

O-235-09

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO 2447920  
BY SCOFF FOOD LIMITED**

**TO REGISTER A SERIES OF THREE TRADE MARKS:**

**SCOFF**      **scoff**      **SCOFF**

**IN CLASSES 29, 30, 31, 32, 39 AND 43**

**AND**

**THE OPPOSITION THERETO  
UNDER NO 96283  
BY MINISCOFF LTD**

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by Scoff Food Limited  
to register a series of three trade marks:**

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and the opposition thereto  
under no 96283  
by Miniscoff Ltd**

***Background***

1) On 27 February 2007 The Eat Drink & Be Merry Pub Co Ltd applied to register the above trade marks. Subsequent to this the applicant changed its name to Scoff Food Ltd (SFL). The application was published for opposition purposes on 16 November 2007 with the following specification:

*hot and cold prepared meals and drinks and snacks containing either entirely or in part meat, fish, poultry and game, meat extracts, preserved and dried and cooked fruit and vegetables, eggs, milk and milk products, edible oils and fats, raw meat;*

*bread, pastry, puddings (containing flour eg treacle sponge, sticky toffee pudding), puddings generally ice cream, custard, cream, hot and cold prepared meals and snacks whose main ingredients are in this class;*

*fresh fruit and vegetables, seeds (edible);*

*non-alcoholic drinks, fruit drink, and fruit juices, syrups and other preparations for making drinks;*

*packaging of food items, prepared and raw for resale, transport of hot and cold food/ready meals, delivery of ready meals of food direct to consumers;*

*catering services for providing food and drink, cafe services, mobile catering services.*

The above goods and services are in classes 29, 30, 31, 32, 39 and 43 (respectively) of the Nice Agreement concerning the International Classification

of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

2) On 15 February 2008 Miniscoff Ltd (ML) filed an opposition to the registration of the trade mark. ML bases its opposition on section 5(2)(b) of the Trade Marks Act 1994 (the Act). According to section 5(2)(b) of the Act a trade mark shall not be registered if because:

“it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

The earlier trade mark upon which ML relies is **miniscoff**. This trade mark is the subject of United Kingdom trade mark registration no 2232910. The application for registration was made on 17 May 2000 and the registration process was completed on 8 December 2000. Consequently, the trade mark is subject to the proof of use requirements. The trade mark is registered for the following goods:

*foodstuffs and beverages for infants and invalids;*

*meat, and meat products, poultry, poultry products, all for food for human consumption; prepared meals and constituents for meals; snack foods; preserved, dried, cooked and processed fruit and vegetables and preparations made therefrom; potato and potato products; yoghurts, desserts comprising of yoghurt and fruit; milk, milk drinks, flavoured milk drinks, cheese and dairy products; and dairy desserts; preparations all for use as desserts and puddings; soups and preparations for making soup; jellies, jams, fruit sauces; all included in Class 29;*

*rice, tapioca, sago and preparations made therefrom; flour and preparations made from cereals; pasta and pasta products; bread, pastry and confectionery; ices; puddings and desserts; honey, treacle; sauces; and biscuits, cookies; cereals and cereal preparations; chocolate, chocolate cakes and non-medicated confectionery; ice cream, chilled desserts, mousses, sorbets and frozen preparations.*

*mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages.*

The above goods are in classes 5, 29, 30 and 32 (respectively) of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

3) ML claims that during the five year period ending on the date of the publication of the application, ie up to and including 16 November 2007, it made genuine use of its trade mark in respect of all of the goods for which its trade mark is registered. It claims that its goods are identical or similar to the class 29, 30 and 32 goods of the application. It claims that the goods of the application in class 31 are similar to *prepared meals and constituents for meals; snack foods; preserved, dried, cooked and processed fruit and vegetables and preparations made therefrom; potato and potato products; preparations all for use as desserts and puddings*. It claims that the services of the application are similar to its goods as they are closely linked to and ancillary to these goods.

4) SFL filed a counterstatement. It denies that the respective trade marks are similar. It requires ML to supply proof of use of its trade mark. It denies that the respective goods and services are identical or similar.

5) Both parties filed evidence. They were advised that they had a right to a hearing and that if neither party requested a hearing a decision would be made from the papers and any written submissions that were received. Neither side requested a hearing nor filed written submissions. However, the counterstatement explains why SFL does not consider the respective trade marks similar. Both parties have also included submissions in their evidence. I bear in mind the explanation and submissions in making this decision.

#### ***Main evidence of ML***

6) This consists of a witness statement by Mr Angus Oliphant. Mr Oliphant is co-founder and director of ML.

7) Mr Oliphant states that ML uses its trade mark in relation to children's food for restaurants and prepared meals and snacks for children for retail purposes. Mr Oliphant exhibits at AO1 a customer list and turnover figures, these are allocated by years. The list includes figures and customers for 2007 and 2008, however, the period for proof of use ends on 15 November 2007. Turnover for the years 2004 to 2007 was £231,789, £359,049, £474,890 and £459,148 respectively. Taking into account the earlier turnover figures and a continuity of various purchasers, it is reasonable to accept that a good part of the 2007 figures will have occurred prior to 16 November 2007. Even if this were not the case, little turns upon this matter in terms of what use is shown. Mr Oliphant notes that ML's clients include Center Parcs, Stena Line, Tootsies Restaurants, Ocado Ltd and Virgin Active Health Clubs.

8) Exhibited at AO2 are copies of invoices, these all bear the name miniscoff in an oval (underneath this "great food for children" appears), some of the invoices are also headed "Miniscoff Invoice". The invoices are for 19 November 2004, 21 December 2004, 7 December 2004, 22 February 2005, 26 October 2005, 17 February 2005, 11 July 2006, 9 October 2006, 1 March 2006 and 11 January

2006. They are made out to Brakes, Center Parcs, Hensons Foods Ltd, Rainforest Café, Stena Line, Natural Retail Limited and Daisy & Tom. The products on the invoices are: shepherd's pies, "mash bang wallop", spaghetti, spaghetti and meatballs, ham and cheese pasta, sweet chicken noodles, "curly wurly" chicken, spaghetti and meatballs with peas, sweet vegetable noodles, salmon pasta, "chill yum yum", pork and beef spears, salmon ocean pie and spaghetti Bolognese. Certain of the invoices also list "[s]eparate component codes" for various products, such as rice, however, no costs or quantities are given so it is not possible to conclude that these products have been sold.

9) Copies of various press articles are exhibited at AO3.

- *The Times Weekend* for Saturday 20 May 2000. An article that gives the background to the business. The products supplied are prepared meals for children using organic products. The goods are described as MINISCOFF.
- *Living South* of June 2000. This is an advertorial promoting MINISCOFF prepared meals. It is headed "Scoff for mini people".
- *The Hill Magazine* of July 2000. This is an advertorial promoting MINISCOFF prepared meals. The meals are described as being organic and for children.
- *SW Magazine* of July 2000. This is an advertorial promoting MINISCOFF prepared meals. It is headed "Scoff for mini people".
- *Bath Chronicle* of May 2004. An article on MINISCOFF prepared meals for children.
- *Business 550* for June 2004. An interview with Mr Oliphant. The article has a subheading referring to organic meals for the under 5s.
- *West Country Life* for July 2004. The article includes an interview with Mrs Oliphant. A packet bearing miniscoff in an oval can be seen. The article refers to Mr and Mrs Oliphant running a business supplying organic children's ready meals to restaurants and delicatessens.
- *Junior* for March 2005. A review of MINISCOFF meals.
- *OFM (Observer Food Monthly?)* for August 2005. An article of organic food for children. In the subheading it refers to "fresh organic baby food". Various brands are referred to. MINISCOFF products are described as being for children from 12 months to 12 years. The products are described as being ready to serve organic meals.
- *City AM* of 10 October 2005. The photocopy does not allow most of the print to be read. However, the article clearly refers to MINISCOFF organic meals for children.
- *Artisan* of December 2005. The article states that ML offers 18 types of prepared meals and snacks.
- *Practical Parenting* of January 2006. This article relates to Ms Oliphant winning the Business Parent of the Year Award for 2006.
- *Mother & Baby* of January 2006. The article refers to Ms Oliphant being "business mum of the month". The article refers to MINISCOFF being a

- range of ready-to-serve organic meals aimed at toddlers and young children.
- *Food Manufacturer* of April 2006. The article refers to the increase in the size of ML's business. MINISCOFF is described as a manufacturer of organic children's ready meals.
  - *Sunday Express* of 4 June 2006. The business is described as providing organic children's food for restaurants and organic prepared meals for retail. Products bearing MINISCOFF in an oval can be seen.
  - *Practical Parenting* of January 2007. This shows that MINISCOFF organic "Chilli Yum Yum" was highly commended in the *Practical Parenting* awards for 2007.
  - *Fresh* of September 2007. The article refers to MINISCOFF producing children's organic ready meals.

10) Exhibited at AO4 are photographs of ML's presence, promoting MINISCOFF, at exhibitions and festivals: Organic Food and Wine Festival in 2003, Speciality and Fine Food Fair of 2004, Food Expo of 2006 and IFE of 2007. MINISCOFF appears in all of the pictures. In the last three pictures the stands refer to "pure scoff" or "the right scoff". (A picture of the stand at Food Expo of 2008 is also exhibited, which is after the material date.)

11) Mr Oliphant goes on to make various submissions in relation to the similarity of the trade marks and the goods and services. I bear these submissions in mind but will not comment further upon them as they are not evidence of fact.

### ***Evidence of SFL***

12) This consists of a witness statement by Mr Stephen Mark Rushton who is the chief executive officer of SFL.

13) Parts of the evidence can be categorised as submission rather than evidence of fact and so I will say no more about these parts but bear them in mind in reaching my decision.

14) Mr Rushton describes his business, which was established in October 2006 and has used the trade mark since May 2007. It is a take-away/home delivery food service which has outlets in Fulham and Kingston. I cannot see that this has a bearing upon this case. I have to consider the specification of the application and the specification of the earlier trade mark that I decide is appropriate on the basis of the proof of use that has been supplied. It has been stated on a number of occasions that concurrent trading is seldom indicative of whether there would not be a likelihood of confusion. This is the case here owing to the distance between the actual trade and the goods of the application, the limited geographical area and the different channels of trade. Alan Steinfield QC, sitting as a deputy judge of the High Court, in *Fiorelli Trade Mark* [2007] RPC 18 gave weight to an absence of confusion in the market place. However, he was

not referred to the authorities in regard to this matter: the Court of Appeal in *The European Ltd v. The Economist Newspaper Ltd* [1998] FSR 283 at p 291, Laddie J in *Compass Publishing BV v. Compass Logistics Ltd* [2004] RPC 41 at p 809 and the Court of Appeal in *Phones 4U Ltd v. Phone 4u. co. uk Internet Ltd* [2007] RPC 5 at paragraphs 42 to 45.) The matter was succinctly summed up by Millet LJ in the first case:

“Absence of evidence of actual confusion is rarely significant, especially in a trade mark case where it may be due to differences extraneous to the plaintiff’s registered trade mark.”

(It is to be noted that in *Rousselon Freres et Cie v Horwood Homewares Limited* [2008] EWHC 881 (Ch) Warren J accepted the position that Laddie J adopted in *Compass Publishing BV v. Compass Logistics Ltd*<sup>1</sup>.) So Mr Rushton’s statement that ML has not referred to any instances of confusion is not indicative of whether there would be a likelihood of confusion when considering the respective specifications. It is also now trite law that the current marketing strategies of a party are not relevant to the considerations under section 5(2)(b) of the Act<sup>2</sup>.

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<sup>1</sup> “98. As to c. (he wrongly considered that the absence of actual evidence of confusion was determinative of the answer to the question as to whether there was a likelihood of confusion under section 5(2) TMA), it is true that Mr Foley relies on parallel trading, citing the passage from *Fiorelli* which I too have set out at paragraph 26 above. From paragraph 74 of the Decision it is clear that Mr Foley does not regard concurrent use as necessarily determinative but sees it as one of the factors to be taken into a global appreciation of a likelihood of confusion. On the evidence, he finds that there is clear unchallenged evidence of parallel trading by the use of JUDGE SABATIER and STELLAR SABATIER over many years and seems to regard that, on the facts of the present case, as at least a very important, if not an overwhelming, factor: he adopts “the proof of the pudding is in the eating” approach adopted by Mr Steinfeld in *Fiorelli*.

99. There is a dispute between Mr Arnold and Mr Vanhegan whether the question of a likelihood of confusion is an abstract question rather than whether anyone has been confused in practice. Mr Vanhegan relies on what was said by Laddie J in *Compass Publishing BV v Compass Logistics Ltd* [2004] RPC 41 at paragraphs 22 to 26, especially paragraph 23. Mr Arnold says that that cannot any longer be regarded as a correct statement of the law in the light of *O2 Holdings Ltd v Hutchison 3G Ltd* [2007] RPC 16. For my part, I do not see any reason to doubt what Laddie J says. *O2 v H3G* was a case considering infringement, not invalidity, and although there is of course some commonality between matters relevant to each, it is correct, in the context of infringement, to look only at the particular circumstances of the alleged infringement. In contrast, in cases of validity, it is necessary to look across the whole range of goods covered by the registration. The Court of Appeal was unimpressed by the suggestion that the abstract test applicable to validity applies in the case of infringement, but it did not give even a hint that the validity test as understood was incorrect: see paragraph 34 of the judgment of Jacob LJ.”

<sup>2</sup> See *NHL Enterprises BV v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Case T-414/05, *Devinlec Développement Innovation Leclerc SA v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Case T- 147/03 and *Daimlerchrysler AG v. Office for Harmonisation In the Internal Market (Trade Marks and Designs)* [2003] ETMR 61.

### ***Further evidence of ML***

15) This consists of a further witness statement by Mr Oliphant. The contents consist of submissions rather than evidence of fact. I bear the submissions in mind in reaching my decision but will make no reference to them here.

### ***Proof of use of ML's trade mark***

16) Section 6A of the Act reads:

“(1) This section applies where –

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

(a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non-use.

(4) For these purposes –

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.



(5) In relation to a Community trade mark, any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.

(7) Nothing in this section affects –

(a) the refusal of registration on the grounds mentioned in section 3 (absolute grounds for refusal) or section 5(4)(relative grounds of refusal on the basis of an earlier right), or

(b) the making of an application for a declaration of invalidity under section 47(2) (application on relative grounds where no consent to registration).”

Under Section 100 of the Act the onus is upon the proprietor of the earlier trade mark(s) to show genuine use:

“If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

17) The European Court of Justice (ECJ) in *Ajax Brandbeveiliging BV v Ansul BV* Case C-40/01 stated :

“36. “Genuine use” must therefore be understood to denote use that is not merely token, serving solely to preserve the rights conferred by the mark. Such use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of goods or services to the consumer or end user by enabling him, without any possibility of confusion, to distinguish the product or service from others which have another origin.

37. It follows that genuine use of the mark entails use of the mark on the market for the goods or services protected by that mark and not just internal use by the undertaking concerned. The protection the mark confers and the consequences of registering it in terms of enforceability vis-à-vis third parties cannot continue to operate if the mark loses its commercial *raison d'être*, which is to create or preserve an outlet for the goods or services that bear the sign of which it is composed, as distinct from the goods or services of other undertakings. Use of the mark must therefore relate to goods or services already marketed or about to be marketed and for which preparations by the undertaking to secure

customers are under way, particularly in the form of advertising campaigns. Such use may be either by the trade mark proprietor or, as envisaged in Article 10(3) of the Directive, by a third party with authority to use the mark.

38. Finally, when assessing whether there has been genuine use of the trade mark, regard must be had to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark is real, in particular whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark.

39. Assessing the circumstances of the case may thus include giving consideration, *inter alia*, to the nature of the goods or service at issue, the characteristics of the market concerned and the scale and frequency of use of the mark. Use of the mark need not, therefore, always be quantitatively significant for it to be deemed genuine, as that depends on the characteristics of the goods or service concerned on the corresponding market.”

In *MFE Marienfelde GmbH v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-334/01* the Court of First Instance (CFI) considered the practical application of the *Ansul* criteria:

“34 When assessing whether use of the trade mark is genuine, regard must be had to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark is real, particularly whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark, the nature of those goods or services, the characteristics of the market and the scale and frequency of use of the mark (*Ansul*, paragraph 43).

35 Concerning the extent of the use made of the earlier mark, account must be taken, in particular, of the commercial volume of all the acts of use on the one hand and the duration of the period in which those acts of use occurred, and the frequency of those acts, on the other.

36 In order to examine, in a given case, whether use of the earlier mark is genuine, an overall assessment must be made taking account of all the relevant factors in the particular case. That assessment implies a certain interdependence between the factors taken into account. Thus, a low volume of goods marketed under that trade mark may be compensated for by a high intensity or a certain constancy in time of the use of that trade mark or vice versa. Moreover, the turnover achieved and quantity of product sales under the earlier mark cannot be assessed in absolute

terms but must be assessed in relation to other relevant factors, such as the volume of commercial activity, the production or marketing capacities or the degree of diversification of the undertaking exploiting the mark, and the characteristics of the products or services on the market in question. For that reason, the Court has held that use of the earlier mark need not always be quantitatively significant for it to be deemed genuine (*Ansul*, paragraph 39).

37 However, the smaller the commercial volume of the exploitation of the mark, the more necessary it is for the party opposing new registration to produce additional evidence to dispel possible doubts as to its genuineness.”

18) The evidence shows external use of **miniscoff** as registered and in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, ie in an oval with slightly italicised lettering. There is nothing token or nugatory about the use that is shown. The scale of use is warranted in the economic sector concerned to maintain or create a share in the relevant market. The use is for prepared organic meals for children.

19) There is no evidence of use of SL’s trade mark in relation to the class 32 goods of the specification.

20) There is no use of the trade mark for goods for invalids. In relation to construing words in a trade mark specification “one is concerned with how the product is, as a practical matter, regarded for the purposes of trade”<sup>3</sup>. One should not, however, give words in a specification an unnaturally narrow meaning<sup>4</sup>. The class in which the goods are placed has to be taken into account<sup>5</sup>. Foodstuffs for infants in class 5, in my view, will not encompass the sorts of goods that are shown in the evidence of ML. The goods in this class encompass such things as baby formula and puréed food sold in small jars, they certainly do not encompass the types of goods upon which the trade mark has been used; which is the key matter here.

21) It is necessary to decide upon a fair description for the goods for which genuine use has been shown. I must not be over pernickety<sup>6</sup>. It is necessary to

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<sup>3</sup> *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281.

<sup>4</sup> *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267.

<sup>5</sup> *Altecnic Ltd's Trade Mark Application* [2002] RPC 34.

<sup>6</sup> *Animal Trade Mark* [2004] FSR 19:

“20 The reason for bringing the public perception in this way is because it is the public which uses and relies upon trade marks. I do not think there is anything technical about this: the consumer is not expected to think in a pernickety way because the average consumer does not do so. In

consider how the relevant public, which for these goods would be the public at large with children, describes the goods<sup>7</sup>. The CFI in *Reckitt Benckiser (España), SL v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-126/03* stated:

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coming to a fair description the notional average consumer must, I think, be taken to know the purpose of the description. Otherwise they might choose something too narrow or too wide. Thus, for instance, if there has only been use for three-holed razor blades imported from Venezuela (Mr T.A. Blanco White's brilliant and memorable example of a narrow specification) "three-holed razor blades imported from Venezuela" is an accurate description of the goods. But it is not one which an average consumer would pick for trade mark purposes. He would surely say "razor blades" or just "razors". Thus the "fair description" is one which would be given in the context of trade mark protection. So one must assume that the average consumer is told that the mark will get absolute protection ("the umbra") for use of the identical mark for any goods coming within his description and protection depending on confusability for a similar mark or the same mark on similar goods ("the penumbra"). A lot depends on the nature of the goods--are they specialist or of a more general, everyday nature? Has there been use for just one specific item or for a range of goods? Are the goods on the High Street? And so on. The whole exercise consists in the end of forming a value judgment as to the appropriate specification having regard to the use which has been made."

<sup>7</sup> *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32:

"29 I have no doubt that Pumfrey J. was correct to reject the approach advocated in the Premier Brands case. His reasoning in paras [22] and [24] of his judgment is correct. Because of s.10(2), fairness to the proprietor does not require a wide specification of goods or services nor the incentive to apply for a general description of goods and services. As Mr Bloch pointed out, to continue to allow a wide specification can impinge unfairly upon the rights of the public. Take, for instance, a registration for "motor vehicles" only used by the proprietor for motor cars. The registration would provide a right against a user of the trade mark for motor bikes under s.10(1). That might be understandable having regard to the similarity of goods. However, the vice of allowing such a wide specification becomes apparent when it is envisaged that the proprietor seeks to enforce his trade mark against use in relation to pedal cycles. His chances of success under s.10(2) would be considerably increased if the specification of goods included both motor cars and motor bicycles. That would be unfair when the only use was in relation to motor cars. In my view the court is required in the words of Jacob J. to "dig deeper". But the crucial question is--how deep?

30 Pumfrey J. was, I believe, correct that the starting point must be for the court to find as a fact what use has been made of the trade mark. The next task is to decide how the goods or services should be described. For example, if the trade mark has only been used in relation to a specific variety of apples, say Cox's Orange Pippins, should the registration be for fruit, apples, eating apples, or Cox's Orange Pippins?

31 Pumfrey J. in *Decon* suggested that the court's task was to arrive at a fair specification of goods having regard to the use made. I agree, but the court still has the difficult task of deciding what is fair. In my view that task should be carried out so as to limit the specification so that it reflects the circumstances of the particular trade and the way that the public would perceive the use. The court, when deciding whether there is confusion under s.10(2), adopts the attitude of the average reasonably informed consumer of the products. If the test of infringement is to be applied by the court having adopted the attitude of such a person, then I believe it appropriate that the court should do the same when deciding what is the fair way to describe the use that a proprietor has made of his mark. Thus, the court should inform itself of the nature of trade and then decide how the notional consumer would describe such use."

“42 The Court observes that the purpose of the requirement that the earlier mark must have been put to genuine use is to limit the likelihood of conflict between two marks by protecting only trade marks which have actually been used, in so far as there is no sound economic reason for them not having been used. That interpretation is borne out by the ninth recital in the preamble to Regulation No 40/94, which expressly refers to that objective (see, to that effect, *Silk Cocoon*, cited at paragraph 27 above, paragraph 38). However, the purpose of Article 43(2) and (3) of Regulation No 40/94 is not to assess commercial success or to review the economic strategy of an undertaking, nor is it to restrict trade-mark protection to the case where large-scale commercial use has been made of the marks (Case T-334/01 *MFE Marienfelde v OHIM – Vétoquinol (HIPOVITON)* [2004] ECR II-0000, paragraph 32, and Case T-203/02 *Sunrider v OHIM – Espadafor Caba (VITAFRUIT)* [2004] ECR II-0000, paragraph 38).

43 Therefore, the objective pursued by the requirement is not so much to determine precisely the extent of the protection afforded to the earlier trade mark by reference to the actual goods or services using the mark at a given time as to ensure more generally that the earlier mark was actually used for the goods or services in respect of which it was registered.

44 With that in mind, it is necessary to interpret the last sentence of Article 43(2) of Regulation No 40/94 and Article 43(3), which applies Article 43(2) to earlier national marks, as seeking to prevent a trade mark which has been used in relation to part of the goods or services for which it is registered being afforded extensive protection merely because it has been registered for a wide range of goods or services. Thus, when those provisions are applied, it is necessary to take account of the breadth of the categories of goods or services for which the earlier mark was registered, in particular the extent to which the categories concerned are described in general terms for registration purposes, and to do this in the light of the goods or services in respect of which genuine use has, of necessity, actually been established.

45 It follows from the provisions cited above that, if a trade mark has been registered for a category of goods or services which is sufficiently broad for it to be possible to identify within it a number of sub-categories capable of being viewed independently, proof that the mark has been put to genuine use in relation to a part of those goods or services affords protection, in opposition proceedings, only for the sub-category or sub-categories relating to which the goods or services for which the trade mark has actually been used actually belong. However, if a trade mark has been registered for goods or services defined so precisely and narrowly that it is not possible to make any significant sub-divisions within the category concerned, then the proof of genuine use of the mark for the

goods or services necessarily covers the entire category for the purposes of the opposition.

46 Although the principle of partial use operates to ensure that trade marks which have not been used for a given category of goods are not rendered unavailable, it must not, however, result in the proprietor of the earlier trade mark being stripped of all protection for goods which, although not strictly identical to those in respect of which he has succeeded in proving genuine use, are not in essence different from them and belong to a single group which cannot be divided other than in an arbitrary manner. The Court observes in that regard that in practice it is impossible for the proprietor of a trade mark to prove that the mark has been used for all conceivable variations of the goods concerned by the registration. Consequently, the concept of 'part of the goods or services' cannot be taken to mean all the commercial variations of similar goods or services but merely goods or services which are sufficiently distinct to constitute coherent categories or sub-categories."

22) In my view there is a clear category of prepared meals. Both organic foods and foods for children represent sub-categories. Consequently, I consider that a fair description of the goods upon which use has been shown is *prepared organic meals for children*. **The class 29 specification includes *prepared meals* and so the purposes of this opposition the specification will be *prepared organic meals for children*.** The class 30 specification does not include prepared meals. However, it does include *pasta products*, which would include prepared meals of pasta. The evidence also shows that such goods have been sold under the trade mark. The fair specification must be within the parameters of the specification. **Consequently, I consider that a fair description of the goods upon which use has been shown is *pasta products being prepared organic meals for children*.**

#### ***Average consumer, nature of purchasing decision and standard for likelihood of confusion***

23) The goods of both the application and the earlier registration and the class 43 services of the application are all bought by the public at large, or the public at large with children. They are not necessarily bought with a great deal of attention, however the average consumer is deemed to be reasonably well informed and reasonably circumspect and observant<sup>8</sup>. The goods and the class 43 services could be the subject of impulse purchase. Owing to the nature of the purchasing process and the nature of the purchaser the possible effects of imperfect recollection are increased.

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<sup>8</sup> *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV* [2000] FSR 77.

24) The class 39 services are packaging, transport and delivery services in relation to foodstuffs. These services, whatever the intention of SFL, will be supplied to a third party. It is difficult to imagine that such services would be supplied to anyone other than another business. Taking into account the nature of the service and the nature of the average consumer, the purchasing decision will be educated and careful and so will limit the possible effects of imperfect recollection.

### **Comparison of goods and services**

25) The specification, following proof of use, of the earlier registration is in classes 29 and 30 respectively:

*prepared organic meals for children;*

*pasta products being prepared organic meals for children.*

The goods and services of the application are:

***hot and cold prepared meals and drinks and snacks containing either entirely or in part meat, fish, poultry and game, meat extracts, preserved and dried and cooked fruit and vegetables, eggs, milk and milk products, edible oils and fats, raw meat;***

***bread, pastry, puddings (containing flour eg treacle sponge, sticky toffee pudding), puddings generally ice cream, custard, cream, hot and cold prepared meals and snacks whose main ingredients are in this class;***

*fresh fruit and vegetables, seeds (edible);*

*non-alcoholic drinks, fruit drink, and fruit juices, syrups and other preparations for making drinks;*

*packaging of food items, prepared and raw for resale, transport of hot and cold food/ready meals, delivery of ready meals of food direct to consumers;*

*catering services for providing food and drink, cafe services, mobile catering services.*

**26) The highlighted goods will encompass the goods of the earlier registration and so must be deemed to be identical<sup>9</sup>.**

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<sup>9</sup> See *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-133/05* paragraph 29:

“In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application (Case T-

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388/00 *Institut für Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 *Oberhauser v OHIM – Petit Liberto (Fifties)* [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 *Vedial v OHIM – France Distribution (HUBERT)* [2002] ECR II-5275, paragraphs 43 and 44; and Case T-10/03 *Koubi v OHIM – Flabesa (CONFORFLEX)* [2004] ECR II-719, paragraphs 41 and 42).”

The above is a translation from the French. There is no variation in the judgment in French:

“29 En outre, des produits peuvent être considérés comme identiques lorsque les produits que désigne la marque antérieure sont inclus dans une catégorie plus générale visée par la demande de marque [arrêt du Tribunal du 23 octobre 2002, *Institut für Lernsysteme/OHMI – Educational Services (ELS)*, T 388/00, Rec. p. II 4301, point 53], ou lorsque les produits visés par la demande de marque sont inclus dans une catégorie plus générale visée par la marque antérieure [arrêts du Tribunal du 23 octobre 2002, *Oberhauser/OHMI - Petit Liberto (Fifties)*, T 104/01, Rec. p. II 4359, points 32 et 33 ; du 12 décembre 2002, *Vedial/OHMI - France Distribution (HUBERT)*, T 110/01, Rec. p. II 5275, points 43 et 44, et du 18 février 2004, *Koubi/OHMI - Flabesa (CONFORFLEX)*, T 10/03, Rec. p. II 719, points 41 et 42].”

This is also the position of Professor Annand, sitting as the appointed person in *Galileo International Technology LLC v Galileo Brand Architecture Limited* BL 0/269/04:

“13. I agree with Mr. Onslow that the issue raised by this appeal is whether, when considering the test of identity for section 5(1), it is sufficient that goods or services overlap or must they be co-extensive. Like Mr. Onslow, I am unaware of any authority supporting a co-extensive test. Kerly’s Law of Trade Marks and Trade Names, 13th Edition, states at para. 8-10:

“... the goods or services must be the same as those the subject of the earlier trade mark. Although not explicit, it would seem that this provision can only sensibly be interpreted as prohibiting registration where there is an overlap of goods or services.”

A footnote indicates that such interpretation is in accordance with Article 13 of Council Directive 89/104/EEC. Although not expressly included, it is well established that the TMA must be read subject to Article 13, which provides:

“Where grounds for refusal of registration or for revocation or invalidity of a trade mark exist in respect of only some of the goods or services for which that trade mark has been applied for or registered, refusal of registration or revocation or invalidity shall cover those goods or services only.”

14. The equivalent to section 5(1) in Council Regulation (EC) No. 40/94 on the Community trade mark (“CTMR”) is Article 8(1)(a). Mr. Onslow referred me to two decisions of the Opposition Division of the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (“OHIM”) concerning Article 8(1)(a) of the CTMR where identity of goods and services was found to subsist through overlaps in specifications. In *WALLIS*, Decision No. 1978/2004, identity was found inter alia between Class 14 specifications even though the contested CTM application covered additional goods in that class. The Opposition Division said:

“There is identity between the goods or services that are subject to comparison if they either have the same wording or can be considered synonyms. The identity is also found if the specification of the earlier mark includes a generic term that covers the specific goods of the contested application. Similarly if the goods specifically designated in the earlier mark are covered by a generic term used in the contested application, such goods are identical, to the degree that they are included in the broad category. Finally, in case that the goods in question overlap in part they are also to be considered as identical.”



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A similar decision was arrived at in PACE, Decision No. 1033/2003. Again, the Class 41 services in the CTM application were wider than those in the earlier CTM registration. In addition, there was held to be identity between some of the applicant's Class 42 services namely, "computer programming; providing of expert opinion". The opponent's registration was in respect of "consulting services related to improving and expediting product development, industrial research services, computer programming services" in Class 42. The Opposition Division observed:

"In particular, the applicant's expression providing of expert opinion in class 42, is broad enough to encompass any consulting services registered by the opponent in class 42, which makes them equivalent to the extent that the one includes the other."

15. The overlap test for identity of goods and services is also applied by the OHIM in connection with priority and seniority claiming under Articles 29, and 34 and 35 of the CTMR respectively. Indeed, it is recognised that partial priority claiming (i.e. where the subsequent application is for a narrower or wider specification than in the application(s) from which priority is claimed) is a possibility under section 33 of the TMA, which speaks of a right of priority "for some or all of the same goods or services" in a Convention application.

16. I believe that overlapping specifications satisfy the test for identical goods or services in section 5(1) of the TMA. There is no necessity for such specifications to co-extend."

I do not consider that the judgment of Norris J is in *Budejovický Budvar, národní Podnik v Anheuser-Busch Inc* [2008] EWHC 263 (Ch) is in conflict with the above. In that case he stated:

"41. There is however one respect in which this appeal succeeds. AB's application for a declaration of invalidity extended to the whole of BB's registration in respect of "beer ale and porter; malt beverages;" (although its own registration related only to "beer ale and porter"). In his decision the Hearing Officer regarded it as obvious that in respect of "beer, ale and porter" the respective specifications encompassed the same goods (and the contrary has not been argued before me). He said:-

"The only possible area of contention is the description "malt beverages" in the mark in suit. The term covers all beverages made with malt, including "malt beers" and the like. Accordingly the specification of the registration that is the subject of these proceedings is covered in its entirety by the specifications of [AB's] earlier mark"

This is a determination of a mixed question of fact and law which I must approach with caution. But in my judgement this passage discloses an error of principle. AB's earlier mark covered only "beer, ale and porter". BB's included "malt beverages". The specification of AB's earlier mark simply did not cover entirely the specification of the mark in suit. It is necessary to decide whether "malt beverages" can only be "beer ale and porter", or whether "malt beverages" can include goods which are not identical with or similar to "beer ale and porter".

42. I do not consider that "malt beverages" can only be (and are therefore identical with) "beer ale and porter". The form of the specification would indicate that "beer, ale and porter;" is one category and "malt beverages" another, with possibly an overlap between the two. One is not simply an alternative description for the other."

In the above judgment Norris J was considering whether the respective goods could be described as being identical, not whether they should be considered to be identical. There is a deal of difference between stating that goods **are** identical and stating that they are considered to be identical.

27) In “construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of trade<sup>10</sup>”. Words should be given their natural meaning within the context in which they are used, they cannot be given an unnaturally narrow meaning<sup>11</sup>. Consideration should be given as to how the average consumer would view the goods or services<sup>12</sup>. The class of the goods and services in which they are placed is relevant in determining the nature of the goods<sup>13</sup>. In assessing the similarity of goods and services it is necessary to take into account, inter alia, their nature, their intended purpose, their method of use and whether they are in competition with each other or are complementary<sup>14</sup>. In *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281, Jacob J also gave guidance as to how similarity should be assessed<sup>15</sup>. In considering the services the

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If one did not follow the principles laid down by the CFI and Professor Annand considering similarity of goods in certain cases would become virtually impossible. If, for example, an earlier registration was for wedding dresses and an application for clothing one would have to consider the degree of similarity between the former goods and every potential product covered by the term clothing as there would be varying degrees of similarity and the global appreciation of the likelihood of confusion requires consideration of the degree of similarity between goods and/or services.

An applicant has plenty of time to amend a specification which includes a portmanteau term so that the term list goods which are of specific interest. If the applicant does not do so then it must expect to bear the consequences.

<sup>10</sup> *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281.

<sup>11</sup> *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267.

<sup>12</sup> *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32 dealt with a non-use issue but are still pertinent to the consideration of the meaning and effect of specifications:

“In my view that task should be carried out so as to limit the specification so that it reflects the circumstances of the particular trade and the way that the public would perceive the use. The court, when deciding whether there is confusion under section 10(2), adopts the attitude of the average reasonably informed consumer of the products. If the test of infringement is to be applied by the court having adopted the attitude of such a person, then I believe it appropriate that the court should do the same when deciding what is the fair way to describe the use that a proprietor has made of his mark. Thus, the court should inform itself of the nature of trade and then decide how the notional consumer would describe such use”

<sup>13</sup> *Altecnic Ltd's Trade Mark Application* [2002] RPC 34.

<sup>14</sup> *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117.

<sup>15</sup> He considered that the following should be taken into account when assessing the similarity of goods and/or services:

- “(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;

judgment of Jacob J in *Avnet Incorporated v Isoact Ltd* [1998] FSR 16 must be taken into account:

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

The concept of the complementary nature of goods and/or services has been dealt with by the CFI on a number of occasions. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T- 325/06 the CFI stated:

“82 It is true that goods are complementary if there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking (see, to that effect, Case T-169/03 *Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI)* [2005] ECR II-685, paragraph 60, upheld on appeal in Case C-214/05 *P Rossi v OHIM* [2006] ECR I-7057; Case T-364/05 *Saint-Gobain Pam v OHIM – Propamsa (PAM PLUVIAL)* [2007] ECR II-757, paragraph 94; and Case T-443/05 *El Corte Inglés v OHIM – Bolaños Sabri (PiraÑAM diseño original Juan Bolaños)* [2007] ECR I-0000, paragraph 48).”

28) The class 32 goods of the application are all drinks, they are liquid whilst the goods of the earlier registration are foods and solid. They differ in their nature. The goods of the earlier registration are to satiate hunger, the class 32 goods of the application to slake the thirst. So their purposes are different and those purposes define the end user, in one case a drinker, in the other an eater; I bear in mind that the products could be consumed at the same time. There is no interdependent, symbiotic or other close relationship between the respective goods. The goods are not fungible and so are not in competition. If sold in the same shops they will normally be sold in different areas or on different shelves. **Taking into account all of these factors I find that the class 32 goods of the application are dissimilar to the goods of the earlier registration.**

29) The class 31 goods of the application are foodstuffs and so have that in common with the goods of the earlier registration. However, they differ in that they are, taking into account the class, fresh and unprepared and will not

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(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.”

constitute, of themselves, a meal. Both sets of goods can be used to satiate hunger, however that is a similarity on the most general of level. The goods of the application either need further preparation or will be eaten as stand-alone items eg fruit. That they can be constituents of the goods of the earlier registration is of itself not a similarity<sup>16</sup>. Potato may be essential to a hot pot or shepherd's pie but, as per *Boston Scientific Ltd*, it is difficult to envisage that the producer of one was responsible for the other. Consequently, I do not consider that the respective goods are complementary. A prepared organic meal for children is unlikely to be an alternative to an item or items of fresh fruit and vegetables or seeds; they are not fungible, they are not in competition. The respective goods are likely to be in separate areas of shops. However, I am aware that fresh fruit can now be found sold peeled and cut up in receptacles, in such circumstances the fruit can be seen as a course in a meal, it could be seen as the dessert element. I am not aware of this practice in relation to vegetables (which have not been processed or had something added to them) or seeds. **Taking these factors into account I consider that if vegetables are similar to the goods of the earlier registration it is at the most limited of extents. Fruits, however, have a very limited degree of similarity with the goods of the earlier registration. I cannot see that seeds coincide with the goods of the earlier registration in any meaningful way within the parameters of the case law. Seeds are dissimilar to the goods of the earlier registration.**

30) The class 39 services of the application are packing, transport and delivery services. In considering the issue of similarity it is necessary to bear in mind the *Avnet* principle. As stated above these are services that are being supplied to third parties; whatever the conception of the parties. The customer for home delivery/take away food services is not purchasing a packaging, transport or delivery service by reference to the trade mark. He or she is purchasing the food product by reference to the trade mark. Packaging, transport and delivery services are essential to all goods, that they are used does not make them similar to the goods in relation to which they are used. No more than computers are similar to all of the goods and services that use them<sup>17</sup>. Again, as per *Boston Scientific Ltd*, it is difficult to envisage that the producer of one was responsible for the other. The services and the goods are not complementary. The respective goods are not fungible, they are not in competition. The goods are physical objects, the services perform a function; they are not of the same nature. The end user of the goods of the earlier registration is someone who wants to satiate their hunger. The services of the application will be used by those who want products packed, transported and/or delivered. Consequently,

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<sup>16</sup> See *Promat GmbH c Office de l'harmonisation dans le marché intérieur (marques, dessins et modèles)* (OHMI) Case T-257/08.

<sup>17</sup> See *Les Editions Albert René v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Case T-336/03 and *Commercy AG v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Case T-316/07.

they do not have same end users nor the same purpose. In his evidence Mr Oliphant comments on undertakings that produce, pack, transport and deliver their products to customers. As I have indicated above all goods will be packed, transported and delivered; it is how commerce works. **Taking into account the Avnet principle I find that the class 39 services are not similar to the goods of the earlier registration.**

31) The class 43 services all supply prepared meals, they all include takeaway and delivery services. Their purpose is to satiate hunger as is the purpose of the goods of the earlier registration. One could avail oneself of the service or buy a prepared organic meal for children instead. Consequently, the respective goods and services have the same end users, the same purpose and are in competition. The supplying of prepared meals is essential to the provision of the services, the average customer is likely, as per *Boston Scientific Ltd*, to consider that the goods and services have the same source. The respective goods and services are complementary. **There is a high degree of similarity between the goods of the earlier registration and the class 43 services of the application.**

32) *Collins English Dictionary* (5th Ed 2000) defines snack, inter alia, as:

“a light quick meal eaten between or in place of main meals”.

So the difference between a prepared meal and a prepared snack is cigarette paper thin, if there is any difference, other than the choice of word. **Consequently, the snack elements of the class 29 and 30 specifications of the application are at least extremely similar to the goods of the earlier registration, if not identical.**

33) *Puddings (containing flour eg treacle sponge, sticky toffee pudding), puddings generally ice cream* are all completed, prepared products. They can all form a course of a meal, they do not require any additional elements. They are solid food products and so have the same nature as the goods of the earlier registration. They are used to satiate hunger and so have the same general purpose and end user as the goods of the earlier registration. In my experience desserts normally have their own discrete areas of shops, which is separate to that for prepared meals. I cannot see that one would choose these products as a substitute for a prepared organic meal for children, they are not fungible. They are, therefore, not in competition. The respective goods are neither indispensable nor important for the use of each other, they are not complementary. **Taking all these factors into account I consider that overall there is a fair degree of similarity between *puddings (containing flour eg treacle sponge, sticky toffee pudding), puddings generally ice cream* and the goods of the earlier registration.**

34) *Preserved and dried and cooked fruit and vegetables* need to be split up in the consideration of their similarity with the goods of the earlier registration. *Cooked fruit and vegetables* have undergone a process that makes them ready to use without further preparation, other than possibly heating up. They have this in common with the goods of the earlier registration. I am aware that some shops sell such goods close to prepared meals, the former goods can be used in combination in order to create a prepared meal. Consequently, there is a degree of competition between the two sets of goods. The respective goods are neither indispensable nor important to one another. They are not complementary. The respective goods are likely to be found in different areas of shops. They share the same nature, at a fairly general level, with the goods of the earlier registration of being prepared foodstuffs. Their purpose at that general level is the same, to satiate hunger; however, at the more specific level their purpose is different in that one set of goods is to provide a meal and the other to form part of a meal. **Taking these factors into account *cooked fruit and vegetables* are similar to the goods of the earlier registration to a limited degree.** *Preserved and dried fruit and vegetables* will encompass goods that have been tinned, frozen and put into jars; as well as those that have been dried. Preserved fruit and vegetables may be in a state that means that they do not require further preparation; they may be eaten cold or heated up eg peaches and potatoes respectively. **Taking these factors into account the same considerations and criteria apply to *preserved fruit and vegetables* as apply to *cooked fruit and vegetables*, consequently *preserved fruit and vegetables* are similar to the goods of the earlier registration to a limited degree.** To my knowledge there are a limited number of vegetables that are dried eg peas, tomatoes and mushrooms (even if tomatoes are technically fruits and mushroom fungi, they are viewed and referred to as vegetables in the normal course of trade and purchase). With the exception of some dried tomatoes, which are sold in jars, dried vegetables require reconstituting with water and then cooking. Dried fruits encompass such things as prunes, figs, apricots, raisins, sultanas and bananas. Prunes, figs and apricots will normally be reconstituted with water before use. Raisins, sultanas and the like can be eaten from the packet or used as an ingredient, normally in sweet dishes but in some cooking from Asia Minor and the Middle East in savoury dishes also. From their nature and their use *dried fruit and vegetables* are not fungible with the goods of the earlier registration. They are not in competition. Although as ingredients the goods of the application may be used in the goods of the earlier registration the average customer is not likely, as per *Boston Scientific Ltd*, to consider that the respective goods have the same source and so are they not complementary. There is also no necessity for the goods of the application to be part of the goods of the earlier registration. The respective goods are sold in different areas of shops. **The differences between *dried fruit and vegetables* and the good of the earlier registration are such that if there is a similarity, on the basis that they are foodstuffs and will be eaten, it is at the lowest of levels.**

35) *Meat extracts, eggs, edible oils and fats, raw meat, pastry* are all products that will be used to produce dishes, they need an element of transformation and so they are different in this respect from the goods of the earlier registration and so different in their nature. The user of these goods is someone who is preparing food for cooking, whilst the user of the goods of the earlier registration is simply heating or eating them. The purpose of the goods of the application is to be used with other products to produce something edible, the purpose of the goods of the earlier registration is to supply the completed product. The respective goods are not fungible, they are not in competition with each other. Although as ingredients or cooking media the goods of the application are essential to the goods of the earlier registration the average customer is not likely, as per *Boston Scientific Ltd*, to consider that the goods and services have the same source and so are not complementary. The respective goods will be found in totally different areas of shops. **The differences between the respective goods is such that if there is a similarity, on the basis that they foodstuffs, it is at the lowest of levels.** (I note that despite some very general levels of similarity between rum and wine the CFI confirmed that these goods were not similar<sup>18</sup>. The presence of similarities at the most general of levels does not necessarily create similarity overall.)

36) *Milk* is a liquid that is drunk, used in various hot beverages and as an ingredient in cooking. Its nature as a liquid, a beverage or an ingredient is different to the goods of the earlier registration. The purpose of the purchase is defined by the uses outlined above. The purpose of a prepared meal is to supply sustenance with no further preparation, other than possibly heating. The purpose of the use of the goods is different and this purpose defines the end user. Milk is sold in discrete areas of shops, it is not found in the same area as prepared meals. Milk and prepared meals are in no way fungible, the respective goods are not in competition. Prepared organic meals for children may contain milk, although there is no necessity, however, the average customer is not likely, as per *Boston Scientific Ltd*, to consider that the goods and services have the same source and so are not complementary. **Milk is dissimilar to the goods of the earlier registration.**

37) *Milk products* will encompass a variety of products such as yoghurts and possets (cream being a milk product). Such goods can be eaten as desserts and so in relation to similarity the same arguments as were dealt with in relation to *puddings* will apply and the outcome must be the same. **Consequently, I consider that overall there is a fair degree of similarity between *milk products* and the goods of the earlier registration.**

38) *Bread* has its own discrete areas of shops or its own shops. As a staple of the diet it has its own identifiable traditions and customs. It is not an ingredient of

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<sup>18</sup> *Bodegas Montebello, SA c Office de l'harmonisation dans le marché intérieur (marques, dessins et modèles) (OHMI) Case T-430/07.*

the goods of the earlier registration; it has no relationship with them, let alone being indispensable or important to them. It is not complementary to the goods of the earlier registration. It is not fungible with the goods of the earlier registration, they are not in competition. At the most general level it is a foodstuff and so has this degree of similarity with the goods of the earlier registration; as do all foodstuffs. **Any similarity with the goods of the earlier registration is at the very lowest level.**

39) *Custard* is an accompaniment to certain deserts. The specification is for custard rather than custard powder and so one is looking at the completed product; which could be chilled or tinned. It is sold in discrete areas of shops, not in the same area as prepared meals. It is unlikely to be used on its own or as an accompaniment to prepared meals. It is sold in different areas of shops to prepared meals. It is not fungible with the goods of the earlier registration and in no way in competition. It is not an ingredient of the goods of the earlier registration; it has no relationship with them, let alone being indispensable or important to them. It is not complementary to the goods of the earlier registration. Any similarity is at the most general level, the respective goods are prepared foodstuffs. **Any similarity with the goods of the earlier registration is at the very lowest level.**

40) *Cream* can be used as a sauce with desserts or as an ingredient in a variety of dishes, both sweet and savoury. It is sold in discrete areas of shops, not in the same area as prepared meals. It is unlikely to be used on its own or as an accompaniment to prepared meals. As an ingredient the same argument applies as in relation to *meat extracts, eggs, edible oils and fats, raw meat, pastry*. **Consequently, the differences between the respective goods is such that if there is a similarity, on the basis that they foodstuffs, it is at the lowest of levels.**

41) I am somewhat at a loss as to the nature of the product covered by *drinks either entirely or in part meat, fish, poultry and game*. I am aware of Bovril®, a meat extract that can be mixed with hot water and then used as a beverage; it is also used, I believe, in cooking. However, it seems difficult to twist language to describe a meat extract as a drink “entirely or in part of meat”. I am not aware of any beverages that are entire, or in part, of fish, poultry or game. Soups might be so constituted but a soup, even though drunk, will not normally be described as a drink. When sold in vending machines soups are described as soups. I am faced with goods which to the best of my knowledge do not exist, which makes a comparison with the goods of the earlier registration an impossibility. In *Canon* the ECJ stated:

“22. It is, however, important to stress that, for the purposes of applying Article 4(1)(b), even where a mark is identical to another with a highly distinctive character, it is still necessary to adduce evidence of similarity between the goods or services covered. In contrast to Article 4(4)(a),



which expressly refers to the situation in which the goods or services are not similar, Article 4(1)(b) provides that the likelihood of confusion presupposes that the goods or services covered are identical or similar.”

The court required evidence of similarity to be adduced. This finding has been reiterated by the ECJ and the CFI eg in *Commercy AG v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-316/07:

“43 Consequently, for the purposes of applying Article 8(1)(b) of Regulation No 40/94, it is still necessary, even where the two marks are identical, to adduce evidence of similarity between the goods or services covered by them (see, to that effect, order of 9 March 2007 in Case C-196/06 P *Alecansan v OHIM*, not published in the ECR, paragraph 24; and Case T-150/04 *Mülhens v OHIM – Minoronzoni(TOSCA BLU)* [2007] ECR II-2353, paragraph 27).”

The above part of the *Canon* judgment has been more recognised in the breach than in the observance in this jurisdiction. It may not always be practical to adduce evidence of similarity; it may be that the nature of the goods is so well-known that it would be a waste of effort and resources to do so. In its evidence ML makes various submissions about why the respective goods and services are identical or similar, however, they are at a very general level and certainly do not place the arguments within the parameters of the case law. It asserts rather than analyses. In relation to the goods under consideration here it includes them in a general assertion as to similarity. Consequently, it has not dealt with the nature of the goods in question, if such goods exist. **As I can make no comparison and ML has put forward no argument in relation specifically to these goods I cannot find that *drinks either entirely or in part meat, fish, poultry and game* are either identical or similar to the goods of the earlier registration.**

### **Comparison of trade marks**

42) The trade marks to be compared are:

**Application**

**Earlier registration**

SCOFF

scoff

SCOFF

miniscoff

I do not consider that anything turns upon the different formats of the three trade marks of the application, they are all SCOFF trade marks in an ordinary script.

43) The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details<sup>19</sup>. The visual, aural and conceptual similarities of the marks must, therefore, be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components<sup>20</sup>. Consequently, I must not indulge in an artificial dissection of the trade marks, although I need to take into account any distinctive and dominant components. The average consumer rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he/she has kept in his/her mind and he/she is deemed to be reasonably well informed and reasonably circumspect and observant<sup>21</sup>. The assessment of the similarity of the trade marks must be made by reference to the perception of the relevant public<sup>22</sup>.

44) Mini is a well-known combining form as per *Collins English Dictionary* (5th Ed 2000):

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<sup>19</sup> *Sabel BV v Puma AG* [1998] RPC 199.

<sup>20</sup> *Sabel BV v Puma AG* [1998] RPC 199.

<sup>21</sup> *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV* [2000] FSR 77.

<sup>22</sup> *Succession Picasso v OHIM - DaimlerChrysler (PICARO)* Case T-185/02.

“combining form. smaller or shorter than the standard size. e.g. minibus. e.g. miniskirt. [C20: from miniature and minimum]”.

Scoff is a well-known word. I reproduce the definition from *Collins English Dictionary* (5th Ed 2000):

“2; Informal; chiefly Brit; vb. 1. to eat (food) fast and greedily; devour. n. 2. food or rations. [C19: variant of scaff food; related to Afrikaans, Dutch] schoft quarter of the day, one of the four daily meals”.

As can be seen from above it can be used as both a verb and a noun. I am aware of it being used in both forms.

45) It is often stated that the beginnings of words are more important in consideration of similarity than the endings<sup>23</sup>. However, this is clearly dependent upon the nature of the beginning. The earlier trade mark, owing to its composition of two readily identifiable morphemes – mini and scoff- will be perceived by the average consumer as consisting of these two parts<sup>24</sup>. Mini being descriptive of size effectively describes the scoff element and so could be considered to be subordinate to it. Scoff itself is descriptive of food, indeed is a synonym for food, and so lacks distinctiveness in relation to food. The distinctiveness of the earlier trade mark rests in the combination of the two non-distinctive elements to create a distinctive whole<sup>25</sup>. It is difficult to see that the

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<sup>23</sup> See for instance: *Les Editions Albert René v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Case T-336/03.

<sup>24</sup> See *ecoblue AG v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Case T-281/07:

“30 In that regard, it should be pointed out as a preliminary point that, although the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details, the fact remains that, when perceiving a verbal sign, he will break it down into elements which, for him, suggest a concrete meaning or which resemble words known to him (see, to that effect, Case T-256/04 *Mundipharma v OHIM – Altana Pharma (RESPICUR)* [2007] ECR II-449, paragraph 57, and judgment of 13 February 2008 in Case T-146/06 *Sanofi-Aventis v OHIM – GD Searle (ATURION)*, not published in the ECR, paragraph 58).”

<sup>25</sup> In *MacLean-Fogg Co v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Case T-339/05 the CFI stated:

30 For a trade mark which consists of a neologism or a word produced by a combination of elements to be regarded as descriptive within the meaning of Article 7(1)(c) of Regulation No 40/94, it is not sufficient that each of its components may be found to be descriptive. The word or neologism itself must be found to be so (*SnTEM*, *SnPUR*, *SnMIX*, cited in paragraph 18 above, paragraph 31, and *PAPERLAB*, cited in paragraph 25 above, paragraph 26; see also, by analogy, *Koninklijke KPN Nederland*, cited in paragraph 13 above, paragraph 96, and *Campina Melkunie*, cited in paragraph 13 above, paragraph 37).

31 A trade mark consisting of a neologism or a word composed of elements each of which is descriptive of characteristics of the goods or services in respect of which registration is sought is

combination of the two elements gives a sufficiently direct and specific relationship with the goods. Certainly in my mind it does not do so, the combination of the two morphemes alludes rather than describes. It is also to be taken into account that there is a presumption of validity in relation to an earlier registered trade mark<sup>26</sup>.

46) Owing to the presence of scoff in both trade marks there must be a degree of visual, phonetic and conceptual similarity. Having similarities does not make trade marks similar; however, I consider that the presence of the clearly identifiable scoff element in the earlier registration does lead to the trade marks being similar, despite the lack of distinctiveness on its own of the scoff element<sup>27</sup>.

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itself descriptive of the characteristics of those goods or services for the purposes of Article 7(1)(c) of Regulation No 40/94, unless there is a perceptible difference between the neologism or the word and the mere sum of its parts: that assumes that, because of the unusual nature of the combination in relation to the goods or services, the neologism or word creates an impression which is sufficiently far removed from that produced by the mere combination of meanings lent by the elements of which it is composed, with the result that the word is more than the sum of its parts (*SnTEM*, *SnPUR*, *SnMIX*, cited in paragraph 18 above, paragraph 32, and *PAPERLAB*, cited in paragraph 25 above, paragraph 27; see also, by analogy, *KoninklijkeKPN Nederland*, cited in paragraph 13 above, paragraph 100, and *Campina Melkunie*, cited in paragraph 13 above, paragraph 41). In that connection, an analysis of the term in question in the light of the relevant lexical and grammatical rules is also useful (see *PAPERLAB*, cited in paragraph 25 above, paragraph 27, and the case-law cited).

42 Therefore, for the purpose of applying Article 7(1)(c) of Regulation No 40/94, it is necessary to consider, on the basis of the relevant meaning of the word sign at issue, whether, from the viewpoint of the public addressed, there is a sufficiently direct and specific relationship between the sign LOKTHREAD and the goods in respect of which registration is sought (see, to that effect, Case T-222/02 *HERON Robotunits v OHIM (ROBOTUNITS)* [2003] ECR II-4995, paragraph 38, and the case-law cited, and Case T-311/02 *Lissotschenko and Hentze v OHIM (LIMO)* [2004] ECR II-2957, paragraph 30)."

<sup>26</sup> Mr Richard Arnold QC, sitting as the appointed person, in *Republic Technologies (NA) LLC v Quelle Aktiengesellschaft* BL O/254/07 stated:

"17. I would add that, as the opponent accepts, the hearing officer correctly proceeded on the basis that the opponent's mark is presumed to be validly registered and therefore must be assumed to possess or have acquired at least the minimum degree of distinctiveness required to justify registration in the absence of any attack on the validity of the registration. I consider that I was mistaken to hold the contrary in *Oska's Ltd's Trade Mark Application* [2005] RPC 20 at [39]."

<sup>27</sup> See *L'Oréal SA v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case C-235/05 P:

"45 The applicant's approach would have the effect of disregarding the notion of the similarity of the marks in favour of one based on the distinctive character of the earlier mark, which would then be given undue importance. The result would be that where the earlier mark is only of weak distinctive character a likelihood of confusion would exist only where there was a complete reproduction of that mark by the mark applied for, whatever the degree of similarity between the marks in question. If that were the case, it would be possible to register a complex mark, one of the elements of which was identical with or similar to those of an earlier mark with a weak distinctive character, even where the other elements of that complex mark were still less

In reaching this conclusion I also bear in mind the judgment of the ECJ in *Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) v Shaker di L Laudato & C Sas* Case C-334/05 P in which it was stated:

“41 It is important to note that, according to the case-law of the Court, in the context of consideration of the likelihood of confusion, assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark. On the contrary, the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components (see order in *Matratzen Concord v OHIM*, paragraph 32; *Medion*, paragraph 29).

42 As the Advocate General pointed out in point 21 of her Opinion, it is only if all the other components of the mark are negligible that the assessment of the similarity can be carried out solely on the basis of the dominant element.”

In this case, as I have indicated, there is not a clearly dominant element; unless one considers the adjectival subordination gives rise to the domination of the noun element. However, there are two clearly identifiable elements and the scoff element is a separate and distinguishable element of the trade mark and is neither a subordinate nor a subordinated element.

### **Conclusion**

47) In considering whether there is a likelihood of confusion various factors have to be taken into account. There is the interdependency principle – a lesser degree of similarity between trade marks may be offset by a greater degree of similarity between goods, and vice versa<sup>28</sup>. In this case there are goods and services that are dissimilar; in relation to such goods and services there can be no likelihood of confusion as the cumulative process requires some similarity. Outwith the dissimilar goods and services, the proximity of the respective goods and services runs the entire gamut from very low levels of similarity to identity. The respective trade marks have visual, phonetic and conceptual similarity. The conceptual similarity is particularly strong, as they share the word scoff and, therefore, its meaning. It is necessary to consider the distinctive character of the earlier trade mark; the more distinctive the earlier trade mark (either by nature or

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distinctive than the common element and notwithstanding a likelihood that consumers would believe that the slight difference between the signs reflected a variation in the nature of the products or stemmed from marketing considerations and not that that difference denoted goods from different traders.”

<sup>28</sup> *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117.

nurture) the greater the likelihood of confusion<sup>29</sup>. The distinctive character of a trade mark can be appraised only, first, by reference to the goods or services in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public<sup>30</sup>. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the mark to identify the goods for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings<sup>31</sup>. The earlier trade mark consists of two non-distinctive elements but that does not, of itself, define the degree of distinctiveness. The earlier trade mark alludes to something that is small and is a food without directly describing it, in normal language. However, this is a strong allusion, especially taken into account that the goods are for children, this brings a connection to the mini element. I consider that the earlier trade mark has a very limited degree of inherent distinctiveness. As indicated above, in relation to the goods of the application and the earlier registration and the class 43 services of the application, owing to the nature of the purchasing process and the nature of the purchaser, the possible effects of imperfect recollection are increased.

48) In *Medion AG v Thomson multimedia Sales Germany & Austria GmbH* Case C-120/04 the ECJ stated:

“30 However, beyond the usual case where the average consumer perceives a mark as a whole, and notwithstanding that the overall impression may be dominated by one or more components of a composite mark, it is quite possible that in a particular case an earlier mark used by a third party in a composite sign including the name of the company of the third party still has an independent distinctive role in the composite sign, without necessarily constituting the dominant element.

31 In such a case the overall impression produced by the composite sign may lead the public to believe that the goods or services at issue derive, at the very least, from companies which are linked economically, in which case the likelihood of confusion must be held to be established.

32 The finding that there is a likelihood of confusion should not be subject to the condition that the overall impression produced by the composite sign be dominated by the part of it which is represented by the earlier mark.

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<sup>29</sup> *Sabel BV v Puma AG* [1998] RPC 199.

<sup>30</sup> *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91.

<sup>31</sup> *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

33 If such a condition were imposed, the owner of the earlier mark would be deprived of the exclusive right conferred by Article 5(1) of the directive even where the mark retained an independent distinctive role in the composite sign but that role was not dominant.”

In this case I consider that the scoff element has an independent distinctive rôle in the earlier trade mark even if the scoff element on its own is not distinctive for food. It is necessary to consider the effect of the scoff element within the context of the trade mark, not in the abstract, and how it helps within the trade mark as a whole to identify the producer of the goods. (This is not a matter of a house mark and a sub-brand but that does not gainsay the general principle.)

**49) Taking into account all the above factors I consider that where there is more than the most limited degree of similarity between the respective goods and services that there is a likelihood that the average consumer will consider that they, at least, come from the same undertaking or from an economically-linked undertaking. Conversely I do not consider that there is a likelihood of confusion where the similarity of the goods and services is extremely limited. Consequently, the application is to be refused in respect of the following goods and services:**

*hot and cold prepared meals and snacks containing either entirely or in part meat, fish, poultry and game, preserved and cooked fruit and vegetables, milk products;*

*puddings (containing flour eg treacle sponge, sticky toffee pudding), puddings generally ice cream, hot and cold prepared meals and snacks whose main ingredients are in this class;*

*catering services for providing food and drink, cafe services, mobile catering services.*

It may be registered in respect of:

*drinks containing either entirely or in part meat, fish, poultry and game, meat extracts, dried fruit and vegetables, eggs, milk, edible oils and fats, raw meat;*

*bread, pastry, custard, cream,*

*fresh fruit and vegetables, seeds (edible);*

*non-alcoholic drinks, fruit drink, and fruit juices, syrups and other preparations for making drinks;*

***packaging of food items, prepared and raw for resale, transport of hot and cold food/ready meals, delivery of ready meals of food direct to consumers.***

**Costs**

50) As each party has had a degree of success each party will bear its own costs.

**Dated this 5<sup>th</sup> day of August 2009**

**David Landau  
For the Registrar  
the Comptroller-General**