

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

BETWEEN

ANN KILGALLON (Proprietor)

and

EVE St. LEGER t/a Flair Confectionery (Applicant for Declaration of Invalidity)

CONCERNING

Trade Mark No. 237276

The registered trade mark

1. ANN KILGALLON, of 38 Salthill Apartments, Monkstown, Co. Dublin, Ireland is the registered proprietor of this Trade Mark (“the said mark”),



which is registered in class 30 in respect of ‘*chocolate and confectionery products proper to this class; drinking chocolate*’.

The application for registration of the mark was filed on 23 August, 2007 and, by virtue of Section 45(3) of the Act, the mark is registered as of that date. Publication of the registration of the mark appeared in Journal No. 2095 dated 2 April, 2008.

Application for declaration of invalidity

2. On 12 May, 2008, EVE St. LEGER trading as FLAIR CONFECTIONERY of College Road, Co. Cork, Ireland applied under Section 52 of the Trade Marks Act, 1996 (“the Act”) for “the Revocation of the Register by removal therefrom of the registration” (sic)

and included with the application a statement of the grounds on which it was made. The provisions of that section of the Act deal with the Invalidation of Trade Marks and it was clarified by the Applicant and accepted by the Controller and the Proprietor that this was indeed an Application for Invalidation not for Revocation. On 18 August, 2008 the Proprietor filed a Notice of Opposition against the application under Rule 41(3) of the Trade Mark Rules, 1996 (“the Rules”). Evidence submitted by the Applicant consisted of a Statutory Declaration and evidence by way of two Exhibits (E1 and E2) dated 3 October, 2008. No further evidence, statements or counter-statements were filed.

3. The matter became the subject of a hearing before me, acting for the Controller on 6 May, 2010. The parties were notified on 2 June, 2010 that I had decided to refuse the application and to allow the registration of the mark to stand. I now state the grounds of my decision and the materials used in arriving thereat in response to a request by the Applicant in that regard pursuant to Rule 27(2) filed on 9 June, 2010.

Grounds of the Application

4. In its Statement of Grounds in support of the application for a Declaration of Invalidation, the Applicant makes a number of statements and claims, which I summarise as follows:
 - (i) The Applicant is the Proprietor of Trade Mark Registration No. 162371 (EVE A LITTLE TEMPTATION logo) (“the earlier mark”), shown below, and enjoys a substantial reputation in Ireland under that mark.



- (ii) The Applicant’s turnover under the mark during the years 2002 to 2006 inclusive amounted to over €750,000, with each year showing an increase over the previous year.
 - (iii) The Applicant’s expenditure on advertising between 2002 and 2007 was almost €50,000.

- (iv) The word 'EVE' is the dominant element of both the Applicant's and the Proprietor's marks and the goods covered by both registrations are identical or similar. Therefore, there exists a likelihood of confusion, including a likelihood of association, on the part of the public between the two marks.

Notice of Opposition

5. In its Notice of Opposition the Proprietor denies all the claims made by the Applicant in the Statement of Grounds and states that if the word 'EVE' is the dominant element of the mark (which is not admitted) the said word is presented in a stylised form and is thus distinguishable from any depiction of the word 'EVE' in the Applicant's Trade Mark.

Evidence submitted

6. The Statutory Declaration submitted by the Applicant repeated the claims made in the Statement of Grounds and the exhibits provided supporting evidence. No evidence was filed by the Proprietor.

Notice under Rule 61(5)

7. On 26 April 2010 the Proprietor gave notice of its intention to refer at the Hearing to packaging used in connection with and displaying the said mark, and enclosed a sample of that packaging with the notice. Subsequently, on 28 April, 2010, the Proprietor gave notice of its intention to refer at the Hearing to another item of packaging, used in connection with and displaying another mark, and enclosed a sample of that packaging with the notice also. In both cases the packaging consisted of a box within which the Proprietor claimed it sold chocolates.

The Hearing and Arguments of the Parties

8. At the Hearing the Applicant was represented by Mr. Cliff Kennedy, Trade Mark Agent of MacLachlan & Donaldson and the Proprietor by Mr. Seamus Doherty, Trade Mark Agent of Cruickshank & Co.
9. A summary of the main issues from the Hearing is as follows:
- i. Mr. Kennedy enquired as to why the boxes, referred to above, were belatedly filed and, having received an explanation from Mr. Doherty, he objected to their admission

as evidence. Mr. Kennedy argued that their inclusion would amount to an admission of further evidence, which was contrary to the basic principles enunciated by a number of Courts. He did, however, express his willingness to have the boxes 'left on the table', as long as they were not deemed to be evidence but merely examples of packaging, which in his view, rendered them irrelevant, as the box, upon which the said mark was depicted, was not registered or at issue in these proceedings, and nor was the said mark registered in relation to packaging. I agreed with Mr. Kennedy's position on this matter and deemed the boxes inadmissible as evidence.

- ii. Mr. Kennedy objected also to Mr. Doherty's attempts to introduce, as evidence at the Hearing, other assertions of fact, including references to the genesis of the Proprietor's mark, sales figures, retail outlets, price, target customers and the contents of packaging.
- iii. I ruled all this evidence to be inadmissible save the information regarding the genesis of the said mark, which I allowed as it was being provided in reply to a direct question, asked by Mr. Kennedy during his oral submission, on that specific point.
- iv. In turn Mr. Doherty argued that the claims made in the Applicant's Statement of Grounds, in respect of turnover and advertising, had not been proven and should be disregarded as evidence also. However, these 'claims' were items of fact and therefore admissible, since they had been submitted in the form of a Statutory Declaration, supported by evidence; the existence of which Mr. Doherty was unaware.
- v. In terms of the legislation both parties confined their arguments to the provisions of Section 10(2)(b) of the Act, which concerns the likelihood of confusion on the part of the public, which includes the likelihood of association, of the Proprietor's mark with the earlier mark of the Applicant. This is the relevant Section on which this case rests and on which I have decided the matter.

Section 10(2)(b)

10. 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.

11. 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.

12. The first two of these conditions are clearly fulfilled in this case. The Applicant’s mark was filed, at this Office, prior to 23rd August, 2007 (the relevant date) and by virtue of Section 11(1)(a) of the Act, is an earlier trade mark as against the Proprietor’s mark for the purposes of Section 10. The goods of the Proprietor’s mark are identical with or similar to the goods for which the Applicant’s earlier trade mark stands protected, as both specifications of goods include ‘confectionery’ and ‘chocolate’.

Comparison of the marks

13. 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 protected by the marks. 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*)¹ that the average consumer normally perceives a mark as a whole and does not proceed to analyse its

¹ Paragraph 23 of decision dated 11 November, 1997

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.

Visual comparison of the marks

14. Visually the marks are very different. Both marks have figurative elements that do not relate in any way to the goods in respect of which the marks are registered, nor are they pictorial representations of any of the word elements of the marks. The Applicant's mark comprises three main elements – a very large fig leaf, the word 'EVE' and the phrase 'A Little Temptation'. There is also a second fig leaf, which is much smaller than, and different in colour to, the large fig leaf.
15. There are two elements to the Proprietor's mark, the highly-stylised word 'EVE', with its backward-facing second 'E' and a positioning of the 'V' below the two 'Es', and the Egyptian ankh symbol, which, I am informed, is the hieroglyphic sign for 'eternal life'.
16. Notwithstanding the unusual arrangement of the letters of the said mark I see the letters as forming the word 'EVE', though some consumers may not perceive instinctively this to be the case. Some may see this part of the said mark as a solid shape split apart by a v-shaped wedge. Another feature of the said mark is that it is constructed in such a fashion so that the right side is a mirror image of the left side (there is a vertical axis of symmetry through the entire centre of it), which gives it an iconic or geometric look, as distinct from the free-form look of the Applicant's mark. In my opinion the said mark has the appearance of a symbol you might see in a church.
17. There is some visual similarity in that both marks contain the word 'EVE', but that similarity is diluted greatly as that word is presented in completely different styles in each case. There is far more visual difference than there is visual similarity between the marks and even allowing for the presence of 'EVE' in both marks I cannot consider the overall level of visual similarity to be anything other than extremely low.

Aural comparison of the marks

18. When compared from an aural perspective there is similarity between the marks. That similarity is, like the visual similarity, confined to the word 'EVE'. While the said mark

does not contain any other aural elements the Applicant's mark contains the additional words 'A LITTLE TEMPTATION'. The phrase 'A LITTLE TEMPTATION' does not relate to or describe in any way the goods in respect of which the marks are registered, nor is its function to qualify the 'EVE' element; it has standing in its own right. Even though this phrase is depicted in smaller lettering than the word 'EVE', it does catch the eye (which is of course its intention) and is very much part of the verbal make-up of the Applicant's mark. If I were asked to read the Applicant's mark I would speak the words 'EVE A LITTLE TEMPTATION' instinctively. I would not ignore the 'A LITTLE TEMPTATION' part.

19. The word 'EVE' is the first word of both marks and this does have the effect of creating a greater sense of verbal similarity than if the word 'EVE' were located, say, at the end of the Applicant's mark. Taking this into account, I am satisfied, nonetheless, that there are significant verbal differences between the marks, to such an extent that I would assess the single word 'EVE' as having a low to medium level of aural similarity compared to the words 'EVE A LITTLE TEMPTATION'.

Conceptual comparison of the marks

20. The conceptual assessment or appreciation of a mark is an individual thing and should be carried out independently from others. If one has to be educated as to what the concept of a mark is then it fails to make the impact intended. With any given mark one consumer may see something that another may not, or one may not see any particular concept at all, despite the best efforts of those associated with the mark. It is important to say this because in these proceedings the Proprietor made statements explaining the conceptual meaning of the said mark, which were not in tune with my instinctive impressions of it.
21. On the other hand with some marks the concept is obvious, as is the case with the Applicant's mark. All elements of the Applicant's mark, the female name 'EVE', the fig leaves, and the phrase 'A LITTLE TEMPTATION' convey immediately and instinctively the notions of the Garden of Eden and 'original sin', which are concepts familiar to most consumers in this State. The mark does not convey a general concept of the first woman 'Eve', but a specific concept, that being the tempting by Eve. The Applicant is clearly linking the goods sold under its mark (confectionery and chocolate for the purposes of these proceedings) with temptation, indulgence and sin (not in a sense of wilful or

deliberate violation of some religious or moral principle, but in a sense of a lack of strength to abstain), and teases that its goods may not be good for you, but they are too good to resist. Despite the fact that the temptation in the Garden of Eden was directed at Eve's male companion, I find the message in the Applicant's mark targets both sexes.

22. The concept of the said mark is not so obvious. While it contains a version of the word 'EVE', it is not identifiable readily with any particular woman called Eve. Some consumers may not even see it as 'EVE'. The ankh symbol may be seen as a cross associated with Christianity (which I confess is what I perceived it to be until informed otherwise). Having said that, I find that the said mark contains a version of the word 'EVE' that is a reference to the female forename 'Eve', but I do not see it identifying any specific 'Eve'. The figurative element (now that I know that it is the symbol for eternal life) can be considered unisex and, therefore, does not help me to identify any particular 'Eve' either. It does not qualify the 'Eve' in any way or describe any trait, quality, feeling, act, thought, possession or thing associated with her.
23. So, on the one hand there is a concept of the 'Eve', of Garden of Eden and 'original sin' fame, and on the other a concept of an 'Eve' and eternal life. I find it would be stretching it a bit too far to infer that the presence of a version of the word 'EVE' and an Egyptian symbol in the said mark equates to both marks conveying identical or highly similar concepts. Overall, I would assess the marks as having a low to medium level of conceptual similarity.

Dominant and distinctive elements

24. At the Hearing Mr. Kennedy put great emphasis on the 'EVE' element of the marks, describing them as the distinctive and dominant components of both. I find this to be the case in respect of the said mark as the 'EVE' element is larger and more dominant than the figurative element and it comprised the totality of the verbal element. However, I do not find that 'EVE' dominates the Applicant's mark to the same degree as it does the said mark. There is no question that it is the dominant verbal element of the Applicant's mark. However, because of its large size and black colour, the fig leaf is, without doubt, a significant part of the Applicant's mark and catches the eye, making it a contender for the title, and I think it unlikely that the average consumer would fail to notice it. It is important to ensure that, when attempting to identify the dominant component of a

complex mark (the Applicant's mark is such a mark), one understands the meaning of the term and accepts that there may not be a dominant component. While one component may be more, or even slightly more significant than another component this does not mean that it is dominant, i.e. dominates the mark. In order for one component of a complex mark to dominate the mark that component must stand way above all other components to such a degree that it renders the other components insignificant or negligible. In the case of the Applicant's mark the word 'EVE' fails to do this.

25. There is a lot more going on with the Applicant's mark than just the word 'EVE'. So much so that, in my opinion, if the 'EVE' component were removed from the Applicant's mark, the components remaining would allow it to be recognised still as being associated with the Applicant. Removing the 'EVE' from the said mark would not have the same result. In assessing the components of the Applicant's mark, in terms of distinctiveness and dominance, I find the word 'EVE' to be the most distinctive verbal component, but I find the mark does not have a single dominant component.

26. Having completed a global assessment, I have come, unsurprisingly, to the conclusion that the overall impression given by the marks is that they are different and I find, therefore, that the two marks have a low level of overall similarity.

Likelihood of confusion

27. 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 Justice² in this area and they include the following:

- the likelihood of confusion must be appreciated globally, taking into account all of the relevant factors,
- a global assessment of likelihood of confusion implies some interdependence between the relevant factors and, in particular, between the extent of the similarity of the respective marks and that of the respective services,

² 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

- a lesser degree of similarity between the respective marks may be offset by a greater degree of similarity between the respective services, and vice versa,
- the more distinctive the earlier mark, the greater will be the likelihood of confusion resulting from the use of a similar mark,
- in determining the distinctive character of the earlier mark, an overall assessment must be made as to its capacity to identify the relevant services and distinguish them from those having a different origin,
- in making that assessment, account must be taken of the inherent characteristics of the mark and also of the distinctiveness it may have acquired through use,
- the global appreciation of the likelihood of confusion must, as regards the visual, aural or conceptual similarities of the respective marks, be based on the overall impression likely to be created by them in the mind of the average consumer having regard to their distinctive and dominant components,
- for the purposes of that assessment, the average consumer of the services is deemed to be reasonably observant and circumspect but account must be taken of the fact that the average consumer rarely has the chance to make a direct comparison of the respective marks and must rely on his imperfect recollection of them.

28. 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 in paragraphs 14-25 above, I regard the marks in question as having a low level of similarity. However, the said mark and the Applicant's mark cover similar or identical goods ('confectionery' and 'chocolate'). In determining whether a likelihood of confusion exists, I must be mindful that a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods and services³. 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.

³ Lloyd Schufabrik Meyer & Co. GmbH v. Klijsen Handel BV (C342/97) [1999] 2 C.M.L.R. 1343, para 19

Inherent distinctiveness of the earlier mark: The Applicant's mark may be regarded as having a high degree of inherent distinctiveness. It 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 Applicant's mark has been in use since 1993, but the evidence submitted by the Applicant does not suggest to me that a significant proportion of the relevant public would identify the Applicant's goods by reference only to the trade mark. While €50,000 was spent in advertising between 2002 and 2007, the target audience was based typically in Cork and the surrounding counties. Notwithstanding that turnover exceeded €750,000 during the same period this does not indicate significant market share of the chocolate business in the State, nor do the invoices submitted signify extensive geographic penetration (the invoices with the highest value sales are all to customers in Cork). It appears to me that the majority of the Applicant's sales are through its single retail outlet in Cork. Therefore, I am not satisfied that it has acquired the substantial additional distinctiveness through use and promotion necessary to justify it being afforded an increased level of protection.

Overall impression created by the marks: The overall impression created by the marks in question is that they are very different. The wording is different, the concept is different and, most importantly in my opinion, the different figurative elements of the marks reinforced significantly that difference.

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.

29. Applying those criteria to the present case, it can be said that the comparison is between only very slightly similar marks used in relation to identical or similar goods, which goods are of low value and are purchased by consumers generally and without the application of very serious consideration to the purchase decision.
30. In looking at the question of likelihood of confusion I must do so from a marketplace perspective 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 said mark 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).* 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 invalidate the registration of a trade mark by reason of Section 10(2)(b). The question is whether it is likely or unlikely that the average person would be confused in the course of the typical purchasing scenario.

31. At the Hearing Mr. Kennedy outlined a typical purchasing scenario and suggested that there can be little doubt that when a customer wishes to purchase the Applicant's product he/she would ask for a box of 'EVE' chocolates and suggested the same would be true if a consumer wishes to purchase one of the Respondent's products. In Mr. Kennedy's opinion this was compelling argument for the existence of a likelihood of confusion. This is an important point that I must address.
32. Firstly, chocolates bearing the marks may be referred to as 'EVE' chocolates, but this does not make the Applicant's or the Proprietor's mark 'EVE'. As Mr. Kennedy mentioned at the Hearing, the Applicant has applied for the trade mark 'EVE' (the word alone without any stylisation or figurative components) in its own right, demonstrating clearly that the Applicant itself sees a difference between its earlier mark and the single word 'EVE'.
33. Secondly, the goods on offer under the Applicant's and the Proprietor's marks are low cost items typically found in high street stores where the consumer has the opportunity to examine the goods before making a purchase. They are not products that the consumer must ask for, as is the case with goods containing tobacco. They would be placed most likely on a shelf for self-selection. Therefore the visual characteristics of the trade marks, in my opinion, must be considered more significant than the aural in determining the likelihood of confusion. In the present case the visual dissimilarity between the marks is so obvious that I do not believe the consumer would be likely to be confused.

34. Having said that, I have looked at the possible outcomes of scenarios where a consumer asks for a box of 'EVE' chocolates. If the product is requested over the telephone or someone is asked to go to the shop for a box of 'EVE' chocolates, then the requester is transferring responsibility for the selection of the product to a third party. In such circumstances, by being absent at the moment of selection, the end consumer loses his ability to repeat a positive or avoid a negative experience of a particular product bearing a particular mark. In order for a likelihood of confusion to exist it must be present in the mind of the end consumer and arise when they are the person making the selection and have the opportunity to view and examine, at first hand, the trade mark. So, in this scenario, the question of likelihood of confusion cannot be considered relevant.
35. If the request is made at a shop counter the shop-assistant will select the appropriate chocolates stocked by the shop, be they from the Applicant or the Proprietor. If the shop stocks products from both the Applicant and the Proprietor, both will be presented and the customer will be asked to choose. Either way, before making a purchase, the requestor has an opportunity to view the product(s) presented and examine them in order to satisfy himself/herself of their origin before making a purchase. In carrying out that examination I believe the marks are so dissimilar that the average consumer would not be likely to confuse, or even associate, the Applicant's mark with the Proprietor's mark, notwithstanding that he/she may be relying on an imperfect recollection of either mark.
36. At the hearing it was suggested that anyone familiar with the Applicant's mark, would on encountering the said mark, assume that the product had been re-branded. Such a branding change would be a major departure from the typical re-branding practices in trade, which are centred on evolutionary steps, wherein subtle changes are made, but the core identity of the brand is maintained. The re-branding alluded to in this case would be dramatic and revolutionary and, in my opinion, would result in a loss of brand identity. Therefore, I do not accept this proposition.

Decision

37. In reaching the above conclusions I have taken account of the fact that 'EVE A LITTLE TEMPTATION (logo)' is an inherently distinctive trade mark and that the likelihood of confusion arising from the use of a similar mark is increased accordingly. In my opinion,

however, the features of 'EVE A LITTLE TEMPTATION (logo)' that give it its distinctiveness are different to those that give 'EVE (logo)' its distinctive character and that, in the present case, the similarity of the marks is so low, that it is more superficial than real, such that confusion is not likely in practice. For these reasons, I have decided that the application for invalidation of mark No. 237276 is not supported and should be rejected.

Dermot Doyle

Acting for the Controller

21st July, 2010