

**O-292-15**

TRADE MARKS ACT 1994

IN THE MATTER OF UK APPLICATION NO 3048178  
IN THE NAME OF J SAINSBURY PLC  
IN RESPECT OF THE TRADE MARK:

**SAINSBURY'S TOP DOG**

AND

AND OPPOSITION THERETO UNDER NO 402706 BY  
TOP DOG EATS LIMITED

## BACKGROUND

1. On 24 March 2014, J Sainsbury Plc (the applicant) applied to register the trade mark SAINSBURY'S TOP DOG in class 29 of the Nice Classification system.<sup>1</sup> The specification stands as follows:

**Class 29**

Meat, poultry and game; hot dogs; meat extracts; meat products; meat pies; sausages; mincemeat; hamburgers; beef burgers; poultry products; snack foods in Class 29; prepared meals in Class 29; constituents for meals in Class 29.

2. The application was published on 16 May 2014, following which Top Dog Eats Limited, (the opponent) filed notice of opposition against the application.

3. The opposition was brought under sections 5(2)(b) of the Trade Marks Act 1994 (the Act). The opponent relies upon the following marks and services:

Mark details and relevant dates	Services relied on
<p><b>CTM 11837101:</b></p> <p><b>TOP DOG</b></p> <p><b>Filing date:</b> 22 May 2013</p> <p><b>Date of entry in the Register:</b> 30 November 2013</p>	<p><b>Class 43</b></p> <p>Services for providing food and drink; Bar services; Cafés; Cafeterias; Canteens; Food and drink catering; Restaurants; Self-service restaurants; Snack-bars;</p>
<p><b>TM 3003275:</b></p> <p><b>top dog</b></p> <p><b>Filing date:</b> 23 April 2013</p> <p><b>Date of entry in the Register:</b> 11 October 2013</p>	<p><b>Class 43</b></p> <p>Restaurant services; Restaurants; Restaurants (self-service-); Restaurants (Self-service -); Drink dispensing machines (rental of);Fast food restaurant services; Fast-food restaurants; Food preparation; Food preparation services; Food service apparatus (rental of -); Hospitality services [food and drink]; Ice cream parlour services; Pizza parlors; Provision of food and drink;Provision of food and drink in restaurants; Provision of information relating to restaurants; Restaurant information services; Restaurant reservation services; Restaurant services; Restaurants; Restaurants (Self-service -); Salad bars; Self-service cafeteria services; Self-service restaurants; Services for providing food and drink; Snack bar services; Snackbars; Tea room services; Tea rooms; Wine bars.</p>

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<sup>1</sup> *International Classification of Goods and Services for the Purposes of the Registration of Marks under the Nice Agreement (15 June 1957, as revised and amended).*

4. The opponent states:

*“9. ...that where it can be said that the Earlier Registered Trade Marks retain an independent and distinctive role with the composite mark, use of the composite mark is likely to be confusingly similar to the Earlier Registered Trade Marks. In this case, each of the word elements of the Earlier Registered Trade Marks are wholly contained within the Opposed Mark and should therefore be deemed to be confusingly similar to the Earlier Registered Marks.”*

5. On 23 September 2014 the applicant filed a counterstatement, denying the grounds of opposition.

6. The opponent filed evidence, which I do not intend to itemise here but will refer to as necessary below. Neither side filed written submissions in lieu of attendance at a hearing nor did they request a hearing.

7. I give this decision following a review of all of the material before me.

## **DECISION**

8. Section 5(2)(b) reads as follows:

“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.”

9. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

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

(a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) 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.

(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.”

10. The opponent's marks are earlier marks, neither of which had been registered for five years at the date of publication of the application. Consequently, the proof of use requirements, set out in s.6A of the Act, do not apply.<sup>2</sup> Accordingly, the opponent is entitled to rely on its full specification as registered for its earlier mark in these proceedings.

### **Section 5(2)(b) case law**

12. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

#### **The principles**

(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 be dominated by one or more of its components;

(f) however, it is also 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;

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<sup>2</sup> See section 6A of the Act (added by virtue of the Trade Marks (Proof of Use, etc.) Regulations 2004: SI 2004/946) which came into force on 5th May 2004.

(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 creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

### **The average consumer**

13. In accordance with the above cited case law, I must determine who the average consumer is for the goods and services at issue and also identify the manner in which those goods and services will be selected in the course of trade.

14. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited* [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

15. Services for the provision of food and drink, be they cafés, takeaway restaurants or any other types of establishment listed in the opponent’s specifications, are normal everyday services provided to members of the general public. The applicant’s goods are fairly frequent, low cost purchases. Both purchasing processes are primarily visual selections and in both cases the average consumer is likely to pay no more than a moderate degree of attention to such a transaction. In the case of catering services, these may be purchased by a member of the general public for a special occasion and may also be commissioned by businesses providing catering on a regular basis, or as part of a particular event or function. In either case, the level of attention paid by the consumer is likely to be higher as these are higher cost, less frequent purchases. They may need to consider, inter alia, the nature of the event, cost and venue. In both cases the purchase is likely to be primarily visual, being

made from advertising leaflets, flyers and websites and in the case of a member of the general public, possibly at the point of sale. However, I do not rule out the potential for oral use of the mark where word of mouth recommendation plays a part or where the goods are requested from behind a counter.

**Comparison of goods and services**

16. The goods and services to be compared are as follows:

The opponent’s services	The applicant’s goods
<p><b>Class 43</b>            Services for providing food and drink; Bar services; Cafés; Cafeterias; Canteens; Food and drink catering; Restaurants; Self-service restaurants; Snack-bars;</p>	<p><b>Class 29</b>            Meat, poultry and game; hot dogs; meat extracts; meat products; meat pies; sausages; mincemeat; hamburgers; beef burgers; poultry products; snack foods in Class 29; prepared meals in Class 29; constituents for meals in Class 29.</p>
<p><b>Class 43</b>            Restaurant services; Restaurants; Restaurants (self-service-); Restaurants (Self-service -); Drink dispensing machines (rental of); Fast food restaurant services; Fast-food restaurants; Food preparation; Food preparation services; Food service apparatus (rental of -); Hospitality services [food and drink]; Ice cream parlour services; Pizza parlors; Provision of food and drink; Provision of food and drink in restaurants; Provision of information relating to restaurants; Restaurant information services; Restaurant reservation services; Restaurant services; Restaurants; Restaurants (Self-service -); Salad bars; Self-service cafeteria services; Self-service restaurants; Services for providing food and drink; Snack bar services; Snackbars; Tea room services; Tea rooms; Wine bars.</p>	

17. Factors which may be considered in making this comparison include the criteria identified in *British Sugar Plc v James Robertson & Sons Limited (Treat)*<sup>3</sup> (hereafter Treat) for assessing similarity between goods and services:

- (a) the respective *uses* of the respective goods or services;
- (b) the respective *users* of the respective goods or services;

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<sup>3</sup>[1996] R.P.C. 281

- (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 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, taking into account how goods/services are classified in trade.

18. I also bear in mind the decision in *El Corte Inglés v OHIM Case T-420/03*, in which the court 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 T-169/03 Sergio Rossi v OHIM-Sissi Rossi* [2005] ECR II-685)”

19. The comments of Daniel Alexander, sitting as the Appointed Person, in *LOVE*<sup>4</sup>, which dealt with similarity of goods but by analogy is relevant to similarity of services, are also to be borne in mind:

“18... 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.”

20. And at paragraph 20 where he warned against applying too rigid a test:

“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. Where appropriate I will, for the purposes of comparison, group related services together in accordance with the decision in *Separode Trade Mark*<sup>5</sup>:

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<sup>4</sup> BL O/255/13

“5. The determination must be made with reference to each of the different species of goods listed in the opposed application for registration; if and to the extent that the list includes goods which are sufficiently comparable to be assessable for registration in essentially the same way for essentially the same reasons, the decision taker may address them collectively in his or her decision.”

22. When considering the parties services I am mindful of the decision in *Avnet Incorporated v Isoact Ltd* [1998] FSR 16, in which Jacob J stated:

“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.”

23. With regard to interpreting terms in specifications, I will bear in mind the guidance provided in *Treat*:

“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 trade”. Words should be given their natural meaning within the context in which they are used; they cannot be given an unnaturally narrow meaning.”

24. I will also bear in mind Floyd, J's statement in *YouView TV Ltd v Total Ltd*:<sup>6</sup>

"...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) (IP TRANSLATOR) [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."

25. And *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T- 325/06 in which the GC explained when goods were complementary:

“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

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<sup>5</sup> *BL O-399-10*

<sup>6</sup> [2012] EWHC 3158 (Ch) at [12]



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).”

26. All of the opponent’s services in the specification for both of its earlier marks relied on in these proceedings are services for the provision of food and drink, be that in, inter alia, a restaurant, café or pizza parlour. The applicant’s goods are food goods in class 29. There are several Registry decisions which have considered the similarity of prepared foods and ingredients to the provision of services in class 43.<sup>7</sup> Applying the same analysis, there is a similarity between the opponent’s services and the following of the applicant’s goods:

hot dogs; meat products; meat pies; sausages; hamburgers; beef burgers; poultry products; snack foods in Class 29; prepared meals in Class 29.

27. This is because all of these goods are in a form which is ready to eat and may be selected as an alternative to eating at a catering venue of the type provided by the applicant. Consequently, the respective goods and services have the same end users and purpose and are in competition. Food goods which are ready to eat are essential to the provision of the applicants’ services giving rise to the position outlined in *Boston Scientific* where the average consumer is likely to consider that the goods and services have the same source. There is a high degree of similarity between these goods and services.

28. The remaining goods in class 29 of the application are ingredients, constituent parts of meals and food extracts, all of which need further processing. None of them are prepared meals or snacks of the type identified above. It is unlikely that the average consumer would consider these types of goods, the ‘raw’ food goods, to be provided by the same undertaking as the service. There are no shared channels of trade. The purpose of the goods is to create food/meals by, in most cases, combining a number of them. They are a step removed from the catering services which provide food to satisfy hunger. They are not in competition, the users and uses are not the same. In the absence of any evidence to the contrary, I am unable to find any similarity between the opponent’s services for the provision of food and drink and the following goods:

Meat, poultry and game; meat extracts; mincemeat; constituents for meals in Class 29.

### **Comparison of marks**

29. It is clear from *Sabel BV v. Puma AG* (particularly at paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and

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<sup>7</sup> See O-001/10, CUCINA, O-198/12, FLAMIN GRILL and O-299-14 PROVENANCE BRANDS

conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“...it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

30. It would be wrong, therefore, to dissect the trade marks artificially, although, it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

31. The marks to be compared are:

The opponent's mark(s)	The applicant's mark
<b>TOP DOG</b>  <b>top dog</b>	<b>SAINSBURY'S TOP DOG</b>

32. The opponent's marks are both presented with no stylisation, the first in upper case and the second in lower case. They each consist of the two words 'TOP' and 'DOG' which hang together. The overall impression of the mark rests in its totality.

33. With regard to the distinctiveness of the applicant's mark the opponent states:

“The opposed Mark contains the words 'TOP' and 'DOG' with the word SAINSBURY'S in normal script. The distinctive part of the respective marks is 'TOP DOG'.”

34. The applicant's mark consists of the word 'SAINSBURY'S' followed by the two words 'TOP' and 'DOG'. They are all of equal size, in block capitals with no form of stylisation. No part of the mark is emphasized. The word SAINSBURY'S is the first word of the mark and will be easily identified and understood by the average consumer. The remaining words hang together. Both 'SAINSBURY'S' and 'TOP DOG' are distinctive within the mark as a whole with both playing an equal role in the overall impression of the mark.

## Visual similarities

35. The visual similarity between the marks rests in the fact that the second and third words of the application, 'TOP' and 'DOG' are the totality of the opponent's marks.

The obvious difference is the addition of the word 'SAINSBURY'S' at the start of the applicant's mark.

36. Overall these marks are visually similar to a medium degree.

## Aural similarities

37. The opponent states that there is phonetic similarity due to the fact that the word elements of its earlier mark are reproduced in the mark applied for.

38. The mark applied for comprises the words 'SAINSBURY'S TOP DOG'. The opponent's mark is the words 'TOP DOG'.

39. Taking these factors into account, these marks are aurally similar to a medium degree.

## Conceptual similarities

40. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer.<sup>8</sup> The assessment must be made from the point of view of the average consumer who cannot be assumed to know the meaning of everything.<sup>9</sup>

41. The opponent states:

*"17. The word 'dog' is an accepted term for 'sausage'. The Earlier Registered Trade Marks for TOP DOG have a number of conceptual meanings, including 'a successful or dominant person'. In the context of the services for which the mark for which the Earlier Registered Trade Marks are registered for, the term TOP DOG is likely to be perceived as an allusion to the products and services provided, which could include the provision of a hot dog restaurant. In this context in particular, the Opposed Mark is highly conceptually similar to the Registered Trade Marks.*

*18. It is also far more important to consider what that meaning will be to the average consumer. If the meanings are related, such that the consumer could consider them linked, then there is a basis for a finding of confusion.*

*19. The Opponent therefore submits that for the reasons stated above there is a high conceptual similarity between the Opposed Mark and the Earlier Registered Marks."*

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<sup>8</sup> This is highlighted in numerous judgments of the GC and the CJEU including *Ruiz Picasso v OHIM* [2006] e.c.r.-I-643; [2006] E.T.M.R. 29.

<sup>9</sup> See the comments of Anna Carboni, sitting as the Appointed Person in *Cherokee*, BL O-048-08, paragraphs 36 and 37.

42. The applicant states:

*“1. TOP DOG is deemed to be a non-distinctive laudatory statement.*

*The term ‘dog’ is commonly used and referred to when referencing hot dogs. MacMillan defines ‘dog’ as ‘a hot dog’ and when used in conjunction with the term ‘top’ is deemed to denote a laudatory term...*

*The term ‘top’ is defined in the Collins English Dictionary as ‘the best or finest part of anything’.*

*With the above in mind, the Applicant’s mark SAINSBURY’S TOP DOG can only be interpreted as a composite mark which indicates to a consumer that it is an own-brand best or finest food product.”*

43. TOP DOG is a term normally used to refer to the most important or dominant in a group. In the context of hot dogs it has a more allusive meaning than in respect of the rest of the goods and services at issue. Whatever the meaning afforded the term TOP DOG, it will be the same in respect of both marks. The addition of SAINSBURY’S does not alter the average consumer’s understanding of TOP DOG, it simply provides an originator. Both will be considered to be ‘TOP DOG’ marks, albeit with the applicant’s mark being seen to be connected in some way with Sainsbury’s. The marks are conceptually similar to a medium degree.

#### **Distinctive character of the earlier mark**

44. The degree of distinctiveness of the earlier mark must be assessed. This is because the more distinctive the earlier mark, based either on inherent qualities or because of use made, the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24). In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

*“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark 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 undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *WindsurfingChiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).*

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular

undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

45. The applicant states that the earlier mark is deemed to be a non-distinctive and laudatory statement. In reaching a decision regarding the distinctive character of TOP DOG, I bear in mind the following guidance:

46. In *Formula One Licensing BV v OHIM*,<sup>10</sup> the Court of Justice of the European Union found that:

“41. ....it is not possible to find, with regard to a sign identical to a trade mark protected in a Member State, an absolute ground for refusal, such as the lack of distinctive character, provided by Article 7(1)(b) of Regulation No 40/94 and Article 3(1)(b) of Directives 89/104 and 2008/95. In this respect, it should be noted that the characterisation of a sign as descriptive or generic is equivalent to denying its distinctive character.

42. It is true that, as is clear from paragraph 48 of the judgment under appeal, where an opposition, based on the existence of an earlier national trade mark, is filed against the registration of a Community trade mark, OHIM and, consequently, the General Court, must verify the way in which the relevant public perceives the sign which is identical to the national trade mark in the mark applied for and evaluate, if necessary, the degree of distinctiveness of that sign.

43. However, as the appellant rightly points out, their verification has limits.

44. Their verification may not culminate in a finding of the lack of distinctive character of a sign identical to a registered and protected national trade mark, since such a finding would not be compatible with the coexistence of Community trade marks and national trade marks or with Article 8(1)(b) of Regulation No 40/94, read in conjunction with Article 8(2)(a)(ii).”

47. And in *L’Oréal SA v OHIM*,<sup>11</sup> when the Court of Justice of the European Union found that:

“45. The applicant’s approach would have the effect of disregarding the notion of the similarity of the marks in favour of one based on the distinctive character of the earlier mark, which would then be given undue importance. The result would be that where the earlier mark is only of weak distinctive character a likelihood of confusion would exist only where there was a complete reproduction of that mark by the mark applied for, whatever the degree of similarity between the marks in question. If that were the case, it would be possible to register a complex mark, one of the

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<sup>10</sup> Case C-196/11P

<sup>11</sup> Case C-235/05 P

elements of which was identical with or similar to those of an earlier mark with a weak distinctive character, even where the other elements of that complex mark were still less distinctive than the common element and notwithstanding a likelihood that consumers would believe that the slight difference between the signs reflected a variation in the nature of the products or stemmed from marketing considerations and not that that difference denoted goods from different traders.”

48. With regard to the services provided by the opponent, which are services for the provision of food and drink, including, inter alia, restaurants, fast food restaurants, pizza parlours and cafés, I find the mark TOP DOG to possess a normal degree of inherent distinctive character, it is neither descriptive nor allusive of the services at issue.

### **Likelihood of confusion**

49. The test for the assessment of a likelihood of confusion is a cumulative one meaning that where there is no similarity between the goods/services, there can be no likelihood of confusion. Accordingly, as a consequence of my findings above, the applicant’s request to oppose the applicant’s trade mark fails under section 5(2)(b) of the Act in respect of the following goods:

Meat, poultry and game; meat extracts; mincemeat; constituents for meals in Class 29.

50. In assessing the likelihood of confusion with regard to the remaining goods in the applicant’s specification, I must adopt the global approach advocated by case law and take into account the fact that marks are rarely recalled perfectly, the consumer relying instead on the imperfect picture of them he has kept in his mind.<sup>12</sup> I must also keep in mind the average consumer for the services, the nature of the purchasing process and have regard to the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective services and vice versa.

51. In reaching a decision on the likelihood of confusion I am mindful of the guidance on how to approach issues of similarity involving composite signs which can be found in the CJEU’s judgment in *Medion AG v Thomson multimedia Sales Germany & Austria GmbH*, Case C-120/04 where it was held that:

“29. In the context of consideration of the likelihood of confusion, assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark. On the contrary, the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components (see *Matratzen Concord*, paragraph 32).

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<sup>12</sup>*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27

30. However, beyond the usual case where the average consumer perceives a mark as a whole, and notwithstanding that the overall impression may be dominated by one or more components of a composite mark, it is quite possible that in a particular case an earlier mark used by a third party in a composite sign including the name of the company of the third party still has an independent distinctive role in the composite sign, without necessarily constituting the dominant element.

31. In such a case the overall impression produced by the composite sign may lead the public to believe that the goods or services at issue derive, at the very least, from companies which are linked economically, in which case the likelihood of confusion must be held to be established.

32. The finding that there is a likelihood of confusion should not be subject to the condition that the overall impression produced by the composite sign be dominated by the part of it which is represented by the earlier mark.

33. If such a condition were imposed, the owner of the earlier mark would be deprived of the exclusive right conferred by Article 5(1) of the directive even where the mark retained an independent distinctive role in the composite sign but that role was not dominant.”

52. I am also mindful of the recent decision of the CJEU in *Bimbo S.A. v OHIM*<sup>13</sup> in which it was held that:

“25...a component of a composite sign does not retain such an independent distinctive role if, together with the other component or components of the sign, that component forms a unit having a different meaning as compared with the meaning of those components taken separately.

...

33. Next, ...it should be pointed out that the purpose of examining whether any of the components of a composite sign has an independent distinctive role is to determine which of those components will be perceived by the target public.

34. Indeed, ...it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.

35...Such an assessment must be based on the overall impression produced by the trade marks at issue, since the average consumer

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<sup>13</sup> Case C-591/12P

normally perceives a mark as a whole and does not proceed to analyse its various details... Therefore, this does not involve an exception, that must be duly substantiated, to that general rule.

36. Moreover, the individual assessment of each sign...must be made in the light of the particular circumstances of the case and cannot therefore be regarded as being subject to general presumptions...it is clear, in particular, from the case-law subsequent to *Medion* (EU:C:2005:594), that the Court of Justice did not introduce, in that judgment, a derogation from the principles governing the assessment of the likelihood of confusion.”

53. I take into consideration the fact that the application is made in respect of goods in class 29 while the opposition is based on services in class 43. I have found the marks to have a medium degree of visual, aural and conceptual similarity. I also bear in mind that the earlier mark possesses an average degree of inherent distinctive character.

54. Neither party to these proceedings has mentioned the word SAINSBURY'S and its perception in the mind of the average consumer. I am content that SAINSBURY'S is well known by the average consumer as a supermarket which sells (at least) groceries of the type at issue in these proceedings.

55. In its evidence the opponent provides a witness statement by Ms Theresa Castle, a trade mark attorney at Bird & Bird, the opponent's representative. Her witness statement is dated 1 December 2014.

56. At paragraph 3 of her statement Ms Castle states:

*“I submit this witness statement in support of the argument that restaurant chains commonly retail their products into supermarkets in the United Kingdom.”*

57. The 22 exhibits provided with Ms Castle's witness statement are the results of searches conducted on a number of supermarket websites. The exhibits were all printed on the 4-17 November 2014.

58. Searches were carried out on the websites of *Sainsbury's*, *Waitrose*, *Tesco*, *Asda* and *Morrison's*. All five supermarkets sell products branded *Pizza Express* and *Nando's* and include foods such as pizzas and chicken products and a number of branded sauces from both restaurant chains. All five also sell bags of *Starbucks* branded coffee. *Waitrose*, *Tesco* and *Asda* also sell sauces under the *Wahaca* restaurant name.

59. Differences I have already identified mean that there is no likelihood of the marks being mistaken for one another giving rise to direct confusion, which leaves the consideration of indirect confusion which is explained in *L.A. Sugar Limited v By Back Beat Inc*<sup>14</sup>, in which Mr Iain Purvis Q.C. sitting as the Appointed Person noted:

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<sup>14</sup> *Case BL-O/375/10*



“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: ‘The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.’

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (‘26 RED TESCO’ would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as ‘LITE’, ‘EXPRESS’, ‘WORLDWIDE’, ‘MINI’ etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (‘FAT FACE’ to ‘BRAT FACE’ for example).”

60. In this case the common element, TOP DOG retains an independent role in the mark SAINSBURY’S TOP DOG. The addition of the word SAINSBURY’S does not change the meaning of the remainder of the mark. The evidence filed by the opponent shows a pattern of restaurant and fast food chains offering food goods and sauces through a number of supermarkets. I note that the pages filed by the opponent were printed after the material date but am content that they reflect the position at the relevant time, and that is certainly my own experience. An average consumer familiar with TOP DOG restaurants, cafés and fast food restaurants would, on encountering the applicant’s mark, simply perceive it as an indication that TOP DOG restaurants were making their food goods available through Sainsbury’s supermarkets, giving rise to the type of indirect confusion outlined above.

61. In conclusion, the average consumer (whether a member of the general public or a business purchaser) will consider the common element to indicate goods being provided by the same or an economically linked undertaking.

## **CONCLUSION**

**62. The opposition succeeds under section 5(2)(b) of the act in respect of the following goods:**

**hot dogs; meat products; meat pies; sausages; hamburgers; beef burgers; poultry products; snack foods in Class 29; prepared meals in Class 29.**

**63. The opposition fails under section 5(2)(b) of the act in respect of the following goods:**

**Meat, poultry and game; meat extracts; mincemeat; constituents for meals in Class 29.**

### **COSTS**

64. Both parties have achieved a measure of success and I consider both should bear its own costs.

**Dated this 23rd day of June 2015**

**Ms Al Skilton  
For the Registrar,  
The Comptroller-General**