

**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. 242639 and in the matter of an Opposition thereto.

LEONA KINAHAN

Applicant

HIPP & CO.

Opponent

(Represented by Tomkins & Co.)

The Application

1. On 11 November, 2009, Leona Kinahan, an Irish citizen, of Curragh, Rosemount, Moate, Co. Westmeath, Ireland made application (No. 2009/02003) under Section 37 of the Trade Marks Act, 1996 (“the Act”) to register the sign below as a trade mark in respect of “*Retail purposes (presentation of goods on communication media, for -); sales promotion for others*” in Class 35.





2. The application was accepted for registration and advertised accordingly under No. 242639 in Journal No. 2147 dated 31 March, 2010.

3. Notice of Opposition to the registration of the mark, pursuant to Section 43 of the Act, was filed on 20 June, 2010 by Hipp & Co. of Brunigstrasse, 141 CH-6072 Sachseln, Switzerland. The Applicant filed a counter-statement on 5 October, 2010. Evidence was then filed under Rules 20, 21 and 22 of the Trade Mark Rules, 1996 (“the Rules”). The Applicant filed written submissions in lieu of attending at a hearing of the matter, while the Opponent attended at a hearing on 30 October, 2013.

4. Acting for the Controller, I decided to dismiss the opposition and to allow the application to proceed to registration. The parties were informed of my decision by way of letter dated 19 December, 2013. I now state the grounds of my decision and the materials used in arriving thereat in response to a request by the Opponent in that regard pursuant to Rule 27(2) of the Trade Mark Rules 1996, filed on 17 January, 2014.

Grounds of the Opposition

5. In its Notice of Opposition the Opponent identifies itself as manufacturers and merchants of a wide range of baby and children products, and related services. The Opponent attached to its Notice of Opposition details of the following 5 Community Trade Marks, which the Opponent states it has used in relation to baby and children products, and related services.

Trade Mark	Number	Classes
HIPP	004529517	3,5,8,9,10,12,16,20,21,25,29,30,44
	004535001	3,5,8,9,10,12,16,20,21,25,29,30,44
	005276688	3,5,8,9,10,21,24,25,44
HIPP	002208841	5,29,30,32
HiPP ¹	002578003	3,10,16,24,25,28,31,43,44

The Opponent raises objection to the present application under various Sections of the Act, which I shall summarise as follows:

- Section 8(1)(b) – *mark devoid of any distinctive character;*
- Section 8(4)(a) – *use of the mark is prohibited by law;*
- 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 mark would take unfair advantage of, or be detrimental to, distinctive character or reputation of the Opponent’s marks;*
- Section 10(4)(a) - *use of mark 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 states it initially applied for the trade mark in 2009 in respect of goods and services in classes 3,9,10,12 20,24,25,28 and 35, but did not pursue it

¹ In the Notice of Opposition this was referred to as “HIPP”, but the correct trade mark is “HiPP”

after HIPP & Co. initiated opposition proceedings. The Applicant did not wish to, nor had intended to, infringe on the rights of HIPP & Co. and therefore the present application was lodged for services in Class 35 only. The Applicant states that it does not see any similarity between its mark and the Opponent's product base and brand and therefore wishes to proceed with the application.

Rule 20 Evidence

7. Evidence submitted by the Opponent under Rule 20 consisted of a Statutory Declaration, dated 31 March, 2011 of Alexander Maier, Attorney at Law and authorised signatory of Hipp & Co. and 8 accompanying exhibits "A" to "H". Exhibit "A" contains details of the 5 marks relied upon in the Notice of Opposition.
8. Mr. Maier states his Company has used the trade mark HIPP in Ireland since February 2004, when his Company commenced selling its products to its supplier, Kelkin Limited, pursuant to a contractual arrangement dated 1 January, 2004. As a result of such use, his Company has built up substantial reputation and goodwill in the mark. Goods bearing the mark are sold in Superquinn, Boots, Tesco, SuperValu, Dunnes Stores and the Centre for Sustainable Living. Also, goods bearing the mark may be ordered online for home delivery at www.organicssupermarket.ie, which describes itself as "Ireland's first 100% truly Organic Supermarket". At "Exhibit B" he attaches an extract from for this website showing HIPP & Co. products on offer.
9. Mr. Maier attaches at "Exhibit C" an extract from his Company's new website www.hipp.co.uk showing a list of stockists of his Company's HIPP products in Ireland. He states that visitors from Ireland visit this website, as they did the old but no longer used www.hippbabyclub.co.uk site.
10. He provides details of his Company's relationship with Kelkin Limited and states that Kelkin represents, distributes and promotes his Company's HIPP products in its Grocery division throughout Ireland. He attaches at "Exhibit D" an extract from the www.kelkin.ie website in which his Company's HIPP trade mark and certain of its Community Trade Marks are referred to (though the only brand mentioned that appears to be owned by the Opponent is "HiPP Organic").

11. He attaches at “Exhibit E” two tables detailing the products (all being in the nature of food and drink) distributed by his Company in Ireland under its HIPP trade mark during 2010. The first table shows the number of units (883,761) of various food and drink products and the second the value (€679,178) of such products. He attaches at “Exhibits F” two tables of market analysis, prepared by AC Nielsen, the leading global provider of marketing research information, showing that HIPP & Co. had an 11% share of the volume and an 8.5% share of the value of the baby meal market in the UK in February 2008. He submits that, bearing in mind the number of visitors from Ireland to his Company’s website, these marketing figures be taken into account when assessing his Company’s reputation within Ireland.
12. He provides details of his Company’s promotion activities including media advertising, in-store promotions, product sampling, donations, distribution of goody bags and its involvement in the Maternity and Infant Awards. He states that, in 2010 alone, his Company budgeted £67,000 for marketing and promotion activities in Ireland and that his Company also contributes 10% of its sales figures to Kelkin Limited for the purposes of trade promotions and other advertising activities. He attaches 6 samples of such promotion material at “Exhibit G”, one of which is of such poor quality I cannot identify any reference to a HIPP & Co. trade mark, one relates to HiPP promotion and the other four refer to “HiPP Organic” products.
13. Mr. Maier submits that, although not specified in the application, the Applicant’s services are all related to the provision of baby and children products. He refers to the Applicant’s website www.hipbaby.ie, on which the statement “Shop for Organic Baby Gifts and Clothes” appears, and attaches at “Exhibit H” selected pages from the website showing such products.

Rule 21 Evidence

14. Evidence submitted by the Applicant under Rule 21 consists of a Statutory Declaration, dated 11 September, 2011 of Leona Kinahan and 15 accompanying exhibits marked “LK1” to “LK15”.
15. Ms. Kinahan states that, in 2008, she decided to set up a website selling clothing and gifts for babies and toddlers. The idea stemmed from the fact that her eldest daughter suffered from eczema and that she found it difficult to source decent organic cotton clothing for her

child, so she decided to venture into that line of business herself. In wanting a “hip and trendy” theme and having brain-stormed with friends she came up with the catchy name HipBaby. She states that she thoroughly researched the name before adopting it as her business name and found only one dormant website using the name HipBaby. She registered the business name and paid for the design and development of the www.hipbaby.ie website. Exhibit “LK1” contains details of the business name registration by the Companies Registration Office, showing 5 March, 2007 as the date of registration, and an invoice dated 31 August, 2008 in respect of website design and development.

16. Ms. Kinahan states she commenced trading under the HIPBABY trade mark on 31 October, 2008 and has continuously used the trade mark since then in relation to her website. She confirms the goods sold on her website do not bear the trade mark HIPBABY, but rather the trade mark is used in relation to the online service she provides. She attaches at exhibit “LK2” a screenshot from her website showing use of the trade mark and samples (business cards, a compliment slip, an invoice and a postcard) of the mark in use by her business on a daily basis.
17. She states she has spent considerable time, money and effort advertising and promoting the HIPBABY brand. On 26 November, 2008 she commenced an “adword” campaign on Google whereby she retained various keywords which would result in the HIPBABY website being listed as a hit when third parties entered a search using those terms. She states she never used the term HIPPA as a keyword to lure people to her HIPBABY website. Exhibit “LK3” shows the entire list of keywords retained by her for the adword campaign.
18. Ms. Kinahan attaches at exhibit “LK4” samples of advertising of the HIPBABY mark carried on third party websites, including www.magicmum.com and www.weddingsonline.ie. She states that her business also has a presence on the Intel and Ericsson intranets, in return for which she offers discounts to employees of those companies.
19. She states that a monthly HIPBABY newsletter is issued to those who have signed up to the website. At the date of swearing the Declaration the newsletter is distributed to over 3000 signatories. She attaches at exhibit “LK5” the April 2009 and June 2009 issues of the newsletter.

20. She attaches at exhibit “LK6” a document showing the number of visitors to the HIPBABY website since its launch. Attached at exhibit “LK7” is a screenshot of the HIPBABY Facebook page, set up in August 2009, showing over 1,000 fans.
21. Ms. Kinahan states the HIPBABY website includes a section which contains links to other websites, with these other websites reciprocating by providing links to the HIPBABY website. In particular she mentions www.alastairramsey.net (a charitable organisation) to whom 5% of sales from products purchased on the HIPBABY website are donated. She attaches at exhibit “LK8” a screenshot from the website whereon there is a link to the HIPBABY website.
22. She attaches at exhibit “LK9” samples of advertising and promotion of the HIPBABY trade mark in the print media, including the Irish Independent, the Sunday Business Post and Maternity magazine. Attached at exhibit “LK10” is a DVD containing an extract from the “Ireland AM” show on TV3 in which featured Ms. Kinahan and the HIPBABY brand.
23. Ms. Kinahan provides details of the advertising spend and turnover in respect of the HIPBABY trade mark for 2009 and exhibits at “LK11” a letter from Ray Lane & Associates, Chartered Accountants and Registered Auditors, confirming the turnover figure.
24. She states that she is perplexed at the nature of the opposition as filed as she does not sell any goods whatsoever under the term HIPBABY and has no intention of doing so. She refers to the Opponent’s mark as the surname HIPPP, which has become a well-established trade mark in the area of baby food and beverages only.
25. She provides at exhibit “LK12” details of the results of four searches carried out by her on Google using the search terms “Hip Baby”, “Hipp Baby”, “Hip Organic Food” and “Hipp Organic Food”. She states that, while her website and trade mark appear several times in the first five pages of the “Hip Baby” search results, her website or trade mark do not appear in the first 5 pages of results for any of the other 3 search terms. She claims, that as 85% of visitors to Google do not look beyond the first page of search results, this shows that there is no likelihood of confusion whatsoever between her trade mark and those of the Opponent. Also at exhibit “LK12” are screenshots from the Opponent’s website www.hipp.co.uk which shows the Opponent’s term HIPPP is used mainly in conjunction with the word Organic. The extracts from the Opponent’s website also shows that the word HIPPP is the surname of the

family who, having converted the family farm into one of the first organic farms in Europe in 1956, and went on to establish the HIPBABY business based on the finest organic ingredients.

26. Ms. Kinahan attaches at exhibit “LK13” a screenshot from www.alexa.com, which shows a list of word searches that customers of Hipp Organic carried out when searching for the www.hipp.co.uk website. She claims that the absence of the word “Hip” in these search terms further proves there is no evidence of confusion for customers.
27. She exhibits at “LK14” an extract from the Oxford dictionary defining what the word “Hip” means.
28. She rejects the claims made by Alexander Maier in his Statutory Declaration that the term “Hip” is not a common term with regard to baby and children products and claims there are thousands of websites that use the terms “Hip” and “Baby” to portray the trendiness of the goods on offer. She lists 10 such sites in her Declaration and attaches at exhibit “LK15” screenshots from others.

Rule 22 Evidence

29. Evidence submitted by the Opponent in reply to the Applicant’s Rule 21 evidence consisted of a second Statutory Declaration, dated 4 April, 2012 of Alexander Maier and 4 accompanying exhibits “TM1” to “TM4”.
30. Mr. Maier states that, contrary to what is claimed in Ms. Kinahan’s Declaration, prior to lodging the application, thorough research could not have been undertaken by the Applicant, because thorough research would have revealed the existence of a Canadian company trading since 1995 under the HIPBABY mark. He attaches at exhibit “TM1” extracts from the Canadian company’s website. He states the Applicant did not carry out a clearance search to ensure that there were no existing rights in the identical or similar trade mark for identical or similar goods and services, as such a search would have disclosed his Company’s marks upon which the opposition is based. He says that the Applicant did not seek professional legal services on the availability of the HIPBABY trade mark and accordingly her research was in no way thorough nor did the applicant act in a diligent manner.
31. He says that the statement by the Applicant that it has not used the trade mark in relation to goods, nor has any intention to do so, is contradicted by the fact that on 20 March, 2009

Leona Kinahan applied to register the mark in relation to a wide range of goods and services in Classes 3, 9, 10, 12, 20, 24, 25, 28 and 35. On that earlier application Leona Kinahan made a declaration that she is using, or has a *bona fide* intention of using, the mark in respect of the goods and/or services for which registration was sought. He attaches at “TM2” a copy of the said application. That earlier application was opposed by his Company and was deemed withdrawn as the Applicant did not file a Counter Statement in reply to the Notice of Opposition.

32. Mr. Maier attaches at “TM3” a copy of a letter, dated 1 October 2010, from the Applicant to the Patents Office in which Ms. Kinahan clearly acknowledges his Company’s rights by stating “*as we do not wish to nor had we intended to infringe the rights of HIPP & CO. we therefore amended our application accordingly withdrawing from all Classes bar Class 35 in this new application*”.

33. He states it is clear from Ms. Kinahan’s Statutory Declaration that use of the trade mark HIPBABY is not and will not be confined to online retailing. His Company sells products through various websites which are available to consumers in Ireland. He attaches at “TM4” extracts from the Amazon website by way of example. Also products are sold to consumers in Ireland through the website www.hipp.ie, which is redirected to the UK website www.hipp.co.uk.

Written Submissions

34. The Applicant elected to file written submissions in lieu of attending at a Hearing. Those submissions were comprehensive, addressed in detail all the evidence filed by the parties and directed me to various case law and decisions of the Office for Harmonisation in the Internal mark (OHIM). It also contained new material not submitted as evidence, which is inadmissible at this stage of the proceedings and which I have ignored.

The Hearing

35. The Opponent was represented by Simon Gray, Trade Mark Attorney of Tomkins & Co., who stated from the outset the principle basis of Opposition was Section 10(2)(b) of the Act (likelihood of confusion or association with the Opponent’s trade marks). The secondary basis was Section 10(3) of the Act (use of mark would take unfair advantage of, or be detrimental to, the distinctive character or reputation of the Opponent’s marks). Mr. Gray

stated the Opponent reserves the right to pursue opposition in the Hearing under any of the additional grounds of Opposition as filed in the Notice of Opposition. However, the opposition was not pursued on any of those other grounds. Far too often opponents list many grounds of opposition, which are unsustainable (and their legal representatives know they are unsustainable) but never abandon them at any stage, as is the case here in respect of Section 8(1)(b), Section 8(4)(a). The Applicant is required to defend its application against all the grounds of opposition and is put to unnecessary expense in defending grounds which are not pursued, or ever likely to be pursued. I can understand, for tactical reasons, Opponents may adapt a blanket approach in their Notice of Opposition. But, by the evidence filing stage the Opponent knows precisely the grounds on which it will fight its case and directs its evidence towards those specific grounds. Therefore, grounds raised in Notices of Opposition but not supported by evidence at Rule 20 stage should be formally abandoned, failing which, in my opinion, the Controller should consider appropriate penalties when awarding costs, irrespective of which party is successful.

36. No evidence or argument was advanced in respect of the grounds of opposition other than those concerning Section 10(2)(b) and Section 10(3). It is upon these grounds that I have decided the matter.

Section 10(2)(b)

37. 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.



38. 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.

39. The first requirement is met as the Opponent’s marks were filed at the OHIM, prior to 11 November 2009 (the relevant date) and by virtue of Section 11(1)(b) of the Act, are earlier trade marks as against the present application for the purposes of Section 10.

Comparison of the marks

40. 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. It is important to 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 for which the Applicant is seeking protection. Notwithstanding the detailed comparisons I make below I am mindful that the European Court of Justice has noted (*Sabel BV v Puma AG and Rudolf Dassler Sport Case C-251/95*)² that 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.

41. The Opponent relies upon five earlier marks. I will deal first with the four that consist only of the term HIPP. Two of the four are “HIPP”, one is “HiPP” and the fourth is . The term “HIPP” is both the distinctive and dominant element of the Opponent’s marks. The Applicant’s mark is , containing the term “BABY”, which is absent from the Opponent’s marks. Mr. Gray argued that the word “BABY” is a common term used in respect of the goods for which the Applicant claims to use its mark and therefore has limited, if any, distinctive character. He argued that the word “HIP” is the dominant and distinctive part of the Applicant’s mark. I do not agree. The assessment of whether the mark contains words that describe the goods or services, or words that are common in the trade, can only

² Paragraph 23 of decision dated 11 November, 1997

be made against the goods and services for which the Applicant seeks protection, not against the goods and services the Applicant claims to use the mark on. As mentioned above, the application must be considered to be in respect of general retail services covering all manner of goods - everything from a needle to an anchor. As such the mark applied for cannot be deemed to be descriptive or in common usage in the trade. In my opinion, neither the word "HIP" nor the word "BABY" can be singled out as the distinctive or dominant element of the Applicant's mark. The entire term "HIPBABY" dominates the Applicant's mark and it is this term that gives the mark its distinctiveness.

42. Irrespective of the spelling, the respective marks share the syllable "HIP", which comes first in the respective marks. It is the only verbal element of the Opponent's four marks, while it is the first of the two words making up the Applicant's mark. The inclusion of the word "BABY" in the Applicant's mark is a significant additional verbal element which, from an oral perspective, serves to put much distance between the respective marks. Overall, in my opinion, these four marks share a medium level of oral similarity to the Applicant's mark.
43. Visually the marks share the letters "H-I-P", but no more. The Opponent's marks contain a second "P", which would not go unnoticed by the average consumer. The Applicant's mark contains the word "HIP", the word "BABY" and the figure of a baby chick. The Applicant's mark is also in two shades of orange, with each word being in a different shade. One of the Opponent's marks is in colour, with each letter depicted in a different colour. Two of the Opponent's marks are in upper case alone, with the other two in uppercase, except that the "i" is in lower case. The entire of the Applicant's mark is in lower case. The respective marks are in different fonts. Visually the marks are far more dissimilar than they are similar. Overall I would assess the respective marks as sharing a low level of visual similarity.
44. Conceptually the Opponent's "HIPPP" marks have no meaning. It would not be understood to be part of the human anatomy, nor would it be understood to be a colloquial term meaning trendy, fashionable or "cool". The Opponent's evidence states the term "HIPPP" is the surname of the German founder of the company and it is conceivable that some consumers may understand it to be a surname. In my opinion, the message conveyed by the term is that it is a made-up word, without any meaning. While there are two distinct meanings of the word "HIP", it is clear the "HIP" in the Applicant's mark refers to a trendy baby, not the body part. No other construct can be put on it. The Applicant's mark conveys the

unambiguous message of a trendy or cool baby, which is far removed from the indiscernible message conveyed by the Opponent's "HIP" marks.

45. Furthermore, in using the word "HIP" the Applicant is not, in my opinion, seeking to copy or link its mark in any way with the marks of the Opponent. The Applicant is using the word in its normal spelling and for its normal meaning, whereas the Opponent's "HIP" is not an English word and it has no meaning. If the tables were turned, in the sense that if the Opponent's mark contained the word "HIP" and the Applicant was attempting to use "HIP", then "HIP" would not be a word with a natural meaning and it could be argued that the Applicant was seeking to attach its mark in some way with the marks of the Opponent. But that is not the case.
46. It is settled case law (C-251/95 *Sabel BV v. Puma AG*, paragraph 23) 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 negligible level of similarity that I consider them to be very different.
47. In *Canon*³ 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 these goods or services. Accordingly, the court found a lesser degree of similarity between these goods or services may be offset by a greater degree of similarity between the marks, and vice versa. I have not yet conducted a comparison between the goods and services for which the Opponent's marks stand protected and the services for which the Applicant seeks registration. However, in this case the differences between the Opponent's "HIP" marks and the Applicant's mark are so manifestly stark that, even if the marks were applied to identical goods and services, I am satisfied there is no likelihood that consumers would be confused or believe the marks emanate from economically-linked undertakings. Therefore, I must reject the opposition grounded on a likelihood of confusion or association with the Opponent's four "HIP" marks.

³ *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, (Case C-39/97 paragraph 17)

48. Turning now to a comparison of the Opponent's HiPP Baby SANFT (logo) mark and the Applicant's mark. While the CJEU found in *Lloyd Schuhfabrik Meyer*⁴ the average consumer rarely has the chance to make a direct comparison between marks and must instead rely upon the imperfect picture of them he has kept in his mind, it also found the average consumer must be deemed to be reasonably well informed, circumspect and observant. I must apply these principles and also assess the respective marks as a whole, viewed through the eyes of the average consumer of the goods and services in question, without dissecting them. To best do so, I find it helpful to look at both marks side-by-side.



49. There is no doubt the marks share some degree of similarity. Each contains the word BABY and each begins with the letters H-I-P. However, while both marks share the same opening syllable, the H-I-P of the Opponent's mark cannot be viewed in isolation from the other "P" that makes up the first word. Each letter of the Opponent's HIPP is depicted in a different colour which, in my opinion, hammers home the Opponent's intension that the HIPP in its mark should not be viewed as, or confused with, the 3-lettered word HIP being the name of a body part or the 3-lettered word meaning trendy or cool. The Opponent has not claimed the word "HIPP" is meant to be anything other than the name of the Opponent's company which is derived from the surname of its founder.

50. I find the HIPP of the Opponent's mark is visually different and, in particular, highly different conceptually to the HIP in the Applicant's mark. The "HIPP" is the dominant and distinctive feature of the Opponents mark, whereas the term "HIPBABY" dominates and gives the Applicant's mark its distinctiveness. In my opinion, the opening words are not the same.

⁴ *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* (Case C-342/97)

51. The word BABY appears in both marks, albeit in different fonts. Nonetheless this element, common to both marks, must be considered identical. The Opponent's mark contains the German word SANFT, which is not present in the Applicant's mark. The Applicant's mark contains the figure of a baby chick, which is absent from the Opponent's mark. Bearing in mind also the different layout, fonts, colours and the three "hearts" in the Opponent's mark, I would assess both marks as sharing a medium level of visual similarity.
52. Verbally the Applicant's mark is contained within the Opponent's mark. The presence of the word SANFT in the Opponent's mark bestows a certain level of dissimilarity between the marks but overall, in my opinion, the marks share a high level of oral similarity.
53. As already assessed above, conceptually the Applicant's mark sends out a specific message of a trendy or fashionable baby. In contrast the Opponent's HiPP Baby SANFT (logo) mark does not send out any discernible message. The "HIPPP" is a German surname and the SANFT is also a German word. The English word "Baby" means the same thing when used in the German language. Therefore, the entire of the Opponent's mark could be understood to be a German phrase relating to babies. I find the marks to be very different conceptually.
54. In my opinion, despite the high level of oral similarity, there is enough visual dissimilarity and such a high degree of conceptual dissimilarity, that overall, I find the two marks share a low level of similarity.

Comparison of the goods/services

55. The degree of difference between the Opponent's "HIPPP" simpliciter marks and the Applicant's mark is so great and obvious that I need not conduct a comparison between the goods and services of the respective marks. There is some degree of similarity between the Opponent's HiPP Baby SANFT (logo) mark and the Applicant's mark, so I must consider the respective goods and services. The Applicant is seeking protection for its mark in respect of retail services alone, while the Opponent's HiPP Baby SANFT (logo) mark is protected for a variety of goods and for consultancy services in relation to children's nutrition and care.
56. Retail services cover a multitude of distinct business activities. The Applicant has, by not specifying the goods for which it provides retail services under its trade mark, opened its application to challenge on all fronts. In her evidence the Applicant has placed great

emphasis on the fact she sells premium quality clothing and accessories for babies and children and that there is no overlap between those goods and the goods for which the Opponents marks stand protected. The Applicant also emphasises that the vast majority of business is conducted online and that Irish consumers cannot purchase the Opponents goods online.

57. These proceedings concern the application for the protection of the mark applied for in respect of the list of goods/services specified in the application; they do not concern what actual goods the Applicant sells or how the Applicant sells them. The wording of the specification “*Retail purposes (presentation of goods on communication media, for -); sales promotion for others*” does not confine the application to any particular method of retailing. The mention of “*presentation of goods on communication media*” confirms the Applicant is seeking protection in respect of online retailing, but the inclusion of the general term “*sales promotion for others*” provides the Applicant with the scope to deliver retail services by any means. So, for the purposes of these proceedings, the application must be considered to be in respect of general retail services. The specification does not identify any particular goods in respect of which protection for retail services is sought. Therefore, I must take the scope of the application for retail services to include the retail of all manner of goods. Accordingly, the application includes retail services for goods for which the Opponent’s trade marks stand protected.

58. According to settled case-law, in assessing the similarity between goods or services, all the relevant factors which characterise the relationship which may exist between them should be taken into account. Those factors include their nature, their intended purpose and their method of use and whether they are in competition with each other, or are complementary.

59. In *Oakley*⁵, 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

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

paragraph 34 of Praktiker Bau- und Heimwerkmärkte, 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.

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.

57. Thus, notwithstanding the incorrect finding of the Board of Appeal to the effect that the services and goods in question have the same nature, purpose and method of use, it is indisputable that those services and goods display similarities, having regard to the fact that they are complementary and that those services are generally offered in the same places as those where the goods are offered for sale.

58. It therefore follows from all of the foregoing that the goods and services in question resemble each other to a certain degree, with the result that the finding in paragraph 24 of the contested decision that such a similarity exists must be upheld.

59. In the second place, with regard to the comparison of ‘retail and wholesale services, including on-line retail store services’ with the goods in question, it must be recalled that the Court held, in paragraph 50 of Praktiker Bau- und Heimwerkmärkte, paragraph 17 above, that the applicant for the Community trade mark must be required to specify the goods or types of goods to which those services relate.

60. In that regard, it must be pointed out that the applicant has, as correctly stated by the Board of Appeal in paragraph 32 of the contested decision, failed to provide any specification whatsoever of the goods or types of goods to which the ‘retail and wholesale services, including on-line retail store services’ relate.

61. Thus, it must be held that ‘retail and wholesale services, including on-line retail store services’, on account of the very general wording, can include all goods, including those covered by the earlier trade mark. Therefore, it must be held that ‘retail and wholesale services, including on-line retail store services’, display similarities to the goods concerned.”

60. In the present case the Applicant has not identified the retail area(s) for which it seeks protection in respect of retail services. Accordingly, I am none the wiser as to what the nature, intended purpose or method of use of the goods the Applicant retails, or whether such goods are in competition with or complimentary to the goods for which the Opponents earlier HIPP BABY SANFT (logo) mark stands protected. Therefore, I must conclude that there is similarity between the retail services and goods across all these factors.

Likelihood of confusion

61. The question is whether that similarity 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 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,

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

- 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.

62. In applying those criteria to the facts of the present case, I have reached the following conclusions:

Inherent distinctiveness of the earlier mark: The Opponent's HIPPI BABY SANFT (logo) mark has a high degree of inherent distinctiveness and has an obvious capacity to identify the goods for which it is registered as being those of a particular undertaking and thus to distinguish those goods from those of other undertakings.

Additional distinctiveness acquired through use: The Opponent's mark is long established, recognised easily and known in the State, and is readily associated with baby food, drinks and supplements. I am satisfied that it has acquired substantial additional distinctiveness through use and promotion on these products.

The average consumer: The class of goods covered is broad and looked at from that perspective, the consumers of the relevant goods are the public generally and it is the likely perception of the average member of the public that I shall consider.

Degree of similarity between the marks and between the goods: For the reasons set out in paragraphs 47-52 above, I regard the marks in question as having a low level of similarity. However, the retail services covered by the Application are similar to the goods of the earlier registration, which means a lower level of similarity between the marks could be

deemed sufficient to declare a likelihood of confusion exists. Bearing this important consideration in mind I am satisfied nonetheless that the actual level of similarity between the marks falls way short of what is required in order for me to conclude that such a likelihood exists.

Overall impression created by the marks: The overall impression created by the marks in question is that they are different. Visually the marks look different and verbally they are somewhat different. Conceptually the marks are completely different and the addition of the figurative element of the Applicant's mark helps to reinforce that conceptual difference.

Overall assessment of likelihood of confusion:

63. 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 HIPP BABY SANFT (logo) mark and the Applicant's mark. 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 use the Applicant's retail services in the mistaken belief that the services are being provided by the undertaking he knows by the earlier mark (direct confusion) or that the retailer is linked economically to the undertaking he identifies by the earlier mark (indirect confusion by association).* 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. I have decided that, even allowing for imperfect recollection, there is no likelihood of confusion.

64. The comparison between the Opponent's HIPP BABY SANFT (logo) mark and the Applicant's mark has identified some similarities and in the case of the word "BABY" an identical element, but notwithstanding these, when the respective marks are viewed as a whole the immediate and obvious conclusion I draw is that the marks are different. In that respect this case drives home the importance of viewing marks as a whole and not to simply compare components of the respective marks.

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

65. The Opposition was also grounded on Section 10(3) of the Act provides as follows:

"A trade mark which is identical with or similar to an earlier trade mark 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."

66. 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, the earlier mark(s) must have a reputation in the State (or in this case in the Community); thirdly, the use of the later trade mark must be without due cause; and fourthly, that use must take unfair advantage of, or be detrimental to, the distinctive character or reputation of the earlier marks.

67. I have already found that there is some level of similarity between the Applicant's mark and the Opponent's marks. For the purposes of Section 10(3) a reputation within the European Community (EU) is sufficient in respect of a Community Trade Mark (CTM). The plain meaning of Section 10(3) of the Act suggests that a CTM, which may not even be used in Ireland, and which may have a reputation in only one Member State of the Community, could be unfairly taken advantage of, or suffer detriment, when a similar mark is used in this State, despite the fact that consumers here may have no knowledge of the earlier mark or its reputation. However, the lack of quality and probative value of the evidence submitted by the Opponent does not allow me to conclude that a reputation exists, either in Ireland or at Community level, in respect of the marks the Opponent relies upon.

68. In fact the evidence is extremely sparse and is limited to the following:

- (a) Extracts from The Organic Supermarket website showing that “HIPP” and “HIPP ORGANIC” labelled products are available for purchase. However, there is no evidence as to what brands were actually sold, or how many, if any were sold.
- (b) An extract from the hipp.co.uk website showing that “HIPP” and “HIPP ORGANIC” products are stocked by a number of named retailers and leading supermarket chains in Ireland.
- (c) Extracts from the website of the Opponent’s distributor in Ireland (Kelkin) stating that they are an agent for “HIPP ORGANIC”.
- (d) Two tables of data showing the number of product items sold and the corresponding value of those products sales. However, there is no mention of any brand in these tables.
- (e) Two tables produced by ACNielsen showing the Opponent’s share of the baby meals business in terms of market volume and market value (HIPP is third behind Cow & Gate and Heinz). However, yet again there is no indication as to the trade mark(s) under which the market share was achieved.
- (f) Kelkin promotion material referring to “HIPP” and “HIPP ORGANIC” products.

69. In light of the nature of the evidence it is appropriate for me to differentiate between the Opponent’s “HIPP” marks and its “HIPP BABY SANFT (logo)” mark, which I will look firstly at.

70. The Opponent has protection for its “HIPP BABY SANFT (logo)” mark by way of a Community Trade Mark, but other than providing proof of this registration the Opponent has not provided a single shred of evidence pointing to any use of this mark. All the evidence adduced by the Opponent in support of its opposition relates to its “HIPP” marks or to its “HIPP ORGANIC” mark, though the latter was not put forward or relied upon as a ground of opposition. I must conclude the Opponent has not demonstrated it has a reputation in its “HIPP BABY SANFT (logo)” mark, either in Ireland or at Community level. Therefore, the Opponent has failed to satisfy the fundamental requirement that it has a reputation in this mark. Accordingly, I must reject the opposition under Section 10(3) in respect of this mark.

71. Finally, turning to the Opponent's "HIPP" marks. The evidence shows the Opponent sold goods in Ireland; specifically food, drink and nutritional products for babies. But the evidence does not show under what mark(s) those products were traded. It was either under "HIPP" or "HIPP ORGANIC". In view of this lack of certainty and clarity in the evidence I cannot reach any firm conclusions as to under what trade mark(s) the Opponent has earned its reputation. Whatever way the reputation is divided, I am satisfied the Opponent's "HIPP" marks are so markedly different to the Applicant's mark that there is no possibility that use by the Applicant of its mark would cause detriment or take unfair advantage of the Opponent's HIPP marks. Accordingly, I reject the opposition grounded on Section 10(3) in respect of the Opponent's "HIPP" marks.

Conclusion

72. For these reasons, I have decided to dismiss the opposition and to allow the Applicant's mark to proceed to registration.

Dermot Doyle

Acting for the Controller

16 May, 2014