

O/335/19

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003315196

BY SEPCO EUROPE LIMITED

TO REGISTER THE TRADE MARKS (SERIES OF 3):

El Amigos

AND

el amigos

AND

EL AMIGOS

IN CLASSES 29 AND 30

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 414336 BY

SELECTION DIFFUSION VENTES

BACKGROUND AND PLEADINGS

1. On 4 June 2018, Sepco Europe Limited (“the applicant”) applied to register the trade marks (series of 3) **El Amigos**, **el amigos** and **EL AMIGOS** in the UK. The application was published for opposition purposes on 24 August 2018. Registration is sought for the following goods:

Class 29 Cheese; Chips (Potato -); Chips [french fries].

Class 30 Bread; Flat bread; Corn chips; Taco chips.

2. The application is opposed by Selection Diffusion Ventes (“the opponent”) based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent relies on International Registration designating the UK no. 1213895 for the following mark:

AMIGOS

3. The earlier mark was registered on 7 April 2014 and was granted protection in the UK on 17 January 2017. The priority date claimed is 8 October 2013. The opponent relies upon all goods for which the earlier mark is registered, as set out in paragraph 11 below.

4. The opponent submits that the respective goods are identical or similar and that the marks are similar.

5. The applicant filed a counterstatement denying the claims made.

6. The opponent is represented by Williams Powell and the applicant is unrepresented. The opponent filed written submissions during the evidence rounds dated 4 February 2019 but did not file any evidence. No evidence or submissions were filed by the applicant. I do not propose to summarise the submissions filed by the opponent, but I have taken them into consideration and will refer to them below where necessary. No

hearing was requested and neither party filed written submissions in lieu. This decision is taken following a careful perusal of the papers.

DECISION

7. Section 5(2)(b) of the Act states as follows:

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

(a)...

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

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

8. 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.”

9. Given its date of priority, the trade mark upon which the opponent relies qualifies as an earlier trade mark under the above provisions. I note that the applicant has requested that the opponent provide proof of use of its mark. However, as the opponent's trade mark had not completed its registration process more than 5 years before the publication date of the application in issue in these proceedings, it is not subject to proof of use pursuant to section 6A of the Act. The opponent can, therefore, rely upon all of the goods it has identified.

Section 5(2)(b) – case law

10. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

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

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other

components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings to mind the earlier mark, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods

11. The competing goods are as follows:

Opponent's goods	Applicant's goods
<p data-bbox="193 255 794 293"><u>Class 29</u></p> <p data-bbox="193 300 794 1055">Meat, fish, poultry and game; meat extracts; pressed, preserved, dried and cooked or deep-frozen vegetables; preparations based on cooked, preserved and deep-frozen vegetables; guacamole; soups; canned or deep-frozen prepared dishes based on meat, vegetables, fish or poultry; crustaceans (not live); seafood (not live); jellies; jams; marmalades; compotes; edible oils and fats; appetizers based on meat, fish, poultry, crustaceans, vegetables; potato chips; fritters or cakes based on meat, fish, poultry, fruits or vegetables.</p> <p data-bbox="193 1133 794 1171"><u>Class 30</u></p> <p data-bbox="193 1178 794 1942">Prepared or cooked dishes based on pasta, rice, cereals; cereal preparations; flour-based preparations; noodles; cakes; pizzas; quiches; tarts; pancakes; corn or wheat flour-based pancakes; farinaceous foods; chips for tacos; corn chips; sweet donuts; cereals; semolina; rice; pasta; sandwiches; breads; bagels; pita breads; pastry; Viennese pastries; condiments; spices; seasonings; aromatic preparations for food; mustard; vinegar; sauces (condiments); salad dressings; canned sauces; cakes; sugar confectionery; confectionery; cookies;</p>	<p data-bbox="799 255 1393 293"><u>Class 29</u></p> <p data-bbox="799 300 1393 398">Cheese; Chips (Potato -); Chips [french fries].</p> <p data-bbox="799 477 1393 515"><u>Class 30</u></p> <p data-bbox="799 521 1393 620">Bread; Flat bread; Corn chips; Taco chips.</p>

biscuits, sweet or savory; chocolates; edible ices; honey.	
<u>Class 32</u> Beers; syrups and other preparations for making beverages; soda water; lemonades; non-alcoholic aperitifs.	
<u>Class 33</u> Wines; spirits; liqueurs.	

12. When making the comparison, all relevant factors relating to the goods in the specifications should be taken into account. In the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary.”

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

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;

(e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and, in particular, whether they are or are likely to be found on the same or different shelves;

(f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance, whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

14. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court (“GC”) stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut for Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark.”

Class 29

15. “Potato chips” in the opponent’s specification is self-evidently identical to “Chips (Potato -)” in the applicant’s specification.

16. The meaning of “potato chips” in the opponent’s specification is ambiguous. For the average UK consumer this will cover a variety of different styles of potatoes prepared and cooked to form ‘chips’ which will be eaten as a warm accompaniment to a meal or as a small meal on their own. On this basis, “Chips [French fries]” in the applicant’s specification will fall within this broader category, and the goods will be identical on the principle outlined in *Meric*. I recognise that there may be some consumers who view “potato chips” as a thinly sliced fried cold potato snack. Even if I am wrong in my view that the former is the correct interpretation, “Chips [French fries]” in the applicant’s specification will also fall within the broader category of “pressed, preserved, dried and cooked or deep-frozen vegetables” in the opponent’s

specification. These goods can, therefore, be considered identical on the principle outlined in *Meric*.

17. “Edible oils and fats” in the opponent’s specification will include goods such as butter. This is similar in nature to “cheese” in the applicant’s specification, as they are both processed products that are traditionally made from milk. The users will be similar on a superficial level because they are both consumer goods. There will be some overlap in intended purpose and methods of use as both may be added to a meal for additional flavour (such as cheese being grated over pasta or butter being added to potatoes). There may also be a degree of competition in this respect. The goods will overlap in trade channels and they are often sold in the same area of the supermarket. I consider there to be at least a medium degree of similarity between these goods.

Class 30

18. “Corn chips” appear in both the opponent’s specification and the applicant’s specification and are self-evidently identical.

19. “Bread” in the applicant’s specification is self-evidently identical to “breads” in the opponent’s specification.

20. “Chips for tacos” in the opponent’s specification is self-evidently identical to “taco chips” in the applicant’s specification.

21. “Flat breads” in the applicant’s specification falls within the broader category of “breads” in the opponent’s specification. These goods can, therefore, be considered identical on the principle outlined in *Meric*.

The average consumer and the nature of the purchasing act

22. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties’ goods. I must then determine the manner in which the goods are likely to be selected by the average consumer. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The*

Partnership (Trading) Limited, U Wear Limited, J Fox Limited, [2014] EWHC 439 (Ch), Birss J described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

23. I have no submissions from either party on the average consumer or the purchasing process for the goods in issue. In my view, the average consumer for the goods would be a member of the general public. The goods in issue are consumer goods which are likely to be of low cost and purchased fairly frequently. However, a number of factors are still likely to be considered by the average consumer when purchasing the goods, such as flavour, salt content and preparation method (such as whether crisps have been baked or fried). I consider that the level of attention paid during the purchasing process will be medium.

24. The goods are most likely to be obtained by self-selection from the shelves of a retail outlet such a supermarket or grocery store or from an online equivalent. Consequently, visual considerations are likely to dominate the selection process. However, I do not discount that there may be an aural component to the purchase of the goods given that questions may be asked of sales assistants at the time of purchase.

Comparison of trade marks

25. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade 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 trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant

components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“... it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

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

27. The respective trade marks are shown below:

Opponent's trade mark	Applicant's trade marks (series of 3)
AMIGOS	El Amigos and el amigos and EL AMIGOS

28. The applicant's marks all consist of the words EL AMIGOS in upper or lower case, or a combination of the two. Notional and fair use of a mark will cover use in upper, lower and title case and so differences created by the uses of different cases will not

be a point of difference between them. Consequently, my assessment of the marks applies to all three of the applicant's marks.

29. The opponent's mark consists of the word AMIGOS. There are no other elements to contribute to the overall impression which is contained in the word itself. The applicant's marks all consist of the words EL AMIGOS. The overall impression of the marks lies in the combination of these words.

30. Visually, the word AMIGOS appears in both the opponent's mark and the applicant's marks. The only difference is the presence of the word EL in the applicant's marks. I consider the marks to be visually highly similar.

31. Aurally, the applicant's marks will be pronounced as ELL-AHH-MEE-GOES and the opponent's mark will be pronounced AHH-MEE-GOES. The only aural difference between the marks is the addition of the word EL in the applicant's marks which has no aural counterpart in the opponent's mark. I consider the marks to be aurally similar to a high degree.

32. Conceptually, the word AMIGOS will be recognised by the average consumer as a foreign word. I keep in mind the comments of Anna Carboni, sitting as the Appointed Person in *Chorkee Ltd v Cherokee Inc.*, Case BL O/048/08. In that case Ms Carboni described the limits to which judicial notice can be used in order to find that the average consumer is aware of particular facts. She said:

“While the Applicant contended in its Counterstatement that the earlier marks would be recognised to refer to the Cherokee tribe and that the tribe was well known to the general public, no evidence was submitted to support this. By accepting this as fact, without evidence, the Hearing Officer was effectively taking judicial notice of the position. Judicial notice may be taken of facts that are too notorious to be the subject of serious dispute. But care has to be taken not to assume that one's own personal experience, knowledge and assumptions are more widespread than they are.”

33. The Cambridge English dictionary defines “amigo” as a friend and notes that it is used especially by or when talking to a Spanish-speaking person¹. The parties both agree that this is the English translation of this word. I consider that a significant proportion of average consumers will recognise the meaning of this word. For those consumers, the conceptual meaning of both marks will be the same. If they recognise that “EL” is the Spanish word for “THE” then they will attribute little importance to it. If they do not recognise the meaning of “EL” then they will attribute no meaning to it in any event. I note that in its counterstatement, the applicant claims that the presence of the word THE changes the meaning from concept to the particular, but I do not consider that this distinction materially changes the meaning conveyed by the marks. In both cases, I consider the marks will be identical to the extent that they will both convey the meaning of “FRIENDS”. For those consumers who do not recognise the meaning of “AMIGOS”, neither mark will convey any particular meaning to them, as the words will be viewed as foreign language words with no identifiable meaning. For these consumers, the marks will be conceptually neutral.

Distinctive character of the earlier trade mark

34. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-2779, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not

¹ <https://dictionary.cambridge.org/dictionary/english/amigo>

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).”

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

36. The opponent has filed no evidence to demonstrate that the distinctive character of its mark has been enhanced through use and, consequently, I have only the inherent position to consider. I have already found that the average consumer will recognise the word AMIGOS to mean friends. I note the opponent’s suggestion that this may be a reference to sharing food with friends in the context of the goods. I do not consider that this meaning will be identified by the average consumer and, in any event, this cannot be considered descriptive or allusive. In my view, the opponent’s mark is inherently distinctive to at least a medium degree.

Likelihood of confusion

37. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods and services down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and

vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the opponent's trade mark, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

38. I have found there to be a high degree of visual and aural similarity between the marks. I have found the marks to be conceptually identical insofar as they refer to "FRIENDS" for those consumers who recognise the meaning of the word AMIGOS. I have found the marks to be conceptually neutral for those consumers who do not understand the meaning of the word AMIGOS and simply see the marks as foreign language words. I have found the earlier mark to have at least a medium degree of inherent distinctive character. I have identified the average consumer to be a member of the general public who will select the goods primarily by visual means (although I do not discount an aural component). I have concluded that an average degree of attention will be paid during the purchasing process. I have found the parties' goods to be identical, highly similar or similar to at least a medium degree.

39. Bearing in mind the principle of imperfect recollection and the high degree of visual, aural and conceptual similarity between the marks, I consider that the average consumer who understands the meaning of the word AMIGOS is likely to mistakenly recall one for the other. Even for those consumers for whom neither mark has any conceptual meaning, I consider that the visual and aural similarities will lead to the marks being mistakenly recalled as each other. This is particularly the case given that only an average degree of attention will be paid during the purchasing process and the goods for which the marks are applied for/registered are similar to at least a medium degree. I consider that there is a likelihood of direct confusion.

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

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.”

41. Even if the differences between the marks are identified by the average consumer, bearing in mind the similarities between the marks and that the opponent’s mark has at least a medium degree of inherent distinctive character, I consider that the marks will be seen as variants used by the same or economically linked undertakings. I therefore consider that there will be a likelihood of indirect confusion.

CONCLUSION

42. The opposition is successful and the application is refused.

COSTS

43. As the opponent has been successful, it is entitled to a contribution towards its costs. I note that the opponent has filed a costs proforma, however these are intended for use by unrepresented parties only. I have considered the opponent’s request for costs, but I consider that it’s cost award should be calculated based upon the scale published in Tribunal Practice Notice 2/2016 as there has been nothing out of the ordinary and no unreasonable behaviour in this case to make me conclude that a departure from the scale would be appropriate. I award the opponent the sum of **£600** as a contribution towards the costs of the proceedings. The sum is calculated as follows:

Preparing a statement and considering the applicant's statement	£200
Preparing written submissions	£300
Official Fee	£100
Total	£600

44. I therefore order Sepco Europe Limited to pay Selection Diffusion Ventes the sum of £600. This sum should be paid within 14 days of the expiry of the appeal period or, if there is an appeal, within 14 days of the conclusion of the appeal proceedings.

Dated this 13th day of June 2019

S WILSON

For the Registrar