

O/445/11

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION 2553574  
BY ALDI STORES LIMITED IN RESPECT OF THE TRADE MARK:**



**AND**

**OPPOSITION THERETO (NO 101234) BY BARILLA G. e. R. FRATELLI**

## **THE BACKGROUND AND THE PLEADINGS**

1) On 21 July 2010 Aldi Stores Limited (“Aldi”) applied for the following trade mark for the following goods in class 30:



Pasta; pizza; garlic bread; lasagne; foccacia; ready meals.

The application was published in the Trade Marks Journal on 3 September 2010.

2) Barilla G. e. R. Fratelli (“Fratelli”) opposes the registration of the above application. Its opposition was filed on 26 November 2010 under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). Four earlier marks are relied upon which consist either of the words CASA BARILLA or BARILLA alone (two of these four are stylized). None of the earlier marks had been registered for more than five years as of the date of publication of Aldi’s application, so there is no requirement to show that they have been genuinely used (section 6A of the Act refers).

3) Aldi filed a counterstatement denying the grounds of opposition. Both sides filed evidence. The matter then came to be heard before me on 25 November 2011 where Aldi were represented by Mr Tom St Quintin, of Counsel, instructed by Hulse & Co; Fratelli were represented by Dr Peter Colley, also of Counsel, instructed by Potter Clarkson LLP.

## **THE EVIDENCE**

4) I do not intend to summarise either sides’ evidence in any real detail. This is because it consists, in the main, of submissions rather than evidence of fact. The submissions will, of course, be borne in mind. Of what could be said to be factual, I note the following:

- In Fratelli’s evidence (filed by its trade mark attorney, Mr Peacock) information relating to the word CASA. It is submitted that CASA will be known in the UK as the Italian/Spanish/Portugese word for house/home. Mr Peacock also provides evidence of a number of undertakings in the food industry using the word CASA as part of various names and, so, the word is commonly used meaning, in Mr Peacock’s view, that more emphasis will be placed on the BARILLA/BARELLI elements of the respective marks.

- In Aldi's evidence (filed by its trade mark attorney, Mr Houghton) information as to the likely pronunciation of the word BARILLA. Evidence comes from Webster's Dictionary, the Concise Oxford Dictionary, and from Wikipedea.org (all in relation to the word TORTILLA) and a page from Wikipedia relating to the English International Phonetic Alphabet. The argument is that BARILLA will be pronounced as BAR-REE-YA. (Mr Peacock filed a further witness statement disagreeing with this).

### **SECTION 5(2)(b)**

5) I consider that Fratelli's best case resides with its CASA BARILLA mark. Even if BARILLA/BARELLI is the dominant and distinctive element in the respective marks, the inclusion of the word CASA preceding both these words will create a more similar whole. The earlier mark is relied upon in relation to various food based goods in classes 29 and 30, and services (which include the provision of food) in class 43. I will my make analysis and determination accordingly, but will comment further on the other earlier marks if it becomes necessary to do so.

### **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,

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 GmbHv 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 average consumer**

8) 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)).

9) The goods and services concerned are not specialist ones and will be purchased by members of the general public. They are not highly considered purchases, even for the services in class 43. No more than an average degree of consideration will be deployed by the average consumer when selecting the goods or a service provider.

### **Comparison of goods/services**

10) In terms of the comparison to be made, all relevant factors relating to the goods/services in the respective specifications should be taken into account in determining this issue. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the CJEU 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 purpose and their method of use and whether they are in competition with each other or are complementary."

11) Guidance on this issue has also come from Jacob J In *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281 where the following factors were highlighted as being relevant when making the comparison:

- (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. 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.”

12) In relation to understanding what terms used in specifications mean/cover, the case-law informs me 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 the trade”<sup>1</sup> and that I must also bear in mind that words should be given their natural meaning within the context in which they are used; they cannot be given an unnaturally narrow meaning<sup>2</sup>. Finally, when comparing the respective goods/services, if a term clearly falls within the ambit of a term in the competing specification then identical goods/services must be considered to be in play<sup>3</sup> even if there may be other goods/services within the broader term that are not identical.

13) Aldi have applied for the following goods in class 30:

Pasta; pizza; garlic bread; lasagne; foccacia; ready meals.

14) Fratelli’s earlier mark (to the degree relied upon) covers:

**Class 29:** Meat, fish, poultry and game; meat extracts; preserved, frozen, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs, milk and milk products; edible fats and oils.

**Class 30:** Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery, pasta, biscuits, ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice.

**Class 43:** Providing of food and drink; temporary accommodation.

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<sup>1</sup> See *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281

<sup>2</sup> See *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267

<sup>3</sup> See *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs)(OHIM) Case T-133/05 (“Gérard Meric”)*.

15) In terms of the applied for goods, pasta appears in the earlier mark so identity is in play. This is not in dispute. Lasagne is also a type of pasta. Mr St Quintin initially argued that lasagne was the finished dish itself and not the constituent pasta. However, I pointed out to him at the hearing that the Collins English Dictionary defines lasagne as both a type of pasta and also the finished dish. Mr St Quintin conceded, on this basis, that the goods must be considered as identical. Garlic bread and foccacia are both types of bread, bread being a term that falls within the earlier mark's specification. Identity is also in play here, which was, again, accepted by Mr St Quintin.

16) That leaves pizza and ready meals. At this point I should highlight that the earlier mark's class 30 specification consists of the class heading for class 30. Counsel were aware, of course, of the *IP TRANSLATOR* case which is currently pending before the CJEU. This case concerns whether a specification consisting of a class heading should be deemed to cover all of the goods/services in that class. If the answer is that the class heading does cover all of the goods/services that fall within that class then, in the context of the case before me, pizza and ready meals would be identical to the goods of the earlier mark even though they do not have a direct counterpart in the specification as listed. I agreed with Counsel that I would suspend my decision pending the judgment of the CJEU<sup>4</sup>, but only if it was necessary to so. In the meantime, I will make an assessment, absent identity, on how similar pizza and ready meals are to the goods/services actually listed in the specification of the earlier mark.

17) I say "how similar" in the preceding paragraph because Mr St Quintin conceded that there was a moderate degree of similarity between the specifications. Dr Colley, though, pitched the degree of similarity at a higher level. As degrees of similarity can have a bearing on my assessment of whether there exists a likelihood of confusion, I should make an assessment of where I consider the degree to fall. In terms of pizza, most of Dr Colley's submissions focused on its similarity with bread. He argued that pizza covered pizza bread (the base of a pizza) which was a type of bread (a term in the earlier mark's specification). I do not accept this submission. Terms must be given their natural meaning. I do not consider that anyone will consider pizza to include anything other than a finished pizza product. When this is taken into account there is certainly no more than a moderate degree of similarity (as Mr St Quintin submitted) between pizza or indeed any of the other food products covered either by the class 29 or class 30 specifications. There is, though, the class 43 services to consider. The services include the term "provision of food and drink". Such a term would cover pizzerias and, also, takeaway pizza services. From this perspective there is a clear competitive relationship. The average consumer may choose to either purchase a pizza from a shop and cook it at home, or, alternatively, to go out for pizza or


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<sup>4</sup> Advocate General Bot has now issued an opinion in *IP TRANSLATOR* which, if adopted by the CJEU, would mean that the class heading does not automatically cover all of the goods/services that fall within that class. However, as the actual judgment has yet to come then this has no impact on the course of action I have adopted.

obtain it ready cooked from a pizza takeaway service. There is of course an inherent difference between the nature of a good and the nature of a service (which also impacts on the method of use) but the purpose is the same in terms of both the good and the service relating to the consumption of pizza. I consider pizza to be reasonably similar to the provision of food and drink. In terms of ready meals, this would include within its ambit ready meals consisting of pasta. The earlier mark includes pasta which covers not just dried pasta, but also fresh pasta sold in chiller cabinets. Both goods may be made predominantly from pasta (although the ready meal is likely to have some sauce with it already), both could be found in the chiller aisle (although perhaps not right next to each other), both are for eating. The method of use both involves cooking, although more process will be required for pasta as it not only has to be cooked, but also combined with a sauce. The choice between the two is a competitive one. Someone may choose a ready meal or alternatively, buy the pasta itself and combine, once cooked, with a sauce. When weighing these various factors I consider there to be a reasonable degree of similarity between ready meals and pasta. There is also a reasonable degree of similarity between ready meals and the provision of food and drink on a similar basis to that explained with reference to pizza.

**Comparison of the marks**

18) 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. The marks to be compared are:

The applied for mark	The earlier mark
	<p><b>CASA BARILLA</b></p>

19) It was common ground at the hearing that the average consumer is likely to understand that the word CASA means house or home. As such this is unlikely to be perceived as a dominant and distinctive element. The consequence of this is that BARELLI/BARILLA will be the dominant and distinctive element of the marks. Dr Colley argued that the other features of the applied for mark (including the columns and presentation) were negligible and could virtually be ignored. I do not consider this to be the case. The other elements form part of the overall construction of the mark and are not negligible in terms of its visual impression.



The whole mark must be compared. One point I should note is that the difference created by the colour in the applied for mark cannot be a significant distinguishing feature as the earlier mark is not registered with regard to colour<sup>5</sup>.

20) In terms of the visual similarities/differences, the word CASA is common to both marks and their second verbal elements (BARILLA/BARELLI) are of similar length, both beginning with the same three letters BAR and both containing a LL towards the end of the word. The letters E and I in BARELLI are replaced by an I and A in BARRILLA. However, the applied for mark also has column like structures on either side of the words and is on a label style background. Weighing these similarities and differences, I come to the view that the similarities outweigh the differences, and easily so. I consider there to be a good degree of visual similarity.

21) In terms of aural similarity, I consider CASA BARELLI likely to be pronounced as KA-SA BA-RE-LLI (or a variation thereof being not significantly different). There was a debate between Counsel as to whether BARILLA in the earlier mark would be pronounced in a similar way to the word TORTILLA (with the LLA pronounced as YYA). Evidence was filed by Mr Houghton (for Aldi) showing how TORTILLA would be pronounced. However, it is a different thing altogether to assume that because TORTILLA is pronounced in a certain way that the UK average consumer will apply a similar pronunciation to BARELLI. There is no evidence to lead to the assumption I am being asked to make and it is not an assumption I would make myself. The UK average consumer is not famed for its knowledge of foreign languages and foreign phonetics. I consider that when the average consumer encounters the mark CASA BARILLA it will be pronounced as KA-SA BA-RI-LLA (or a variation thereof being not significantly different). Weighing this up, I consider there to be a reasonably high degree of aural similarity.

22) In terms of conceptual similarity, for a conceptual meaning to be relevant it must be one capable of immediate grasp<sup>6</sup>. Such assessment must, of course, be made from the perspective of the average consumer. Whilst both Counsel agreed that CASA may be known as a Spanish/Italian word for HOUSE/HOME, there was more debate about the BARELLI/BARILLA elements. Mr St Quintin argued that the words would be seen as surnames (given that it follows the word CASA) whereas Dr Colley simply said that it would be seen simply as a foreign word which does not translate into English. Whilst, following analysis of the marks, Mr St Quintin may be correct, it is the immediate grasp that is important. In my view,

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<sup>5</sup> See to that effect *Mary Quant Cosmetics Japan Ltd v. Able C&C Co Ltd*, O-246-08 and, also, the judgment of Mr Justice Mann in *Specsavers International Healthcare Limited & Others v Asda Stores Limited* [2010] EWHC 2035 (Ch).

<sup>6</sup> This is highlighted in numerous judgments of the GC and the ECJ including *Ruiz Picasso v OHMi* [2006] e.c.r. –I-643; [2006] E.T.M.R. 29.

the words BARELLI/BARILLA will simply be seen as a foreign sounding word. As such there is only a superficial degree of conceptual similarity between CASA BARELLI and CASA BARILLA (on account of the CASA element and the foreign sounding second word) which is unlikely to provide any more than a neutral impact. Even if a surname is perceived, given that they are surnames unlikely to be known by the average consumer then this, in any event, will do little to alter this assessment.

### **The distinctiveness of the earlier CASA BARILLA mark**

23) 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). No use of the earlier mark has been put forward so I have only the inherent characteristics of it to consider. From this perspective, as already observed, BARILLA will be perceived by the average consumer as a foreign word but with no obvious translation. CASA may be known as the word HOUSE/HOME. The mark certainly gives an Italian/Spanish feel, it is mildly allusive but no more than that. I consider this to be the type of mark entitled to a reasonable (but not high) degree of distinctive character.

### **Likelihood of confusion**

24) 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.

25) I have found the marks to be visually similar to a good degree, aurally similar to a reasonably high degree, with a neutral conceptual impact. I have found the goods to be identical or reasonably similar to goods/services covered by the earlier mark. I have found the earlier mark to possess a reasonable degree of inherent distinctive character. Imperfect recollection must also be borne in mind given that marks are rarely seen side by side. Mr St Quintin submitted that in this case the effects of imperfect recollection were mitigated, to a degree, because the BARILLA/BARELLI elements would be perceived as surnames and that because of this the average consumer would pay particular attention to the actual surname because they are accustomed to having to differentiate between surnames. I have already said that BARILLA/BARELLI may not be perceived as a surname and, as such, this argument does not help. However, even if the average consumer did perceive them as surnames, the submission is not accepted. Whilst consumers may be used to differentiating between surnames which are known to them, BARILLA/BARELLI is unlikely to be a known surname.

There is nothing to pin the exact surname into the mind of the average consumer. Due to this, the effects of imperfect recollection are not mitigated. Bearing this in mind, together with my assessment as to the degree of similarity, together with my assessment as to the nature of the average consumer and their purchasing process, I have little hesitation in concluding that, in respect of identical goods, there is a likelihood of confusion.

26) In relation to the non-identical goods (pizza and ready meals) I have found them to be reasonably similar to goods/services within the specification of the earlier mark. Whilst I bear in mind the interdependency principle, I do not consider that the combined effect of the relevant factors avoids a likelihood of confusion. In relation to pizza, the link between pizza and food services which includes the supply of pizza, coupled with the degree of similarity between the marks, together with the other relevant factors, combine to inform the average consumer that the same economic source is responsible for both. In relation to ready meals, the various factors will combine to inform the average consumer that the respective goods in question, although not identical, come from the same economic source; there would also be a likelihood of confusion between ready meals and food services for similar reasons to that stated for pizza. There is a likelihood of confusion in relation to pizza and ready meals. **The opposition succeeds in its entirety**<sup>7</sup>.

### **COSTS**

27) Fratelli has been successful and is entitled to a contribution towards its costs. I hereby order Aldi Stores Limited to pay Barilla G. e. R. Fratelli the sum of £1600. This sum is calculated as follows:

*Preparing a statement and considering the other side's statement - £300*

*Opposition fee- £200*

*Filing evidence and considering GSL's evidence - £500*

*Attending the hearing - £600*

28) 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 12<sup>th</sup> day of December 2011**

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

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<sup>7</sup> In view of this there is no reason to suspend my decision to await the judgment in the *IP TRANSLATOR* case. The judgment will not put the opponent into any worse position. Neither is there any need to consider the opposition on the basis of the other earlier marks.