

**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. 244661 and in the matter of an Opposition thereto.

UNILEVER PLC

Applicant

(Represented by FRKelly)

SOCIÉTÉ DES PRODUITS NESTLÉ, S.A.

Opponent

(Represented by Tomkins & Co.)

The Application

1. On 30 November, 2010, Unilever PLC, a British company, of Port Sunlight, Wirral, Merseyside, United Kingdom, made application (No. 2010/02065) under Section 37 of the Trade Marks Act, 1996 (“the Act”) to register the words “RANDOM ACTS OF HAPPINESS” as a Trade Mark in respect of “*Ice cream, water ices, frozen confections, preparations for making the aforesaid goods*” in Class 30.
2. The application was accepted for registration and advertised accordingly under No. 244661 in Journal No. 2172 dated 16 March, 2011.
3. Notice of Opposition to the registration of the mark pursuant to Section 43 of the Act was filed on 14 June, 2011 by Société Des Produits Nestlé, S.A., of 1800 Vevey, Canton of Vaud, Switzerland. The Applicant filed a counter-statement on 8 September, 2011 and evidence was, in due course, filed by the parties under Rules 20, 21 and 22 of the Trade Marks Rules, 1996 (“the Rules”).
4. Both parties filed written submissions in lieu of attending a Hearing in the matter and each filed written submissions in reply to other party’s written submissions. 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 10 July, 2014. 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.

Grounds of the Opposition

5. In its Notice of Opposition the Opponent refers to its proprietorship of two Irish trade marks, RANDOMS (No. 239647) and LET YOUR RANDOM SIDE OUT (No. 242436), each registered in respect of the following goods:

Class: 29

Vegetables and potatoes (preserved, dried or cooked), fruits (preserved, dried or cooked), frozen fruits and vegetables, mushrooms (preserved, dried or cooked), meat, poultry, game, fish and seafood, all these products also in the form of extracts, soups, jellies, pastes, preserves, ready-made dishes, frozen or dehydrated; jams; eggs; milk, cream, butter, cheese and other food preparations having a base of milk; milk substitutes; milk-based beverages; milk-based and cream-based desserts; yoghurts; soya milk (milk substitute), soya-based preparations; edible oils and fats; protein preparations for human food; non-dairy creamers; sausages; charcuterie; peanut butter; soups, soup concentrates, broth, stock cubes, bouillon, consommés.

Class: 30

Coffee, coffee extracts, coffee-based preparations and beverages; iced coffee; coffee substitutes, extracts of coffee substitutes, preparations and beverages based on coffee substitutes; chicory; tea, tea extracts, tea-based preparations and beverages; iced tea; malt-based preparations; cocoa and cocoa-based preparations and beverages; chocolate, chocolate products, chocolate-based preparations and beverages; confectionery, sweets, candies; sugar; chewing gum; natural sweeteners; bakery products, bread, yeast, pastry; biscuits, cakes, cookies, wafers, toffees, puddings; ice cream, water ices, sherbets, frozen confections, frozen cakes, soft ices, frozen desserts, frozen yoghurts; binding agents for making ice cream and/or water ices and/or sherbets and/or frozen confections and/or frozen cakes and/or soft ices and/or frozen desserts and/or frozen yoghurts; honey and honey substitutes; breakfast cereals, muesli, corn flakes, cereal bars, ready-to-eat cereals; cereal preparations; rice, pasta, noodles; foodstuffs having a base of rice, of flour or of cereals, also in the form of ready-made dishes; pizzas; sandwiches; mixtures of alimentary paste and oven-ready prepared dough; sauces; soya sauce; ketchup; aromatising or seasoning products for food, edible spices, condiments, salad dressings, mayonnaise; mustard; vinegar.

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

- Section 8(1)(a) – *the mark does not fall within the definition of a trade mark;*
- Section 8(1)(b) – *mark devoid of any distinctive character;*
- Section 8(1)(d) – *mark consists exclusively of signs or indications which have become customary in the trade;*

- Section 8(3)(b) – *mark of such a nature as to deceive,*
- Section 8(4)(a) – *use of mark prohibited by enactment or rule of law,*
- Section 10(2)(b) – *likelihood of confusion on the part of the public, and likelihood of association with the Opponent’s earlier marks*
- Section 10(4)(a) – *use of mark is prevented by virtue of rule of law protecting an unregistered trade mark.*

The Opponent also claims the mark applied for should be refused, at the exercise of the Controller’s discretion.

Counter-Statement

6. In its Counter-Statement the Applicant admits the Opponent is the proprietor of the marks cited in the Notice of Opposition, but denies all the grounds of opposition. The Applicant also claims the Notice of Opposition filed by the Opponent is vexatious and should be dismissed.

Rule 20 Evidence

7. Evidence submitted by the Opponent under Rule 20 consists of a Statutory Declaration, dated 17 May 2012, of Dale Carter, Trade Mark Attorney of Nestlé UK Limited and 4 accompanying exhibits, marked “SPN1” to “SPN4”. He states that his company is the world’s largest food and beverage company and attaches at Exhibit “SPN1” copies of his company’s Annual Reports for the years 2009-2011 inclusive. He refers to his company’s earlier two trade marks and attaches at Exhibit “SPN2” extracts from the Trade Mark Register relating to the marks.
8. Mr. Carter states the turnover in goods sold in Ireland under the two earlier marks for the periods June to December 2009 and January to December 2010 are €746,000 and €1,259,500 respectively. He says both earlier marks are used in relation to a confectionary product and he attaches at Exhibit “SPN3” sample advertising material showing use of both marks in respect of sweets.
9. Mr. Carter says goods bearing the earlier marks are sold extensively in all leading Irish supermarkets and at festivals. He attaches at Exhibit “SPN4” photographs showing sampling activities at various events in 2009. He states that, in particular, he wishes to

draw attention to the use by his company in advertising campaigns of the phrase “RANDOM ACTS OF KINDNESS”. He states that various other phrases and slogans which incorporate the word RANDOM, for example RANDOM PROTESTS and RANDOM MOBILE, are used to heighten consumer awareness of his company’s earlier marks.

10. Mr. Carter states that the amount spent on advertising and promoting the earlier marks in Ireland between June and December 2009 and January to December 2010 are €1,130,027 and €561,967 respectively. By virtue of the comprehensive advertising campaign the RANDOMS products have become well-established in the relevant impulse sugar confectionary market, rising from a 2.2% share in 2009 to 4.7% in 2010. This places the product at number 2 in the best-seller charts behind his company’s FRUIT PASTILLES.

Rule 21 Evidence

11. Evidence submitted by the Applicant under Rule 21 consists of a Statutory Declaration dated 4 April, 2013 and two exhibits marked “Exhibit 1” and “Exhibit 2”, of Terry Daly, Trade Mark Counsel, for the Applicant. He states that his company commenced use of the RANDOM ACTS OF HAPPINESS trade mark in Ireland in April 2011. The mark is used in connection with the HB ice cream brand and was initially launched as a campaign to encourage people to buy somebody an ice cream as a random act of happiness. His Company invested significantly in a Television/Radio/Internet and national press campaign and he attaches at “Exhibit 1” materials highlighting use of the mark in advertising campaigns.
12. Mr. Daly states that his company’s media consultants were shortlisted for the Media Awards 2012 for the RANDOM ACTS OF HAPPINESS media campaign and he attaches at “Exhibit 2” the shortlist. He states his company is not aware of any instances of confusion in relation to its mark and the Opponent’s marks, since commencement of use in Ireland.
13. The remainder of Mr. Daly’s declaration is a critique of the content of the Statutory Declaration of Dale Carter, in which he described the Opponent’s evidence as entirely underwhelming. He says no evidence has been provided whatsoever in respect of the LET YOUR RANDOM SIDE OUT trade mark and it would appear that this mark has not been

used in Ireland. The Opponent has not submitted a single invoice to support claims of sales in Ireland, nor has it provided any advertisements from actual publications/magazines or any invoices regarding advertisement expenditure. There is no evidence in relation to the alleged television and radio advertisement campaigns.

Rule 22 Evidence

14. Evidence filed under Rule 22 consists of a second Statutory Declaration of Dale Carter, dated 7 November 2013 and two accompanying exhibits “DC1” and “DC2”, and a Statutory Declaration, dated 14 November 2013, of Aoife Hallihan and a single attached exhibit marked “AH1”. For his part Mr Carter argues that most, if not all, of the evidence submitted in support of the application either postdates the relevant date or has no probative value. In reply to Mr. Daly’s comments regarding a lack of material to support the claimed sale of goods bearing the Opponent’s marks he attaches at Exhibit “DC1” 31 invoices in respect of sales of “ROWNTREES RANDOMS”, all of which he states predate the date of filing of the mark at issue. However, on examination I find that only 6 of the 31 invoices predate the relevant date.
15. In reply to Mr. Daly’s comments about the Opponent’s claimed expenditure on advertising prior to the relevant date, Mr. Carter attaches at Exhibit “DC2” copies of invoices, issued by Ground 4D Marketing, relating to advertising and promotional campaigns for products sold under the Opponent’s RANDOMS mark in Ireland. The remainder of Mr. Carter’s declaration confirm the statements and claims he made in his first Statutory Declaration.
16. For her part, Ms. Hallihan states that she is the Head of Shopper and Category for Nestlé (Ireland) Limited and that the information contained in the First Statutory Declaration of Mr. Carter, in respect of market share of goods bearing the Opponent’s RANDOMS mark, was derived from AC Nielsen’s Nitro database. She states that AC Nielsen is an internationally renowned and trusted market research company and that the figures quoted accurately reflect the Irish marketplace for the year 2010. She states that, unfortunately, at the date of her declaration, she is unable to access data on the Nitro database dating back to 2010 so as to enable her to rerun the report she ran previously, but that, solely for illustrative purposes, she is able to extract data in respect of the period 1 January 2011 to 9 November 2011, using the same set of parameters. She attaches, at Exhibit “AH1”,

screenshots of the AC Nielsen Nitro database used to extract the data and the resulting table showing market-share within the relevant sector, which shows “ROWNTREES RANDOMS” with a 4.0% share of the market and still second in the top-seller list.

Written submissions in lieu of attending at a hearing

17. In its written submission, filed in lieu of attending at a hearing, the Opponent identifies the essence of the opposition as the Applicant seeking to register a trade mark that is similar to the earlier marks of the Opponent for goods that are identical to those contained in the specification of goods of the Opponent’s earlier marks. As such the Opponent confined its arguments to the grounds of opposition relating to Section 10(2)(b) of the Act. In light of that, and as no evidence was filed to support any of the other grounds of opposition mentioned in the Notice of Opposition, it is upon Section 10(2)(b) alone that I have decided the matter.

18. The Opponent states its RANDOMS and LET YOUR RANDOM SIDE OUT marks are used on bags of confectionery where each bag contains individual sweets with a different combination of textures, shapes and flavours. The use of the mark RANDOMS follows the principle that no two bags are ever quite the same or, in other words, each bag contains a random mix of sweets. The Opponent argues that it has made widespread use of the word RANDOM in many marketing slogans connected to the product on which the mark is used, such as “*fancy a random bus trip*”, “*random protects*”, “*random reliant*”, “*random mobile*”, “*randomer*” and, most notably, “*random acts of kindness*”. The word RANDOM has been deliberately and repeatedly highlighted in the advertising and promotion of the RANDOMS confectionery product with the aim of imprinting the word on the consciousness of the consumer and linking the word to the confectionery product that bears the Opponent’s RANDOMS trade mark.

19. The Opponent also argues the adoption of the word RANDOM as a trade mark by the Opponent arises from the profile of the word as a “buzzword” in the youth culture of today. The word suggests something which is unpredictable, unconventional or unexpected. One commonly hears the phrase “*that’s random*” meaning “*that’s unexpected*”. The result is the consumer associates the word with the Opponent and use of the word by the Applicant, as a key word in the mark applied for, is sufficient to create a link between the products of the Applicant and those of the Opponent, leading to a

likelihood of confusion. This, the Opponent argues, is particularly so given that one of the marketing catch-lines used by the Opponent is “random acts of kindness”.

20. The Opponent outlined some of the well-established principles, as enunciated by the Courts, which must be adhered to in determining and assessing the likelihood of confusion for the purposes of Section 10(2)(b). The Opponent also drew my attention to the Office for Harmonisation in the Internal Market’s (OHIM) Opposition Guidelines and to an OHIM Opposition Division decision¹ which concerns an application for the mark PLAINPAY.

21. The arguments of the Opponent can be summarised as follows:

- i. The goods for which the Applicant has applied to use its mark are identical to goods covered by the Opponent’s marks.
- ii. It is well established that consumers give due regard to the beginning of a mark and emphasis would be placed on the word RANDOM.
- iii. The Opponent’s marks are inherently distinctive and have acquired an additional high level of distinctiveness through use.
- iv. Having been used for two years prior to the application of the disputed mark the word RANDOM/S has become the distinct and dominant element of both earlier marks and the word “random” was the key word in the promotion of the Opponent’s goods.
- v. As a result of exposure to the opponent’s marks the average consumer would be liable to link the respective marks and to understand that RANDOM ACTS OF HAPPINESS is simply another junior mark of the Opponent used for its product line.
- vi. The judgement of the CJEU in *Canon*² laid down that a lesser degree of similarity between the goods may be offset by a greater degree of similarity between the marks and vice versa. The complete identity between the goods of the opposed mark and those of the Opponent’s earlier marks offsets any lesser degree of similarity between the marks.

22. In its written submissions the Applicant argues that its RANDOM ACTS OF HAPPINESS mark is easily distinguishable from a visual, phonetic and conceptual

¹ OHIM Opposition case B832859 (decision of 18 April 2012) wherein PLAINPAY was successfully opposed on the basis of the earlier mark PLAIN.

² Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc. (1999) (Case C-39/97) 1 CLMR 77,95

perspective when compared with the invented term RANDOMS. The average consumer would not regard the word RANDOM separately from the words ACT OF HAPPINESS, and in any case, the Opponent does not hold any trade mark registration for the word RANDOM but instead for the invented term RANDOMS.

23. The Applicant argues that the Opponent's claimed use in advertising and marketing of phrases and slogans incorporating the term RANDOM are irrelevant as the Opponent has not claimed any rights in such phrases. The comparison must be based on the earlier marks relied upon in the Notice of Opposition namely RANDOMS and LET YOUR RANDOM SIDE OUT. The word RANDOM is an adjective which does not have a singular or plural form and in the earlier mark is used to describe a characteristic of a person while in the Applicant's mark it is used to describe the nature of a particular gesture. The suggestion by the Opponent that confusion is likely simply because the respective marks share the letters R-A-N-D-O-M is beyond far-reaching.

24. The Applicant argues that the evidence filed by the Opponent under Rule 22 at Exhibits "DC1" and "DC2" should be disregarded as they constitute new evidence not strictly in reply to the Applicant's evidence under Rule 21. However, the Applicant notes that the invoices (in "DC2") do not relate to either of the trade mark registrations upon which the opposition is based as they refer to the trade mark ROWNTREES RANDOMS. The Opponent has shown some use of the mark ROWNTREES RANDOMS, which in any event is irrelevant. The evidence of Aoife Hallihan, in respect of the AC Nielsen market-share data, also refers to the mark ROWNTREES RANDOMS. However, no evidence has been submitted to support the claim of use of the mark LET YOUR RANDOM SIDE OUT.

25. In summary the Applicant argues the following:

- i. The Opponent has failed to substantiate any claims regarding use and reputation of either of the marks RANDOMS and LET YOUR RANDOM SIDE OUT.
- ii. In reality the Opponent always uses the term RANDOMS in conjunction with the trade mark ROWNTREES. No evidence has been produced in relation to sales of goods bearing the word RANDOMS on its own.

- iii. The Examination Division of the Patents Office did not cite the Opponent's marks during the examination of the Applicant's application. Therefore the Office did not consider the earlier trade marks confusingly similar.
- iv. Having conducted a visual, phonetic and conceptual comparison between the respective marks it is clear the marks are completely different.
- v. The Opponent is attempting to dissect the Applicant's mark and to take a component of the mark and compare it with the Opponent's RANDOMS mark and the RANDOM element of the Opponent's LET YOUR RANDOM SIDE OUT mark. This is contrary to settled case law where in *COSMOBELLEZA*³ the Court held:

“Assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark. On the contrary, such a comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a complex trade mark may not, in certain circumstances, be dominated by one or more of its components. It is only if all the other components of the mark are negligible that the assessment of the similarity can be carried out solely on the basis of the dominant element. That could be the case, in particular, where that component is capable alone of dominating the image of that mark which members of the relevant public keep in their minds, so that all the other components of the mark are negligible in the overall impression created by it (see Case T- 7/04 Shaker v OHIM – Limiñana y Botella (Limoncello della Costiera Amalfitana shaker) [2008] ECR II- 3085, paragraph 40 and case-law cited).

Written Submissions filed in reply

26. Both parties responded to the written submissions of the other party. Nothing that would have a material bearing on the outcome of the proceedings was submitted by either party. Both responses were a reiteration of the position of the respective parties and a rebuttal of certain arguments of the other.

Section 10(2)

27. 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)

³ Hearst Communications, Inc. v Office for Harmonisation in the Internal Market (CJEU Case T-344/09)

(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.

28. 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 goods of the application must be identical with or similar to those in respect of which the earlier trade mark is protected, (iii) the mark applied for must be similar to that earlier trade mark, and, (iv) there must be a resultant likelihood of confusion on the part of the public.

29. The first two of these conditions are fulfilled in this case. The Opponent’s trade mark Registrations Nos. 239647 (RANDOMS) and 242436 (LET YOUR RANDOM SIDE OUT) were filed with this office on 10 July 2008 and 17 September 2009 respectively, 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. The goods of the application for registration are identical with or similar to the goods for which the Opponent’s earlier trade marks stand registered, as both specifications include “*Ice cream, water ices, frozen confections*”.

Comparison of the marks

30. These proceedings are based on the Opponent’s two earlier marks and I will, in turn, compare each with the mark at issue. 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*) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. I have based the comparisons on the visual, aural and conceptual similarity of the marks on the overall impressions given by them, rather than on specific points of detail that are likely to go unnoticed by the average consumer.

31. Firstly, looking at the Opponent’s RANDOMS mark. Clearly there is some degree of visual similarity with the Applicant’s RANDOM ACTS OF HAPPINESS mark, in that

the first six letters of each are R-A-N-D-O-M. The Applicant's mark contains three words that do not appear in the Opponent's mark which puts some distance between the marks from a visual perspective.

32. Aurally the marks are similar in respect of the opening two syllables. Because of the existence in the Applicant's mark of three additional words not found in the Opponent's mark there is clearly a high degree of verbal dissimilarity between the marks.
33. It is well established that the start of a word mark is generally the most important in terms of its visual and aural identity and the opening syllables of these marks are the same. However, in my opinion, that is not the case in this instance. The RANDOM element of the Applicant's mark is neither the dominant nor the distinctive nor the memorable component of the mark. In my opinion the average consumer is more likely to recall the ACTS OF HAPPINESS element than the RANDOM element. RANDOM merely describes or qualifies the type of ACTS OF HAPPINESS to be performed. Taking both marks as a whole I would assess the level of visual and aural similarity as low.
34. Conceptually, the Opponent's RANDOMS mark is an invented term that has no meaning. In its evidence and argument the Opponent emphasised that each of the respective marks contains the word RANDOM, but that is not strictly true. The Opponent's mark is RANDOMS not RANDOM. Asking a shopkeeper for a bag of RANDOMS sweets is not the same as asking for a random bag of sweets.
35. The word random is not a noun and as such it is neither singular nor plural. It is, however, a play on the adjective "random" that describes something that is selected by chance, chosen arbitrarily or happens unexpectedly, but I am satisfied that anyone encountering the Opponent's RANDOMS mark will make a link with the word random. In its written submissions the Opponent provides background to the adoption of the mark, explaining that it is based on current youth culture use of the term "random" and to reflect a characteristic of the contents of the packet of sweets bearing the mark. This is a reasonable explanation of the origin of the Opponent's mark when used for confectionary and the like. However, this explanation cannot hold true for all goods for which the Opponent's mark is registered. It begs the question as to why the mark is registered for a multitude of goods including, *inter alia*, meat, poultry, game, fish and seafood, which are

hardly items targeted at the youth population or capable of being produced with random characteristics. (Perhaps the Opponent had *bona fide* intentions of trading in chickens with random numbers of legs, which might appeal to families whose members all like a leg).

36. The Applicant's RANDOM ACTS OF HAPPINESS has clear meaning and refers to a gesture done in order to make someone happy. I find there is a very negligible level of conceptual similarity between the Opponent's RANDOMS mark and the Applicant's RANDOM ACTS OF HAPPINESS mark. I am satisfied that the overall level of similarity between the marks is very low.
37. Turning now to the comparison between the Opponent's LET YOUR RANDOM SIDE OUT and the mark at issue. Visually and aurally the marks share the word RANDOM, but nothing else. The words LET, YOUR, SIDE and OUT are unique to the Opponent's mark, while the Applicant's mark also contains the words ACTS, OF, and HAPPINESS. The Opponent's mark consists of five words with the word RANDOM as the third word. RANDOM is the first word of the Applicant's four-worded mark. It is clear these marks are far more dissimilar than similar. In my opinion they share a very low level of aural and visual similarity.
38. Conceptually, both marks consist of a phrase or slogan suggesting an action, but not the same type of action. On the one hand, the Opponent's mark suggests you let yourself go, or do something untypical, odd, outlandish or even dangerous, which may result in either a negative or positive reaction from others. On the other, the Applicant's mark suggests you do something that will make someone happy, which will always be received positively by others. On the basis that it is possible that letting one's random side out (i.e. doing something out of character) may result in the performance of an act of happiness, I find there is some degree of conceptual similarity between the respective marks, but it is at the low end of the scale.
39. Having completed an assessment of the Opponent's LET YOUR RANDOM SIDE OUT mark and the Applicant's RANDOM ACTS OF HAPPINESS mark I find the overall level of similarity to be very low. Therefore, both the Opponent's marks share a very low level of similarity with the Applicant's mark.

Likelihood of confusion

40. 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 Justice⁴ 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,
- 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

⁴ *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

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.

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

Degree of similarity between the marks and between the goods: For the reasons set out above, I regard the marks in question as having a very low level of similarity. However, the goods covered by the Application are identical to, or similar to, those of the earlier registrations.

Inherent distinctiveness of the earlier mark: The Opponent's marks have a high degree of inherent distinctiveness and have an obvious capacity to identify the goods for which they are 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 Opponents marks were used for up to two years prior to the Applicant applying for its mark. This is not an extensive period of use. However, significant sales of confectionary were achieved during that time. Therefore, I am satisfied the Opponent has acquired some additional distinctiveness through use and promotion.

Overall impression created by the marks: The overall impression created by the marks in question is that they are very different. The wording is very different and the concept is somewhat different.

The average consumer: 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.

Overall assessment of likelihood of confusion:

42. 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 trade marks and the Applicant's mark. The confusion in question may be direct confusion, whereby the Applicant's product is mistaken for that of the Opponent, or indirect confusion, whereby the Applicant's product is associated in the mind of the consumer with that of the Opponent and a common commercial origin is inferred. The principles set out above are very familiar to all practitioners in the field and inevitably provide a wealth of material for opposing parties to include in their submissions at hearings, which they did in this case. Nonetheless 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 of the goods in question. In essence I must judge the matter of the assessment of likelihood of confusion in accordance with ECJ guidance to decision-makers, which can be summarised as follows: *Imagine a typical purchasing scenario involving the average person who already knows the product sold under the earlier trade mark and ask yourself whether it is likely that he will select and purchase a product bearing the mark put forward for registration in the mistaken belief that it is the product he knows by the earlier mark (direct confusion) or that it is related to that product (indirect confusion by association).*

43. In the present case the visual, aural and conceptual differences between the said mark and the Opponent's marks are, in my opinion, so obvious that a person exercising reasonable care would be unlikely to select goods bearing the RANDOM ACTS OF HAPPINESS mark in place of one bearing either of the Opponent's marks. The trade marks do not look or sound sufficiently similar to make direct confusion between them a real likelihood. In my opinion, even allowing for imperfect recollection, confusion is unlikely.

44. It is settled case law that a lesser degree of similarity between the goods may be offset by a greater degree of similarity between the marks, and vice versa, 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.

45. In its evidence the Opponent mentions its use of other phrases containing the word RANDOM when advertising its products (e.g. “Random Protests”, “Random Reliant”). In particular, the Opponent argues that its use of the term “Random Acts of Kindness” would lead to confusion in the marketplace as between the two party’s marks. However, no evidence has been produced to lead me to conclude that this phrase was used in a trade mark sense in connection with the Opponent’s goods. The only mention of that phrase appears on a single chart titled “2009 Sampling Activity”, which identifies five categories of activity (festivals, sampling, events, big game days and other) to be undertaken in promoting the Opponent’s goods.
46. “Random acts of kindness” appears in the “other” category alongside “laughter lounge”, “train conductor”, “random protests” and “beach/park run”. It appears to me that this chart is for the Opponent’s internal use only and there is no evidence to suggest the phrase (or any other phrase in the “other” category) made its way into the public domain and would be recognised by the average consumer as being associated with the Opponent’s goods. Accordingly, I reject the Opponent’s claims that its use of the phrase “random acts of kindness” would lead to confusion in the marketplace.
47. For these reasons, I have decided that the prior registration and use of the trade marks RANDOMS and LET YOUR RANDOM SIDE OUT do not constitute grounds for refusal, under Section 10 of the Act, of the application to register RANDOM ACTS OF HAPPINESS. Therefore, I have decided to dismiss the opposition and to allow the application to proceed to registration.

Dermot Doyle

Acting for the Controller

12 September, 2014