

O/136/12

TRADE MARKS ACT 1994

IN THE MATTER OF AN APPLICATION FOR REGISTRATION OF
A TRADE MARK UNDER NO 2533007
BY PREMIER FOODS GROUP LIMITED

AND

OPPOSITION THERETO UNDER NO 100790
BY CARL KARCHER ENTERPRISES INC

Background

1. Application no 2533007 stands in the name of Premier Foods Group Limited ("Premier") and seeks registration of the following as a series of two trade marks:



2. Registration is sought in respect of the following services:


Class 35

Providing product information over a global computer network

Class 43

Providing recipe information over a global computer network

3. Following publication of the application in the *Trade Marks Journal*, notice of opposition was filed by Carl Karcher Enterprises Inc ("CKE"). CKE's opposition is founded on grounds under section 5(2)(b) of the Act and relies on the following Community trade mark:

Mark no	Mark	Filing/registration date	Specification of goods and services
6778286		25.3.2008/ 11.12.2008	Class 29 Meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies, jams, eggs, milk and milk products; edible oils and fats Class 30 Coffee, tea, cocoa, sugar, rice, tapioca, artificial coffee; flour and preparations made from cereals, bread, pastry

			and confectionery, ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments). Class 43 Restaurant services
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4. Premier filed a counter-statement in which it denied that either the respective marks or goods and services, were similar.

5. Both sides filed evidence. This consists of witness statements by Nicholas Christopher Alwyn Bolter, partner of Edwards Angell Palmer & Dodge UK LPP, CKE's legal representatives and JoAnna Serena Emery who is Trade Mark Manager for Premier. I will not summarise this evidence but will refer to it as necessary in this decision. Both parties filed written submissions and neither sought to be heard. I give this decision after a careful consideration of all the material before me.

Decision

6. The opposition is based on grounds under section 5(2)(b) of the Act which states:

“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. An “earlier trade mark” is defined in section 6 of the Act. It states:

“6.-(1) In this Act an "earlier trade mark" means -

- (a) a registered trade mark, international trade mark (UK) or Community trade mark which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,
- (b) a Community trade mark which has a valid claim to seniority from an earlier registered trade mark or international trade mark (UK), or

- (c) a trade mark which, at the date of application for registration of the trade mark in question or (where appropriate) of the priority claimed in respect of the application, was entitled to protection under the Paris Convention or the WTO agreement as a well known trade mark.

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.

(3) A trade mark within subsection (1)(a) or (b) whose registration expires shall continue to be taken into account in determining the registrability of a later mark for a period of one year after the expiry unless the registrar is satisfied that there was no *bona fide* use of the mark during the two years immediately preceding the expiry.”

8. CKE relies on the community trade mark set out above. It qualifies as an earlier trade mark under the above provisions. The earlier mark completed its registration process less than five years before the publication date of the mark for which registration has been applied, and thus, under the provisions of section 6A of the Act, CKE is not required to prove use of its earlier mark.

9. In determining the question under Section 5(2)(b), I take into account the guidance provided by the Court of Justice of the European Union (CJEU) in *Sabel v Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [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* [2000] E.T.M.R.723, *Medion AG v Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di Laudato & C. Sas v OHIM* C-334/05 (Limoncello), as cited with approval in *Och-Ziff Management Europe Ltd and Oz Management LP v Och Capital LLP, Union Investment Management Ltd and Ochoki* [2010] EWCH 2599 (Ch). It is clear from these cases that:

- (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 greater 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.

Comparison of goods and services

10. In *British Sugar Plc v James Robertson & Sons Ltd* [1996] RPC 280 (“TREAT”), Jacob J said (at 289):

“When it comes to 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. After all, a trade mark specification is concerned with use in trade.”

11. Adapted to the current position, he went on to set out the following factors as being relevant to the question of similarity of goods and services:

- (a) the respective uses of the respective goods or services;
- (b) the respective users of the respective goods or services;
- (c) the nature of the goods and services;
- (d) the respective trade channels through which the goods or services are marketed;

(e) the extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify the goods or services, for instance whether market research companies put them into the same or different sectors.

12. Subsequently, in *Canon Kabushiki Kaisha v MGM Inc* the ECJ stated:

“23. In assessing the similarity of the goods or services concerned.....all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, *inter alia*, their nature, intended purpose and their method of use and whether they are in competition with each other or are complementary.”

13. In Case T-420/03 – *El Corte Inglés v OHIM- Abril Sanchez and Ricote Sauger* (Boomerang TV) the General Court (GC) commented:

“96.....Goods or services which are complementary are those where 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 the production of those goods or provision of those services lies with the same undertaking (Case T14169/03 Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI) [2005] ECR II-685, paragraph 60, and judgment of 15 March 2006 in Case T-31/04 *Eurodrive Services and Distribution v OHIM – Gomez Frias* (euroMASTER), not published in the ECR, paragraph 35).”

14. In addition, I take into account Jacob J’s comment in *Avnet Incorporated v Isoact Limited* [1998] FSR 16 where he said:

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

15. Neither should specifications be given an unnaturally narrow meaning (*Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267). In *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32, although in the context of a non-use issue, the court considered the interpretation of specifications and stated:

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

16. For ease of reference, the goods and services to be compared are as follows:

Premier's application	CKE's earlier mark
<p>Class 35 Providing product information over a global computer network</p> <p>Class 43 Providing recipe information over a global computer network</p>	<p>Class 29 Meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies, jams, eggs, milk and milk products; edible oils and fats</p> <p>Class 30 Coffee, tea, cocoa, sugar, rice, tapioca, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery, ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments).</p> <p>Class 43 Restaurant services</p>

17. Both parties have made submissions regarding their respective areas of trade and how their goods and services are marketed. In addition, in his witness statement, Mr Bolter comments on how, in his experience, new brands are launched and also refers to the undertaking of 'trade mark clearance'. He further comments on how Premier uses its mark on various foodstuffs. None of this is of assistance in my consideration as Premier's application does not seek to protect its mark in respect of foodstuffs. I have to compare the respective goods and services on a notional basis which means I have to take into account the goods and services as registered by CKE's earlier mark and for which registration is applied by Premier. I am mindful of the findings of the GC in *Saint-Gobain SA v OHIM* Case T-364/05 where it said:

"67... it is important to reiterate that the comparison between the goods in question is to be made on the basis of the description of the goods set out in the registration of the earlier mark. That description in no way limits the methods by which the goods covered by the earlier mark are likely to be marketed."

18. Whilst not specifically explaining why it considers its goods in classes 29 and 30 to be similar to Premier's services in class 35, CKE submits:

"Although not specified, it can be inferred from the Class 43 services relating to recipe information and [Premier's] use of the star design....for food products, that the 'products' covered in Class 35 are food products..."

19. In support of its view that its goods in classes 29 and 30 are similar to Premier's services in class 43 CKE submits:

"the recipe information will be used by the average consumer for the preparation of food and dishes which can include the goods covered by [CKE's earlier mark]"

and:

“providing recipe information over a global computer network involves providing information about the food products, including food products in Class 29 and 30 covered by [the earlier mark], that are combined to create the dish described in the recipe. Similarly, “providing recipe information” describing how to create specific dishes, are services similar to ‘restaurant services’ in Class 43. ‘Restaurant services’ include describing dishes on a menu and providing the selected dishes to the customer.”

20. As regards the respective services in class 43 CKE submits they are similar because:

“they both relate to food and the recipes are followed for its preparation of dishes in a restaurant”.

21. For its part, in its submissions, Premier refers me to the relevant case law and denies the respective goods and services are similar. In respect of the comparison of its services in class 35 with those in classes 29 and 30 of the CKE’s earlier mark it submits they are not similar because:

“the goods covered by Class 29 and Class 30 are specific foodstuffs whereas the Class 35 service relates to the provision of information. Nor are these goods and services necessarily complementary. [Premier] argues that the average consumer would not believe that the responsibility for the services under Class 35 and the goods under Class 29 and Class 30 lie with the same undertaking. The average consumer is accustomed to viewing information over a computer network, such as a recipe, and does not assume that all of the ingredients required for a recipe must come from the same undertaking that has provided the recipe information.”

22. In relation to the comparison of its services with those of CKE’s earlier mark in class 43, Premier submits they are also dissimilar. It states:

“The average consumer would recognise that the provision of product or recipe information and restaurant services are achieved through different trade channels, have different uses, do not compete with each other and are accessed as services via entirely different means”.

23. Premier’s information services in class 35 are such that they are not limited in respect of a certain type of product and could, therefore, relate to information about any type of product. CKE’s strongest case, as it suggests, must lie in relation to any such information provided about food products. Whilst the users of such information services could include businesses, they are services used by the general public who are likely to be the most relevant average consumer. They will access such services in order to find out such information as e.g. how the product is produced, its nutritional or calorific value and how it can be used. They are services provided, as specified, via a computer network and so are accessed in a virtual medium.

24. CKE's goods in classes 29 and 30 are foodstuffs. These will also be purchased by the general public. The goods are items to be eaten, whether on their own or combined with other foodstuffs as ingredients in another dish. They are items sold through supermarkets and other retail outlets (including online stores).

25. The respective goods and services are not competitive and one would not be a substitute for the other. Whilst I have no evidence on the point, it is, I believe, well-known that the Internet provides users with the opportunity to obtain information, whether accurate or not, on any number of products including food products and from any number of sources not just producers of food. Information about a food product necessarily relates to food, however, I do not consider that this makes the two similar. Someone who is hungry wants something to eat: his appetite will not be satisfied by finding out e.g. how a food item is made and vice versa. The respective goods and services are not complementary in that one is indispensable or important for the other in a way that the average consumer will think that they come from the same undertaking and there is no evidence to the contrary. CKE's goods in class 29 and 30 are not similar to Premier's services in class 35.

26. CKE's services in class 43 are restaurant services for which the average consumer is, again, the general public. They are services which provide the average consumer with the facilities to enable them to have something to eat, something which may have been selected from a menu of available dishes. Such food may be bought and provided to be eaten either on the premises where they were prepared or may be taken away to eat elsewhere. They may be bought in person or remotely, e.g. by telephone or via the Internet and delivered to the customer at another location e.g. at home. Whilst the food may be chosen from a menu, and that menu may have information about the dish and its ingredients, the 'core meaning' of restaurant services is, as I indicate above, the provision of facilities to enable someone to eat something and not to provide information on how to prepare it. CKE's services in class 43 are not similar to Premier's services in class 35.

27. Premier's services in class 43 cover the provision of information over a global computer network and my comments in relation to the similarity or otherwise of the respective services are equally applicable here. In this case, the information Premier seeks to register relates to the provision of recipe information. Whilst each of the respective services relates to food in a general sense and acknowledging that it may be that some will enquire whether a particular dish they may wish to order from a restaurant contains a particular ingredient e.g. where they may have an allergy to that ingredient or wish to ensure the dish is suitable for those following a particular diet regime, there is no evidence that the average consumer will request the recipe for the food he has ordered or even be interested in how it was made. And whilst a menu may set out brief details of what a dish contains, in my experience this is limited to the main ingredients of that dish and does not extend to the provision of instructions that would allow someone to recreate that dish. In any event, even if meals were to be ordered on the basis of such information provided on the menu, this does not make the respective services similar. As was stated in *Les Éditions Albert René V Office for Harmonisation in the Internal Market (Trade Marks & Designs)* (OHIM) 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.”

28. The average consumer makes use of restaurant services to eat not to obtain information or recipes. Whilst following a recipe may also result in obtaining something to be eaten, this is several steps removed from actually obtaining the recipe itself such that I do not consider the respective services in class 43 to be similar.

29. I have found that none of CKE’s goods and services is similar to the services of Premier’s application. Where there is no similarity of goods or services, there can be no likelihood of confusion, as per the judgment of the CJEU in *Waterford Wedgwood plc v OHIM* Case C-398/07:

“30 According to established case-law, the likelihood of confusion on the part of the public must be assessed globally, taking into account all the relevant factors of the case in hand (see, to that effect, *SABEL*, paragraphs 22, and Case C-342/97 *Lloyd Schuhfabrik Meyer* [1999] ECR I-3819, paragraph 18).

31 That global assessment of the likelihood of confusion implies some interdependence between the factors taken into account and, in particular, between the similarity of the trade marks and that of the goods or services concerned. Accordingly, a low degree of similarity between the goods or services covered may be offset by a high degree of similarity between the marks, and vice versa. The interdependence of those factors is expressly referred to in the 7th recital of Regulation No 40/94, according to which the concept of similarity is to be interpreted in relation to the likelihood of confusion, the assessment of which depends, in particular, on the recognition of the trade mark on the market and the degree of similarity between the mark and the sign and between the goods or services designated (see, by way of analogy, *Canon*, paragraph 17, and *Lloyd Schuhfabrik Meyer*, paragraph 19).

32 Moreover, given that the more distinctive the earlier mark, the greater will be the likelihood of confusion (*Sabel*, paragraph 24), marks with a highly distinctive character, either per se or because of the recognition of them on the market, enjoy broader protection than marks with a less distinctive character (see *Canon*, paragraph 18, and *Lloyd Schuhfabrik Meyer*, paragraph 20).

33 It follows that there may be a likelihood of confusion, notwithstanding a low degree of similarity between the trade marks, where the goods or services covered by them are very similar and the earlier mark is highly distinctive (see, to that effect, *Canon*, paragraph 19, and *Lloyd Schuhfabrik Meyer*, paragraph 21).

34 However, the interdependence of those different factors does not mean that the complete lack of similarity can be fully offset by the strong distinctive character of the earlier trade mark. For the purposes of applying Article (1)(b)

of Regulation No 40/94, even where one trade mark is identical to another with a particularly high distinctive character, it is still necessary to adduce evidence of similarity between the goods or services covered. In contrast to Article 8(5) of Regulation No 40/94, which expressly refers to the situation in which the goods or services are not similar, Article 8(1)(b) of Regulation No 40/94 provides that the likelihood of confusion presupposes that the goods or services covered are identical or similar (see, by way of analogy, *Canon*, paragraph 22).

35 It must be noted that the Court of First Instance, in paragraphs 30 to 35 of the judgment under appeal, carried out a detailed assessment of the similarity of the goods in question on the basis of the factors mentioned in paragraph 23 of the judgment in *Canon*. However, it cannot be alleged that the Court of First Instance did not take into account the distinctiveness of the earlier trade mark when carrying out that assessment, since the strong reputation of that trade mark relied on by Waterford Wedgwood can only offset a low degree of similarity of goods for the purpose of assessing the likelihood of confusion, and cannot make up for the total absence of similarity. Since the Court of First Instance found, in paragraph 35 of the judgment under appeal, that the goods in question were not similar, one of the conditions necessary in order to establish a likelihood of confusion was lacking (see, to that effect, *Canon*, paragraph 22) and therefore, the Court of First Instance was right to hold that there was no such likelihood.”

30. That being the case, I do not proceed to consider the matter further. There is no likelihood of confusion and the opposition fails in its entirety.

Costs

31. The opposition has failed and Premier is entitled to an award of costs in its favour. I take note that the evidence of fact filed by both parties was limited and that no hearing took place. I make the award on the following basis:

Filing counter-statement and reviewing notice of opposition	£400
Filing evidence and reviewing that of the other side	£500
Filing submissions	£300
Total:	£1,200

32. I order Carl Karcher Enterprises Inc to pay Premier Foods Group Limited the sum of £1,200 as a contribution towards its costs. This sum is to 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 26th day of March 2012

**Ann Corbett
For the Registrar
The Comptroller-General**