

O-266-14

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 2643395A
BY DAVID WOOD BAKING LIMITED
TO REGISTER THE TRADE MARK
WEDGE PIE
IN CLASS 30
AND**

**IN THE MATTER OF OPPOSITION
THERE TO UNDER No. 400296 BY
VOLVERE CENTRAL SERVICES LIMITED**

**IN THE MATTER OF APPLICATION No. 2634363
BY VOLVERE CENTRAL SERVICES LIMITED
TO REGISTER THE TRADE MARK
THE WEDGE
IN CLASSES 29 & 30
AND**

**IN THE MATTER OF OPPOSITION
THERE TO UNDER No. 400711 BY
DAVID WOOD BAKING LIMITED**

BACKGROUND

1) On 11 September 2012 Volvere Central Services Limited (hereinafter VCS) applied to register the trade mark “The Wedge” in respect of the following goods:

Class 29: Meat, fish, poultry, game; preserved, dried and cooked meat, fish, poultry and game; dairy products, namely milk, cream, butter and ice cream.

Class 30: Cornish pasties produced in Cornwall; sausage rolls, meat rolls, savoury rolls; prepared and partly prepared meals.

2) The application was examined and accepted, and subsequently published for opposition purposes on 17 May 2013 in Trade Marks Journal No.2013/020.

3) On 23 August 2013 David Wood Baking Limited (hereinafter DWB) filed a notice of opposition. The grounds of opposition are in summary:

- a) DWB contends that it has used the terms WEDGE PIE/PIE WEDGE/WEDGE in relation to pastry, pies, pies containing meat, poultry, game, fish vegetables or fruit since 2006. It states that it has a reputation in the word WEDGE in the UK for pie products, therefore use of the mark in suit would lead to misrepresentation and damage to DWB’s reputation. The mark therefore offends against section 5(4)(a) of the Act.
- b) DWB contends that the mark in suit is devoid of any distinctive character and descriptive when used on any product in the shape of a wedge. The mark in suit therefore offends against sections 3(1)(b) and 3(1)(c) of the Act.
- c) Further, DWB contends that the mark in suit is deceptive for any products that are not sold in the shape of a wedge and so offends against section 3(3)(b) of the Act.

4) On 15 August 2013 VCS filed a counterstatement, subsequently amended, denying the grounds of opposition.

5) On 23 November 2012, DWB applied to register the trade mark WEDGE PIE in respect of the following goods:

In Class 30: Flour and preparations made from cereals, bread, crackers, cakes and confectionery; rolls, bread rolls; pizzas and pasta dishes; breadcrumbs; preparations for making instant meals and instant snack foods; chutneys, sauces and ketchups; desserts and preparations for making desserts; savoury and spicy sauces; marinades; spices; dips; seasonings; gravies, gravies for meat; sauces (condiments).

6) The application was examined and accepted, and subsequently published for opposition purposes on 1 March 2013 in Trade Marks Journal No.6981.

7) On 21 May 2013, VCS filed a notice of opposition. The grounds of opposition are in summary:

a) VCS is the proprietor of the trade mark shown in paragraph 1 above. The opponent has been using this mark since 15 July 2012 in respect of pastry, pies, pies containing meat, poultry, game, fish vegetables or fruit in the UK. VCS has acquired goodwill and reputation in these products and use of the mark in suit is likely to give a likelihood of confusion, misrepresentation and deception which will lead to a loss and damage to VCS. The mark in suit therefore offends against Sections 5(2)(b) and 5(4)(a) of the Act.

8) On 29 July 2013, DWB filed a counterstatement denying the grounds.

9) The oppositions were consolidated on 18 October 2013.

10) Both parties filed evidence. Both parties seek an award of costs in their favour. Neither party wished to be heard. Both parties filed written submissions which I shall refer to as and when relevant in my decision.



DWB'S EVIDENCE

11) DWB filed a witness statement, dated 24 December 2013, by David Wood a Director of DWB. He states that triangular shaped pies, known as "Wedge Pies" were developed by Woodhead (Scarborough) Ltd "in around 2006". In June 2011 this business went into administration and the business was sold to Bakery Products Ltd who continued to produce the pies from the same premises until June 2012 when they also went into administration. Mr Wood states:

"2. My company, David Wood Baking Limited, purchased the tangible assets of Bakery Products Limited on the 7 July 2012 which included the stock of Wedge Pies from the cold store in order to provide a continuity of supply to customers."

12) Mr Wood also provides the following exhibits:

- DW1: A copy of minutes from a project meeting held by the directors of Woodhead (Scarborough) Ltd on 5 October 2005 in which the development of "Wedges" is referred to, and it is clear that the concept was being developed and the possibility of trade marks were being considered. The company subsequently registered PIE WEDGE and device in the UK under number 2433877. The details of this mark are as follows:

| Mark (A series of two) | | Date filed /registered | Class | Goods |
|---|---|------------------------|-------|--|
|  |  | 28.09.06 27.04.07 | 30 | Bakery and ready to bake products, pies, pasties, rolls, quiches, tarts, flans, all being either savoury or sweet. |

- DW2: The product was developed and sold via various agents throughout the UK under the name WEDGE, WEDGE PIES and PIE WEDGE. It is clear that research into the market was carried out in 2007 and the notes state that design rights for triangular pies and also a patent for the baking foil had been registered to the business as “No-one else markets a triangular “wedge shaped pie”. Included is a price list dated 1 January 2011 on headed notepaper from a company in Lincoln called The Pie People which shows a number of pies for sale including 5 listed as “The Wedge” with various meat and also vegetarian fillings.
- DW3: Copies of emails, dated 2009, and also an advert from Morrisons (undated) which shows that the fruit version of the WEDGE PIE was developed for Morrison Supermarkets, and that they also sold meat versions.
- DW4: An invoice detailing the sale of a portion of Bakery Products stock purchased by DWB to Morrisons under the name PIE WEDGE dated 9 July 2012. The invoice is for 6,000 pies priced at £0.89 each totalling £5,340.

VCS’S EVIDENCE

13) VCS filed a witness statement, dated 14 March 2014, by Michael Tziriki the Managing Director of Shire Foods Ltd, a position he has held since 1996. He states that his company is wholly owned by Volvere plc which also owns VCS which is a subsidiary IP holding company. At Exhibit MT1 he provides extracts from Volvere’s annual report which confirms these statements. He states that when Bakery Products Ltd went into administration, VCS purchased a number of assets including UK design rights 3024151 and 3024150 which cover the products sold under the name “The Wedge” and also the tray in which it was baked. These designs were registered on 7 March 2006. This is confirmed by a press article dated 10 August 2012 at Exhibit MT2. Mr Tziriki states that it is his belief that DWB did not purchase the goodwill from Bakery Products Ltd merely tangible assets. He states that since his company acquired the rights and assets of Bakery Products Ltd in June 2012, his company has continued the consistent and substantial use of THE WEDGE in respect of bakery products which have been marketed and sold throughout the UK.

14) At Exhibits MT 8-10 and MT 11-13 he provides excerpts from the catalogues and websites respectively of Pilgrim Foodservice, Hunts Foodservice and Pioneer

Foodservice which are all wholesale food suppliers who sell to schools, pubs, restaurants, hotels, hospitals and sporting arenas throughout the UK. These documents show pies branded THE WEDGE on offer. The catalogues are all dated 4 February 2013 and show that the pies are referred to as either “Shire Foods Wedge Pies” or “Wedge Pies from Shire Foods”. The website details are from 11 March 2014 and show that between the three wholesalers the whole of the UK is covered. He states that products under the mark “The Wedge” have also been available throughout the UK from Bidvest 3663. At Exhibits MT 14-15, he provides copies of a 2011 catalogue and a current version showing the products listed for sale and also providing details of UK wide sales.

15) That concludes my summary of the evidence filed, insofar as I consider it necessary.

DECISION

16) I shall first turn to the grounds of opposition in relation to application 2634363 for “The Wedge” in relation to goods in classes 29 & 30. The first grounds I shall consider are under Sections 3(1)(b) & (c) of the Act which read:

“The following shall not be registered -

(a)

(b) trade marks which are devoid of any distinctive character,

(c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,

(d)

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.”

17) I first turn to the ground of opposition under Section 3(1)(c). The principles to be applied under Article 7(1)(c) of the Community Trade Mark Regulation were conveniently summarised as follows by the CJEU in the following paragraphs from the court’s judgment in Case C-51/10P *Agencja Wydawnicza Technopol sp. z o.o. v OHIM* (with references to previous case law omitted):

“33. A sign which, in relation to the goods or services for which its registration as a mark is applied for, has descriptive character for the purposes of Article 7(1)(c) of

Regulation No 40/94 is – save where Article 7(3) applies – devoid of any distinctive character as regards those goods or services.

36. ... due account must be taken of the objective pursued by Article 7(1)(c) of Regulation No 40/94. Each of the grounds for refusal listed in Article 7(1) must be interpreted in the light of the general interest underlying it.

37. The general interest underlying Article 7(1)(c) of Regulation No 40/94 is that of ensuring that descriptive signs relating to one or more characteristics of the goods or services in respect of which registration as a mark is sought may be freely used by all traders offering such goods or services.

38. With a view to ensuring that that objective of free use is fully met, the Court has stated that, in order for OHIM to refuse to register a sign on the basis of Article 7(1)(c) of Regulation No 40/94, it is not necessary that the sign in question actually be in use at the time of the application for registration in a way that is descriptive. It is sufficient that the sign could be used for such purposes.

39. By the same token, the Court has stated that the application of that ground for refusal does not depend on there being a real, current or serious need to leave a sign or indication free and that it is therefore of no relevance to know the number of competitors who have an interest, or who might have an interest, in using the sign in question. It is, furthermore, irrelevant whether there are other, more usual, signs than that at issue for designating the same characteristics of the goods or services referred to in the application for registration.

50. The fact that the legislature chose to use the word 'characteristic' highlights the fact that the signs referred to in Article 7(1)(c) of Regulation No 40/94 are merely those which serve to designate a property, easily recognisable by the relevant class of persons, of the goods or the services in respect of which registration is sought. As the Court has pointed out, a sign can be refused registration on the basis of Article 7(1)(c) of Regulation No 40/94 only if it is reasonable to believe that it will actually be recognised by the relevant class of persons as a description of one of those characteristics.”

18) In addition, I note that a sign is caught by the exclusion from registration in Article 7(1)(c) if at least one of its possible meanings designates a characteristic of the goods or services concerned (Case C-191/01 P *OHIM v Wm Wrigley Jr Co.*)

19) Although the case law cited above relates to the application of the Community Trade Mark Regulation, the provisions in question are identical to corresponding provisions in the Trade Marks Directive, which find expression in the UK in s.3(1) of the Act. The judgments of the CJEU therefore provide authoritative guidance as to the correct application of s.3(1)(c) of the Act.

20) It is clear that the matter must be assessed from the perspective of “the relevant class of persons”, which in this case is composed primarily of consumers and end users of the services listed in paragraph 1 above, i.e. the general public including businesses. For ease of reference the goods are:

Class 29: Meat, fish, poultry, game; preserved, dried and cooked meat, fish, poultry and game; dairy products, namely milk, cream, butter and ice cream.

Class 30: Cornish pasties produced in Cornwall; sausage rolls, meat rolls, savoury rolls; prepared and partly prepared meals.

21) To the best of my knowledge, and DWB has filed no evidence to show otherwise, the above goods are not sold in triangular or wedge shapes. DWB suggests in its submissions that “The Wedge consists exclusively of a term that may serve to describe the quality (triangular or wedge shaped) of the specified goods”. The average consumer would not expect them to be wedge shaped. For Cornish Pasties VCS points out that these must, by law, be “D” shaped, similarly “rolls” denotes a rounded product. Considering, “prepared and partly prepared meals”, again there is no evidence provided that such items would be sold in triangular or wedge shapes. I accept that some items such as quiches and round pies are subsequently cut to the customers requirement and will be wedge shaped, but this is not how a prepared meal would be made but how it would be sold by the retailer. Further, certain meats are shaped by the part of the animal they originate from, fish have a particular overall shape or the various cuts are determined by the part of the fish from which they originate. “Cooked meats” tend to either follow this natural shape, or be sliced. Some cooked meats can be shaped such as faggots which tend to be tubular, or sausages which are “finger” shaped. There is no doubt in my mind that, *prima facie*, “The Wedge” when used on the goods shown above does not create a descriptive impression of the goods. To my mind the mark is *prima facie* acceptable and does not fall foul of section 3(1)(c). The marks do not form a sign or indication “which may serve, in trade, to designate.... characteristics of goods or services.” Consequently, there is no need to exclude the marks from registration in order to give effect to the policy underlying s.3(1)(c), which is to prevent the registration of “descriptive signs relating to one or more characteristics of the goods or services in respect of which registration as a mark is sought [so that they] may be freely used by all traders offering such goods or services.” **I therefore reject the section 3(1)(c) ground of opposition.**

22) I now turn to the ground of opposition under Section 3(1)(b). The principles to be applied were conveniently summarised as follows by the CJEU in Case C-265/09 P *OHIM v BORCO-Marken-Import Matthiesen GmbH & Co KG* (again with references to previous case law omitted):

“29. ... the fact that a sign is, in general, capable of constituting a trade mark does not mean that the sign necessarily has distinctive character for the purposes of Article 7(1)(b) of the regulation in relation to a specific product or service.

30. Under that provision, marks which are devoid of any distinctive character are not to be registered.

31. According to settled case-law, for a trade mark to possess distinctive character for the purposes of that provision, it must serve to identify the product in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish that product from those of other undertakings.

32. It is settled case-law that that distinctive character must be assessed, first, by reference to the goods or services in respect of which registration has been applied for and, second, by reference to the perception of them by the relevant public.”

23) I must also be aware that the test is one of immediacy or first impression, as confirmed by the European Court of First Instance (now the General Court) which, in its decision on *Sykes Enterprises v OHIM*, T-130/01 (Real People Real Solutions), stated the following:

“...a sign which fulfils functions other than that of a trade mark is only distinctive for the purposes of Article 7(1)(b) of Regulation No 40/94 if it may be perceived immediately as an indication of the commercial origin of the goods or services in question, so as to enable the relevant public to distinguish, without any possibility of confusion, the goods or services of the owner of the mark from those of a different commercial origin.”

24) DWB’s contentions under this ground are exactly the same as those under 3(1)(c), that the average consumer will see the mark “The Wedge” as an indication that the product will be wedged or triangular shaped and so will not be perceived as an indication of origin. I refer to my comments in paragraph 21 above. The mark has a degree of originality, and it requires interpretation and thereof is indicative of one particular undertaking. **The opposition under Section 3(1)(b) fails.**

25) I now turn to the ground of opposition under Section 3(3)(b) which reads:

“3. – (3) A trade mark shall not be registered if it is –

(a).....

(b) of such a nature as to deceive the public (for instance as to the nature, quality or geographical origin of the goods or service).”

26) To my mind if the mark is not contrary to sections 3(1)(b) and (c) then the public cannot be deceived as they would not view the mark as designating a characteristic of the goods and so the mark itself cannot be deceptive. Even if that were not so, in my view DWB’s objection under this section cannot succeed. There are many marks that could deceive the public if they were used inappropriately by their proprietors. The registrar takes what I believe to be a realistic and pragmatic view. Whilst the provision is

there to protect the public, the registrar has to have regard to the intentions of businesses applying the marks in their own interests so that they do not deceive. For instance this is not a “strawberry jam” case where the applicant has applied for jam and clearly will not apply the mark including the word strawberry to jam other than strawberry jam. **The ground of opposition under Section 3(3)(b) therefore fails.**

27) Lastly I turn to the ground of opposition under Section 5(4)(a) of the Act which reads:

“5. (4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented -

- (a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an “earlier right” in relation to the trade mark.”

28) In deciding whether the marks in question offend against this section, I intend to adopt the guidance given by the Appointed Person, Mr Geoffrey Hobbs QC, in the *WILD CHILD* case [1998] RPC 455. In that decision Mr Hobbs stated that:

“The question raised by the grounds of opposition is whether normal and fair use of the designation WILD CHILD for the purposes of distinguishing the goods of interest to the applicant from those of other undertakings (see section 1(1) of the Act) was liable to be prevented at the date of the application for registration (see Article 4(4)(b) of the Directive and section 40 of the Act) by enforcement of rights which the opponent could then have asserted against the applicant in accordance with the law of passing off.

A helpful summary of the elements of an action for passing off can be found in Halsbury’s Laws of England (4th Edition) Vol. 48 (1995 reissue) at paragraph 165. The guidance given with reference to the speeches in the House of Lords in *Reckitt & Colman Products Ltd v. Borden Inc.* [1990] R.P.C. 341 and *Erven Warnink BV v. J. Townend & Sons (Hull) Ltd* [1979] AC 731 is (with footnotes omitted) as follows:

‘The necessary elements of the action for passing off have been restated by the House of Lords as being three in number:

- (1) that the plaintiff’s goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;

(2) that there is a misrepresentation by the defendant (whether or not intentional) leading or likely to lead the public to believe that the goods or services offered by the defendant are goods or services of the plaintiff; and

(3) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant's misrepresentation.

29) First I must determine the date at which DWB's claim is to be assessed; this is known as the material date. In this regard, I note the judgment of the General Court (GC) in *Last Minute Network Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Joined Cases T-114/07 and T-115/07. In that judgment the GC said:

"50 First, there was goodwill or reputation attached to the services offered by LMN in the mind of the relevant public by association with their get-up. In an action for passing off, that reputation must be established at the date on which the defendant began to offer his goods or services (*Cadbury Schweppes v Pub Squash* (1981) R.P.C. 429).

51 However, according to Article 8(4) of Regulation No 40/94 the relevant date is not that date, but the date on which the application for a Community trade mark was filed, since it requires that an applicant seeking a declaration of invalidity has acquired rights over its non registered national mark before the date of filing, in this case 11 March 2000."

30) The filing date of the application is, therefore, the material date. However, if VCS has used its trade mark prior to this then this use must also be taken into account. It could, for example, establish that VCS is the senior user, or that there had been common law acquiescence, or that the status quo should not be disturbed; any of which could mean that the applicant's use would not be liable to be prevented by the law of passing-off – the comments in *Croom's Trade Mark Application* [2005] RPC 2 and *Daimlerchrysler AG v Javid Alavi (T/A Merc)* [2001] RPC 42 refer."

31) There is no evidence of use of VCS's mark prior to the application date; I shall therefore regard the relevant date as 11 September 2012. In its submissions DWB contends:

"DWB has provided clear evidence in the form of an invoice (exhibit DWB4) which shows that DWB acquired the assets of a business in which Goodwill resides in respect of wedge Pies and continued significant sales of the same before the application date of 2634363 THE WEDGE mark. As such, DWB acquired goodwill in a mark similar to THE WEDGE and therefore use of the same would be contrary to the law of passing off."

32) The evidence is clear that both DWB and VCS purchased assets from Bakery Products Ltd (BPL) in July 2012. DWB's evidence clearly states that "tangible assets" were purchased, no mention was made in respect of goodwill which is an intangible

asset. Further, some 6,000 pies which were in stock at the time that BPL went into administration were purchased by DWB and sold to Morrison Supermarkets who had been purchasing pies from BPL. Morrisons would have known that the pies were manufactured by BPL and that DWB were merely acting as a distributor and were not the source of origin. No evidence of any further sales of such pies was provided and so this would appear to have been a one off sale. As a distributor, the goodwill would not have accrued to DWB but to BPL. As such, at the relevant date DWB had no goodwill and so the opposition fails at the first hurdle. **The opposition based upon Section 5(4)(a) fails.**

33) As all the grounds of opposition to trade mark 2634363 have failed the mark can be relied upon in respect of opposition 400296 in relation to the application by DWB to register the mark WEDGE PIE in respect of goods in Class 30. I therefore turn to the first ground of opposition which is under Section 5(2)(b) which 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.”

34) An “earlier trade mark” is defined in section 6, the relevant part of which 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.”

35) The opponent is relying upon its mark listed in paragraph 1 above which is clearly an earlier trade mark. Given the interplay between the date VCS’s mark was registered and the publication date of the mark in suit, the proof of use provisions are not in play.

36) When considering the issues under Section 5(2) and the likelihood of confusion, I take into account the guidance from the settled case law provided by the CJEU in *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 and *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). In the recent case of *La Chemise Lacoste SA v Baker Street Clothing Ltd* [ALLIGATOR O/333/10) Mr Hobbs QC acting as the Appointed Person set out the test shown below which was endorsed by Arnold J. in *Och-Ziff Management Europe Ltd and Oz Management Lp v Och Capital LLP; Union Investment Management Ltd & Ochocki*, [2010] EWCH 2599 (Ch).

(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/ 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; 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;

(e) 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 in that mark;

(f) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa;

(g) 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;

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

(i) 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;

(j) 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.

Distinctive character of the opponent’s earlier trade marks

37) VCS has provided evidence of use of its mark but these are either after the relevant date or relate to use by BPL or Woodhead (Scarborough) ltd. It is not clear that VCS purchased the goodwill of BPL as all the evidence mentions is that “rights” were purchased. VCS has failed to provide total sales figures or even comment upon market share. Nor has it provided any independent evidence to support any such claim. Even if the use had been within the UK it is not sufficient for the opponent to benefit from an enhanced distinctiveness. I believe that the opponent’s mark is inherently distinctive for the goods for which it is registered.

The average consumer and the nature of the purchasing process

38) I must now determine the average consumer for the goods of the parties. The products of both parties are, broadly speaking, foods. As such they would be aimed at both the general public and also at businesses retailing the products. Such goods will be sold in, inter alia, traditional retail outlets on the high street, and on the Internet. The average consumer of the goods at issue is a member of the general public who is likely, in my opinion, to select the goods mainly by visual means, although I accept that in certain outlets e.g. butchers’ shops, the sales assistant may be spoken to in relation to the selection process. Clearly, the average consumer’s level of attention will vary considerably depending on the cost and nature of the item at issue. However, to my mind even when selecting routine inexpensive items of food, the average consumer will pay attention to considerations such as quality, origin, taste and cost. Overall the average consumer is likely to pay a reasonable degree of attention to the selection of items of food.

Comparison of goods

39) For ease of reference I reproduce the specifications of both parties:

| VCS’s specification | DWB’s specification |
|--|---|
| <p>Class 29: Meat, fish, poultry, game; preserved, dried and cooked meat, fish, poultry and game; dairy products, namely milk, cream, butter and ice cream.</p> <p>Class 30: Cornish pasties produced in Cornwall; sausage rolls, meat rolls, savoury rolls;</p> | <p>Class 30: Flour and preparations made from cereals, bread, crackers, cakes and confectionery; rolls, bread rolls; pizzas and pasta dishes; breadcrumbs; preparations for making instant meals and instant snack foods; chutneys, sauces and ketchups; desserts and preparations for making desserts; savoury and spicy sauces; marinades; spices; dips; seasonings; gravies, gravies for meat; sauces (condiments).</p> |

| | |
|-------------------------------------|--|
| prepared and partly prepared meals. | |
|-------------------------------------|--|

40) In assessing the similarity of goods, it is necessary to apply the approach advocated by case law and all relevant factors relating to the respective goods and services should be taken into account in determining this issue. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the CJEU stated at paragraph 23:

‘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.’

41) The accepted test for comparing goods is that set out by Jacob J. in *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 28 TREAT, which was effectively endorsed in *Canon*. In that case the factors to be taken into account were:

- a) The respective uses of the respective goods;
- b) The respective users of the respective goods;
- c) The physical nature of the goods;
- d) The respective trade channels through which the goods 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 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 in the same or different sectors.

42) I also bear in mind the following guidance of the GC in *Gérard Meric v OHIM*, 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).”

43) Finally, in terms of understanding what a "complementary" relationship consists of, I note the judgment of the GC in *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-325/06* where it was stated:

"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 *Segio 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 Ingles v OHIM - Bolanos Sabri (PiraNAN diseno original Juan Bolanos)* [2007] ECR I-0000, paragraph 48)."

44) However, in the cases *Sandra Amalia Mary Elliott v LRC Products Limited* (and cross opposition) [BL O-255-13] in respect of the marks LUV and LOVE respectively Mr Alexander Q.C. acting as the Appointed Person said:

"15 A formulation of the law by the same Hearing Officer in very similar terms was accepted without criticism by either party or by Floyd J (as he then was) *Youview TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch) and the Hearing Officer's statement of the law cannot be faulted.

16 However, because of the particular grounds of appeal in this case, which did not arise in the *Youview* case, it is necessary to make three observations about that summary as it applies to the present case.

17 First, the starting point for the analysis of similarity is the wording of the Act and the Directive. These require the tribunal to determine whether or not the respective goods are "identical or similar" but they do not specify the criteria by reference to which similarity is to be assessed. In the well-established guidance from the Court of Justice on this issue originating in *Canon*, to which the Hearing Officer referred, the Court has not suggested that every case requires assessment of whether the respective goods or services are complementary. To the contrary, the Court has regularly made it clear that all relevant factors relating to the goods or services themselves should be taken into account, of which complementarity is but one (see e.g. in *Boston*).

18 Second, the concept of complementarity is itself not without difficulty. In a number of cases, reference to it does not make the assessment of similarity easier. If tribunals take the explanation of the concept in *Boston* as akin to a statutory definition, it can lead to unprofitable excursions into matters such as the frequency with which certain goods are used with other goods and whether it is possible for one to be used without the other. That analysis is sometimes of limited value because the purpose of the test, taken as a whole, is to determine similarity of the respective goods in the specific context of trade mark law. It may well be the

case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense — but it does not follow that wine and glassware are similar goods for trade mark purposes.

19 Third, the Hearing Officer said at [32]:

As stated above, the legal definition of ‘complementary’, as per Boston , is that the goods must be “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”. It is not sufficient that the goods “can” be used together; nor is it sufficient that they are sold together.

20 In my judgment, the reference to “legal definition” suggests almost that the guidance in Boston is providing an alternative quasi-statutory approach to evaluating similarity, which I do not consider to be warranted. It is undoubtedly right to stress the importance of the fact that customers may think that responsibility for the goods lies with the same undertaking. However, it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together. I therefore think that in this respect, the Hearing Officer was taking too rigid an approach to Boston .

21 Moreover, it is necessary to view the quotation from Boston in the context of the facts of that case where the dispute over similarity turned in part on whether the goods were used together for a rather specific medical procedure. The Court of First Instance said at [77]-[87]:

Similarity between the products

77 According to consistent case-law, in order to assess the similarity of the products or services concerned, all the relevant features of the relationship that might exist between those products or services should be taken into account. Those factors include, in particular, their nature, their intended purpose, their method of use and whether they are in competition with each other or are complementary (Sunrider v OHIM , paragraph 27 above, paragraph 85; judgment of 15 March 2006 in Case T-31/04 Eurodrive Services and Distribution v OHIM — Gómez Frías (euroMASTER) , paragraph 31).

78 As regards the assessment of the similarity of the goods at issue, the Board of Appeal found, in paragraphs 22 to 24 of the contested decision, that, owing to their functional differences, apparatus for placing a suture, on the one hand, and hollow fibre oxygenators with detachable hard-shell reservoir, on the other hand, have a different method of use, are not in competition with each other and are not interchangeable. However, the Board found, in essence, that the goods at issue were closely linked to the goods of the intervener in so far as they had a certain complementary

character, since they could be used simultaneously in the field of medicine, for example during surgery. They might also be purchased through the same distribution channels and be found in the same points of sale, so that the relevant public could be led to believe that they came from the same undertaking.

79 Those findings must be upheld.

80 In this respect, it must be noted that the goods bearing the earlier trade mark and those covered by the mark applied for both concern the medical field and are therefore intended to be used in the context of a therapeutic treatment.

81. In addition, as the Board of Appeal rightly pointed out, all the goods covered by the mark applied for have a certain complementary relationship with those bearing the earlier trade mark.

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).

83. It is also true that, as OHIM moreover acknowledged, apparatus for placing a suture cannot be considered to be indispensable or important for the use of hollow fibre oxygenators with detachable hard-shell reservoir.

84. However, it is clear that apparatus for placing a suture and hollow fiber oxygenators with detachable hard-shell reservoir can be considered to be complementary where, in surgery which has required an incision and during which an oxygenator has been used, the surgeon uses apparatus for placing a suture. Thus, in the course of a single, very specific procedure, namely a surgical operation, two apparatus, namely an oxygenator and apparatus for placing a suture, might be used, one bearing the trade mark CAPIOX and the other the trade mark CAPIO.

85. It follows that, even though the applicant claims that the goods at issue cannot be considered to be similar simply because they are both used in the field of medicine, which, according to the applicant, is the case of nearly all goods of significance, the goods at issue are similar because they are in fact in a certain complementary relationship and specifically target certain

professionals in the medical sector. In addition, in the present case, contrary to what the applicant claims, the goods at issue are not similar solely because they are used in the field of medicine, but because they could be used in the same, very specific surgical operation, namely open-heart surgery.

86. Finally, the products at issue can in fact be found in the same distribution channels, such a criterion being relevant for the purposes of the assessment of the similarity of the goods (PiraÑAM diseño original Juan Bolaños , paragraph 82 above, paragraph 37; see also, to that effect, SISSI ROSSI , paragraph 82 above, paragraph 65; and PAM PLUVIAL , paragraph 82 above, paragraph 95).

87. Accordingly, given the close link between the products in question as regards their end users, the fact that they are to some extent complementary and the fact that they may be distributed via the same distribution channels, the Board of Appeal was right to find that the applicant's goods and those of the intervener were similar (see, to that effect, *Case T-388/00 Institut für Lernsysteme v OHIM — Educational Services (ELS)* [2002] ECR II-4301 , paragraph 56).

22 The Court of First Instance was not attributing decisive importance to the question of whether the goods in that case were complementary in determining the overall question of whether they were similar.”

45) Clearly, “pizzas and pasta dishes; preparations for making instant meals and instant snack foods; desserts and preparations for making desserts” in DWB’s specification are encompassed within the term “prepared and partly prepared meals” in CVS’s specification and must be regarded as identical. Considering “sausage rolls; meat rolls; savoury rolls” in VCS’s specification, these do not usually contain bread and so are not bread rolls in DWB’s specification. Nor do I consider “ice cream” and “confectionery” as being similar as the trade channels are different and they would be found in different parts of a retail outlet. All of the other items within DWB’s specification are, to my mind, not similar to the goods of VCS. I accept that all the goods of both parties are foodstuffs, would be purchased by the same customers, be they the public or businesses and would be stocked by grocery retailers. However, within the retail outlet the products would not be found close to each other, they are not in competition with each other and they are not complementary.

Comparison of trade marks

46) The trade marks to be compared are as follows:

| VCS’s mark | DWB’s mark |
|-------------------|-------------------|
| The Wedge | WEDGE PIE |

47) It is well established that the average consumer is considered to be reasonably well informed, circumspect and observant but perceives trade marks as wholes and does not pause to analyse their various details. In addition, he rarely has the chance to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has kept in his mind. In reaching a conclusion on similarity, I must identify what I consider to be the distinctive and dominant elements of the respective trade marks and, with that conclusion in mind, I must go on and compare the respective trade marks from the visual, aural and conceptual perspectives.

Distinctive and dominant components

48) VCS's mark has no meaning in relation to the goods which it is registered for, and given the use of the definite article it puts emphasis on the second word "Wedge", which is the distinctive and dominant element. Clearly, DWB's mark would be descriptive of snack foods which are presented in the form of a wedge. The two words hang together to form an image even when used on items which are obviously not pies. To my mind, as the whole of DWB's mark hangs together its distinctiveness rests in its whole.

Visual / Aural and Conceptual similarity

49) Clearly both marks contain the word WEDGE. They differ in that the VCS's mark also has the word "THE" as its first element, whereas DWB's mark has the word "PIE" as its second element. Clearly, there is a significant visual, aural and conceptual similarity between the marks albeit there are differences. Overall, the respective marks share a high level of similarity.

Likelihood of confusion

50) I must now take all the above into account and consider the matter globally taking into account the interdependency principle- a lesser degree of similarity between trade marks may be offset by a greater degree of similarity between goods and vice versa. The evidence does not allow me to find the opponent to have a reputation in class 29 or 30 goods, however given the similarity of the marks, where the goods are identical or similar as set out in paragraph 49 above, even allowing for the concept of imperfect recollection, there is a likelihood of consumers being confused into believing that the goods provided by the applicant are those of the opponent or provided by some undertaking linked to them. **The opposition under Section 5(2) (b) therefore succeeds in relation to the following:**

- **Class 30:** pizzas and pasta dishes; preparations for making instant meals and instant snack foods; desserts and preparations for making desserts.

51) However, despite the similarity of the marks where the goods are not similar there is no likelihood of consumers being confused into believing that the goods provided by the applicant are those of the opponent or provided by some undertaking linked to them. **The opposition under Section 5(2) (b) therefore fails in relation to the following:**

- **Class 30:** Flour and preparations made from cereals, bread, crackers, cakes and confectionery; rolls, bread rolls; breadcrumbs; chutneys, sauces and ketchups; savoury and spicy sauces; marinades; spices; dips; seasonings; gravies, gravies for meat; sauces (condiments).

52) I now turn to the ground of opposition under section 5(4)(a). This section of the Act, the various tests and relevant authorities have been set out earlier in this decision, so I do not intend to repeat them here. The first issue is in respect of the relevant date, the establishment of which has also been set out earlier. The application date is the 23 November 2012. In its evidence VCS states that it has used its mark in relation to “bakery products” since acquiring the design rights etc from BPL in mid 2012. However, the catalogues provided are either dated 2011 and clearly relate to use of the mark by BPL, or are dated 2013, after the application date. No details of turnover or marketing figures are provided, no invoices are submitted, nor is any evidence from the industry provided. I am not willing to accept that at the relevant date that VCS had any goodwill in their mark. **The ground of opposition under Section 5(4)(a) therefore falls at the first hurdle.**

CONCLUSION

53) All grounds of opposition in respect of application 2634363 have failed. Of the two grounds of opposition in respect of application 2643395A only that under Section 5(2)(b) had a degree of success and that only in respect of the following goods:

- **Class 30:** pizzas and pasta dishes; preparations for making instant meals and instant snack foods; desserts and preparations for making desserts.

54) The ground of opposition under Section 5(4)(a) in respect of 2643395A failed completely and the ground of opposition under Section 5(2)(b) against the same mark failed in respect of the following goods:

- **Class 30:** Flour and preparations made from cereals, bread, crackers, cakes and confectionery; rolls, bread rolls; breadcrumbs; chutneys, sauces and ketchups; savoury and spicy sauces; marinades; spices; dips; seasonings; gravies, gravies for meat; sauces (condiments).

COSTS

55) As VCS has enjoyed a measure of success it is entitled to a contribution towards its costs.

| | |
|--|------|
| Expenses | £200 |
| Preparing a statement and considering the other side’s statement x 2 | £400 |
| Preparing evidence and considering the evidence of the other side | £400 |
| Providing written submissions | £400 |

| | |
|-------|-------|
| TOTAL | £1400 |
|-------|-------|

56) I order David Wood Baking Limited to pay Volvere Central Services Limited the sum of £1400. This sum 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 13th day of June 2014

**George W Salthouse
For the Registrar,
the Comptroller-General**