

IN THE INTELLECTUAL PROPERTY OFFICE OF NEW ZEALAND

[2013] NZIPOTM 30

IN THE MATTER of the Trade Marks Act 2002

AND

IN THE MATTER of trade mark application no. 835272
BERRY FOREST in class 30 in the
name of **J H WHITTAKER & SONS
LIMITED**

Applicant

AND

IN THE MATTER of an opposition by **CADBURY UK
LIMITED**

Opponent

N J Robb for the applicant

R Wallis and N Harre for the opponent

Introduction

1. This is the decision for the opposition to trade mark application no. 835272 **BERRY FOREST (opposed mark)**¹, which covers the following goods (**opposed goods**):

Class 30:
Confectionery including chocolate confectionery and chocolate bars

2. The applicant is J H Whittaker & Sons Limited (**applicant**).
3. The opponent is Cadbury UK Limited (**opponent**).
4. The trade mark application was filed on 22 December 2010² (**relevant date**).
5. The Trade Marks Act 2002 (**Act**), and the regulations made under that Act (**Regulations**), apply to these proceedings.

Grounds

6. The opponent pursues the following grounds of opposition:

Ground no.	Summary of the allegations	Act reference
3 1	The opposed mark is similar to the opponent's registered mark no. 222414 BLACK FOREST (opponent's registered mark), which is registered for the same or similar goods, and use of the opposed mark is likely to deceive or confuse.	Section 25(1)(b)
2	The opposed mark, or an essential element of it, is identical/similar to the opponent's registered mark, which is well known in New Zealand. The opposed mark is applied for in respect of: (1) goods that are the same as or similar to the opponent's goods; or (2) other goods, and use of the opposed mark would be taken as indicating a connection in the course of trade between the opposed goods and the opponent and such	Section 25(1)(c)

1 Details of this trade mark application are set out in the attached Schedule 1.

2 This is the relevant date for determining the parties' rights – *Pioneer Hi-Bred Corn Company v Hy-Line Chicks Pty Ltd* [1978] 2 NZLR 50 at 61.

3 Details of this registered trade mark are set out in the attached Schedule 2.

	use is likely to prejudice the interests of the opponent.	
3	Use of the opposed mark would be likely to deceive or cause confusion.	Section 17(1)(a)
4	Use of the opposed mark is contrary to New Zealand law because such use would be contrary to sections 9, 10, 13, and/or 16 of the Fair Trading Act 1986.	Section 17(1)(b)
5	Use of the opposed mark is contrary to New Zealand law because such use amounts to passing off.	Section 17(1)(b)
6	Use of the opposed mark would be disentitled to protection in any court because of grounds 4 and 5.	Section 17(1)(b)
7	The opposed mark has no distinctive character and had not at the relevant date acquired a distinctive character in accordance with section 18(2) of the Act.	Section 18(1)(b)

7. In its counter-statement, the applicant denies the grounds of opposition.

Evidence

Opponent's evidence in support of the opposition

8. The opponent's evidence in support of the opposition under regulation 82 of the Regulations consists of the evidence of:

Name	Occupation	Date of evidence	Exhibits	Reference
Alastair de Raadt	Managing Director employed by Cadbury in New Zealand.	25 October 2011	14	de Raadt 1
⁴ Alastair de Raadt	Managing Director employed by Cadbury in New Zealand.	23 January 2012	None	de Raadt 2

Applicant's evidence in support of its trade mark application

⁴ de Raadt 2 is confidential.

9. The applicant's evidence in support of its trade mark application under regulation 84 of the Regulations consists of the evidence of:

Name	Occupation	Date of evidence	Exhibits	Reference
Tania Paula Cresswell Weir	Secretary employed by the firm acting for the applicant in this opposition.	29 March 2012	9	Weir
Philip John Poole	Marketing Manager of the applicant.	30 April 2012	4	Poole

Opponent's evidence in reply

10. The opponent's evidence in reply under regulation 85 of the Regulations consists of the evidence of:

Name	Occupation	Date of evidence	Exhibits	Reference
Alastair de Raadt	Managing Director employed by Cadbury in New Zealand.	27 June 2012	6	de Raadt 3

Preliminary matter

11. The applicant objects⁵ to the following paragraphs of the third de Raadt declaration, which the opponent has adduced as evidence strictly in reply under regulation 85 of the Regulations⁶:

Opponent's evidence	Applicant's reasons
de Raadt 3 at [10] and [11]	Evidence of alleged objections to third parties using black forest should have been made as evidence in chief. Further the statements are vague and contradictory. The reference to an objection to a muesli bar product is inconsistent with Mr de Raadt's complaints that use of BLACK FOREST by anyone on goods other than moulded chocolate is irrelevant.

⁵ Applicant's written submissions at [4].

⁶ Regulation 85 of the Regulations states:

85 Evidence in reply

An opponent to an application for registration may, if the applicant has filed evidence, file evidence strictly in reply within 1 month after the opponent has received a copy of the applicant's evidence.

7

Finding:

At [10], the deponent deposes that:

10. As necessary and as products come to its attention, Cadbury has taken steps to enforce its trade mark against others in the market. I annex as exhibit **ADR3-1** a letter requiring Nice and Natural to cease use of the **BLACK FOREST** trade mark on a muesli bar product. That product is no longer on the market.

At [11], the deponent deposes that:

11. In 2011 Cadbury became concerned about a product put out by Van H Chocolates under its Christmas offering to the market, under the name Black Forest Yuletide Log. A copy of an illustration showing this product is annexed as exhibit **ADR3-2**. Following an approach from Cadbury this product was removed by Van H Chocolates and is no longer listed under its Christmas range. I annex as exhibit **ADR3-3** a printout from that company's website of the Christmas offering which shows that product is missing.

The tenor of the applicant's evidence is that "*BLACK FOREST* is a term that has come to indicate a flavour combination of chocolate and cherry." The Weir declaration adduces as evidence examples of the use of "black forest" and "forest" on food and drink. Copies of examples from the internet are exhibited to that declaration. It appears that the third de Raadt declaration at [10] and [11] are intended to specifically respond to the applicant's evidence (which has been adduced to show that Black Forest is an indicator of the flavour combination: chocolate and cherry) by emphasising that BLACK FOREST is a trade mark and that it has taken steps to enforce its rights under that mark.

Opponent's evidence	Applicant's reasons
De Raadt 3 at [16] and [46]	Mr de Raadt raises new matters regarding the applicant's general branding. This should have been raised as evidence in chief if the opponent considers it has relevance. The applicant says that in addition to not being evidence in reply it is irrelevant.

Finding:

At [16], the deponent deposes that:

16. Cadbury's approach to branding and trade mark protection is similar to many confectionery companies, including Whittakers. Cadbury has a larger number of trade marks and a broader product range than Whittakers, but Whittakers too has trade marked some of its products. I annex as exhibit **ADR3-5** a sample of products some of which Whittakers has registered marks (PEANUT SLAB, ALMOND GOLD, K BAR, SANTE and COCONUT SLAB).

At [46], the deponent deposes that:

46. Whittakers manufacture a number of products under the mark SLAB and notably PEANUT SLAB. This mark combines both an entirely descriptive element and a (slightly) less descriptive element. I have no doubt whatsoever that if Cadbury were to launch a product called FRUIT SLAB or FRUIT AND NUT SLAB, it would meet with an immediate objection from Whittakers.

7 Poole at [10].

I consider that the first sentence of de Raadt 3 at [16] specifically responds to Poole at [20], where it mentions the branding approach for chocolate blocks, including WHITTAKER's brand:

20. ...The way that chocolate is sold is shown in exhibits AR1-9, AR1-10, and AR1-11. Chocolate blocks are grouped by brand. Packaging is typically all of a similar theme with variations for flavour or chocolate type ... Whittaker's packaging has a uniform use of the stylised WHITTAKER's brand and gold packaging.

I consider that the de Raadt 3 at [16]: after the end of the first sentence and [46] do not appear to specifically respond to anything mentioned in the Poole or Weir declarations. I consider that, in this evidence, the opponent is seeking to adduce new material to establish that the applicant manufactures products under SLAB and PEANUT SLAB, which the opponent is alleging is wholly or partially descriptive.

Opponent's evidence	Applicant's reasons
<p>De Raadt 3 at [25]</p>	<p>Mr de Raadt introduces new material regarding trade mark registrations for the BLACK FOREST trade mark. Mr de Raadt implies that these were raised in evidence in chief by saying "as I noted in my first declaration at paragraphs 13 and 14 ...". However, a review of those paragraphs 13 and 14 indicate Mr de Raadt has been careless in making this statement.</p> <p>Paragraph 13 of his first declaration does not say that Australia is a primary market for the Cadbury product. The statement is "it is also sold in Australia". Neither paragraph 13 or 14 refers to trade mark registrations in other countries. The applicant is particularly concerned by the opponent's reference to the BLACK FOREST registration in Australia given that the opponent did not oppose the applicant's BERRY FOREST registration in Australia and both trade marks co-exist on the Australian trade mark register.</p>

Finding:

At [25], the deponent deposes that:

25. As I noted in my first declaration at paragraphs 13 and 14, Cadbury sells **BLACK FOREST** chocolate primarily in Australia and New Zealand, and has registered its trade marks in New Zealand and Australia, as well as Indonesia, China, Ireland and Singapore, and a stylised version in Malaysia. All the examples of Ms Weir's declaration from countries other than New Zealand are irrelevant to the opposition: if such products were to be sold in New Zealand, and they came within the scope of goods, they would infringe Cadbury's registered trade mark for **BLACK FOREST**. As I mentioned previously, Cadbury actively challenges unauthorised use of **BLACK FOREST** in New Zealand, as well as Australia.

I consider that this paragraph is intended to specifically respond to the various examples in the Weir declaration that are adduced in support of the applicant's point that Black Forest is an indicator of the flavour combination: chocolate and cherry by emphasising that BLACK FOREST is a trade mark of the opponent, which actively challenges unauthorised use of its BLACK FOREST trade mark in New Zealand.

Ruling

12. Accordingly, I find that de Raadt 3 at [10], [11], [16]: first sentence, and [25] are evidence that is strictly in reply under regulation 85 of the Regulations, subject to whether this evidence is inadmissible for other reasons (for example, hearsay), and subject to weight. I find that de Raadt 3 at [16]: after the end of the first sentence and [46] are not admissible as evidence strictly in reply under regulation 85 of the Regulations.

Ground 1: section 25(1)(b) of the Act

13. Under section 25(1)(b) of the Act, the “*Commissioner must not register a trade mark (trade mark A) in respect of any goods or services if....it is similar to a trade mark (trade mark C) that belongs to a different owner and that is registered, or has priority under section 34 or section 36, in respect of the same goods or services or goods or services that are similar to those goods or services, and its use is likely to deceive or confuse.*”
14. For this ground, the opponent relies on the opponent's registered mark, which falls within the scope of this ground because it was registered at the relevant date.
15. There are three interrelated elements to the section 25(1)(b) inquiry⁸, which are usually considered and answered separately in the course of making an overall global assessment⁹. The order of inquiry¹⁰ is:

⁸ The context of the section 25(1)(b) inquiry is broad because it requires the fair and notional use of the trade marks on any of the opposed goods or the goods covered by the opponent's registered mark to be considered – *Anheuser Busch Inc. v Budweiser Budvar National Corporation* [2003] 1 NZLR 472 at [30] (which related to consideration of the corresponding ground under section 17(1) of the Trade Marks Act 1953):

1. On his comparison of the trade marks themselves Doogue J correctly recognised that he was required to consider not the actual use of the BB marks but a notional use. The test of likely deception or confusion under s 17(1) is applied to any fair use of each mark in relation to any of the goods covered by the registration.

⁹ *N V Sumatra Tobacco Trading Company v British American Tobacco (Brands) Incorporated* [2010] NZCA 24, (2010) 86 IPR 206 (CA) at [18].

¹⁰ *N V Sumatra Tobacco Trading Company v New Zealand Milk Brands Limited* [2011] NZCA 264 at [32].

- 15.1 is the opposed mark in respect of the same or similar goods covered by the opponent's registered mark?
- 15.2 if so, is the opposed mark similar to the opponent's registered mark?
- 15.3 if so, is use of the opposed mark likely to deceive or confuse¹¹?

Is the opposed mark in respect of the same or similar goods covered by the opponent's registered mark?

16. The opposed goods are:

Class 30:
Confectionery including chocolate confectionery and chocolate bars

17. The opponent's registered mark covers the following goods:

Class 30:
farinaceous products; biscuits; confectionery including frozen confectionery excluding gateaux.

18. In comparing the opposed goods (on a notional fair use basis) and the goods covered by the opponent's registered mark (on a notional fair use basis), I have considered the following list of factors set out in *British Sugar Plc v James Robertson & Sons Ltd*¹² bearing in mind that this list of factors is for "general guidance"¹³ and that "no single consideration is conclusive in itself"¹⁴:

...I think the following factors must be relevant in considering whether there is or is not similarity:

¹¹ *Intellectual Reserve Inc. v Robert Sintes* HC Auckland CIV 2007-404-2610, 13 December 2007 at [15]:

[15] While the outcome of the third issue is likely to be largely informed by the resolution of the first two, it remains a separate issue, but it need only be determined if the answer to issues (a) and (b) is yes.

¹²[1996] RPC 281 at 296-297.

¹³ *British Sugar Plc v James Robertson & Sons Ltd* [1996] RPC 281 at 297; *N V Sumatra Tobacco Trading Company v New Zealand Milk Brands Limited* [2011] NZCA 264 at [38].

¹⁴ *N V Sumatra Tobacco Trading Company v New Zealand Milk Brands Limited* [2011] NZCA 264 at [40]; *Application by John Crowther & Sons (Milnsbridge) Ltd* (1948) 65 RPC 369 at 372.

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

This is rather an elaboration on the old judicial test for *goods of the same description*. [17 See *per* Romer J. in *Jellinek's Application* (1946) 63 R.P.C. 59 at p. 70, approved by the House of Lords in *DAIQUIRI RUM Trade Mark* [1969] R.P.C. 600 at page 620.] It seeks to take account of present day marketing methods.

19. I find that, taking all of the *British Sugar* criteria at [18] together, the goods covered by the opponent's registered mark are the same as, or similar to, the opposed goods. In particular, I consider that the opposed goods: "confectionery" is the same as "confectionery", which is included in the specification of goods for the opponent's registered mark.

Is the opposed mark similar to the opponent's registered mark?

20. I must apply the following test for comparing trade marks, which was considered in *New Zealand Breweries Ltd v Heineken's Bier Browerij Maatschappij NV* [1964] NZLR 115 at 139:
1. You must take the two words and judge of them both by their look and by their sound;
 2. You must consider the goods to which they are to be applied and the nature and kind of customer who is likely to buy these goods; and
 3. You must consider all the surrounding circumstances and what is likely to happen if each of the marks is used in a normal way as a trade mark for the goods of the respective owners of the marks: *In re Pianotist Co.'s Application* (1906) 23 R.P.C. 774,777.
21. In comparing the opposed mark and the opponent's registered mark, I must ultimately focus on the whole of each mark, not do a side by side comparison, and I must allow for imperfect recollection – *De Cordova and Others v Vick Chemical Coy* (1951) 63 RPC 103 at 106:

The likelihood of confusion or deception in such cases is not disproved by placing the two marks side by side and demonstrating how small is the chance of error in any customer who places his order for goods with both the marks clearly before him, for orders are not placed, or are often not placed, under such conditions. It is more useful to observe that in most persons the eye is not an accurate recorder of visual detail, and that marks are remembered rather by general impressions or by some significant detail than by any photographic recollection of the whole. [emphasis added]

22. My impression¹⁵ of the *totality* of the opposed mark and the opponent's registered mark, having regard to the essential features¹⁶ of those marks and, in particular, their similarities¹⁷ is that the marks are dissimilar.
23. Each mark is a word mark with no limitation, which means that it could appear in any stylised manner, font, size, colour, medium, and/or format on, or in relation to, the goods covered by it.
24. The opposed mark consists of the word combination: "BERRY FOREST". The opponent's registered mark consists of the word combination: "BLACK FOREST". The first word in each combination is different, and this can be important.¹⁸ The first word in the opposed mark is BERRY, which is "*any small roundish juicy fruit without a stone*".¹⁹ The first word in the opponent's registered mark is BLACK – "*very dark, having no colour*

¹⁵ *Clark v Sharp* (1898) 15 RPC 141 (Ch) at 146.

¹⁶ *N V Sumatra Tobacco Trading Company v British American Tobacco (Brands) Incorporated* (2010) 86 IPR 206 (CA) at [31]:

[31] We do not accept that submission. As Mr Brown submits, when making a s 17 comparison, while the focus is on the totality of the mark applied for, the court can properly look at a common or essential feature in both marks as being key. In *Heineken*, North P stated:

2. But while it is true that it is necessary to have regard to "the totality" of the proposed trade mark, yet often enough the real risk of confusion may lie in some common feature in the two labels which is liable to linger in the minds of persons requiring a particular kind of goods. Sometimes indeed it will be a word appearing in the labels which either looks or sounds the same.

¹⁷ *Austin, Nichols & Co Inc v Stichting Lodestar* (2005) 11 TCLR 265 (HC) at [13].

¹⁸ *N V Sumatra Tobacco Trading Company v British American Tobacco (Brands) Incorporated* (2010) 86 IPR 206 (CA) at [32]:

[32] We also accept Mr Brown's submission that the first syllable of a mark or, as here, the first word of a composite mark, that is LUCKY, is usually the most important for comparison: see *Re London Lubricants (1920) Ltd's Application* where Sargent LJ observed that:

3. The tendency of persons using the English language to slur the termination of words also has the effect necessarily that the beginning of words is accentuated in comparison and, in my judgment, the first syllable of a word is, as a rule, far more important for the purpose of distinction.

¹⁹ *The New Zealand Oxford Dictionary* (2005) at 102.

*from the absorption of all or nearly all incident light (like coal or soot).*²⁰

Both marks have FOREST in common as the second word, which I consider may be understood as meaning “a large area covered chiefly with trees and undergrowth”; “the trees growing in it”; and/or “a large number or dense mass of vertical objects”.²¹

25. However, I consider that the opponent’s registered mark is more likely to be perceived as BLACK FOREST, rather than as the colour BLACK and FOREST. This is because I consider that the opponent’s registered mark naturally calls to mind two concepts: (1) black forest gâteau (cake), which is “a chocolate sponge with layer of morello cherries or cherry jam and whipped cream and topped with chocolate icing, originally from S. Germany”;²² and/or (2) “a hilly wooded region of SW Germany, lying to the east of the Rhine valley”.²³ I consider that, in the context of confectionery and farinaceous products, the dominant concept that is likely to be called to mind will be the concept of black forest gâteau (cake) because black forest is likely to be taken as a reference to flavour and/or variety of confectionery/farinaceous products.²⁴ In my view, the exclusion of gateaux from the specification of goods for the opponent’s registered mark would not prevent this concept from being called to mind. I also note that the opponent appears to accept that black forest cake is well known.²⁵
26. On the other hand, I consider that BERRY FOREST is not a naturally understood term, which means that I must fall back on the meanings of each word in combination. I consider that BERRY FOREST is likely to be taken to mean a forest of berries, which is a distinct concept to the BLACK FOREST concepts. I also consider that the concept of a forest of berries is slightly fanciful because forests are usually associated with trees. However, I accept that berries may grow wild in forests and those kinds of berries may be referred to as forest berry/berries or forest fruit(s) or fruit(s) of the forest.²⁶

20 *The New Zealand Oxford Dictionary* (2005) at 111.

21 *The New Zealand Oxford Dictionary* (2005) at 415.

22 *The New Zealand Oxford Dictionary* (2005) at 111.

23 *The New Zealand Oxford Dictionary* (2005) at 112.

24 Weir at exhibits TPCW-1-TPCW-6.

25 de Raadt 3 at [7].

26 Weir at exhibits TPCW-7-TPCW-8.

27. I find that, as a whole, the opposed mark is visually, aurally, and, most importantly, conceptually dissimilar to the opponent's registered mark.

Finding

28. Accordingly, I find that the opponent does not succeed on ground 1.

Ground 2: section 25(1)(c) of the Act

29. Under section 25(1)(c) of the Act, the “*Commissioner must not register a trade mark (trade mark A) in respect of any goods or services if... it is, or an essential element of it is, identical or similar to, or a translation of, a trade mark that is well known in New Zealand (trade mark D), whether through advertising or otherwise, in respect of those goods or services or similar goods or services or any other goods or services if the use of trade mark A would be taken as indicating a connection in the course of trade between those other goods or services and the owner of trade mark D, and would be likely to prejudice the interests of the owner.*”

The relevant principles

30. The following issues arise under section 25(1)(c) of the Act²⁷:
- 30.1 Is the opposed mark (BERRY FOREST), or an essential element of it, identical/similar to the opponent's registered mark (BLACK FOREST), which is well known²⁸?
 - 30.2 Are the opposed goods and the goods covered by the opponent's registered mark the same or similar? If not,
 - 30.3 Would use of the opposed mark be taken as indicating a connection in the course of trade with the opponent?
 - 30.4 If the answer to issue 2 or 3 is yes, would use of the opposed mark be likely to prejudice the interests of the opponent?

²⁷*Intellectual Reserve Inc. v Robert Sintes* HC Auckland CIV 2007-404-2610, 13 December 2007 at [40], which was followed in *New Zealand Milk Brands Limited v NV Sumatra Tobacco Trading Co* HC Wellington CIV-2007-485-2485, 28 November 2008 at [46].

²⁸ The threshold for establishing that a mark is well known is similar to the level of reputation required for the law of passing off – *Automobile Club De L'Ouest, ACO v South Pacific Tyres New Zealand Limited* (2006) 70 IPR 639 at 646 and 665, which, on this point, followed *McDonald's Corporation v Joburgers Drive-Inn Restaurant (Pty) Ltd & Ors* (1996) 36 IPR 11 at 23-24.

Finding

31. I have already found that the opposed mark and the opponent's registered mark are dissimilar. Accordingly, I find that it must follow that the opponent does not succeed on ground 2.²⁹

Ground 3: section 17(1)(a) of the Act

32. Under section 17(1)(a) of the Act, the "*Commissioner must not register as a trade mark or part of a trade mark any matter...the use of which would be likely to deceive or cause confusion.*"
33. For this ground, the opponent relies on its registered trade mark: BLACK FOREST, which is the same mark that has been relied on for grounds 1 and 2.

Finding

34. I have already found that the opposed mark and the opponent's registered mark are dissimilar. Accordingly, I find that it must follow that the opponent does not succeed on ground 3.³⁰

Grounds 4 to 6: section 17(1)(b) of the Act

35. Under section 17(1)(b) of the Act, "*the Commissioner must not... register a trade mark or part of a trade mark if...its use is contrary to New Zealand law or would otherwise be disentitled to protection in any court.*"
36. The opponent alleges that use of the opposed mark is contrary to New Zealand law and is disentitled to protection in any court because use of

²⁹ *Higgins Coatings Pty Ltd v Higgins Group Holdings Ltd* HC Wellington CIV-209-485-2594, 30 June 2010 at [24] and *Intellectual Reserve Inc. v Robert Sintes* HC Auckland CIV-2007-404-2610, 13 December 2007 at [53].

³⁰ *Intellectual Reserve Inc. v Robert Sintes* HC Auckland CIV-2007-404-2610, 13 December 2007 at [53].

the opposed mark: (1) would be contrary to sections 9, 10, 13, and 16 of the Fair Trading Act 1986; and (2) amounts to passing off.

37. I need not consider these grounds in detail as a higher threshold of confusion appears to be required to establish a breach of the Fair Trading Act 1986 or passing off than is required under section 17(1)(a) of the Act (ground 3); and the opponent has not succeeded on that ground.

Finding

38. Accordingly, I find that the opponent does not succeed on grounds 4 to 6.

Ground 7: section 18(1)(b) of the Act

39. Under section 18(1)(b) of the Act, the Commissioner must not register “a *trade mark that has no distinctive character*”.

40. The basis for this ground is set out in the notice of opposition at [11] and [12]:

11. The Applicant's Mark has no distinctive character within the meaning of section 18(1)(b) because the Applicant's Mark is not, and cannot be, distinctive of or capable of distinguishing the goods of the Applicant in New Zealand, but must always be confusingly associated or connected with the Opponent, and has not, as a result of either the use made of it or of any other circumstances, acquired a distinctive character.

12. The Applicant's Mark had not at the date of application for registration acquired a distinctive character in accordance with section 18(2).

41. I consider that the alleged factual basis for this ground must immediately fail because the opponent has not succeeded on any of its grounds 1 to 6.

42. In any case, I consider that the test in *W & G du Cros Ltd's Application*³¹ is the appropriate test for determining whether the opposed mark is distinctive:

The question, therefore, is whether the mark itself, if used as a Trade Mark, is likely to become actually distinctive of the goods of the persons so using it. The applicant for registration in effect says, “I intend to use this mark as a Trade Mark, *i.e.*, for the

31 (1913) 30 RPC 660 at 671-672.

purpose of distinguishing my goods from the goods of other persons,” and the Registrar or the Court has to determine, before the mark be admitted to registration, whether it is of such a kind that the applicant, quite apart from the effects of registration, is likely or unlikely to attain the object he has in view. The applicants’ chance of success in this respect must, I think, largely depend upon whether other traders are likely, in the ordinary course of their business and without any improper motive, to desire to use the same mark, or some mark nearly resembling it, upon or in connection with their own goods. [my emphasis]

43. The High Court in *Anthony Brian Coombe v Coca-Cola Amatil (NZ) Limited*³² has applied the following approach for analysing distinctive character:

[40] A useful framework for analysing distinctive character is given by Geoffrey Hobbs QC in “*Cycling IS...*” *Trade Mark Applications*.³³

- The question whether a particular sign possesses a distinctive character cannot be considered in the abstract. It must be considered in relation to the goods or services for which registration is sought,³⁴
- The mark must possess enough of a distinctive character to be regarded as an indication of trade origin by the relevant class of persons or at least a significant proportion thereof;³⁵
- The relevant class of persons consists of the trade and average consumers of the specified goods and services in the territory covered by the application for registration;³⁶
- The average consumer of the goods or services concerned is to be regarded as reasonably well-informed and reasonably observant and circumspect;³⁷
- It is to be remembered that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;³⁸
- The average consumers level of attention is likely to vary according to the category of goods or services in question;³⁹
- The perceptions of the average consumer must be assessed in context, with due regard for the realities of the market place. It will be relevant to have regard to the various methods and practices

³² HC Auckland CIV 2010-485-000816, 8 April 2011 at [40]

³³ “*Cycling IS ...*” *Trade Mark Applications* [2002] RPC 729 at 743-744, cited in IPONZ Practice Guidelines at [3.2.3].

³⁴ *Merz & Krell GmbH & Co* [2001] ETMR 105 at [29]-[30].

³⁵ *Windsurfing Chiemsee Produktions-und Vertriebs v Boots-und Segelzebehor Walter Huber and Franz Attenberger* [1999] ECR 1-2779 at [52].

³⁶ *Ibid*, at [29].

³⁷ *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* [1999] ETMR 690 at [26]; *Bach and Bach Flower Remedies Trade Marks* [2000] RPC 513 at 534.

³⁸ *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* at [25].

³⁹ *Ibid*, at [26].

of marketing that the average consumer of the relevant goods or services is likely to encounter under normal and fair trading conditions.

44. I must also keep in mind “*how any fair use of [BERRY FOREST] in relation to [confectionery including chocolate confectionery and chocolate bars] would be understood by those to whom it will be presented in the course of trade – members of the trade and ultimate consumer*”⁴⁰.”
45. The opposed mark is not being used yet⁴¹, which is why the applicant has filed no evidence under section 18(2)⁴² of the Act. Therefore, if the opposed mark is caught by section 18(1)(b) of the Act, it must not be registered.
46. As I have already mentioned, the opposed mark is a word mark with no limitation, which means that it could appear in any stylised manner, font, size, colour, medium, and/or format on, or in relation to, the opposed goods.
47. I am also mindful of the Court of Appeal’s approach in *McCain Foods (Aust) Pty Ltd v Conagra Inc* at [49] and [50]:

[49] In considering descriptiveness that others might, without improper motive, wish to use it is necessary to consider not simply whether others might wish to employ the word combination on product labels. Modern marketing involves extensive promotion through oral and visual media and [is] not always confined to strict grammatical usage. Accordingly, there is no answer to a descriptiveness objection to say that the mark is not a description of a particular product. If it is a description that might reasonably be used in relation to products of the kind in question it should not be monopolised by one trader. ...

[50] On the approach we have set out it would be unlikely that the word combination “baby dry” for disposable nappies would qualify for registration in New

40 *McCain Foods (Aust) Pty Ltd v Conagra Inc* [2002] 3 NZLR 40 (CA) at [46].

41 Poole at [19]:

4. 19. The reason that BERRY FOREST is not being used yet is because Cadbury complain that it will infringe its BLACK FOREST trade mark registration and give rise to passing off and breach of the Fair Trading Act. We do not want to be sued and have the significant costs of a High Court dispute incurred.

42 Section 18(2) of the Act states:

5. (2) The Commissioner must not refuse to register a trade mark under subsection (1) (b), (c), or (d) if, before the date of application for registration, as a result of either the use made of it or of any other circumstances, the trade mark has acquired a distinctive character.

Zealand. That mark has recently been held eligible for registration by the European Court of Justice: *Procter & Gamble Company v Office for Harmonisation in the Internal Market* [2002] Ch 82. That decision reflects the shift from the previous English law. [emphasis added]

48. I have already considered the meanings of the opposed mark at [26].
49. In any case, it appears that the opponent admits that the opposed mark is registrable as a trade mark, which means that this ground must immediately fail. The third de Raadt declaration states:

21. The word “forest” has no natural association with confectionery, and chocolate in particular, nor with berries. The combination of “black” with “forest” and “berry” with “forest” make both phrases registrable as trade marks. However, because they are so similar there is no room for the use of both to describe the exact same type of product without consumer confusion.

Finding

50. Accordingly, I find that the opponent does not succeed on ground 7.

Decision

Summary of findings

51. I have found that the opponent has not succeeded on any of its grounds of opposition in respect of the opposed mark.

Direction

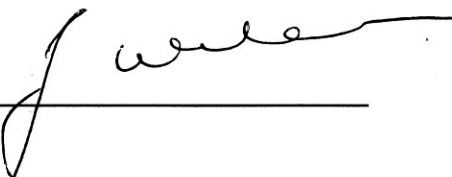
52. Accordingly, I direct that trade mark application no. 835272 BERRY FOREST must be registered after the expiry of the appeal period; but only if there is *no* appeal against this decision.

Costs

53. Accordingly, I award costs to the applicant as the successful party in this opposition in accordance with scale in the sum of **\$3,490** calculated as follows:

Item in IPONZ scale of costs	Costs
Preparing and filing counter-statement:	300.00
Receiving and perusing the opponent's evidence:	400.00
Preparing and filing the applicant's evidence:	800.00
Receiving and perusing the opponent's evidence in reply:	100.00
Preparing the case for hearing:	500.00
Attendance at hearing by counsel (\$180 x 3 hours):	540.00
Hearing fee:	850.00
TOTAL:	\$3,490.00 to the applicant

Dated this 2 day of September 2013



J Walden
Assistant Commissioner of Trade Marks

A J Park Law for the applicant
Baldwins Intellectual Property for the opponent

Schedule 1**Details of New Zealand trade mark application no. 835272:**

Trade mark	BERRY FOREST
Trade mark name	BERRY FOREST
Trade mark type	Word
Class	30 [Nice classification Schedule 9]
Goods	<i>Confectionery including chocolate confectionery and chocolate bars</i>
Applicant	J H Whittaker & Sons Limited
Statement of use	<i>The mark is being used or proposed to be used, by the applicant or with his/her consent, in relation to the goods/services</i>
Status	Under opposition
Filed on	22 December 2010

Schedule 2**Details of New Zealand trade mark registration no. 222414:**

Trade mark	BLACK FOREST
Trade mark name	BLACK FOREST
Explanations	This mark was advertised before acceptance under section 27(1) of the Trade Marks Act 1953.
Trade mark type	Word
Class	30 [Nice classification Schedule 4]
Goods	<i>farinaceous products; biscuits; confectionery including frozen confectionery excluding gateaux.</i>
Applicant	Cadbury UK Limited
Statement of use	<i>Use Claimed</i>
Status	Registered
Registered on	28 May 1996

Deemed date of registration	22 October 1992
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