

O-370-11

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION 2539141  
BY ASHLEY SIMS FOR THE TRADE MARK:**

**Big M SAUCE**

**AND**

**OPPOSITION THERETO (NO 100610) BY MCDONALD'S INTERNATIONAL  
PROPERTY COMPANY, LIMITED**

## **THE BACKGROUND AND THE PLEADINGS**

1) Mr Ashley Sims applied for the trade mark Big M SAUCE on 12 February 2010 in respect of sauces in class 30. The mark was published in the Trade Marks Journal on 12 March 2010.

2) McDonald's International Property Company, Limited ("McDonalds") opposes the registration of Mr Sims' application. Its opposition was filed on 14 July 2010 under sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 ("the Act"). Various earlier marks/signs are relied upon, however, they can be conveniently summarised as marks consisting of: i) the words "BIG MAC", ii) a logo said to consist of the letter M, and iii) the words "THE M". Some (but not all) of the earlier marks are subject to the proof of use conditions contained in section 6A of the Act because they completed their registration procedures more than five years prior to the publication of Mr Sims' application.

3) Mr Sims filed a counterstatement denying the grounds of opposition. Mr Sims did not ask McDonalds to provide proof of use in respect of the earlier marks that are subject to the proof of use provisions; this means that the relevant earlier marks may be relied upon for the specifications reflected in the statements of use that McDonalds have made in respect of them.

4) Only McDonalds filed evidence. The matter then came to be heard before me on 1 September 2011 where McDonalds were represented by Mr Julius Stobbs of iPulse (IP) Ltd; Mr Sims represented himself at the hearing, although a colleague of his also attended and also made a few brief submissions.

5) For reasons that will become apparent, I will focus, for the time being, on the ground of opposition under section 5(2)(b) of the Act in relation to the earlier mark THE M.

### **SECTION 5(2)(b) – EARLIER<sup>1</sup> MARK 2476819 - THE M**

#### **The law**

6) Section 5(2)(b) of the Act reads:

“5.-(2) A trade mark shall not be registered if because –

(a) .....

(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,

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<sup>1</sup> The mark was filed on 14 January 2008, so being an earlier mark to that of Mr Sims.

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

7) In reaching my decision I have taken into account the guidance provided by the Court of Justice of the European Union (“CJEU”) in a number of judgments: *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 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, Case C-3/03 *Matrazen Concord GmbH v GmbGv Office for Harmonisation in the Internal Market* [2004] ECR I-3657 *Medion AG V Thomson multimedia Sales Germany & Austria GmbH* (Case C-120/04) and *Shaker di L. Laudato & Co. Sas* (C-334/05). In *La Chemise Lacoste SA v Baker Street Clothing Ltd* (O/330/10) Mr Geoffrey Hobbs QC, sitting as the Appointed Person, quoted with approval the following summary of the principles which are established by these cases:

"(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, 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, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may, in certain circumstances, be dominated by one or more of its components;

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either *per se* or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) 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;

(k) if the association between the marks causes the public to wrongly believe that the respective goods [or services] come from the same or economically-linked undertakings, there is a likelihood of confusion."

### The conflict

8) This can be reduced down to the following:

Mr Sims' mark and specification	McDonalds' mark and specification
<b>Big M SAUCE</b> in respect of sauces	<b>THE M</b> in respect of goods that include sauces <sup>2</sup>

### The average consumer

9) The case-law informs me that the average consumer is reasonably observant and circumspect (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27). The degree of care and attention the average consumer uses when selecting goods or services can, however, vary depending on what is involved (see, for example, the judgment of the General Court ("GC") in *Inter-Ikea Systems BV v OHIM* (Case T-112/06)).

10) The goods are sauces. These are not specialist products and will be purchased by members of the general public. Such goods are likely to be selected from a shelf in a supermarket or other store, or their on-line equivalents. The visual similarity/dissimilarity of the marks will, therefore, be of importance. I will not, however, ignore completely any aural similarity/dissimilarity. The nature,

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<sup>2</sup> There are other goods in the specification but McDonalds' strongest position must be in respect of the identical goods, sauces. McDonalds' earlier mark is not subject to proof of use and may be considered in relation to sauces.

purpose and cost of the goods means that the degree of care and consideration used when selecting them will not be higher than the norm. I do not say, though, that the purchase is a completely casual one either as sauces will still be inspected to ensure that the correct flavour etc is being selected. It is an averagely considered purchase by a reasonably observant and circumspect consumer.

### **Comparison of goods**

11) As can be seen from the table in paragraph 8, the goods are identical.

### **Comparison of the marks**

12) The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The visual, aural and conceptual similarities of the marks must be assessed by reference to their overall impressions, bearing in mind their distinctive and dominant components.

13) The marks to be compared are: Big M SAUCE v THE M. The word sauce in Big M SAUCE is entirely descriptive. The focus of the mark is, therefore, upon "Big M". The word "Big" qualifies the letter M, consequently, the word BIG plays a subordinate role to the letter M; that being said Big M still produces an element that hangs together, not separating into separate components. The use of the definite article in THE M similarly means that greater focus will be placed upon the letter M in the mark.

14) The common presence of the letter M in both marks creates an inevitable degree of similarity. The addition of the word SAUCE does little to diffuse this similarity due to the entirely descriptive nature of the word. The differences created by the beginnings of the marks BIG/THE must be factored in. However, given my earlier observations as to the significance of these words in the overall impression of the marks, the differences do not significantly outweigh the similarity resulting from the common presence of the letter M. I come to the view that there is at least a reasonable degree of visual similarity. The same analysis feeds through to the aural comparison. The combination of similarities and differences means that there is also at least a reasonable degree of aural similarity.

15) In terms of concept, neither THE M nor BIG M SAUCE have any real concept in totality. The most memorable aspect relates to the letter M, albeit a large (Big) letter M in Big M SAUCE. On account of this there is a reasonable degree of conceptual similarity, the most likely trigger for recollection being based on the letter M. Overall, the marks are reasonably similar.

### **The distinctiveness of the earlier THE M mark**

16) The degree of distinctiveness of the earlier mark must be assessed. This is because the more distinctive the earlier mark (based either on inherent qualities or because of use made), the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24). From an inherent perspective the mark THE M has little obvious relationship with sauces. Letters are not ordinarily used to codify types of sauce. There is no evidence to suggest that letters (let alone the letter M) have any particular relevance to sauces. The mark is at least distinctive, from an inherent point of view, to a reasonable degree.

17) Whilst McDonalds' filed evidence in support of its case, little of it goes to THE M mark. Ms Stobbs conceded that the use of this mark would not be sufficient, alone, to demonstrate a reputation for the purposes of section 5(3). There is no evidence to demonstrate that THE M is entitled to an enhanced degree of protection.

### **Likelihood of confusion**

18) The factors assessed so far have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17), a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). However, there is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused.

19) Mr Sims' submissions focused very much on the actual marketplace, highlighting that McDonalds' products are only ever sold in its own restaurants and that it always uses consistent branding which his mark will not make use of. He highlighted that other similar marks existed that appeared to live alongside products for which McDonalds' are also known. Whilst this is all noted, the test to be applied, as Mr Stobbs submitted, is a notional one. I must consider notional and fair use of the respective marks, setting aside marketing methods. The factors highlighted by Mr Sims cannot, therefore, be taken to limit the scope of McDonalds' mark. The question is whether the average consumer will mistakenly believe that THE M and Big M SAUCE, both used in relation to sauces, are products of the same or an economically related undertaking. I have found the marks to be reasonably similar and that the earlier mark has a reasonable degree of inherent distinctive character. I must also bear in mind the concept of imperfect recollection because consumers rarely have the chance to compare marks side by side. When this is borne in mind, together with the degree of similarity between the marks, and identical goods, it leads me to conclude that there is a clear likelihood of confusion. **The opposition succeeds.**

### **OTHER MARKS AND OTHER GROUNDS**

20) Although Mr Stobbs felt that the other marks (particularly BIG MAC) represented McDonalds' best case (although he felt all of the earlier marks would result in a successful finding), I consider the above conflict to be the clearest and strongest ground of opposition. I do not consider the other marks/grounds to put McDonalds in any stronger position on account of: i) the greater intrinsic differences between the other marks and Mr Sims' mark, ii) the likely consequent necessity to demonstrate through its evidence a greater likelihood of confusion (or to prove misrepresentation or the existence of a link/detriment/unfair advantage) and, iii) that such evidence focuses more on restaurant services and burgers and less on sauce. I do not say that the other claims would fail, it is just that they are more evenly balanced. It would be disproportionate, therefore, to deal with them in this decision.

### **COSTS**

21) McDonalds has been successful and is entitled to a contribution towards its costs. I hereby order Mr Ashley Sims to pay McDonald's International Property Company, Limited the sum of £1600. This sum is calculated as follows:

*Preparing a statement and considering the other side's statement*  
£400

*Opposition fee*  
£200

*Filing evidence*  
£500

*Attending the hearing*  
£500

22) The above sum should be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful

**Dated this 27<sup>th</sup> day of October 2011**

**Oliver Morris  
For the Registrar,  
The Comptroller-General**