

1 THE PATENT OFFICE

2 Tribunal Room 2
3 Harmsworth House
4 13-15 Bouverie Street
5 London EC4Y 3DP

6 Wednesday, 12th July 2006

7 Before:

8 MR. GEOFFREY HOBBS QC
9 (Sitting as the Appointed Person)

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11 In the Matter of the Trade Marks Act 1994

12 -and-

13 In the Matter of Trade Mark Application No: 2339224
14 in the name of
15 COMPASS GROUP HOLDINGS PLC

16 - - - - -

17 Appeal from the decision of Mr. M.J. Layton, acting on behalf
18 of the Registrar, dated 16th February 2006.

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20 (Transcript of the Shorthand Notes of
21 Marten Walsh Cherer Ltd.,
22 Midway House,
23 27-29 Cursitor Street,
24 London EC4A1LT.
25 Telephone No: 020 7405 5010. Fax No: 020 7405 5026.)

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27 MR. IAN SILCOCK (instructed by Messrs. Marks & Clerk) appeared
28 as Counsel on behalf of the Appellant/Applicant.

29 MR. ALLAN JAMES appeared on behalf of the Registrar.

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31 D E C I S I O N
32 (Approved by the Appointed Person)

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1 THE APPOINTED PERSON: In Annex A to this decision, I set out
2 details of trade mark application number 2339224, filed in
3 the name of Compass Group Holdings Plc on 30th July 2003,
4 together with details of the five earlier trade mark
5 registrations which have been found to render the application
6 for registration unacceptable in Classes 29, 30, 32 and 43 on
7 ex officio examination under section 5(2)(b) of the Trade
8 Marks Act 1994.

9 The reasons for refusal of registration were given by
10 Mr. M. J. Layton, acting on behalf of the Registrar, in a
11 written decision issued on 16th February 2006 (BL O-052-06).
12 The Hearing Officer held that the word GUSTO was the leading
13 and dominant feature of the mark applied for and that the same
14 was true of each of the earlier trade marks cited in support
15 of the objection under section 5(2)(b).

16 He went on to hold that between them, the earlier trade
17 marks covered goods and services that were either identical
18 or similar to those covered by the application for
19 registration in Classes 29, 30, 32 and 43.

20 On assessing the earlier registrations in relation to
21 the application for registration, he concluded that there
22 were in each case similarities in terms of marks and goods or
23 services that would combine to give rise to the existence of
24 a likelihood of confusion if the marks in question were used
25 concurrently in the United Kingdom in relation to goods or

1 services of the kind for which they were respectively
2 registered and proposed to be registered.

3 In doing so, he rejected the contention advanced on
4 behalf of the applicant for registration that the word GUSTO
5 possessed only a low degree of distinctiveness, being simply
6 the Italian word for taste, and the further contention that the
7 mark applied for should therefore be regarded as sufficiently
8 differentiated from each of the marks cited against it to be
9 unobjectionable on all counts under section 5(2)(b).

10 The Hearing Officer addressed these contentions in the
11 following terms:

12 "16. The agent submitted at the hearing that the term
13 GUSTO is relatively low in distinctive character as it
14 is the Italian word for taste and that significant
15 differences in presentation between the marks would
16 therefore be sufficient to prevent a likelihood of
17 confusion arising in relation to the goods and
18 services at issue. I do not agree with this view.
19 GUSTO is a word with its own distinct meaning in the
20 English language. The Collins English Dictionary (5th
21 Edition first published 2000) defines the word as a
22 noun denoting "vigorous enjoyment, zest, or relish,
23 esp. in the performance of an action, e.g. the aria
24 was sung with great gusto. [C17: from Spanish: taste,
25 from Latin gustus a tasting; see] gestation." This

1 meaning of the term GUSTO is distinctive for all the
2 goods and services detailed in relation to the marks.
3 I consider that it is this English Definition of the
4 term which is liable to predominate in the minds of
5 average UK consumers encountering the marks. I
6 consider that this may also be the case even for those
7 consumers within the UK who may be aware that the term
8 GUSTO has a different meaning in the Italian or
9 Spanish language.

10 17. In the event that this view is incorrect, it may
11 be helpful to further consider the registrability of
12 the term GUSTO when assessed as a non-English word.
13 It is not the usual practice of the Registrar to
14 object to a non-English word if the equivalent
15 translation in English would be merely devoid of
16 distinctive character under Section 3(1)(b) of the
17 Act. I do not consider that the mark would be liable
18 to objection under Section 3(1)(c) of the Act as the
19 statement GUSTO, meaning taste in Italian or Spanish,
20 does not designate a characteristic of the goods or
21 services covered by the specification of the
22 application. Even if there is a basis for considering
23 the English equivalent term taste to be objectionable
24 under Section 3(1)(c), following the European Court of
25 Justice's (ECJ) reasoned order in case C-3/03,

1 Matratzen Concord GmbH v. OHIM and the decision of
2 Geoffrey Hobbs QC as the Appointed Person in
3 GA Modefine S.A v Di Gio Srl, [BL 0-253-06], it
4 appears that 'there is no real room for refusing to
5 register word marks on the grounds that they are
6 relevantly descriptive in the languages of other
7 Member States.' Consequently, it is not appropriate
8 for the Registrar to object to the registration of
9 word marks which are descriptive of characteristics of
10 the goods or services in the application under Section
11 3(1)(c) of the Act if the descriptive meaning of the
12 word is unlikely to be understood by the relevant
13 average UK consumer. That average consumer is deemed
14 to be reasonably well informed and reasonably
15 observant.

16 The relevant UK consumers are the persons who are
17 likely to be customers or end users of the goods or
18 services at issue. Whilst Italian and Spanish are
19 amongst the most commonly understood languages in the
20 UK, I do not consider that the term GUSTO is so
21 commonly used in Italian or Spanish in the UK that it
22 may be assumed that average consumers of goods and
23 services such as foodstuffs, beverages and restaurant
24 services would be aware of its meaning. Even if some
25 UK consumers are aware that the term GUSTO has a

1 different meaning in the Italian or Spanish language,
2 it is liable to be perceived according to its meaning
3 in English and will therefore be regarded as a
4 distinctive sign in relation to the goods and services
5 under consideration.

6 18. The English meaning of the word GUSTO does not
7 serve as a natural description for the goods and
8 services under consideration. Nor does the term serve
9 as an allusion to the quality or nature of such goods
10 and services. I therefore consider the term GUSTO to
11 be highly distinctive when applied to the goods and
12 services under consideration.

13

14 22. At the hearing Ms Melling submitted that GUSTO is
15 the Italian word for taste and therefore relatively
16 low in terms of distinctive character for the
17 specified goods and services. Ms Melling argued that
18 where significant differences in presentation existed
19 this would therefore be sufficient to prevent a
20 likelihood of confusion arising. I cannot agree with
21 this interpretation of the earlier trade marks. I
22 consider that the term GUSTO is distinctive in respect
23 of the marks at issue for the reasons detailed in
24 paragraphs 16 to 18 above. It is long established in
25 case law that where a mark comprises a combination of

1 a distinctive word and device it is the word element that
2 is liable to be perceived as the dominant distinctive
3 component by average consumers encountering the marks. In
4 the case of mark number 1452381 and word GUSTO is the sole
5 mark element. In the case of Community Trade Mark numbers
6 1987684 and 2930303 the marks each consist essentially of
7 the word GUSTO with a minimal degree of presentation, as
8 detailed in paragraph 15 above. The word GUSTO also
9 predominates as the most distinctive and memorable
10 element within mark number 2060582 and Community Trade
11 Mark number 1410430. The oval border present in mark
12 number 2060582 serves to add prominence to the word
13 GUSTO, which predominates in the mark as the dominant
14 distinctive component, with the words ITALIAN FOR
15 TASTE appearing in a smaller script in upper case
16 below. Mark number 1410430 consists of the word GUSTO
17 presented prominently in a stylised form against an
18 oval background contained within a rectangle. A small
19 device appears above the letter 'u' in the word GUSTO
20 with the word ITALIANO appearing in a smaller script
21 beneath.

22 23. The applicant's mark comprises the word GUSTO
23 presented in lower case with a line beneath. A
24 '+' device and a blue and green representation of a
25 wing or leaf device appear at the end of the mark.

1 (The applicant claims the colours dark blue (Pantone
2 7462), light blue (Pantone 299) and green (Pantone
3 7489) as an element of the mark.) Visually, while
4 there are perceptible differences in the presentation
5 of the term GUSTO in the applicant's mark when
6 compared to the earlier registered marks, the word
7 GUSTO nonetheless serves as the dominant distinctive
8 element within the mark. I therefore consider the mark
9 to be conceptually and aurally identical to the
10 dominant GUSTO element of the earlier trade marks and
11 visually very similar.

12 24. For the reasons set out above I consider that
13 GUSTO is a distinctive term in relation to the goods
14 and services under consideration. Given that the word
15 GUSTO is the dominant distinctive component in each of
16 the marks under consideration I have concluded that
17 there is a high degree of similarity when comparing
18 the applicant's mark to the earlier marks. Each of the
19 marks is liable to be perceived and recalled by
20 average consumers encountering the marks as indicating
21 GUSTO as the source of origin for goods and/or
22 services supplied under the marks."

23 Separately, in relation to the application for
24 registration in Class 35, the Hearing Officer adopted the
25 following position:

1 "No objection was raised in relation to Class 35 at the
2 time of Examination, although I must now note that the
3 specification submitted in respect of Class 35 is no
4 longer acceptable under the terms of the Registrar's
5 revised examination and classification practice in
6 respect of retail services (notified under Practice
7 Amendment Notice 6/05, issued on 11th November 2005)."

8 I understand that he adopted that position in his
9 decision without prior warning to the applicant for
10 registration and, accordingly, without giving it an opportunity
11 to be heard on the point under Rule 54 of the Trade Marks
12 Rules 2000. He gave no further reasons for rejecting the
13 application in Class 35.

14 On 16th March 2006, the applicant for registration gave
15 notice of appeal to an Appointed Person under section 76 of
16 the Act contending, in substance, that the Hearing Officer
17 had exaggerated the power of the word GUSTO to individualise
18 goods or services of the kind in issue to a single
19 undertaking. This was said to have led him to conclude wrongly
20 that the application was objectionable under section 5(2)(b)
21 whereas, on a correct assessment of the position, he ought to
22 have found that none of the earlier trade mark registrations
23 was an obstacle to acceptance of the application for
24 registration in the classes I have identified.

25 In relation to the application for registration in

1 Class 35, it was contended that the objection was
2 procedurally irregular for lack of prior notice to the
3 applicant and, in any event, unmaintainable on the basis on
4 which the Hearing Officer sought to sustain it. I do not
5 need to go any further into the status of the application in
6 Class 35. It stands accepted that the application in that
7 class will be remitted to the Registrar for further
8 processing in accordance with the Act and the Rules.

9 The proposition advanced in support of the main part of
10 the appeal is that there is room on the register for another
11 GUSTO trade mark in relation to goods and services of the
12 kind now under consideration. The basis for saying so is
13 essentially as follows. The earlier trade marks should be
14 taken to be validly registered. In order to be validly
15 registered, they must be usable concurrently, in the United
16 Kingdom, for goods and services of the kind covered by the
17 pertinent registrations, without giving rise to the existence
18 of a likelihood of confusion. Assuming that to be true, it can
19 only be true on the basis that the earlier trade marks are
20 distinctive in and of themselves and also distinctively
21 different from one another, notwithstanding the fact that they
22 are all likely to be recognised and remembered by reference
23 to one and the same element, i.e. the word GUSTO. I
24 understand it to be submitted that the most rational explanation
25 for that must be the inherently low degree of distinctiveness

1 possessed by the word GUSTO.

2 In order to appreciate the symmetry and logic of this
3 argument, it is necessary to have detailed knowledge of the
4 state of the register relating to GUSTO marks in the relevant
5 classes and a clear understanding of the legal test for
6 determining whether there is or is not a likelihood of
7 confusion. However, these are not attributes which I am able to
8 project on to the average consumer of the goods and services
9 concerned. I must simply take account of the position of the
10 average consumer in the relevant commercial setting, represented
11 by notional and fair use of the mark applied for in relation to
12 the goods and services specified by the applicant, taking place
13 concurrently with notional and fair use of each earlier trade
14 mark taken in turn.

15 When assessing the distinctiveness of the word GUSTO,
16 it is not appropriate to apply anything in the nature of a
17 discount for quantity based on the number of citations that
18 need to be considered. The hurdles do not get lower the more
19 of them there are to be jumped.

20 It follows in my view that the Hearing Officer adopted
21 the correct approach to the objection he was considering. I
22 think he reached the right conclusion for the right reasons,
23 and the appeal relating to the refusal of registration in
24 Classes 29, 30, 32 and 43 will therefore be dismissed.

Annex A

1. UK Trade Mark Application 2339224 (filed 30 July 2003)



Class 29

Meat and meat products; fish and fish products; seafood and seafood products; poultry and poultry products; game and game products; ready prepared meals; preparations for making meals; sausages; burgers; hot dogs; preserved, dried, canned and cooked fruits and vegetables and preparations made therefrom; vegetarian foods; prepared vegetables; potatoes and foods made predominantly from potatoes; snack foods; prepared meals; salads; soups; pastes; pates; fillings and spreads; dairy products; cheese; yoghurts; yoghurt based products; milk; milk beverages; milk based products; soya milk; desserts; puddings; eggs; edible oils and fats; nuts; preparations for making meals from all the aforesaid goods.

Class 30

Prepared meals; hot and cold snacks; pizzas and pizza products; rice and rice products; pasta and pasta products; pasta dishes; noodles and noodle dishes; savoury pastries; cheese puffs; quiches; pies; flans; tarts; bakery products; bread; rolls; filled rolls; sandwiches; baguettes; filled baguettes; cakes; buns; pastries; biscuits; croissants; muffins; cookies; brownies; doughnuts; chocolate and chocolate confections; confectionery; ices; ice cream; ice cream products; sorbets; sherberts; frozen confections; puddings; desserts; cereals and cereal preparations; snack bars; crisps; chips; pretzels; preparations made from flour; whole and ground coffee; coffee beans; coffee extracts; coffee essences; mixtures of coffee and chicory; artificial coffee; coffee substitutes; syrups for making coffees; coffee flavourings; coffee based beverages; tea; cocoa; drinking chocolate; artificial drinking chocolate; artificial hot chocolate; salad dressings; mayonnaise; dips; spreads; sago; tapioca; spices; seasonings; honey; treacles; condiments and sauces; chewing gum; bubble gum.

Class 32

Non-alcoholic beverages; non-alcoholic drinks and preparations for making such drinks; fruit juices and vegetable juices; fruit flavoured beverages; mineral and aerated waters; water; spring water; flavoured water; soft drinks, sparkling drinks; concentrates for making such drinks.

Class 35

The bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase those goods on board aircraft; information and advisory services relating to all the aforesaid.

Class 43

Catering services; provision of trolley services for food, snacks and drinks; restaurant, cafe, cafeteria, snack bar and coffee shop services; preparation of foodstuffs or meals or beverages; advice relating to food and drink.

2. UK Trade Mark Registration 1452381 (filed 10 December 1990, registered 10 July 1992)

GUSTO

Class 32

Mineral waters, aerated waters; non-alcoholic beverages; fruit drinks and fruit juices; syrups and preparations for making beverages; beverages containing not more than 1.2% alcohol by volume; all included in Class 32.

3. UK Trade Mark Registration 2060582 (filed 9 March 1996, registered 11 October 1996)



ITALIAN FOR TASTE

Class 30

Bakery items such as savoury biscuits, breads, cookies, tarts and candy; ice creams; pasta and pasta sauces.

4. Community Trade Mark 1410430 (filed 3 December 1999, registered 1 December 2000)



Class 42

Food services and providing of food and drink, catering, bar, snack-bar included in this class.

5. Community Trade Mark 1987684 (filed 7 December 2000, registered 11 April 2005)



Class 30

Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery, ices; honey, treacle; yeast, baking-powder; salt, mustard; sauces (condiments); spices; ice.

Class 42

Providing of food and drink; hotels, saunas, beauty centres, computer software consultancy, catering.

6. Community Trade Mark 2930303 (filed, registered)

GÛSTO

Class 33

Wines.

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