

TRADE MARKS ACT 1994

**IN THE MATTER OF INTERNATIONAL REGISTRATION NO. 979635
IN THE NAME OF
RESAS COMMUNICATION & DESIGN AGENTUR FÜR MARKETING,
WERBUNG UND PRODUKT-ENTWICKLUNG GMBH & CO. KG**

IN RESPECT OF THE TRADE MARK

PURVITA

IN CLASSES 29 and 30

AND

**THE OPPOSITION THERETO
UNDER NO 71967
BY
PURATOS N.V.**

Trade Marks Act 1994

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international registration no. 979635
in the name of Resas Communication & Design
Agentur für Marketing, Werbung und
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in respect of the trade mark:

PURVITA

**in classes 29 and 30
and the opposition thereto
under no. 71967
by Puratos N.V.**

Introduction

1. Resas Communication & Design Agentur für Marketing, Werbung und Produkt-Entwicklung GmbH & Co. KG (“Resas”) is the holder of the above international registration (the ‘IR’). Protection in the United Kingdom was requested on 12 June 2008 (claiming a priority date of 12 December 2007 from the German Office of Origin). The request for protection was published in the United Kingdom, for opposition purposes, in *The Trade Marks Journal* on 6 February 2009. Protection is sought in respect of the following goods¹:

Class 29: Meat, sausage, fish, poultry, game, shellfish (not live); meat extracts; meat, sausage, fish, poultry, game, fruit and vegetable preserves; preserved, dried and cooked fruits and vegetables; jellies; jams; edible oils and fats; tofu; preserved soya beans for food; prepared potatoes and potato products of all kinds (included in this class), including in the form of flakes, powdered potato, croquettes, French fries, fried potatoes, potato fritters, rösti (fried grated potato cakes), potato pancakes, crisps and sticks; poultry meat or poultry meat cuts; minced meat products, cooked, spiced and/or coated with sauce, including combined with fruit, vegetables, potatoes, cheese, pasta and/or breadcrumbs; goose liver pate; semi-prepared and ready-to-cook meals and prepared meals, mainly consisting of meat, fish, seafood, poultry, game and/or sausage, including being stews; soups, meat broth, broth, soup preparations; beans being ready meals; processed and salted nuts; fresh, chilled and frozen ready meals, semi-prepared meals and partly prepared meals with a vegetable base, mainly

¹ Classified according to 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.

consisting of vegetables and soya proteins; vegetarian delicatessen items, mainly consisting of soya-based meat substitutes, fatty spiced spreads for bread, tofu products and soya beans (preserved) for food; foodstuffs, mainly consisting of plant products, in particular soya beans, herbs, spiced oils, except foodstuffs of cereal or rice; semi-prepared and partly prepared meals, mainly consisting of soya beans, potatoes; including all the aforesaid goods (where possible) in frozen form.

Class 30: Savoury biscuits; snacks and snack products; coffee, artificial coffee, tea, cocoa, cocoa-based products, cocoa-based beverage powders, drinking cocoa in paste form and cocoa extracts for food, cocoa, coffee, tea or chocolate-based beverages; rice, tapioca, sago; vegetable flavourings, other than essential oils; fresh, chilled and frozen ready meals, semi-prepared meals and partly prepared meals, mainly consisting of rice, noodles, corn, couscous (semolina) and/or cereals; vegetarian delicatessen foodstuffs, mainly consisting of cereals; farinaceous foods; pizzas, quiches; bread, sandwich bread, crisp bread and dry flatbread, rolls, biscuits and patisserie products, cakes, pastry and confectionery, tarts and desserts; edible ices; honey, treacle; fruit sauces; yeast, baking-powder, custard powder, flavourings for baking, baking essences; sugar, confectionery, chewing gum, marzipan, artificial marzipan, nougat, chocolate, marzipan, nougat and chocolate-based products, sweets, chocolates, including with liquid fillings, in particular wines and spirits; savoury biscuits; snacks; soya flour; soy sauce, tacos; flour and preparations made from cereals, in particular wheat, oats, barley, rye, millet, maize and buckwheat, the aforesaid goods also in the form of mixtures and other preparations, in particular wheat germ, maize meal, maize semolina, linseed, muesli and muesli bars; husked whole meal cereals, in particular wheat, oats, barley, rye, pasta and whole meal pasta; pastry and confectionery; sauces (condiments); bakery products, with fillings mainly consisting of meat, poultry, game, fish, seafood or sausage, and pasta made using meat, bread and bakery products, and combination products, including with added meat, fish, seafood, poultry and game, fruit, vegetables, pasta and/or bakery products; pasta and whole meal pasta; pasta, fresh pasta meals, fresh pasta ready meals, in particular cannelloni, lasagne, tortellini, ravioli, including all the aforesaid meals in frozen form; baguettes and ready-to-eat toasted sandwiches or rolls mainly filled with cheese and/or fruit and/or vegetables; dietetic foodstuffs with a base of carbohydrates, not for medical purposes; salt, pepper, mustard, vinegar, sauces and dips (condiments), salad dressings; spices; fruit sauces; meat, fish and game pies; vegetable and fruit pies; including all the aforesaid goods (where possible) in frozen form.

2. Puratos N.V. (which I will refer to as 'Puratos') filed notice of opposition granting of protection in the United Kingdom, claiming that protection would be contrary to sections 5(1) and 5(2)(a) and (b) of the Trade Marks Act 1994 (the Act). It relies upon a single earlier trade mark (which is also an international registration), as follows:

PURAVITA

Protection in the United Kingdom was requested on 9 June 2000, claiming a priority date of 25 May 2000 from the Benelux Office of Origin. It was published for opposition purposes in the UK *Trade Marks Journal* on 1 November 2000. No opposition was received to the granting of protection of the IR; consequently, the IR was protected in the UK with effect from 2 March 2001, the day after the expiry of the opposition period. It had therefore been protected in the UK for more than five years before the date of publication of the IR which is opposed. This means that the earlier mark is subject to the proof of use provisions². Puratos relies upon and has made a statement of use in respect of all the goods for which its mark is protected, which are:

Class 30: Bread, flour and preparations made from cereals.

3. Puratos attacks all the goods of the IR. It claims that its mark is identical to the IR, the additional 'a' being so insignificant a difference that it would go unnoticed by the average consumer, visually and aurally; protection would be contrary to sections 5(1) and 5(2)(a) of the Act. In the alternative, it claims that the marks are so similar that the IR should be refused under section 5(2)(b) of the Act. Puratos claims that some of the goods are identical and that all of the other categories of goods in the IR are similar to those covered by its earlier mark. It claims that the categories relate to food, baking and food preparation and are in competition with, directly linked or are complementary to the goods for which Puratos claims use (all of the goods of its earlier mark).

4. Resas filed a counterstatement denying that the marks are similar or identical and denying a likelihood of confusion. Resas puts Puratos to proof of use of its mark in the UK. Only Puratos filed evidence: the witness statement is a mixture of fact and submission so whilst the evidence summary below only gives details of factual evidence, I have borne the submissions in mind in making this decision. Neither side asked for a hearing or filed written submissions in lieu of attending a hearing, both being content for a decision to be made from the papers on file.

Puratos' evidence

5. This is in the form of a witness statement from Mr Thomas Philip Webley, who is Puratos' professional representative in these proceedings. He states that he is authorised by Puratos to make this statement. Mr Webley confirms that the facts which he states are true to the best of his knowledge and belief and that where he has been told facts by others, he has identified the source and that the facts are, to the best of his knowledge and belief, true. Mr Webley's witness statement has drawn no comment from Resas.

² See section 6A of the Act (added by virtue of the Trade Marks (Proof of Use, etc.) Regulations) 2004 (SI 2004/946) which came into force on 5th May 2004.

6. Mr Webley states that he has been told by the trade mark team at Puratos that the earlier mark has been used extensively in the UK over the last five years on a range of its products (Mr Webley's witness statement is dated 21 December 2009). Beyond this assertion, there is no factual narrative in the witness statement, but there is an exhibit of 49 pages which contains a mixture of documentary material relating to the earlier mark (TPW1). In summary:

(i) Pages from a brochure which was sent directly to 4,000 customers in 2006. This is in English. The address details at the end are for Puratos Ltd in Buckinghamshire and the website details are for www.puratos.co.uk. There is use of PURAVITA in stylised and word-only form. Puravita is used in relation to three bread mixes called Puravita Fibres+, Puravita Omega-3 and Puravita Pan-O-Col. Page 5 of the exhibit refers to patisserie (cake mix) products (satin crème cake, orange and cranberry loaf cake, blueberry and oats muffin, skinny raspberry muffin and lemon and poppy seed bites), but these are not shown in relation to PURAVITA. Page 6 refers to a wholegrain cake which is 30% less fat than a "standard Satin Crème Cake from Puratos". Page 7 shows chocolate, but the trade mark in use here is 'Belcolade'.

(ii) Advertisement pages from the 'Speciality Breads and Cakes' supplement to British Baker dated 28 April 2006. PURAVITA appears in stylised and word-only form in relation to the three bread mixes (Fibres+, Omega-3 and Pan-O-Col). Page 12 of the exhibit is an example of a national press advertisement (unidentified media) from May/June 2006. PURAVITA appears in stylised and word-only form in relation to the three bread mixes.

iii) Pages 13-34 comprise a number of copies of invoices. The names and addresses have been redacted; however, all the details are in English and the Buckinghamshire address and UK website and phone number details appear on the bottom of each invoice. There are a number of items listed which are without brand names or which appear in conjunction with names other than PURAVITA. Where PURAVITA appears (pages 13, 14, 16, 17, 18, 19, 22, 23, 24, 25, 26, 28, 32 and 34), it is in relation to the three bread mixes which I have identified above. The dates of the invoices cover a range from 5 May 2006 to 24 April 2009 (the latter being after the relevant date). A 15kg bag of PURAVITA bread mix costs approximately £13-20, depending on the date of the invoice. The amount of bread mix bags ordered by each customer does not exceed single figures, nor do the Puravita Fibres+, Puravita Omega-3 and Puravita Pan-O-Col 'Decor' bags, sold in quantities of 5kg.

(iv) Pages 35 to 38 comprise advertisements from the September to October 2006 issues of 'Today's Bako', 'Bake with Bako' (London and the

South East) and 'The Bako Bite'. PURAVITA appears in stylised and word-only form in relation to the three bread mixes.

(v) Pages 39 to 42 are from undated promotional leaflets promoting the Puravita range as a response to a new market trend for nutritious healthy bakery products. The stylisation of PURAVITA in these pages does not appear anywhere else in the evidence. The pages largely refer to bread, although there is an entry for PURAVITA (stylised) JUNIOR, for buns with either sweet or savoury toppings. The postal and website addresses at the end of these pages are located in Belgium, and the telephone numbers are outside of the UK.

(vi) An undated press release (pages 43-44) refers to the new range of three bread mixes, Puravita Fibres+, Puravita Omega-3 and Puravita Pan-O-Col. The text says that the mixes "make it easier for bakers to offer a full range of healthier and more indulgent functional foods". Further, "The new mixes are the latest additions to the company's Great Taste & Wellness range, which already includes ingredients for reduced-fat cakes, croissants and bavaoies, as well as sugar free and no sugar added chocolate."

Pages 45 – 49 are screen-prints from the Puratos website (the copy of which is illegible), from Bako's website and from Google and Yahoo search engine results. These are all from December 2009, after the relevant date for these proceedings.

Decision

Proof of use

7. Section 6(A) of the Trade Marks Act 1994 ("the Act") states:

"(1) This section applies where—

- (a) an application for registration of a trade mark has been published,
- (b) there is an earlier trade mark 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).”

8. In addition to section 6A of the Act, section 100 states:

“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.”

9. To rely upon its earlier trade mark, Puratos has to prove that it has made genuine use of the trade mark, or that there are proper reasons for non-use, in the relevant period. The relevant period is the five years prior to and ending on

the date of publication of the IR, i.e. from 7 February 2004 to 6 February 2009, as per section 6A(3) of the Act.

10. Ms Anna Carboni, sitting as the appointed person in *BreadTalk*, O-070-10, summarised a set of principles from the following leading European Court of Justice genuine use cases: *Ansul BV v AjaxBrandbeveiliging BV*, Case C-40/01, [2003] ETMR 85 (“ECJ”); *La Mer Technology Inc v Laboratoires Goemar SA*, Case C-259/02, [2004] FSR 38 (ECJ); and *Silberquelle GmbH v Maselli-Strickmode GmbH* Case C-495/07, [2009] ETMR. I gratefully adopt her summary:

“(1) Genuine use means actual use of the mark by the proprietor or a third party with authority to use the mark: *Ansul*, [35] and [37].

(2) The use must be more than merely “token”, which means in this context that it must not serve solely to preserve the rights conferred by the registration: *Ansul*, [36].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish the goods or services from others which have another origin: *Ansul*, [36]; *Silberquelle*, [17].

(4) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, i.e. exploitation that is aimed at maintaining or creating an outlet for the goods or services or a share in that market: *Ansul*, [37]-[38]; *Silberquelle*, [18].

(a) Example that meets this criterion: preparations to put goods or services on the market, such as advertising campaigns: *Ansul*, [37].

(b) Examples that do not meet this criterion: (i) internal use by the proprietor: *Ansul*, [37]; (ii) the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle*, [20]-[21].

(5) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including in particular, the nature of the goods or services at issue, the characteristics of the market concerned, the scale and frequency of use of the mark, whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them, and the evidence that the proprietor is able to provide: *Ansul*, [38] and [39]; *La Mer*, [22] - [23].

(6) Use of the mark need not always be quantitatively significant for it to be deemed genuine. There is no *de minimis* rule. Even minimal use may qualify as genuine use if it is the sort of use that is appropriate in the economic sector concerned for preserving or creating market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor: *Ansul*, [39]; *La Mer*, [21], [24] and [25].”

11. The holder of the earlier mark is Puratos N.V. (in Belgium). The documentary evidence which Mr Webley had provided is in respect of Puratos Ltd in Buckinghamshire, with the website www.puratos.co.uk and a UK telephone number. There is no explicit reference to this in Mr Webley’s witness statement, but he does make the statement that he has been told by the trade marks team at Puratos that the earlier mark has been used in the UK in the five years prior to his statement. I will therefore accept at face value the evidence (which Resas has not challenged) as supporting use by an entity with the consent of Puratos to use the mark.

12. There is both use of the word only mark PURAVITA as well as in stylised form, so I do not need to address the issue of acceptable variants. There is use of the word only form within the relevant five year period. Sales of the goods have been in quantities of less than double figures on each occasion, but the fact that the use is not quantitatively significant is not fatal if it is nevertheless genuine. Although the sales are on a small scale, the invoices show that the sales took place consistently and over a sustained period of time. From the contents of the advertisements placed in trade publications, and the brochure sent out to 4000 customers in 2006, the indications are that the PURAVITA goods were a new product. Bearing in mind that the goods (I will come on to what these are shortly) have been sold in bulk sizes (i.e. they are not for domestic use), and appear to be for use by commercial bakers, the sending of a brochure to 4000 customers represents an appropriate attempt at creating a market for a new product which is perhaps niche rather than everyday. This product was then sold, as evidenced in the invoices. This was not internal use and there is no hint of tokenism, or use to preserve the rights conferred by the registration.

13. It is clear from the evidence that the mark has been used on three products: Puravita Fibres+, Puravita Omega-3 and Puravita Pan-O-Col. These are all bread mixes. There is genuine use of the mark in relation to bread mixes. There is no use of PURAVITA on any other goods; where other goods are referred to in the evidence, they are either used with other trade marks, such as Puratos, Belcolade and Great Taste & Wellness, or are not shown as belonging to a Puravita range of goods..

14. Puratos's earlier mark is registered for *Bread, flour and preparations made from cereals*. I have to decide whether Puratos is entitled to rely upon all or any of these terms, or, alternatively what a fair specification would be based on the use Puratos has demonstrated in these proceedings. There is an established body of case law which deals with the task of framing a fair specification. In *Nirvana Trade Mark O/262/06* and *Extreme Trade Mark O/161/07*, Mr Richard Arnold Q.C. (as he then was), as The Appointed Person, comprehensively examined the analogous case law under section 46(5) of the Act. His conclusion in *Nirvana* was that:

“(1) The tribunal's first task is to find as a fact what goods or services there has been genuine use of the trade mark in relation to during the relevant period: *Decon v Fred Baker* at [24]; *Thomson v Norwegian* at [30].

(2) Next the tribunal must arrive at a fair specification having regard to the use made: *Decon v Fred Baker* at [23]; *Thomson v Norwegian* at [31].

(3) In arriving at a fair specification, the tribunal is not constrained by the existing wording of the specification of goods or services, and in particular is not constrained to adopt a blue-pencil approach to that wording: *MINERVA* at 738; *Decon v Fred Baker* at [21]; *Thomson v Norwegian* at [29].

(4) In arriving at a fair specification, the tribunal should strike a balance between the respective interests of the proprietor, other traders and the public having regard to the protection afforded by a registered trade mark: *Decon v Fred Baker* at [24]; *Thomson v Norwegian* at [29]; *ANIMAL* at [20].

(5) In order to decide what is a fair specification, the tribunal should inform itself about the relevant trade and then decide how the average consumer would fairly describe the goods or services in relation to which the trade mark has been used: *Thomson v Norwegian* at [31]; *West v Fuller* at [53].

(6) In deciding what is a fair description, the average consumer must be taken to know the purpose of the description: *ANIMAL* at [20].

(7) What is a fair description will depend on the nature of the goods, the circumstances of the trade and the breadth of use proved: *West v Fuller* at [58]; *ANIMAL* at [20].

(8) The exercise of framing a fair specification is a value judgment: *ANIMAL* at [20].

In his later judgment in *Extreme*, Mr Arnold referred to the General Court's (GC) judgments in *Reckitt Benckiser (Espana) SL v OHIM (ALADIN)* [2005] ECR II-

2861³ *Mundipharma AG v OHIM*, Case T-256/04, noting that paragraph 29 of *Mundipharma* indicates that the matter is to be approached from the consumer's perspective:

"29. The Court notes in this respect that, since consumers are searching primarily for a product or service which can meet their specific needs, the purpose or intended use of the product or service in question is vital in directing their choices. Consequently, since consumers do employ the criterion of the purpose or intended use before making any purchase, it is of fundamental importance in the definition of a subcategory of goods or services."

Referring to the English authorities quoted in *Nirvana*, he said:

"[54] The essence of the domestic approach is to consider how the average consumer would fairly describe the goods in relation to which the trade mark has been used...."

55. To the extent that there is a difference between them, I remain of the view expressed in *NIRVANA* that I am bound by the English authorities interpreting section 46(5) of the 1994 Act and Article 13 of the Directive and not by the CFI's interpretation of Article 46(2) of the CTM Regulation since, as already noted above, there are differences between the two legislative contexts. Nevertheless I consider that English tribunals should endeavour to follow the latter so far as it is open to them to do so. *Mundipharma* suggests that, within the spectrum of domestic case law, the slightly more generous approach of Jacob J in *ANIMAL Trade Mark* [2003] EWHC 1589 (Ch), [2004] FSR 19 is to be preferred to the slightly

³ "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 to which the goods or services for which the trade mark has actually been used 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."

less generous approach of Pumfrey J in *DaimlerChrysler AG v Alavi* [2001] RPC 42.”

15. Professor Ruth Annand, sitting as the appointed person in a coincidentally named *EXTREME* Trade Mark appeal O/217/10, noted that:

“13. The current law on part cancellation for non-use was succinctly summarised by Mr. Geoffrey Hobbs QC sitting as a deputy judge of the High Court in *Daimler AG v. Sany Group Co Ltd* [2009] EWHC 1003 (Ch), paragraph 9:

“The required degree of precision [with which the goods/services of the registration in suit may need to be redefined] has not yet been authoritatively defined by the European Court of Justice (it was touched upon obliquely in Case C418/02 *Praktiker Bau-und Heimwerkermärkte* [2005] ECR I-5873 at paragraphs 49 to 52). In three decisions of the Court of First Instance (Case T-256/04 *Mundipharma AG v. OHIM* [2007] ECR II-449; Case T-483/04 *Armour Pharmaceutical Co v. OHIM* [2006] ECR II-4109; Case T-126/03 *Reckitt Benckiser (España) SL v. OHIM* [2005] ECR II-2861) it has been indicated that the outcome should be a specification expressed in wording which covers no independent sub-category or sub-categories of goods other than the one(s) within which the relevant trade mark can be taken to have been used. In the most recent of these decisions (Case T-256/04 *Mundipharma AG* at paragraphs 27 to 36) it was emphasised that the chosen wording should reflect the purpose and intended use of the relevant goods. I have previously expressed the view that the aim should be to arrive at a fair specification by identifying and defining not the particular examples of goods for which there has been genuine use, but the particular categories of goods they should realistically be taken to exemplify (*WISI Trade Mark* [2006] RPC 13, p. 580 at paragraphs 11 to 18; *DATASPHERE Trade Mark* [2006] RPC 23, p. 590 at paragraphs 19 to 25). That appears to me to be consistent with the case law in England (analysed by Mr. Richard Arnold QC sitting as the Appointed Person in *NIRVANA Trade Mark* (BL O/262/06) at paragraphs 36 to 59) and also with the case law of the Court of First Instance. However it is possible, that the case law in England may not fully accord with the case law of the Court of First Instance, as noted in the decision of Mr. Richard Arnold QC sitting as the Appointed Person in *EXTREME Trade Mark (Pan World Brands Ltd v. Tripp Ltd* [2008] RPC 2, p. 21 at paragraphs 51 to 56; see also Bently and Sherman *Intellectual Property Law* 3rd Edn (2009) pp 906, 907) ...”

....

15. In *NIRVANA*, Mr. Arnold identified that the main difference between the approaches of the English courts and the General Court was that the former based a fair description of the use that had taken place on the perception of the average consumer whereas the latter provided no clear yardstick for determining when a sub-category of products cannot be further divided. To my mind, a danger with the category/subcategory approach is that it invites sub-division according to the product(s) concerned. A tribunal may be seduced into equating a fair description with actual use shown.”

16. I must therefore approach Puratos’ evidence from the standpoint of what is a fair description of the use from the average consumer’s view of the purpose and intended use of the goods, applying any appropriate sub-categorisation as long as it is not overly specific and unduly restrictive. I must take care not to equate a fair description with the actual use Puratos has shown if that is not a fair description from the average consumer’s perception. As per *Melis Trade Mark* (Mr Hobbs as the Appointed Person, O-345-10):

“In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”

17. The use shown is all on bread mixes. Bread is a finished article; the average consumer has a definite perception as to the purpose and intended use of bread: it is the most ‘everyday’ type of product. Bread mixes are not bread and they are also not flour. Flour has many culinary uses with which the average consumer will be familiar, whilst bread mixes are solely for making bread. There is no suggestion in the evidence that either bread or types of flour are available from Puratos. I consider that Puratos is not entitled to rely upon *bread* or *flour* in this opposition. This leaves the term *preparations made from cereals*. Bread mixes are made from cereals (wheat, rye etc) so would seem to be covered by this term. However, the term also covers goods such as breakfast cereals, porridge oats, cereal bars, crisp-type snacks, couscous and pasta. This term is too wide, in the context of the use of PURAVITA which has been shown, to leave without restriction. Although a fair description could be said to be *preparations made from cereals in the form of bread mixes*, this seems tautologous. It is clearer to define the goods as *bread mixes*. I am conscious that the effect of this restriction is, in effect, to define the particular example of the goods for which there has been genuine use; however, in this case I am of the view that the use coincides with the particular category of goods exemplified from the standpoint of the average consumer.

Sections 5(1), 5(2)(a) and 5(2)(b)

18. These sections state:

“5. - (1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.

(2) A trade mark shall not be registered if because –

(a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, or

(b) 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.”

19. I will look later at the case law for a finding of identity of marks, (sections 5(1) and 5(2)(a)). In relation to section 5(2)(b), the leading authorities which guide me are from the ECJ: *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77, *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) C-334/05 P (LIMONCELLO)*. It is clear from these cases that:

(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*,

(b) the matter must be judged through the eyes of the average consumer for the goods/services in question; *Sabel BV v Puma AG*, who is deemed to be reasonably well informed and reasonably circumspect and observant - but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind; *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*,

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v Puma AG*,

(d) 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; *Sabel BV v Puma AG*,

(e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,

(f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v Puma AG*,

(g) in determining whether similarity between the goods or services covered by two trade marks is sufficient to give rise to the likelihood of confusion, the distinctive character and reputation of the earlier mark must be taken into account; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,

(h) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v Puma AG*,

(i) further, the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense; *Marca Mode CV v Adidas AG and Adidas Benelux BV*,

(j) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*.

Average consumer and the purchasing process

20. The average consumer for food is the general public. The average consumer is reasonably well informed and reasonably circumspect and observant, but his level of attention is likely to vary according to the category of goods or services. I consider that the average consumer will pay only a moderate amount of attention when purchasing food which is, generally speaking in relation to the categories of food in the parties' specifications, a frequent and relatively inexpensive purchase. The purchasing process is largely a visual process of self-selection.

Comparison of goods

21. In comparing the respective specifications, all relevant factors should be considered, as per *Canon* where the ECJ stated at paragraph 23 of its judgment:

“In assessing the similarity of the goods or services concerned, as the

French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose⁴ and their method of use and whether they are in competition with each other or are complementary.”

The criteria identified in *British Sugar Plc v James Robertson & Sons Limited (Treat)* [1996] R.P.C. 281 for assessing similarity between goods and services were:

- (a) the respective uses of the respective goods or services;
- (b) the respective users of the respective goods or services;
- (c) the physical nature of the goods or acts of service;
- (d) the respective trade channels through which the goods or services reach the market;
- (e) in the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) the extent to which the respective goods or services are competitive, taking into account how goods/services are classified in trade.

22. Puratos has opposed all the goods of the IR. Owing to the restriction following my assessment of Puratos’ use of its mark, the comparison is to be made between all the goods of the IR and *bread mixes* in the earlier mark. At the conclusion of the evidence rounds, the registrar invited Puratos to provide written submissions in relation to its claim to similarity or identity between the goods of the parties (of course, this was before the above restriction to the specification). No submissions were received.

23. In *Treat*, the court also stated that 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”. As I have noted above, bread mixes are for making bread. Of its nature, a bread mix must contain some sort of flour. Resas’ specification includes farinaceous foods, a term which encompasses bread

⁴ The earlier incorrect translation of ‘Verwendungszweck’ in the English version of the judgment has now been corrected.

mixes which are farinaceous compositions⁵. There is identity between *bread mixes* and *farinaceous foods*. The same is true of Resas' *preparations made from cereals, in particular wheat, oats, barley, rye, millet, maize and buckwheat, the aforesaid goods also in the form of mixtures*: these are identical to Puratos' *bread mixes*, because preparations made from cereals includes bread mixes (as per Puratos' reduced specification). This logic includes *vegetarian delicatessen foodstuffs, mainly consisting of cereals*, which I also find to be identical to *bread mixes*. In relation to *dietetic foodstuffs with a base of carbohydrates, not for medical purposes*, this term would seem to cover bread mixes for example for coeliacs, who require gluten-free bread. So this term is also identical to *bread mixes*.

24. Turning to goods which are not identical, there are several obvious contenders in Resas' class 30 specification for a comparison with bread mixes, as per *Canon* and *Treat*. These are:

- (i) bread, sandwich bread, crisp bread and dry flatbread, rolls,
- (ii) flour and soya flour
- (iii) flour and preparations made from cereals, in particular wheat, oats, barley, rye, millet, maize and buckwheat, the aforesaid goods also in the form of ... other preparations, in particular wheat germ, maize meal, maize semolina, linseed, muesli and muesli bars.

25. Comparing firstly bread and bread mixes, the uses and users, and type of good is the same as they are both staple food products and they are both available in supermarkets and grocery outlets. They are not, however, usually located near to one another in supermarkets; bread mixes are usually sold alongside goods for use in baking (e.g. flour) while bread is sold in a separate area of the shop (usually near the instore bakery which many supermarkets now have). However, the goods are in competition: the choice is whether to buy a ready-made loaf (or sandwich loaf) or to buy a bread mix (or for that matter, flour and yeast) and to make one's own, either in an oven or a bread machine. Rolls are also classified as bread products; a bread mix can be used to create bread dough which can then be shaped and baked as rolls instead of a loaf. Accordingly, I find that there is a good deal of similarity between Puratos's *bread mixes* and Resas's *bread, sandwich bread and rolls*.

⁵ The General Court (previously the Court of First Instance) said in *Gérard Meric v OHIM*, Case T-133/05: "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-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)."

26. Bread is clearly a term which is within everyone's understanding. However, I am not certain as to what 'crisp bread' and 'dry flatbread' signify. Crisp bread, in my experience, is a flat dry cereal product which is found close to the biscuit aisle of a supermarket, alongside crackers and suchlike. I do not think an average consumer would ordinarily describe it as a bread. Although there may be an element of competition between bread and crisp bread (for example, whether to make a sandwich or to spread something onto a crisp bread), the element of competition does not extend to bread mixes; this would be a step too far. Without the benefit of explanation, if there is any similarity between *bread mixes* and *crisp bread*, it must be very low.

27. In my experience, 'flatbreads' are unleavened bread products such as tortillas (the Mexican kind) and pitta bread. These could be made from a dough or bread mix, as an alternative to buying the finished product. I find that there is a good deal of similarity between *dry flatbread* and *bread mixes*.

28. Flour is a major constituent of bread mixes. That, of itself does not mean that the goods are similar⁶, but neither does it mean that they are not similar: the matter is one that must be considered on the facts. Flour is used to make bread, the use and users are the same, and the channels of trade are the same. Flour is complementary to bread mixes in the sense of being indispensable⁷. It is also in competition with bread mixes; the choice is either to purchase a bread mix or to use a separate mix of flour, yeast and the other dry components of bread dough. I consider *bread mixes* to be highly similar to *flour*. Soya flour is a subset of flour, although this does not of itself make it similar to bread mixes unless bread can be made with soya flour. My understanding is that gluten-free bread can be made with soya flour, so, for the reasons already outlined, *bread mixes* are highly similar to *soya flour*.

⁶ The GC considered the relationship between finished article and component parts in *Les Editions Albert René v OHIM* Case T-336/03:

"The mere fact that a particular good is used as a part, element or component of another does not suffice in itself to show that the finished goods containing those components are similar since, in particular their nature, intended purpose and the customers for those goods may be completely different."

⁷ As per *Oakley, Inc v OHIM*, Case T-116/06 (GC): "52 Regarding, third, the complementary nature of the services and goods in question, found to exist by the Board of Appeal in paragraph 23 of the contested decision, it should be pointed out that, according to settled caselaw, complementary goods are those which are closely connected in the sense that one is indispensable or important for the use of the other, so that consumers may think that the same undertaking is responsible for both (see, to that effect, *SISSI ROSSI*, paragraph 49 above, paragraph 60; *PAM PLUVIAL*, paragraph 49 above, paragraph 94; and *PiraÑAM diseño original Juan Bolaños*, paragraph 49 above, paragraph 48)."

29. “Flour and preparations made from cereals, in particular wheat, oats, barley, rye, millet, maize and buckwheat, the aforesaid goods also in the form of ... other preparations, in particular wheat germ, maize meal, maize semolina, linseed, muesli and muesli bars”. Muesli and muesli bars are not of a similar nature to bread mixes. Wheatgerm is a constituent of flour which enriches the wholemeal nature of bread or flour, although it is not an alternative to flour; to this extent, *preparations made from cereals in the form of wheatgerm* are reasonably similar to *bread mixes*. However, there is no information (and it is not within my knowledge) as to whether maize meal, maize semolina and linseed may be incorporated into bread, whether they are in competition with flour or bread mixes or where they may be purchased. Accordingly, I find they are not similar.

30. As I have already noted, Puratos was invited by the registrar to make representations as to the similarity of goods, but did not respond. It may not always be practical to provide evidence of similarity, but Puratos' opposition gives no particularisation: it is a blanket opposition which attacks all the goods of the IR without any explanation. 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 good or services are not similar, Article 4(1)(b) provides that the likelihood of confusion presupposes that the goods or services covered are similar.”

31. In making my comparison between the remainder of Resas' goods in classes 29 and 30 and Puratos' *bread mixes*, I will approach Resas' goods in terms of homogenous categories, where appropriate⁸:

(i) *Meat, sausage, fish, poultry, game, shellfish (not live); meat extracts; meat, sausage, fish, poultry, game, fruit and vegetable preserves; preserved, dried and cooked fruits and vegetables; prepared potatoes and potato products of all kinds (included in this class), including in the form of flakes, powdered potato, croquettes, French fries, fried potatoes, potato fritters, rösti (fried grated potato cakes), potato pancakes, crisps and sticks; poultry meat or poultry meat cuts; minced meat products, cooked, spiced and/or coated with sauce, including combined with fruit, vegetables, potatoes, cheese, pasta and/or breadcrumbs; goose liver pate; semi-prepared and ready-to-cook meals and prepared meals, mainly consisting of meat, fish, seafood, poultry, game and/or sausage, including*

⁸ As per the decision of Mr Geoffrey Hobbs Q.C. , sitting as the appointed person, in *Separode Trade Mark* BL O-399-10, with reference to BVBA Management, Training en Consultancy v. Benelux-Merkenbureau [2007] ECR I-1455 at paragraphs [30] to [38]: “The determination must be made with reference to each of the different species of goods listed in the opposed application for registration; if and to the extent that the list includes goods which are sufficiently comparable to be assessable for registration in essentially the same way for essentially the same reasons, the decision taker may address them collectively in his or her decision.”

being stews; soups, meat broth, broth, soup preparations; beans being ready meals; fresh, chilled and frozen ready meals, semi-prepared meals and partly prepared meals with a vegetable base, mainly consisting of vegetables and soya proteins; semi-prepared and partly prepared meals, mainly consisting of soya beans, potatoes; foodstuffs, mainly consisting of plant products, in particular soya beans; tofu; preserved soya beans for food; vegetarian delicatessen items, mainly consisting of soya-based meat substitutes, fatty spiced spreads for bread, tofu products and soya beans (preserved) for food.

These goods are all in the nature of meat, fish or poultry, vegetables, pulses, fruits and prepared meals. They are not of the same nature as bread mixes and are not for the same purpose (other than at the most general of levels which is for consumption). They share the same channels of trade as bread mixes insofar as they may all be purchased from supermarkets, but within those channels of trade they are not to be found on the same shelves as bread mixes. They will not be bought as an alternative to bread mixes and they are not complementary in the sense of being indispensable to bread mixes⁹. These goods are not similar to bread mixes.

(ii) *jellies; jams; edible oils and fats; herbs, spiced oils.*

These goods are in the nature of condiments or cooking aids. They are not of the same nature as bread mixes and are not for the same purpose (other than at the most general of levels which is for consumption). They share the same channels of trade as bread mixes insofar as they may all be purchased from supermarkets, but within those channels of trade they are not to be found on the same shelves as bread mixes. They will not be bought as an alternative to bread mixes and they are not complementary in the sense of being indispensable to bread mixes¹⁰. These goods are not similar to bread mixes.

(iii) *Biscuits; savoury biscuits; snacks and snack products.*

Biscuits are of a different nature to bread; although made from flour, they are crisp, flat, unleavened products which are either in the nature of confectionery or are savoury, perhaps as an alternative to a packet of crisps. They are not found nearby to bread mixes in shops. Snacks and snack products could encompass

⁹ In *Boston Scientific Ltd v OHIM* Case T- 325/06 the General Court (GC) explained when goods were to be considered complementary: “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).” *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).”

biscuits of both types. The term 'snacks' could also encompass crisp-type food products; there have been no submissions as to what the term covers in comparison to Puratos' goods. I find there is no similarity to bread mixes.

(iv) coffee, artificial coffee, tea, cocoa, cocoa-based products, cocoa-based beverage powders, drinking cocoa in paste form and cocoa extracts for food, cocoa, coffee, tea or chocolate-based beverages.

These goods are all in the nature of drinks; their purpose is entirely different to that of a bread mix, which is for making bread. These goods are not similar.

(v) rice, tapioca, sago; husked whole meal cereals, in particular wheat, oats, barley, rye, pasta and whole meal pasta.

These goods are all in the nature of grains and cereals which have not been milled into flour. They are not of the same nature as bread mixes and are not flour, so are not in competition or complementary to bread mixes. They share the same channels of trade as bread mixes insofar as they may all be purchased from supermarkets, but within those channels of trade they are not to be found on the same shelves as bread mixes. These goods are not similar to bread mixes.

(vi) fresh, chilled and frozen ready meals, semi-prepared meals and partly prepared meals, mainly consisting of rice, noodles, corn, couscous (semolina) and/or cereals.

These goods are all in the nature of prepared meals. They are not of the same nature as bread mixes and are not for the same purpose. They share the same channels of trade as bread mixes insofar as they may all be purchased from supermarkets, but within those channels of trade they are not to be found on the same shelves as bread mixes. They will not be bought as an alternative to bread mixes and they are not complementary in the sense of being indispensable to bread mixes. These goods are not similar to bread mixes.

(vii) patisserie products, cakes, pastry and confectionery, tarts and desserts; edible ices; sugar, confectionery, chewing gum, marzipan, artificial marzipan, nougat, chocolate, marzipan, nougat and chocolate-based products, sweets, chocolates, including with liquid fillings, in particular wines and spirits; pastry and confectionery.

These are all in the nature of finished sweet products or the constituents of them (such as marzipan and sugar). They are not in the same nature as bread and therefore not in the same nature as bread mixes. Pastry and cakes, although made with flour, do not serve the same purpose as bread and therefore bread mixes. Some of the goods, such as marzipan and sugar, may be sold nearby to bread mixes, but this is because bread mixes are sold alongside flour, baking

powder and other baking ingredients. It does not make them complementary to or in competition with bread mixes, and it does not cause them to serve the same or a similar purpose. These goods are not similar to bread mixes.

(viii) *vegetable flavourings, other than essential oils; honey, treacle; fruit sauces; yeast, baking-powder, custard powder, flavourings for baking, baking essences; soy sauce; sauces (condiments); salt, pepper, mustard, vinegar, sauces and dips (condiments), salad dressings; spices; fruit sauces.*

These goods are in the nature of condiments or cooking aids. They are not of the same nature as bread mixes and are not for the same purpose. They share the same channels of trade as bread mixes insofar as they may all be purchased from supermarkets, but within those channels of trade they are not to be found on the same shelves as bread mixes. They will not be bought as an alternative to bread mixes and they are not complementary in the sense of being indispensable to bread mixes. These goods are not similar to bread mixes.

(ix) *tacos*

Tacos are rigid, shaped savoury cereal food products; they are sold ready-shaped so as to hold a meat or vegetable filling. They have more in common with crispbreads and crackers than with bread. They would not be bought as an alternative to bread and consequently bread mixes are not in competition with tacos. They are not found on adjacent shelving in supermarkets. Tacos are not similar to bread mixes.

(x) *pizzas, quiches; bakery products, with fillings mainly consisting of meat, poultry, game, fish, seafood or sausage, and pasta made using meat, bread and bakery products, and combination products, including with added meat, fish, seafood, poultry and game, fruit, vegetables, pasta and/or bakery products; pasta and whole meal pasta; pasta, fresh pasta meals, fresh pasta ready meals, in particular cannelloni, lasagne, tortellini, ravioli, including all the aforesaid meals in frozen form; meat, fish and game pies; vegetable and fruit pies.*

These goods are in the nature of meals, except for fruit pies which are desserts. In relation to fruit pies, their nature and purpose is not the same as for bread mixes: bread is a savoury item for satisfying hunger, whilst a fruit pie is a sweet dessert item eaten after a meal or as a confectionery item. Fruit pies are not similar to bread mixes. Quiches and the items following the term "bakery products" are meals or components of meals which have a pastry or farinaceous basis, such as sausage rolls, pasties and filled pasta shapes. They share the same channels of trade as bread mixes insofar as they may all be purchased from supermarkets, but within those channels of trade they are not to be found on the same shelves as bread mixes. They will not be bought as an alternative to bread mixes and they are not complementary in the sense of being indispensable to bread mixes. These goods are not similar to bread mixes.

Pizzas have a bread dough base. A bread mix could be bought as an alternative to buying a ready-made pizza base for the purpose of making one's own pizza, instead of buying a ready-made pizza. So, if one wishes to make a pizza, the choice is either to buy a base, or to make the base from scratch using flour and the other separate ingredients of a pizza base, or to buy a bread mix and make the base without having to combine the separate ingredients. There is an element of competition between ready-made pizza bases and bread mixes. However, a pizza base is but one part of a pizza so that a bread mix becomes an ingredient of a pizza. Bread mixes and pizzas are not sold near to one another in supermarkets and they are not complementary in the sense of being indispensable for one another. There have been no submissions from Puratos as to whether, for example, it is common in trade for makers of bread mixes, which are unfinished food items, to make finished pizzas. In my experience, pizzas are not sold under the same trade marks as bread mixes or even under those on pizza bases. I find that pizzas are not similar to bread mixes.

Comparison of trade marks

32. The authorities direct that, in making a comparison between the marks, I must have regard to each mark's visual, aural and conceptual characteristics. I have to decide which, if any, of their components I consider to be distinctive and dominant, without engaging in an artificial dissection of the marks, because the average consumer normally perceives a mark as a whole and does not analyse its details.

33. The marks to be compared are:

Puratos's mark	Resas's mark
PURAVITA	PURVITA

Both marks are single words; therefore, neither has a dominant element. They will be perceived as single element invented words (I will look at this in more detail below) which do not describe the goods and are therefore distinctive. Visually, the only difference between the marks is the presence in the earlier mark of the letter 'a' between PUR and VITA, which makes the earlier mark eight letters long as opposed to the IR's seven letters. The common denominator in sections 5(1) and 5(2)(a) is that the marks must be identical. In *LTJ Diffusion SA v Sadas Vertbaudet SA* Case C-291/00 the European Court of Justice stated:

"54 In those circumstances, the answer to the question referred must be that Art.5(1)(a) of the directive must be interpreted as meaning that a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they

may go unnoticed by an average consumer.”

Puratos claims in its notice of opposition that the additional ‘a’ in its own mark is so insignificant a difference that it would go unnoticed by the average consumer, “visually and aurally”. In *Reed Executive Plc v Reed Business Information Ltd* [2004] R.P.C. 40, Jacob LJ considered the interpretation of the ECJ’s answer to the reference in the *LTJ Diffusion SA v Sadas Vertbaudet SA* case. He said that the ECJ was recognising that an additional element may take the case outside of one of identity: the ECJ said at paragraph 51 that there is identity between the sign and the trade mark “where the former reproduces, without any modification or addition, all the elements constituting the former.” Jacob LJ further commented:

“27 As a matter of policy there is no reason to suppose that the Court meant to soften the edges of “strict identity” very far. For even if a sign and mark are not “identical” for the purposes of Art.5.1.(a) if there is a likelihood of confusion it will be caught by Art.5.1(b).”

In this case, there is a most definite addition in the shape of an extra letter, which is a vowel, which is also an extra syllable. I am not considering whether a different script or the addition of a non-distinctive or descriptive word will be noticed by the average consumer. The marks cannot be said to be identical which means that the grounds under sections 5(1) and 5(2)(a) are not well founded. However, the addition of the single letter ‘a’ in the middle of word marks of this length (although not long words, they are also not short words) where all else is identical, means that the marks are, visually, highly similar.

34. Aurally, the extra letter ‘a’ makes more of a difference than visually. This is partly because it is a vowel, the addition of which has the effect of introducing a third syllable to the earlier mark. Puratos’ mark consists therefore of three syllables rather than the two syllables present in Resas’ mark. A further difference between the marks is created by the addition of the ‘a’ in the earlier mark: it has the aural effect of creating the possible pronunciation of PURA as the dictionary word PURER. This cannot be said of Resas’ mark. Both marks are invented with potentially a number of ways they could be referred to orally. In both marks PUR could be pronounced as in PURR. If this was the case for the earlier mark, it would be pronounced as PURR-A-VEETA or PURR-A-VITA. The IR would be PURR-VEETA or PURR-VITA. If the addition of the ‘a’ created a tendency to approximate PURA to the known word PURER, the pronunciation would be PURER-VEETA or PURER-VITA as opposed to PURR-VEETA or PURR-VITA. This latter scenario puts more of an aural distance between the marks than the first; the level of aural similarity in both scenarios will either be highly similar (PURR-A-VEETA/VITA against PURR-VEETA/VITA) or a good deal of similarity if the PURA element is approximated to the word PURER.

35. If both marks are seen as they are spelt, they are completely invented words and therefore the marks are neither conceptually dissonant nor conceptually similar as there is no concept at play. Even if PURER is pronounced as PURER, although there may be some evocation of purity, as a whole the mark is still invented. There is no concept which is capable of immediate grasp: the marks are not conceptually similar. The similarity between the marks exists at a visual and aural level: on these two levels, the similarity is high.

Distinctiveness of Puratos' mark

36. It is necessary to consider the distinctive character of Puratos' mark because the more distinctive it is, either by inherent nature or by use (nurture) the greater the likelihood of confusion¹¹. The distinctive character of a trade mark must be assessed by reference to the goods or services in respect of which registration is sought and by reference to the way it is perceived by the relevant public¹². The level of use shown by Puratos is not of a sufficient level so as to enhance the earlier mark's distinctive character, so I have only its inherent nature to consider. I have given above my views in relation to the conceptual significance of the mark, but whether it will be seen as an invented word with no conceptual significance, or an invented word with evocative connotations of purity and vitality, its level of distinctive character is at the higher end of the scale.

Likelihood of confusion

37. In deciding whether there is a likelihood of confusion between the marks, I must weigh the various factors I have identified and also bear in mind the principle of interdependency, whereby a lesser degree of similarity between the goods may be offset by a greater degree of similarity between the trade marks, and vice versa (*Canon*). The goods of the parties range from being identical to not similar at all; where I have found that the respective goods are not similar there is no likelihood of confusion. I keep in mind the whole mark comparison and the effect which the predominantly visual, frequent and inexpensive purchasing process has upon the weight of these elements. I should guard against dissecting the marks so as to distort the average consumer's perception of them; the average consumer perceives trade marks as wholes and rarely has the opportunity to compare marks side by side, relying instead upon the imperfect picture he has of them in his mind. I have found that the visual and aural level of similarity between the marks is high but that there is no conceptual similarity. The goods are likely to be bought visually by self selection in supermarkets and other food retail outlets so that it is the visual similarity which is particularly important, although nothing turns on this issue because the marks also have a good deal of aural similarity. The average consumer will have to rely

¹¹ *Sabel BV v Puma AG* [1998] RPC 199.

¹² *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91.

upon his visual and aural recollection of the marks rather than any conceptual hook (even if the purity/vitality meaning is perceived, it is not overwhelming). Factoring in the nature of the purchase, the close proximity of the marks and the high distinctive character of Puratos' mark together with those goods which I have found to be identical or similar, I consider that confusion will be inevitable in relation to:

Farinaceous foods; bread, sandwich bread, dry flatbread, rolls; soya flour; preparations made from cereals, in particular wheat, oats, barley, rye, millet, maize and buckwheat, the aforesaid goods also in the form of mixtures; preparations made from cereals in the form of wheat flour; vegetarian delicatessen foodstuffs, mainly consisting of cereals; dietetic foodstuffs with a base of carbohydrates, not for medical purposes.

The opposition fails in relation to all the other goods.

Costs

38. As each side has achieved a measure of success, each shall bear its own costs.

Dated this 25 day of January 2011

**Judi Pike
For the registrar,
the Comptroller-General**