a factor in the overall assessment of a likelihood of confusion. On balance, I find there is no likelihood of confusion between the Opponent's SMOOCH trade mark for ice-creams and frozen confectionery and the Applicant's trade mark MOOCH when used on milkshakes and yoghurt.

59. Finally, as regards Section 10(2)(b) I turn to *confectionery; ices; frozen yoghurt and frozen yoghurt based desserts combined with fruit and sauces*". The Applicant believes its frozen yoghurt is substantially different to the Opponent's ice-cream. While frozen yoghurt may be considered a healthier option, both are dairy-based frozen desserts, often with the same ingredients. The Applicant may use nothing but, what are considered, healthy ingredients in its formula, but frozen yoghurts can contain syrups, sugar, chocolate, candy and the like, just like ice-creams and other frozen confectionery. Also, there are low-fat (or more realistically lower-fat) ice-creams on the market. The Applicant has not applied to use its mark on low-fat yoghurt alone and nor is the Opponent's mark registered for ice-cream alone. While some consumers may go for the perceived healthier option, there is no getting away from the obvious competition that exists between these goods. I find "*confectionery; ices; frozen yoghurt and frozen yoghurt based desserts combined with fruit and sauces*" are identical to ice-cream and frozen confectionery. The Applicant's MOOCH trade mark shares an overall medium level of similarity with the Opponent's trade mark SMOOCH, but, in my opinion, the level of similarity may be considered even greater when the typical purchasing scenario is taken into account.

60. The goods are also low-value items and the average consumer will not pay much attention before making a purchase. The respective goods are often purchased on impulse, when the consumer decides she fancies an ice-cream or similar product. There are two typical purchasing scenarios associated with the respective goods (a) the goods will be stored side-by-side in the freezer section of retail outlets and can be selected by the consumer without assistance, or (b) the goods will be supplied by a retail-assistant who will retrieve or prepare the product from behind a counter. In these scenarios the role played by the visual and verbal characteristics of the marks are far more important than that played by their conceptual meaning. Also, the likelihood of imperfect recollection is more probable when low-cost

everyday items are being purchased in the typical scenario that is associated with the goods at issue.

61. In its evidence and written submissions the Applicant claims there is no likelihood of confusion between the respective marks in relation to these particular goods. The Applicant admits that, during its due diligence, it became aware of the Opponent's mark and the ice-cream upon which it is used. The Directors of the Applicant considered whether there was similarity between the marks and the respective goods, and concluded that whatever differences existed they were sufficient to prevent any possibility of confusion in the marketplace. I commend the Applicant for performing searches to identify existing and possible conflicting marks prior to lodging its application, which should always be done as best practice. But, in my opinion, the Applicant erred in reaching the conclusions it did.
62. The Applicant also argues that, during the examination of the application, this Office came to share the view, that no confusion was likely. The Office had raised objections to the application based on the Opponent's earlier SMOOCH trade mark, but waived them because the Trade Mark Examiner was persuaded by the Applicant's arguments that confusion was unlikely.
63. The Opponent takes up this point and argues that the objections to the application raised by this Office reinforces, rather than detracts from, the Opponent's contention there would be confusion in the marketplace; because it is clear the first impression of the Examiner was that the trade marks MOOCH and SMOOCH were confusingly similar.
64. It is important to point out that trade mark examinations are conducted solely between the Applicant and the Office and that the Office is not aware of, nor seeks, the position of the proprietor of any earlier marks cited in any objections. The Examiner must make a decision based solely on the arguments advanced by the Applicant. If the Examiner believes it's a knife-edge case, s/he may be prepared to be persuaded sufficiently enough to allow the application to limp over the line. In such cases, in accepting the mark for publication, the Examiner will be conscious a safety net exists and that the proprietors of any marks cited during the examination of the application will have the opportunity to lodge an opposition. Having been aware of the Opponent's SMOOCH mark in connection with ice-cream and frozen confectionery and having been notified that the Office's initial impression was that

the respective marks were confusingly similar, the Applicant should not have been surprised the Opponent initiated opposition proceedings.

65. The Applicant contends that there has not been any confusion between the respective marks, while the Opponent claims confusion has arisen. I do not put much store in the evidence of confusion adduced by the Opponent as neither the letter from Brian Sweeney nor the e-mail from Clara Woolhead have been sworn into evidence by the writers themselves. Also, the letter from Brian Sweeney is clearly a response to solicitations made by the Opponent, while, in her e-mail, Clara Woolhead identifies herself as a friend of a former employee of the Opponent. As such, neither document can be considered independent evidence or to possess any probative value.

66. That does not mean confusion is unlikely. The relative date for these proceedings is the 14 April 2011 and by that date the Opponent had made extensive use of its trade mark SMOOCH, whereas the Applicant did not commence use of its MOOCH mark until August 2011. I must consider the typical purchasing scenario of the goods at issue (those listed in the specifications, not the actual goods sold under the respective marks) and decide if a consumer, on encountering the Applicant's mark on 14 April, 2011, having knowledge of the earlier mark in respect of the goods at issue would be likely to be confused.

67. I am satisfied that if both marks were used in a fair and normal way in the marketplace there is a likelihood that consumers, who are familiar with the Opponent's goods bearing the trade mark SMOOCH, would be confused if they encountered the Applicant's MOOCH trade mark on identical goods. Accordingly, I must refuse the application in respect of "*confectionery; ices; frozen yoghurt and frozen yoghurt based desserts combined with fruit and sauces*" in class 30, because it offends against Section 10(2)(b) of the Act.

Section 10(3) – take unfair advantage of, or be detrimental to, the Opponent's mark

68. Section 10(3) of the Act provides as follows:

"A trade mark which –

(c) is identical with or similar to an earlier trade mark, and

(d) is to be registered for goods or services which are not similar to those for which the earlier trade mark is protected,

shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the State (or, in the case of a Community trade mark, in the Community) and the use of the later trade mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or reputation of the earlier trade mark.

69. The purpose and effect of that provision is to afford an extra level of protection to marks that have a reputation over and above that which is given to other trade marks. As is evident from the wording of the Section, there are a number of conditions that must be fulfilled in order for it to apply. Firstly, there must be identity or similarity of the marks at issue; secondly, there must be a dissimilarity between the respective goods⁷; thirdly, the earlier mark (or marks, as in this case) must have a reputation in the State; fourthly, the use of the later trade mark must be without due cause; and fifthly, that use must take unfair advantage of, or be detrimental to, the distinctive character or reputation of the earlier marks.

70. I have already found that the first three conditions have been met – there is a level of similarity with the Opponent’s marks, there is the required dissimilarity (extended to include similarity following the CJEU decision) in respect of certain of the goods applied for and that the Opponent’s mark enjoys some reputation in the State. However, is that reputation entitled to protection under the Paris Convention as a well-known trade mark and does it enjoy the type of reputation that Section 10(3) seeks to protect? Such a reputation would be expected to extend beyond the limited class of consumers of the Opponent’s goods and to penetrate the consciousness of the wider public such that a substantial number of people would know and recognise the mark even if they had never used the Opponent’s goods. The Opponent gave evidence that its goods were sold in over 180 shops across 22 counties that resulted in turnover of approximately €1.5 million per annum. In my opinion these figures are not very substantial in terms of the number of stores selling the goods at issue or in terms of the overall turnover for these goods in Ireland. While the Opponent has earned some reputation for its trade mark SMOOCH, in my opinion, that reputation has not reached the level to succeed in an opposition under Section 10(3). Therefore, I dismiss the opposition on this ground.

⁷ In the light of the CJEU decision in Case C-292/00 *Davidoff* [2003] ECR I-389, it is now more correct to say that there is not a requirement that the goods be similar (although the provision is equally applicable in the case of similar goods).

Section 10(4)(a)

71. The final ground of opposition that falls to be considered is under Section 10(4) of the Act, the relevant part of which reads as follows:

“A trade mark shall not be registered if, or to the extent that, its use in the State is liable to be prevented –

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade,”

72. In order to succeed in its opposition under this Section, the Opponent must establish that the use by the Applicant of the said mark in relation to the goods covered by the application would, as of the relevant date, have constituted a misrepresentation that those goods were the goods of the Opponent and that such misrepresentation would have caused damage to the Opponent. The Opponent has not even mentioned let alone provided evidence to support claims of misrepresentation. What was advanced were statements that, if the mark was registered, it would do very serious damage to the Opponent’s business and that the objection under this Section requires the support of evidence of use, which the Opponent has provided. Such statements alone are not sufficient to allow me to find the Applicant’s is engaged in a deliberate attempt to misrepresent goods as those of the Opponent or that use of the Applicant’s mark would unknowingly lead to a misrepresentation that the Applicant’s goods were those of the Opponent. Accordingly, I dismiss the opposition under Section 10(4)(a).

Decision

73. For the reasons set out above, I have decided to uphold the opposition and to refuse to allow the Applicant’s mark to proceed to registration in respect of *“confectionery; ices; frozen yoghurt and frozen yoghurt based desserts combined with fruit and sauces”* in Class 30, but to allow the application to proceed to registration in respect of all other goods and services.

Dermot Doyle

Acting for the Controller

23 January, 2015