

**THE HIGH COURT  
COMMERCIAL**

**2007 NO. 103 SP  
2007 NO. 52 COM**

**IN THE MATTER OF THE TRADE MARKS ACT, 1996  
AND IN THE MATTER OF AN APPLICATION PURSUANT TO THE TRADE MARKS ACT, 1996 BY REYNOLDS METALS COMPANY DATED  
24TH OCTOBER, 2001 FOR REGISTRATION OF "TUB-ITS" AS A TRADE MARK IN CLASS 21 OF THE REGISTER OF TRADE MARKS**

**BETWEEN**

**COFRESCO FRISCHHALTERPRODUKTE GmbH & CO. K.G.**

**PLAINTIFF**

**AND  
THE CONTROLLER OF PATENTS, DESIGNS AND TRADE MARKS  
AND  
REYNOLDS METALS COMPANY**

**DEFENDANTS**

**Judgment of Ms. Justice Finlay Geoghegan delivered the 14th day of June, 2007.**

1. The plaintiff ("Cofresco") is the registered proprietor of a Community Trade Mark No. 001377514 TOPPITS (logo) which is registered for goods in classes 6, 16 and 21. The second named defendant ("Reynolds") applied on 24th October, 2001, to register TUB-ITS as a trade mark. A notice of opposition was filed on behalf of Cofresco. Following a hearing, a decision was given on 9th November, 2006, on behalf of the first named defendant ("the Controller") dismissing Cofresco's opposition. The written grounds of that decision by the Hearing Officer are dated 29th November, 2006.

2. Cofresco brings this appeal against the decision of the Controller dismissing its opposition pursuant to s. 79 of the Trade Marks Act, 1996.

**The appeal**

3. Section 79 of the Act of 1996 provides:

"(1) Unless otherwise provided by rules of court, within the period of three months from the date of a decision of the Controller under this Act, an appeal shall lie from the decision to the Court.

(2) On an appeal under this section—

(a) the Controller shall be entitled to appear and be heard, and shall appear if so directed by the Court: and

(b) the Court may exercise any power which could have been exercised by the Controller in the proceedings from which the appeal is brought.

(3) By leave of the Court, an appeal from a decision of the Court under this section shall lie to the Supreme Court on a specified point of law."

4. At the date of commencement of these proceedings (8th February, 2007) there were no Rules of Court specifically applicable to appeals pursuant to this section. Order 94, r. 48 of the Rules of the Superior Courts applied to appeals brought pursuant to s. 25 of the Trade Marks Act, 1963 and provided that they should be by way of re-hearing and, except with special leave of the Court, on the same evidence as that before the Controller.

5. The Controller did not appear at the hearing before the Court. He was not obliged to do so as no direction had been given under s. 79(2)(a) of the Act of 1996. Insofar as in this judgment I refer to "the parties", I am referring to the plaintiff and second named defendant being the parties appearing at the hearing. It was common case between the parties that, having regard to s. 79(2)(b) of the Act of 1996, this appeal is a re-hearing and that the Court must consider and determine the same issue that was before the Controller, namely Cofresco's opposition to the registration of Reynolds' trade mark. This appears correct. It was also agreed that it be determined on the evidence before the Controller and exhibited in the grounding affidavit herein.

**Ground of opposition**

6. Only one ground of opposition was pursued by Cofresco before the Hearing Officer. The same ground is the subject matter of this appeal. It is that the application for registration should be rejected having regard to s. 10(2)(b) of the Act of 1996. This provides:

"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."

7. It is common case that Cofresco's trade mark is "an earlier trade mark" within the meaning of s. 10(2)(b). It is also agreed that Reynolds' trade mark would be registered for goods which are either identical or similar to the goods for which Cofresco's trade mark is protected. The goods for which Reynolds has sought registration are within Class 21 and specified as "storage containers, not of common metal, for household and kitchen use". Cofresco's trade mark is registered for Class 21.

8. The single issue to be determined is whether there is a likelihood of confusion between the Cofresco trade mark TOPPITS and the Reynolds' trade mark TUB-ITS within the meaning of s. 10(2)(b) of the Act of 1996.

9. Counsel for Cofresco and Reynolds are in substantial agreement as to the general principles to be applied by the Court in assessing the likelihood of confusion. These follow in particular from a number of decisions of the European Court of Justice. They are well summarised in the written submissions filed on behalf of Cofresco as follows:

"1 In determining and assessing the likelihood of confusion for the purpose of section 10(2)(b), account must be taken of all the circumstances of the case, including the degree of similarity between the two marks and between the goods or services, the likelihood that the public will make an association between the earlier mark and the mark in respect of which registration is sought, and the distinctiveness of the earlier mark. [Case C-251/95 *Sabel BV v. Puma AG* [1997] 1 E.C.R. I-06191 (paragraph 22)].

2 In assessing the degree of similarity between two marks, the decision maker must determine the degree of visual, aural and conceptual similarity between them and, where appropriate, evaluate the importance to be attached to those different elements, taking account of the category of goods or services in question and the circumstances in which they are marketed. [Case C-342/97 *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel BV* [1999] E.C.R. I-03819 (paragraph 27)] For this purpose the average consumer is deemed to be reasonably well informed, reasonably observant and circumspect. [*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel BV* (paragraph 26)]

3 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,. Each mark must be viewed as a whole and should not be dissected for the purposes of a comparison. This is because the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. [*Sabel BV v. Puma AG* (paragraph 23)]

4 The higher the degree of distinctiveness of the earlier trade mark the greater the protection granted to it and vice versa. [*Sabel BV v. Puma AG* (paragraph 24); Case C-39/97 *Canon Kabushiki Kaisha v. Metro-Goldwyn-Meyer Inc.* [1998] E.C.R. I-05507 (paragraph 18)] Distinctiveness may be inherent or enhanced by a reputation which the mark enjoys on the market. [*Canon Kabushiki Kaisha v. Metro-Goldwyn-Meyer Inc.* (paragraph 18)]"

10. Detailed oral submissions were made on the extent to which a decision maker, whether a hearing officer or judge, can bring to bear his/her own experience as a consumer in assessing the likelihood of confusion and for that purpose the circumstances in which the goods in question are marketed or the probable purchasing practices of consumers of such goods.

11. The goods in question are essentially low-cost plastic re-sealable containers for general household or kitchen use. Counsel for Cofresco accepted that they were goods which in general are purchased by self-service in a supermarket context. They are not goods which are subject to any particular marketing or selling practices. No evidence was adduced before the Controller of any particular marketing or selling practices.

12. In such circumstances, it appears to me that the proper approach of a judge in bringing to bear his/her own experience as a consumer remains in accordance with the principles set out in the speech of Lord Diplock in the House of Lords in *GE Trademark* [1973] R.P.C. 297 where, at p. 321 in the context of a dispute as to whether the Court of Appeal should have confined itself to consideration of evidence of public opinion survey or were permitted to bring into account their own subjective impressions as to whether they themselves would have been likely to be confused, he stated:

"My Lords, where goods are of a kind which are not normally sold to the general public for consumption or domestic use but are sold in a specialised market consisting of persons engaged in a particular trade, evidence of persons accustomed to dealing in that market as to the likelihood of deception or confusion is essential. A judge, though he must use his common sense in assessing the credibility and probative value of that evidence is not entitled to supplement any deficiency in evidence of this kind by giving effect to his own subjective view as to whether or not he himself would be likely to be deceived or confused. In the instant case this would apply to the large industrial electrical machinery sold under the Rondel Mark. But where goods are sold to the general public for consumption or domestic use, the question whether such buyers would be likely to be deceived or confused by the use of the trade mark is a 'jury question'. By that I mean: that if the issue had now, as formerly, to be tried by a jury, who as members of the general public would themselves be potential buyers of the goods, they would be required not only to consider any evidence of other members of the public which had been adduced but also to use their own common sense and to consider whether they would themselves be likely to be deceived or confused.

The question does not cease to be a 'jury question' when the issue is tried by a judge alone or on appeal by a plurality of judges. The judge's approach to the question should be the same as that of a jury. He, too, would be a potential buyer of the goods. He should, of course, be alert to the danger of allowing his own idiosyncratic knowledge or temperament to influence his decision, but the whole of his training in the practice of the law should have accustomed him to this, and this should provide the safety which in the case of a jury is provided by their number. That in issues of this kind judges are entitled to give effect to their own opinions as to the likelihood of deception or confusion and, in doing so, are not confined to the evidence of witnesses called at the trial is well established by decisions of this House itself."

13. As appears, a judge may bring to bear his/her own experience as a potential buyer and common sense in assessing the likelihood of deception. It appears similarly permissible for a judge to bring to bear his/her own experience in determining the probable purchasing scenario of the goods in question in which the likelihood of deception must be determined. In doing so, regard should also be had, (in the absence of evidence to the contrary) to some well-established assumptions about general consumer behaviour.

14. Counsel for Cofresco placed particular reliance upon the fact that as the goods in question here are low cost goods that it is probable that they will be bought in a way in which there will be no careful or in-depth examination of the mark. In *Unilever plc v. Controller of Patents, Designs and Trade Marks and Anor* [2006] IEHC 427 (Unreported, 15th December, 2006) Smyth J. stated at p. 17:

"In my judgment, it is relevant, in considering the issue of the confusion, to consider the goods in respect of which the applicant seeks to register the mark. Dishwasher products are everyday household goods. The ordinary assumption that no very careful or in depth examination of the mark will be made therefore applies (Kerly 17.06)."

15. On the facts of this case I am satisfied that I should assume that no very careful or in-depth examination of the relevant trade marks would be made in the purchase of the goods concerned.

16. Counsel for Cofresco also submitted that I should take into account the fact that the average consumer only rarely has the

chance to make a direct comparison between the marks; is more likely to be purchasing the respective goods with a time difference and will have an imperfect recollection of the earlier mark. He referred in particular to what was stated by the European Court of Justice in *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijen Handel BV* at para. 26:

"For the purposes of that global appreciation, the average consumer of the category of products concerned is deemed to be reasonably well-informed and reasonably observant and circumspect (see, to that effect, Case C-210/06 *Gut Springenheide and Tusky* [1998] ECR I-4657, paragraph 31). However, account should be taken of the fact that the average consumer only rarely has the chance to make a direct comparison between the different marks but must place his trust in the imperfect picture of them that he has kept in his mind. It should also be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question."

17. I agree that such imperfect recollection should be taken into account. Criticism was made by counsel for Cofresco of the approach of the Hearing Officer herein to the probable purchasing scenario insofar as he discounted the likelihood of confusion by reason of his view that the average consumer would be likely to pay at least as much attention to functional considerations as he would to brand names in choosing plastic kitchen and household storage containers.

18. I accept that the Court should not take a similar approach. It does not appear a permissible consideration. Rather the context in which the Court should make an assessment of the likelihood of confusion is as set out by the Hearing Officer at para. 20 of his decision namely:

"In making an assessment of the likelihood of confusion, the scenario to be considered is that of the average consumer, who must be assumed to be already familiar with the Opponent's product sold under its earlier trade mark, being exposed in the course of a typical shopping experience to goods bearing the mark applied for."

## Conclusion

19. I have assessed the likelihood of confusion between the trade mark 'TUB-ITS', if registered, and the earlier registered trade mark 'TOPPITS' in accordance with the above principles and have concluded that there is not a likelihood of confusion.

20. In reaching this conclusion I have taken into account that the goods in question are identical or very similar; they are low-cost goods; they will be primarily purchased in a self-service supermarket context; there may be a time gap from one purchase to the next; a purchaser may not be presented simultaneously with goods bearing both trade marks; a purchaser may have an imperfect recollection of the trade mark 'TOPPITS' at the time of potential purchase of goods with the mark 'TUB-ITS' and the goods are of a nature where, as a matter of probability, there will not be detailed examination of the trade mark.

21. I have reached this conclusion having made a global assessment of the visual, aural and conceptual similarities of the marks by reference to the overall impression of the marks bearing in mind their distinctive and dominant components.

22. I recognise that there are aural similarities of 'TOPPITS' and 'TUB-ITS'. However, in the probable purchasing scenario it appears to me that the visual and conceptual characteristics of the marks are more important than the aural. The goods appear to me, as a matter of probability, likely to be purchased following visual inspection. Insofar as a consumer may have an imperfect recollection of the mark 'TOPPITS', it appears to me the visual and conceptual aspects of the two marks are likely to be more important than the aural to such imperfect recollection.

23. The visual similarities of the marks are that they each begin with the letter 'T', have six letters and end with "ITS". The differences include 'TOPPITS' being one single word and 'TUB-ITS' being a hyphenated word. The visual impact of the hyphenated and non-hyphenated words is different. However, more importantly the dominant visual impact is made by the first syllable of each mark. It appears appropriate that I should have particular regard to this. As Smyth J. stated in *Unilever v. Controller of Patents, Designs and Trade Marks*:

"Whether two words are used or a compound word is used, if the emphasis is clearly on the first word or prefix in the compound word then it seems to me that that is the predominant sound and the visual impact of the mark.

24. In the English language the words "top" and "tub" are well known, commonly used words with distinctive meanings. The dominant visual impact of each mark being associated with "tub" and "top" respectively appear to me quite distinctive and not likely to lead to confusion.

25. Conceptually the marks also appear not to be similar in the English language. 'TUB-ITS' is a clear conjoining by the hyphen of two easily recognised words commonly used in the English language, the first of which has a clear connection with the type of goods to which it will be applied. It creates an idea of placing some item or items (ITS) in a container (TUB). The impact of TOPPITS on the experienced hearing officer was that of a meaningless invented word. The impact on other consumers may be similar. Its impact on me is of an invented word but not totally meaningless. It conjures an idea of covering in the sense of placing a top (TOP) on an item or items (ITS). On either basis the conceptual impact is distinct from that created by the obviously meaningful TUB-ITS written as it is.

26. In reaching the above conclusion I have carefully considered the judgment given by the Rechtbank's-Gravenhage [District Court of the Hague] on 19th July, 2006 in a similar dispute between the parties herein in relation to the same two trade marks. There is, of course, the important difference between the assessments made in the respective proceedings that the consumers in Ireland are predominantly English speaking. It was common case between the parties that the likelihood of confusion in this jurisdiction in these proceedings must be assessed in that context. Whilst the Court in the Hague did take into account the fact that qualified public in the Benelux countries competent in English might comprehend 'TUB-ITS' in a more descriptive way (in the context of conceptual similarity) it appears to me that the distinct visual impact of the dominant first syllables of 'top' and 'tub' and conceptual differences referred to above did not impact on the judges in that jurisdiction as they have on me. Language may account for this difference.

27. It also appears that, in accordance with the principles set out above, the Court in the Hague concluded that, by reason of the use of 'TOPPITS' as a trade mark since at least 1985 and an annual turnover in Belgium and the Netherlands of approximately €7 million in the period 1999 to 2005 and amounts spent on promoting the mark, that 'TOPPITS' had "a large degree of distinctiveness and enjoys a considerable degree of consumer awareness". Such a conclusion on the facts may have justified a higher level of protection.

28. On the facts herein I do not consider that Cofresco has made out a case for the Court in this jurisdiction, to take into account a

particularly high degree of distinctiveness of the earlier trade mark 'TOPPITS' such as it should be granted greater protection in accordance with the principles set out above. Cofresco has given no evidence of any use of the trade mark in the Irish market, therefore it cannot gain an enhanced reputation by reason of such use. It is distinctive, as one would expect of a registered trade mark. However, it does not appear to me that it has any particularly inherent distinctiveness which would justify the Court granting to it a higher level of protection than would be the norm created by the registration of a trade mark.

**Order**

29. The plaintiff's appeal fails. I will hear counsel as to whether, having regard to s.79(2)(b) of the Act of 1996 and the fact that this hearing is a re- hearing of Cofresco's opposition to the registration of the trade mark the appropriate order is:

- i. an order dismissing the plaintiff's appeal; or
- ii. an order dismissing the plaintiff's opposition to the registration of the trade mark TUB-ITS.