

O-411-14

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3030230 BY
BON CATERING SERVICES LIMITED**

TO REGISTER THE TRADE MARK:



FOR GOODS AND SERVICES IN CLASSES 30, 35 AND 43

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 60000078 BY
ALDI STORES LIMITED**

BACKGROUND

1) On 12 November 2013 Bon Catering Services Limited (“the applicant”) applied to register the trade mark shown on the cover page of this decision. The application was published for opposition purposes on 06 December 2013 for the following goods and services:

Class 30: Bread, pizzas, filled bakery goods, in particular filled baguettes; sandwiches, toasted sandwiches, hot and cold filled rolls; pastries; prepared meals; pies; pasta dishes; rice salads, vegetable salads, pasta salads, prepared salads; bread rolls; cakes and baked goods; non-medicated confectionery; cocoa, chocolate and coffee-based beverages, tea-based beverages.

Class 35: Retail services connected with the sale of foodstuffs and beverages.

Class 43: Restaurant and café services; take-away food services; catering services.

2) The application is opposed by Aldi Stores Limited (“the opponent”) under the fast track opposition procedure. The opposition, which is directed against all of the goods and services in the application, is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”), for which the opponent relies upon the following goods and services for the following two trade mark registrations respectively:

UK no. 2606506 which was applied for on 09 January 2012 and for which the registration process was completed on 14 September 2012:



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 oils and fats; soup; pate; ready meals; canned foods; processed foods; mustard.

Class 30: Cakes and pastries; processed foods; bakery products; biscuits.

Class 32: Beer.

Class 33: Wine; spirits.

UK no. 2554381 which was applied for on 28 July 2010 and for which the registration process was completed on 12 November 2010:



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 oils and fats; soup; pate; ready meals; canned fish; mustard.

Class 30

Cakes and pastries.

The significance of the respective dates on which the opponent's marks were applied for and on which their registration process was completed is that 1) both the opponent's marks constitute an earlier mark in accordance with section 6 of the Act, and 2) neither is subject to the proof of use conditions contained in section 6A of the Act, their respective registration procedures having been completed less than five years before the publication of the Applicant's mark.

3) The opponent filed separate statements of grounds for each earlier mark. The applicant filed separate respective counterstatements in which the basis of the opposition is denied. Both sets of pleadings contain what amount to detailed submissions in relation to the grounds; I take these into account in what follows.

4) Rules 20(1)-(3) of the Trade Marks Rules 2008 (as amended by the Trade Marks (Fast Track Opposition) (Amendment) Rules 2013) ("the Rules") (the provisions which provide for the filing of evidence) do not apply to fast track oppositions, but Rule 20(4), which does, reads:

"(4) The registrar may, at any time, give leave to either party to file evidence upon such terms as the registrar thinks fit."

The net effect of the above is to require parties to seek leave in order to file evidence (other than proof of use evidence which is not pertinent in these proceedings) in fast track oppositions. No leave was sought in respect of these proceedings.

5) Rule 62(5) (as amended) of the Rules states that arguments in fast track proceedings shall be heard orally only if (1) the Office requests it or (2) either party to the proceedings requests it and the registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost. Otherwise written arguments will be taken. A hearing was neither requested nor considered necessary. The opponent filed separate written submissions.

Section 5(2)(b)

6) The opposition is based upon section 5(2)(b) of the Act, which reads as follows:

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

... (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) I have taken into account the guidance provided by the Court of Justice of the European Union (“CJEU”) in a number of judgments: *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 117, *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* [2000] F.S.R. 77, *Marca Mode CV v. Adidas AG + Adidas Benelux BV* [2000] E.T.M.R. 723, *Case C-3/03 Matrazen Concord GmbH v GmbGv Office for Harmonisation in the Internal Market* [2004] ECR I-3657 *Medion AG V Thomson multimedia Sales Germany & Austria GmbH* (Case C-120/04) and *Shaker di L. Laudato & Co. Sas* (C-334/05). In *La Chemise Lacoste SA v Baker Street Clothing Ltd* (O/330/10) (approved by Arnold J in *Och-Ziff Management Europe Ltd v Och Capital LLP* [2011] FSR 11), 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."

Comparison of goods and services

8) When comparing the respective goods and 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 (see *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-133/05 – “Meric”*) even if there are other goods/services within the broader term that are not identical. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. 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.”

9) 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.”

10) With regard to complementarity (one of the factors referred to in *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*), it was stated in *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T- 325/06*:

“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).”

11) I also bear in mind the guidance given by Mr Daniel Alexander QC, sitting as the Appointed Person, in case B/L O/255/13 *LOVE* where he warned against applying too rigid a test with regard to complementarity:

“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*.”

12) In relation to understanding what terms used in specifications mean and cover, the guidance in the case-law is to the effect 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”¹ and that I must also bear in mind that words

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

should be given their natural meaning within the context in which they are used; they cannot be given an unnaturally narrow meaning². I also note the judgment of Mr Justice Floyd in *YouView TV Limited v Total Limited* where he stated:

“..... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IPTRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. *Treat* was decided the way it was because the ordinary and natural, or core, meaning of "dessert sauce" did not include jam, or because the ordinary and natural description of jam was not "a dessert sauce". Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question.”

13) In paragraph 15 of its respective counterstatements the Applicant states that the opponent's submissions in relation to the goods and services covered by the marks are not disputed. However, the Opponent's submissions, and therefore the Applicant's corresponding concession, were not fully explicit about precisely which goods were identical and about the degrees of similarity of the other goods covered. It is therefore appropriate for me to provide a more explicit assessment on these points.

14) The identical terms *cakes* and *pastries* appear both in the application and in the Opponent's specifications. The Applicant's *bread, pizzas, pastries; pies; bread rolls; cakes and baked goods* all fall within the ambit of the Opponent's *bakery products*; they are identical. By virtue of nature, purpose and use *filled bakery goods, in particular filled baguettes; sandwiches, toasted sandwiches, hot and cold filled rolls* are highly similar to the Opponent's *ready meals* in class 29. The Applicant's *prepared meals; pasta dishes; rice salads, vegetable salads, pasta salads, prepared salads* all fall within the ambit of the Opponent's *processed foods*; they are identical. Moreover, by virtue of nature, purpose and use they are also highly similar to the Opponent's *ready meals* in class 29. The Applicant's non-medicated confectionery will include goods which are highly similar to the opponent's *cakes and pastries*.

15) The Applicant does not dispute the Opponent's submission that the Applicant's *cocoa, chocolate and coffee-based beverages, tea-based beverages* in class 30 are similar to the Opponent's goods in class 30 (*cakes and pastries; processed foods; bakery products; biscuits*), because they are complementary and serve the same purpose. However, given the inherent difference in nature, there cannot be more than a low degree of similarity between them.

16) The Applicant's *retail services connected with the sale of foodstuffs and beverages* means that the retailing relates to goods covered by the Opponent's *beer* in class 32, *wine and spirits* in class 33, and its various foodstuffs in classes 29 and

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

30. Applying the guidance given in *Oakley, Inc v OHIM*, Case T-116/06, at paragraphs 46-57 of that case, there is a clear aspect of complementarity which leads to a medium degree of similarity between the goods and the service.

17) The Applicant does not dispute the Opponent's submission that *restaurant and café services; take-away food services; catering services* in class 43 are similar to the Opponent's goods in class 30 on the grounds of complementarity. I consider there to be a reasonable degree of similarity between the Applicant's *take-away food services* in class 43 and the Opponent's goods in class 30 and *ready meals* in class 29; the similarity is of a medium level in the case of *restaurant and café services; catering services*.

The average consumer and the purchasing process

18) According to the case-law, 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/services can, however, vary depending on what is involved.

19) The average consumer of foodstuffs and the retail services connected with them, and of restaurant, café and take-away food services, will normally be a member of the general public. Catering services might be provided to commercial customers as well as at private receptions, etc. The foods in the Applicant's and Opponent's specifications are not particularly costly, nor are they infrequent purchases. Overall, consumers will normally pay a reasonable degree of attention, neither higher nor lower than the norm, when selecting these goods, and this will be reflected in their choice of the retail outlet through which they purchase. The goods may include impulse purchases, and there is scope for imperfect recollection. Consumers will, for the most part, select the goods themselves from a range of retail outlets such as supermarkets, convenience stores and bakers. The purchasing process for foodstuffs is a predominantly visual one, so the visual aspects of the marks take on more importance. Although one may book a table at a restaurant etc. over the telephone, this will normally be done after the service provider has been selected by means of the perusal of websites, advertisements and other visual media so my assessment of the importance of the visual aspects of the marks is not materially changed.

The distinctiveness of the earlier mark(s)

19) The degree of distinctiveness of the earlier marks must be assessed. This is because the more distinctive the earlier marks (on the basis either of inherent qualities or because of use made), the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24). The distinctive character of a trade mark must be assessed by reference to the goods or services in respect of which registration is sought and by reference to the way it is perceived by the relevant public (see *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91). In *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, Mr Iain Purvis Q.C., as the Appointed Person, pointed out that the level of 'distinctive character' is only likely to increase the likelihood of confusion

to the extent that it resides in the element(s) of the marks that are identical or similar. He said:

“39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it.

40. In other words, simply considering the level of distinctive character possessed by the earlier mark is not enough. It is important to ask ‘in what does the distinctive character of the earlier mark lie?’ Only after that has been done can a proper assessment of the likelihood of confusion be carried out”.

20) As these are fast track opposition proceedings, in which neither party has sought leave to file evidence, I have only the inherent characteristics of the opponent’s mark to consider.

21) In determining the distinctive character of a mark, I must make an overall assessment of the greater or lesser capacity of the mark(s) to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings³. Both marks contain the words BON APPETIT, words which are not invented. Whilst they are not an adjectival phrase which could be used directly to describe the relevant goods and services, or their characteristics, they nevertheless constitute a well-known expression. Although the phrase is French, there would, in my view, be few consumers who would not recognise its meaning as an exhortation to enjoy the meal or food that has been presented. Given its well understood meaning, I consider that the phrase itself is very low in inherent distinctive character. There are of course other elements of the marks to bear in mind. They add something to the marks but only such that, as a whole, they have a low to moderate level of inherent distinctive character. However, as stated earlier, this increased (albeit still fairly limited) distinctiveness will not really assist because it stems from aspects of the respective marks which are not in common.

Comparison of the marks

22) 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.

23) The marks to be compared are shown below:

The Applicant’s mark	The earlier mark 2554381	The earlier mark 2606506

³ See *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 at paragraph 22.



24) The Applicant's mark consists of the words BON APPÉTIT in a heavy, plain, capital lettering, written in black against an orange background. The word BON fills the whole of the upper part of the mark, the word APPÉTIT appearing beneath it in substantially smaller lettering. The "O" in BON is attenuated to form a thin black frame around the figure "99", which stands out, being written in a white script against the orange background in the centre of the upper part of the mark.

25) The Opponent's mark 2554381 consists of the words BON APPÉTIT in title case, with an acute accent over the E, followed by an exclamation mark, and stylised in a light, curvilinear script, written in white against a blue background. Beneath the words, along the curved line which separates the upper blue field from the lower plain white section of the mark runs a swirl device in red, white and blue, culminating in a blue curl figure at the bottom right.

26) The Opponent's mark 2606506 consists, in its lower part, of the words BON APPÉTIT in capitals in a fairly unremarkable script, but with slightly larger initial letters, with an acute accent over the E, followed by an exclamation mark, the words being written in dark blue against a white background, and surrounded by a fancy framing device in a dark colour suggestive of gold. Behind this device, appearing in the upper part of the mark, is a representation of the French tricolour in blue, white and red

27) The words **BON APPÉTIT** clearly form a prominent part of all the marks. The words appear in all of the marks so creating a degree of visual similarity. However, taking into account the markedly different graphic treatment of the words in the Applicant's mark, the striking contrast between its black, white and orange colour scheme and the blue white and red of the earlier marks, and the prominence given to its conspicuous featuring of the numeral "99", overall there is only a low to moderate degree of visual similarity between the Applicant's mark and both earlier marks.

28) The pronunciation of both earlier marks will consist of four syllables: BON-APP-ET-EE (or, by those with a more robustly insular approach to French pronunciation, BON-APP-ER-TEET). The Applicant's will be pronounced as above, with the addition of the further three syllables in "ninety-nine" – probably at the end of the phrase BON APPÉTIT. There is therefore at least a reasonable degree of aural similarity.

29) The concepts of all the marks are based primarily on the phrase BON APPÉTIT which will be understood by the relevant consumers as meaning "enjoy your meal/food". This creates an aspect of conceptual similarity, albeit through a phrase which has only a very low degree of inherent distinctiveness, a point I will return to later when I come to assess whether there exists a likelihood of confusion. The concept of "Frenchness" in earlier mark 2606506 does, though, create a conceptual

difference; however, this is less apparent with earlier mark 2554381. The additional “99” in the Applicant’s mark does not seem to have any significance beyond that of the numeral as such, but this in itself introduces an element of conceptual difference.

Likelihood of confusion under 5(2)(b)

30) 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.

31) I have found the Applicant’s goods in class 30 to be respectively identical, highly similar, or of low similarity, and its services in classes 35 and 43 to be respectively of reasonable or medium similarity to the goods of the earlier marks’ specifications. The point of similarity between the respective marks resides in an element which I have assessed as having very low distinctiveness. This does not mean that there could never be a likelihood of confusion between marks in which this phrase appears. However, in the case before me, even measured from the perspective of identical goods, the differences in the overall visual impressions are quite striking, and once the other differences (the additional 99) is factored in, will mean that the average consumer will clearly be able to differentiate them (even taking into account imperfect recollection) and will not directly confuse the marks. Whilst the marks are aurally closer, these are goods and services for which the visual impressions of the marks take on more importance.

32) Moreover, the differences are so marked as to rule out the likelihood that the Applicant’s mark might, for example, be seen as a brand variant, particularly when the point of similarity resides in something which is of weak distinctiveness. The factors combined indicate to me that there will be no indirect confusion. The opponent is no better position for the goods/services which are not identical. **The opposition fails in its entirety.**

COSTS

33) The Applicant has been successful and is entitled to a contribution towards its costs. I hereby order Aldi Stores Limited to pay Bon Catering Services Limited the sum of £500. In making this award I have taken into account that the parties’ pleadings included submissions.

Preparing a statement and considering the other side’s statement £500

34) 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 29th day of September 2013

**Martin Boyle
For the Registrar,
The Comptroller-General**