

**DECISION
of the Fourth Board of Appeal
of 11 January 2021**

In case R 204/2020-4

MAX KIENE GmbH

Oberhafenstraße 1
20097 Hamburg
Germany

Applicant / Appellant

represented by Hauck Patentanwaltspartnerschaft mbB, Kaiser-Wilhelm-Straße 79-87,
20355 Hamburg, Germany

v

Frito-Lay Trading Company GmbH

Spitalgasse 2
3011 Bern
Switzerland

Opponent / Defendant

represented by BOMHARD IP, S.L., C/Bilbao, 1, 5º, 03001 Alicante, Spain

APPEAL relating to Opposition Proceedings No B 1 767 063 (European Union trade
mark application No 9 233 313)

THE FOURTH BOARD OF APPEAL

composed of D. Schennen (Chairperson), C. Bartos (Rapporteur) and E. Fink
(Member)

Registrar: H. Dijkema

gives the following

Decision

Summary of the facts

- 1 By an application filed on 8 July 2010, MAX KIENE GmbH ('the appellant') sought to register the sign



for the following list of goods, as limited on 29 April 2011:

Class 29 - Preserved, frozen, dried and cooked fruits and vegetables; pulses, dried fruits, dried vegetables; potato snack foods; dried tropical and subtropical fruits, raisins, currants and pulses; fruit snacks; nuts of all kinds (processed); roasted, dried, salted, spiced and seasoned nuts; roasted almonds; roasted peanuts; pine nuts (processed); nut snacks, mixed nuts;

Class 30 - Confections; Confectionery; The aforesaid goods other than edible ices and frozen cakes; Savoury biscuits and pretzels; Rice snacks, corn snacks, cereal snacks;

Class 31 - Fresh fruit and vegetables, fresh tropical and subtropical fruits and pulses; almonds and nuts of all kinds, fresh or unprocessed, fresh peanuts, fresh pine nuts.

- 2 On 7 December 2010, Frito-Lay Trading Company GmbH ('the defendant') filed an opposition against the EUTM applied for. The grounds of opposition were those laid down in Article 8(1)(b) and (5) EUTMR. The opposition was based on
 - a) EUTM No 7 504 012

WALKERS MAX

registered on 23 July 2009 for the goods:

Class 29 - Chips, crisps, ready to eat snacks consisting primarily of potatoes, potato chips and fabricated potato chips;

Class 30 - Chips, crisps, puffs, corn chips, tortilla chips, rice chips, puffed and extruded snacks.

- b) UK trade mark No 2 295 390

MAX

registered on 13 August 2004.

- 3 The appellant requested the defendant to submit proof of genuine use of its earlier UK trade mark. The defendant submitted the following evidence:

Enclosures	Description
OP-3	Excerpts from website <i>logos.wikia.com</i> showing the history and development of the MAX potato crisps packaging between 1999 and 2018
OP-4	Two commercials, by way of screenshots from YouTube®, run in 1999 and 2000
OP-5	Data on sales of MAX product range in the UK
OP-6	Sample artwork packaging of MAX product range offered in the UK in 2009
OP-7	Excerpts from the defendant's historical websites dating back between 2005 and 2007
OP-8	Excerpts from a Google® search showing results of search for 'WALKERS' together with 'MAX'
OP-9	Excerpts from the website <i>www.foodstufffinds.co.uk</i> showing a sample of MAX potato crisps packaging of 2009

- 4 By decision of 29 November 2019 ('the contested decision'), the Opposition Division refused the EUTM applied for and ordered the appellant to bear the costs of the proceedings.
- 5 The Opposition Division held that the earlier UK trade mark mentioned above under paragraph 2b) was used for 'potato crisps' in Class 29 and 'crisps of potato flour' in Class 30. It furthermore held that these goods were similar and identical to the contested goods and that the signs were also similar. Consequently, a likelihood of confusion between the earlier UK trade mark and the EUTM applied for exists.

Submissions and arguments of the parties

- 6 The appellant filed a notice of appeal against the decision followed by a statement of grounds, requesting that the contested decision be set aside and the opposition be rejected.
- 7 The appellant argued that the evidence of proof of use only covered a short time span of the relevant period.
- 8 In its response, the defendant requested that the appeal be dismissed. It argued that the earlier UK trade mark was genuinely used during the relevant period and the use of the trade mark 'MAX' together with the term 'WALKERS' did not change the distinctive character of the earlier UK trade mark 'MAX'.
- 9 Together with its response, the defendant submitted, as a supplement to its Enclosure OP-4, Enclosure AP consisting of screenshots from YouTube® of commercials run in 1999 and 2000.

Reasons

- 10 The appeal is admissible and well founded.

- 11 With respect to the earlier EUTM, despite the fact that the signs coincide in the, at least highly allusive element ‘max’, there is no likelihood of confusion, not even for identical goods. The earlier UK trade mark is no longer an earlier right on which an opposition may be based, in accordance with Article 8(2) EUTMR.

1. The opposition based on the earlier EUTM mentioned above under paragraph 2a)

- 12 Under Article 8(1)(b) EUTMR, upon opposition by the proprietor of an earlier trade mark, the trade mark applied for shall not be registered if, because of the identity or similarity of the signs and the identity or similarity of the goods or services, there exists a likelihood of confusion on the part of the public in the territory in which the earlier trade mark is protected.

1. The relevant consumer and its level of attention

- 13 The opposition is based on an earlier EUTM. Therefore, the relevant territory in respect of which the likelihood of confusion must be assessed is the European Union as a whole. However, for an EUTM application to be refused registration, it is sufficient that the relative ground of Article 8(1)(b) EUTMR exists in only part of the European Union (05/02/2020, T-44/1984, TC Touring Club, EU:T:2020:31, § 84). The Board of Appeal focusses on the English-speaking public, taking the same approach as the Opposition Division.
- 14 For the purpose of that global appreciation, the average consumer of the category of goods and services concerned is deemed to be reasonably well informed and reasonably observant and circumspect. The level of attention of the relevant consumer is likely to vary according to the category of goods or services in question and the average consumer only rarely has the chance to make a direct comparison between the different marks but must place his or her trust in the imperfect picture of them that he or she has kept in his or her mind (22/06/1999, C-342/97, Lloyd Schuhfabrik, EU:C:1999:323, § 26; 30/06/2004, T-186/02, Dieselit, EU:T:2004:197, § 38).
- 15 The relevant goods are various foodstuff, which are directed at the general consumer, whose attention will be average.

2. Comparison of goods

- 16 In order for the similarity of the goods or services at issue to be assessed, all the relevant features of the relationship between those goods or services should be taken into account. Those factors include, inter alia, their nature, their intended purpose, their method of use, their end-users and whether they are in competition with each other or are complementary (29/09/1998, C-39/97, Canon, EU:C:1998:442, § 23). Other factors may also be taken into account such as, for example, the distribution channels of the goods concerned (11/07/2007, T-443/05, Pirañam, EU:T:2007:219, § 37). The reference point is whether the relevant public would perceive the relevant products as having a common commercial origin (04/11/2003, T-85/02, Castillo, EU:T:2003:288, § 38).

i) Class 29

- 17 The earlier ‘ready to eat snacks consisting primarily of potatoes’ are identical to the applied for ‘potato snack foods’. Both snacks consisting of (primarily) potatoes.
- 18 The other goods applied for in Class 29, ‘preserved, frozen, dried and cooked fruits and vegetables; pulses, dried fruits, dried vegetables; dried tropical and subtropical fruits, raisins, currants and pulses; fruit snacks; nuts of all kinds (processed); roasted, dried, salted, spiced and seasoned nuts; roasted almonds; roasted peanuts; pine nuts (processed); nut snacks, mixed nuts’ are similar to an at least low degree to the earlier ‘chips’, which can be made of vegetables, such as potatoes, yucca or carrots, or fruits, such as apples, bananas or mangos.

ii) Class 30

- 19 Snacks can have the appearance of chips. Cereals comprise not only grain, which includes also rice, but also corn. Consequently, the applied for ‘rice snacks’, ‘corn snacks’ and ‘cereal snacks’ are identical to the applied for ‘corn chips’, ‘tortilla chips’ and ‘rice chips’.
- 20 The remaining goods in Class 30, ‘confections; confectionery; the aforesaid goods other than edible ices and frozen cakes; savoury biscuits and pretzels’ can be served in the form of snacks, a light meal eaten between regular meals. Consequently, they are at least highly similar, if not even identical to the earlier ‘corn chips’, ‘tortilla chips’ and ‘rice chips’.

iii) Class 31

- 21 The applied for ‘fresh fruit and vegetables, fresh tropical and subtropical fruits and pulses; almonds and nuts of all kinds, fresh or unprocessed, fresh peanuts, fresh pine nuts’ may be served as snacks. Consequently, they are similar to an at least average degree to the earlier goods in Class 29 and 30.

3. Comparison of the signs

- 22 The comparison in relation to the visual, aural and conceptual similarity of the signs in question has to take into account the overall impression given by them, bearing in mind, in particular, their distinctive and dominant components (06/10/2005, C-120/04, Thomson Life, EU:C:2005:594, § 28).
- 23 Although the average consumer normally perceives a sign as a whole and does not proceed to analyse its various details, the fact remains that, while perceiving a word sign, he/she will break it down and identify the elements which suggest a concrete meaning or resemble words known to him/her (28/11/2019, T-736/18, Bergsteiger, EU:T:2019:826, § 111; 03/10/2019, T-500/18, MG Puma, EU:T:2019:721, § 29).

- 24 For the protection of word marks, it is irrelevant whether they are written in capitals or lower-case letters (31/01/2013, T-66/11, Babilu, EU:T:2013:48, § 57). Indeed, their protection relates to the word mentioned in the application for registration and not to the specific graphic or design elements which that mark might have (03/12/2015, T-105/14, iDrive, EU:T:2015:924, § 59; 16/09/2013, T-338/09, MBP, EU:T:2013:447, § 54; 22/05/2008, T-254/06, RadioCom, EU:T:2008:165, § 43).
- 25 It is settled case-law that the consumer generally pays greater attention to the beginning of a sign than to its end, as the first part of a sign normally has a greater impact, both visually and phonetically, than the final part (22/05/2012, T-179/11, Seven Summits, EU:T:2012:254, § 36) and this is particularly applicable to the present case.
- 26 The contested sign is composed of the term ‘MAX’, which is placed in a double circle [Ⓜ]. The term ‘max’ is an abbreviation of the term ‘maximum’ and will be understood as such in the entire European Union. Nearly all official languages of the European Union has a term similar to the English term, such as ‘*maximum*’ in Czech, German, French and Slovak, ‘*maksimum*’ in Danish and Slovene, ‘*maksimaalne*’ in Estonian, ‘*maksimalus*’ in Lithuanian, ‘*maksimus*’ in Latvian, ‘*maximális*’ in Hungarian or ‘*maksymalny*’ in Polish, just to mention some of them. It will at least allude to the meaning of ‘best’ or ‘utmost’. This can be confidently asserted, since ‘max’ is a word used in advertising all over the world to convey these laudatory notions (25/05/2018, R 2287/2017-2, FERMENTIX / FERMENT MAX et al., § 26). The term is the dominant element of the sign applied for, despite it being at least highly allusive, since a double circle has no distinctive character at all.
- 27 The earlier sign enjoys protection for the term ‘WALKERS MAX’. With respect to the term ‘max’, the same considerations as mentioned above apply. The term ‘walkers’ has no meaning at all with respect to the registered goods and is therefore the dominant and distinctive element in the earlier sign; the element ‘max’ has only a secondary position.
- 28 Visually and aurally, there is some similarity based on the same at least highly allusive element ‘max’.
- 29 Conceptually, the earlier sign, in its entirety, has no meaning at all; consequently, the signs cannot be compared. In so far as both signs refer to ‘the best’, the signs are conceptually similar.

4. Distinctive character of the earlier trade mark

- 30 The defendant did not explicitly claim that its trade mark is particularly distinctive by virtue of intensive use or reputation. In any case, such enhanced distinctive character would be on the earlier trade mark in its entirety, i.e. ‘WALKERS MAX’ and not on a single, at least highly allusive element. Consequently, the assessment of the earlier trade mark’s distinctive character will rest on its distinctive character per se.

- 31 The earlier trade mark as a whole has inherently a normal degree of distinctive character, despite the presence of the at least highly allusive element ‘max’.

5. Overall assessment of the likelihood of confusion

- 32 According to the case-law of the Court of Justice, the risk that the public might believe that the goods or services in question come from the same undertaking or, as the case may be, from economically-linked undertakings, constitutes a likelihood of confusion. It follows from the very wording of Article 8(1)(b) EUTMR that the concept of a likelihood of association is not an alternative to that of a likelihood of confusion, but serves to define its scope (29/09/1998, C-39/97, Canon, EU:C:1998:442, § 29; 22/06/1999, C-342/97, Lloyd Schuhfabrik, EU:C:1999:323, § 17).
- 33 A likelihood of confusion on the part of the public must be assessed globally. That global assessment implies some interdependence between the factors taken into account and in particular similarity between the trade marks and between the goods or services covered. Accordingly, a lesser degree of similarity between these goods or services may be offset by a greater degree of similarity between the signs, and vice versa (29/09/1998, C-39/97, Canon, EU:C:1998:442, § 17; 22/06/1999, C-342/97, Lloyd Schuhfabrik, EU:C:1999:323, § 19). The more distinctive the earlier trade mark, the greater the risk of confusion, and trade marks with a highly distinctive character, either per se or because of the reputation they possess on the market, enjoy broader protection than trade marks with a less distinctive character (29/09/1998, C-39/97, Canon, EU:C:1998:442, § 18).
- 34 Despite the fact that the signs coincide in the at least highly allusive element ‘max’, there is no likelihood of confusion, not even for identical goods. In the earlier trade mark, the element ‘max’ has only a secondary position, and does not add at all to the distinctive character of the earlier trade mark. Within the earlier trade mark, it will be seen as an element purley indicating the quality.
- 35 In light of these considerations, the opposition, as far as it is based on this earlier trade mark, must fail.

II. The opposition based on the earlier UK trade mark mentioned above under paragraph 2b)

- 36 The Board of Appeal, in appeal proceedings, must carry out a full new examination, in terms of both, law and fact (22/03/2007, T-215/03, Vips, EU:T:2007:93, § 96). The outcome of the appeal depends on whether or not a new decision with the same operative part as the decision under appeal may be lawfully adopted at the time of the appeal ruling (23/09/2003, T-308/01, Kleencare, EU:T:2003:241, § 26).
- 37 In accordance with Article 8(1)(b) EUTMR, upon opposition by the proprietor of an earlier trade mark, a EUTM applied for is not to be registered if because of its identity or similarity to the earlier sign and the identity or similarity of the goods

or services, there exists a likelihood of confusion on the part of the public in the territory in which the earlier trade mark is protected.

- 38 Article 8(2)(a)(ii) EUTMR provides that a trade mark registered in a Member State constitutes an earlier right.
- 39 The opposition is based on a trade mark registered in the United Kingdom. At the date of filing of the opposition, as well as at the date when the contested decision was rendered, the United Kingdom was a member of the European Union.
- 40 With effect from midnight, Central European Time, 31 January 2020, the United Kingdom left the European Union. In accordance with Article 127 of the Agreement on the withdrawal of the United Kingdom of Great Britain and Northern Ireland from the European Union and the European Atomic Energy Community ('Withdrawal Agreement'), OJ EU 2019/C 384 I/01, Union law remains applicable in and to the United Kingdom during the transition period in accordance with Article 126 Withdrawal Agreement, i.e. until midnight, Central European Time, of 31 December 2020. As of 1 January 2021, Union law is no longer applicable in and to the United Kingdom.
- 41 Consequently, with effect from 1 January 2021, UK trade marks no longer constitute earlier rights within the meaning of Article 8(2)(a)(ii) EUTMR.
- 42 UK trade marks must be treated in the same way as any other trade mark that was, but is no longer, valid and in force due to, e.g., a decision revoking or invalidating the earlier right or the failure of renewing the registration, situations in which the opposition must be considered to be, or have become, unfounded (13/09/2006, T-191/04, *Metro*, EU:T:2006:254, § 33; 17/10/2016, R 662/2016-4, *nowwireless/now network*, § 11; 01/10/2019, R 416/2019-4, *Beon worldwide/BEON*, § 17).
- 43 Since an earlier right must enjoy protection within the European Union on the day the decision is rendered, which is not anymore the case with respect to the UK trade mark, the opposition must be rejected as unfounded insofar it was based on this earlier UK trade mark.

III. Result

- 44 Since the opposition fails, the appeal must be allowed, the contested decision annulled and the opposition rejected. Therefore, the EUTM applied for may proceed to registration.

Costs

- 45 Pursuant to Article 109(1) EUTMR, the defendant, as the losing party, must bear the appellant's costs of the opposition and appeal proceedings.

Fixing of the costs

- 46 In accordance with Article 18(1)(i) EUTMIR, the costs of representation of the opposition proceedings are fixed at the level of EUR 300.
- 47 In accordance with Article 18(1)(iii) EUTMIR, the costs of representation of the appeal proceedings are fixed at the level of EUR 550. Additionally, the defendant has to bear the appeal fee of EUR 720.
- 48 The total amount is fixed at EUR 1 570.

Order

On those grounds,

THE BOARD

hereby:

- 1. Annuls the contested decision and rejects the opposition;**
- 2. Allows the EUTM applied for to proceed to registration;**
- 3. Orders the defendant to bear the appellant's costs in the opposition and appeal proceedings;**
- 4. Fixes the amount to be reimbursed by the defendant to the appellant at the level of EUR 1 570.**

Signed

D. Schennen

Signed

C. Bartos

Signed

E. Fink

Registrar:

Signed

p.o. P. Nafz

