

**TRADE MARKS ACT 1938 (AS AMENDED) AND
TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION No 1508329 BY
BRESSOR ALLIANCE TO REGISTER THE MARK
APERIFRAIS IN CLASS 29**

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER No 37747 BY FROMAGERIES BEL**

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**IN THE MATTER OF Application No 1508329
by Bressor Alliance to register the mark
APERIFRAIS in Class 29**

10 **and**

**IN THE MATTER OF Opposition thereto
under No 37747 by Fromageries Bel**

15

DECISION

20 Bressor Alliance applied under the Trade Marks Act 1938 on 3 August 1992 to register the
mark APERIFRAIS in Class 29 in respect of the following goods:-

Meat, fish, poultry and game; eggs, cheese, milk and milk products; all the
aforementioned goods being fresh; preserved, dried and cooked fruits and vegetables;
jellies, jams and compote; edible oils and fats; all included in Class 29.

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The application is opposed by Fromageries Bel on the following grounds:-

- 30 1. The opponents say that they are the registered proprietors of the marks
APERICUBE, No 1366358, and APERIT-CUBE LA VACHE QUI RIT,
No B977291. They say that the mark applied for is confusingly similar to their
registered marks and that the same goods or goods of the same description are
at issue. Thus registration of the mark applied for would offend the provisions
of Section 12(1) of the Act.
- 35 2. The opponents say they have used their marks and have a reputation in them.
Registration of the mark applied for would therefore be contrary to the
provisions of Section 11 of the Act.
- 40 3. The opponents ask the Registrar to exercise his discretion and refuse the
applicants' application.

Details of the opponents registered marks are as follows:-

No	Mark	Class	Specification
5	B977291 APERIT-CUBE LA VACHE QUI RIT	29	Cheese
	1366358	29	Milk, milk products and cheese, all included in Class 29

10 The applicants deny the opponents grounds of opposition. They also ask the Registrar to exercise his discretion in their favour.

Both sides ask for an award of costs.

15 The two sides filed evidence in these proceedings and the matter came to be heard on 16 April 1998 when the opponents were represented by Mr Michael Edenborough of Counsel instructed by D Young & Co and the applicants were represented by Mr Robert Onslow of Counsel instructed by Mewburn Ellis.

20 By the time this matter came to be heard, the Trade Marks Act 1938 had been repealed in accordance with Section 106(2) and Schedule 5 of the Trade Marks Act 1994. In accordance with the transitional provisions set out in Schedule 3 to that Act however, I must continue to apply the relevant provisions of the old law to these proceedings. Accordingly, all references in the later parts of this decision are references to the provisions of the old law.

Opponents' evidence

30 The opponents' evidence consists of a Statutory Declaration by Mr B Dufort who is their General Manager.

Mr Dufort explains that the APERICUBE mark in its present form has been in use since 1976 and before that in hyphenated form since 1960. It is used in relation to a cheese spread which is packaged in small cubes.

35 Sales throughout Europe and worldwide are said to total some £24.5 M in 1992, £24.7 M in 1993 and £101 M for the first six months of 1994. (I have assumed 10 French Francs to the £ in arriving at these figures.) A sample of monthly sales statistics is provided at Exhibit FB4 but these do not assist the opponents' case and I therefore ignore them.

40 Mr Dufort explains that their cheese product was first launched in the United Kingdom in 1974 under the mark PARTYCUBE and was re-launched in the United Kingdom in September, 1993 under the mark APERICUBE. Sales were through the Safeway supermarket chain and wholesalers and amounted to some 9.6 tonnes in 1993 and 2.4 tonnes (to date) in 45 1994.

Mr Dufort provides under Exhibit FB5 an illustration of the applicants' APERIFRAIS product and points to the fact that like his company's APERICUBE product, it is packaged in bite-sized portions and marketed as being an accompaniment to aperitifs. He expresses the opinion that a customer who encounters the respective products will regard the prefix as an indication of origin and assume that APERIFRAIS is merely a fromage frais version of his company's APERICUBE product. He also thinks the two marks are phonetically close.

Applicants' evidence

The applicants' evidence consists of a Statutory Declaration by Mr Jean-Michel Flu who is General Manager of the Patents and Trade Marks Department of Bongrain SA. This company is responsible for the Industrial Property matters of the applicants.

Mr Flu says that the applicants use their mark APERIFRAIS in relation to a flavoured full fat cheese with toppings. Sales commenced in the United Kingdom in October 1992 and have been continuous since that date. Annual sales since 1992 have been as follows:

	1992	£ 9,600
	1993	£ 530
20	1994	£ 6,899
	1995	£48,568.

Examples of promotional material are exhibited under JMF1 and sample invoices under JMF2.

Mr Flu says he is not aware of any confusion between the applicants' products sold under the mark APERIFRAIS and the opponents' products under their mark APERICUBE.

At JMF3 Mr Flu provides a letter from Mr Tim Rowcliffe, the Managing Director of Anthony Rowcliffe & Son Limited who are specialist importers of quality cheese. Mr Rowcliffe says he clearly understands the mark APERIFRAIS as denoting a product from the applicants and APERICUBE as denoting a product of the opponents.

Under Exhibit JMF4 Mr Flu provides details of a number of APER and APERI marks on the Register of Trade Marks. He draws particular attention to APERIMIX registered for goods including snack goods and APERILEGES for goods including savouries and snack foods.

At Exhibit JMF5 Mr Flu provides dictionary references to the effect that Aperitif which commences with the element APERI is used to denote a drink taken as an appetizer. Mr Flu says that the information provided under Exhibits JMF 3, 4, 5 and 6 support his belief that APERI is a non-distinctive element commonly used in the trade in relation to drinks or snacks which may be consumed as appetizers.

Mr Flu says he is also aware of a recent Decision made by the Paris Court of Appeal in a dispute between Fromageries Bel (the present opponent) and Flodor. Exhibit 7 is a copy of the Decision and an English language translation thereof. In that case an issue was whether

or not the trade mark APERICHIPS belonging to Flodor could co-exist with the registered trade marks APERI and APERICUBE belonging to Fromageries Bel. The Paris Court of Appeal confirmed the Judgement at first instance that (i) APERI evokes an aperitif; (ii) CHIPS and CUBE do not have the same meaning; (iii) APERICHIPS can co-exist with APERICUBE; and (iv) APERI should be cancelled for non-use.

Finally Mr Flu says that he believes sales of the opponents' products have not been substantial. Under Exhibits JMF8 to 14 he provides letters from a number of substantial supermarkets who confirm they do not sell products under the mark APERICUBE.

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Opponents' Reply Evidence

The opponents filed two statutory declarations dated 27 September 1996 by Ms Jacqueline M Lake and Mr David W Lake, both directors of Farncombe International Ltd, a specialist intellectual property investigation company.

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Both declarants describe in detail the steps taken to establish that the two marks mentioned by the applicants as being on the Register of Trade Marks in the United Kingdom APERIMIX and APERILEGES are not in use in relation to the sale of any goods in the United Kingdom marketplace.

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Mr Lake also conducted a further investigation to establish use of the terms FRAIS and APERI in the United Kingdom marketplace. No use of APERI was found but it was established that a number of products are sold under marks containing the term "Fromage Frais".

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A further statutory declaration dated 3 October 1996 is provided by Ms Louise Westbury, a registered trade mark agent employed by D Young & Co, the opponents' trade mark agents.

Ms Westbury refers to the commemoration booklet exhibited by Mr Dufort under Exhibit FB3. She provides a copy of the booklet and a certified translation thereof under Exhibit LW1. Under Exhibit LW2 Ms Westbury provides extracts from the New Shorter Oxford English Dictionary (1993) and the Larousse Gastronomique Cookery encyclopaedia (1995). She says that these extracts illustrate that there is no foundation for the assertion that the prefix APERI is one commonly used in the trade in relation to appetisers and also that FRAIS (solus) has no meaning.

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Finally Ms Westbury says that she has been advised by the opponents' French trade mark agents that they have filed, on behalf of the opponents, an appeal against the decision of the German Patent Office who had apparently decided that APERIFRAIS and APERICUBE were not confusingly similar. I add here that details of the German Patent Office decision have not been filed in these proceedings.

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That completes my review of the evidence filed in these proceedings and I now turn to consider the grounds of opposition under Sections 11 and 12 of the Act. These sections read as follows:

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11 It shall not be lawful to register as a trade mark or part of a trade mark any
matter the use of which would, by reason of its being likely to deceive or cause
confusion or otherwise, be disentitled to protection in a court of justice, or would be
contrary to law or morality, or any scandalous design.

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12 (1) Subject to the provisions of subsection (2) of this section, no trade
mark shall be registered in respect of any goods or description of goods that is
identical with or nearly resembles a mark belonging to a different proprietor and
already on the register in respect of:-

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a. the same goods

b. the same description of goods, or

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c. services or a description of services which are associated with those
goods or goods of that description.

The references in Section 12(1) to a near resemblance is clarified by Section 68(2B) of the Act
which says that references in the Act to a near resemblance of marks are references to a
resemblance so near as to be likely to deceive or cause confusion.

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The established tests for objection under Sections 11 and 12 are set down in Smith Hayden &
Co Ltd's application (volume 1946) 63 RPC 101 and, in the case of Section 11, as adapted by
Lord Upjohn in the BALI trade mark case 69 RPC 496. Adapted to the matter in hand the
tests may be expressed as follows:

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(a) (under Section 11). Having regard to the user of the mark APERICUBE is the
tribunal satisfied that the mark applied for, APERIFRAIS if used in a normal and
fair manner in connection with any goods covered by the registration proposed will
not be reasonably likely to cause deception and confusion amongst a substantial
number of persons?

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(b) (under Section 12). Assuming user by the opponents of their marks
APERICUBE and APERIT-CUBE LA VACHE QUI RIT in a normal and fair
manner for any of the goods covered by the registration of that mark, is the tribunal
satisfied that there will be no reasonable likelihood of deception among a number of
persons if the applicants use their mark APERIFRAIS normally and fairly in respect of
any goods covered by their proposed registration?

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40 I deal first of all with the ground of opposition under Section 11 of the Act. It would appear
that the opponents first launched their product in the United Kingdom under the mark
PARTYCUBE in 1974 and that a re-launch under the mark APERICUBE did not occur until
September, 1993. This was after the relevant date of these proceedings which is 3 August,
1992 and after the applicants commenced to use their mark in October 1992. As it would
appear that the opponents had no user prior to the relevant date they must fail in their ground
of opposition under Section 11 and I so find.

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I now turn to the ground of opposition under Section 12(1). At the outset it is clear that the respective specifications cover the same goods so the only matter to be decided is whether or not the respective marks are confusingly similar. For the benefit of readers the respective marks are as follows:

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Applicants' mark

Opponents' mark

APERIFRAIS

APERICUBE

10 I add here that it was accepted at the hearing that if the opponents could not succeed in respect of Registration 1366358 their position is no better in respect of Registration 977291. For simplicity therefore I decide this case on a comparison of the two marks displayed here.

15 In comparing the respective marks I use the established tests propounded by Parker J in Pianotist Co's application (1906) 23 RPC at page 777 line 26 et seq:

20 "You must take the two words. You must judge of them both by their look and by their sound. You must consider the goods to which they are to be applied. You must consider the nature and kind of customer who would be likely to buy those goods. In fact, you must consider all the surrounding circumstances; and you must further consider what is likely to happen if each of these trade marks is used in a normal way as a trade mark for the goods of the respective owners of the marks. If, considering all those circumstances, you come to the conclusion that there will be a confusion - that is to say - not necessarily that one will be injured and the other will gain illicit benefit, 25 but that there will be a confusion in the mind of the public, which will lead to confusion in the goods - then you may refuse the registration, or rather you must refuse the registration in that case."

30 In this case as imperfect recollection could be a factor I also bear in mind the judgement of Luxmore L J. which was approved by the House of Lords, in the Aristoc Ltd v Rysta Ltd case [1945] 62 RPC at page 72 line 46 to page 73 line 4 where he says:

35 "The answer to the question whether the sound of one word resembles too nearly the sound of another so as to bring the former within the limits of Section 12 of the Trade Marks Act 1938 must nearly always depend on first impression, for obviously a person who is familiar with both words will neither be deceived nor confused. It is the person who only knows the one word and has perhaps an imperfect recollection of it who is likely to be deceived or confused. Little assistance therefore is to be obtained from meticulous comparison of the two words, letter by letter and syllable by 40 syllable pronounced with the clarity to be expected from a teacher of elocution. The court must be careful to make allowance for imperfect recollection and the effect of careless pronunciation and speech on the part not only of the person seeking to buy under the trade description, but also of the shop assistant ministering to that person's wants."

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As might be expected the evidence filed in these proceedings shows that the opponents' mark is used in relation to goods sold in cube shaped packaging so that any distinctiveness which resides in their mark falls on the APERI element. In the case of the applicants' mark the position is less clear-cut but the term "Fromage Frais" is well known in the United Kingdom in relation to cheese and I believe that a significant number of customers would recognise "FRAIS" in the applicants' mark in that context. If this occurs then the APERI element of the applicants' mark would be seen as its distinguishing feature. If that is indeed the case then it follows that the respective marks are similar, indeed confusingly similar, and that I should find in favour of the opponents in their ground of opposition under Section 12(1) of the Act.

At the hearing Mr Onslow made a number of submissions about surrounding circumstances which he believed should allow his client's mark to proceed to registration.

The first of such submissions was based on the fact that the applicants had commenced to use their mark in the United Kingdom before the opponents commenced to use their registered mark. In this situation he asked me to speculate what might occur should I refuse his client's mark and the opponents sued for infringement of their registered mark. Mr Onslow forecast stalemate whereas Mr Edenborough was confident that his clients, the opponents, would be successful. Whatever might be the outcome I am not prepared to speculate as to what might happen in the future depending on the decision I reach here. That will be a matter for the parties in due course.

A second matter raised by Mr Onslow is that the opponents' mark was registered in the face of other APERI marks which remain on the Register and which could be brought into use in the future. I accept that this is the case. While the opponents have established at this point in time that the APERIMIX and APERILEGES marks are not in use in the marketplace they have, as far as I am aware, taken no active steps to remove these marks for the Register. Mr Edenborough said his clients had made a commercial decision on the grounds that as the marks are not in use there is no likelihood of confusion at this time. If the situation changed then his clients would have to decide what action to take to protect their position. I have considered this point carefully but again it appears to me that I should not speculate what might happen in future. I must decide these proceedings based on the evidence before me and, as matters stand, only these two parties' marks are in use in the marketplace and the question of confusion between the marks must be addressed in that context.

Finally there is the question as to what APERI means to the average United Kingdom purchaser of cheese? Despite the claims made by the applicants in their written evidence, and the submissions made by Mr Onslow at the hearing, I do not accept that APERI indicates the words "Aperitif" or "Appetiser" in relation to cheese or cheese products. Nor do I believe that even if I find for the opponents in these proceedings I will be giving them monopoly rights in the element APERI. Any finding in this case is based on a comparison of the marks before me and does not mean that a different finding could not arise in the future if different marks are being compared.

Having looked at the surrounding circumstances I return to a comparison of the respective marks. When I first encountered the marks I thought them very similar indeed. They are the same length, have a significant portion in common and have descriptive or semi descriptive suffixes. In short I think the marks APERICUBE and APERIFRAIS are confusingly similar.

5 It is my belief that a significant portion of the British public would also find the marks confusingly similar and when one takes imperfect recollection into account would either associate the two marks and thus be confused as to origin of the respective goods or indeed mistake one mark for the other. In conclusion therefore, I find the opponents successful in their opposition under Section 12(1) of the Act.

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There remains the Registrar's discretion but as I have found for the opponents under Section 12(1) of the Act no exercise of the Registrar's discretion is appropriate.

15 Finally, there was one other matter in the evidence on which I sought clarification from the opponents' agents. In the evidence of Mr Dufort he referred to the sale of 9.6 tons of cheese in 1993 and 2.4 tons in 1994. Such figures have no meaning for the tribunal or indeed anyone else at the hearing when I sought clarification. I therefore asked that such sales should be expressed in £'s and allowed fourteen days for this to be done. This clarification has no impact whatsoever on this decision.

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As the opponents have been successful in these proceedings they are entitled to a contribution to their costs. I hereby order the applicants to pay to the opponents the sum of **£735**.

25 Dated this 30th day of April 1998

N A HARKNESS
Assistant Registrar of Trade Marks
For the Registrar
30 **the Comptroller General**