

O-437-15

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK REGISTRATION NO 2575663

**IN THE NAME OF ANTHONY STEWART, SASKIA CLARK-STEWART
& INDIA CLARK-STEWART
OF THE FOLLOWING TRADE MARK IN CLASS 29**

STAGGIS

AND

**AN APPLICATION FOR INVALIDITY
UNDER NO 500620
BY HORMEL FOODS CORPORATION**

Background and pleadings

1. This dispute concerns trade mark registration no. 2575663 which consists of the trade mark STAGGIS (“the registration”). It was filed by Anthony Stewart, Saskia Clark-Stewart and India Clark-Stewart (“the proprietor”) on 18 March 2011. The registration was published on 22 April 2011 and subsequently registered on 1 July 2011. It was registered in respect of the following goods:

Class 29: Meat, poultry and game; meat extracts; meat preserves; Haggis made with venison; compotes; pates; prepared meals; soups and potato crisps; lasagnes; raviolis; venison olives; spreadable pastes; fillings; stuffing.

2. On 17 September 2014, an application for invalidation was filed by Hormel Foods Corporation (“the applicant”). The applicant requested invalidation of the registration under section 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). This ground is relevant in invalidation proceedings on account of the provisions of section 47(2) of the Act.

3. The applicant is relying upon the following two earlier registrations (“the earlier mark”), both of which are subject to proof of use.

Mark: STAGG

Number: UK 2161906

Filing date: 23 March 1998

Publication date: 10 June 1998

Registration date: 25 September 1998

Goods: Class 29: Meat, fish, poultry and game; meat extracts; tinned meats; prepared meats; prepared food containing meat; tinned chilli, beef stew and corned beef hash; preserved, dried and cooked fruits and vegetables; jellies; jams, fruit sauces; eggs, milk and milk products; edible oils and fats; sauces; but none of the aforesaid being made from or containing venison.

And,

Mark: STAGG

Number: CTM 819847

Filing date: 1 May 1998

Publication date: 7 December 1998

Registration date: 30 June 1999

Goods: ¹Class 29: Meat, fish, poultry and game; meat extracts; tinned meats; prepared meats; prepared food containing meat; tinned chilli, beef stew and corned beef hash; preserved, dried and cooked fruits and vegetables; jellies; jams, fruit sauces; eggs, milk and milk products; edible oils and fats; sauces; but none of the aforesaid being made from or containing venison.

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

4. The proprietor filed a counterstatement denying the claims made by the applicant. They also requested that the applicant provide the necessary proof of use of the earlier mark.

5. The applicant filed evidence and 37 pages of written submissions which shall be referred to where necessary. No hearing was requested and so this decision is taken following a careful consideration of the papers.

Applicant's evidence

Witness Statement of Andrew Thomas King

6. Mr King is a trade mark attorney at Mewburn Ellis. He has held this position for over 3 years and has been with the company since November 2008.

- Exhibit ATK1 comprises of a collection of various entries from the Collins English Dictionary.
- Exhibit ATK2 are printouts from the "Scottish Venison" website – www.scottish-venison.info which references various Scottish restaurants and hotels.
- Exhibit ATK3 is a printout of the "Best Practice Venison Cutting Guide" dated March 2007, which is from the "Butchery and Cutting" pages of the Scottish Venison website. It is dated March 2007.
- Exhibit ATK4 comprises of a collection of website printouts from the website of "Lincolnshire Wild Venison" www.lincolnshirewildvenison.co.uk The printouts are dated 4 September 2013.
- Exhibit ATK5 are supermarket and other retail website printouts. They are dated 4 September 2013.

¹ The registration also covers Class 25 "Clothing; footwear; headgear" but these goods are not relied upon by the applicant.

- Mr King states that exhibits ATK4 and ATK5 “evidently originate from the UK, partly because of the “co.uk” web address and also because prices are indicated in GBP (£)”².
- Exhibit ATK6 consists of two menus from UK restaurants. One is dated 12 August 2013 and the other is dated 1 June 2013.
- Exhibit ATK7 are printouts from OHIM’s (Office for Harmonization in the Internal Market) “TMclass” online classification database. They show that “haggis” is classified in class 29, along with black pudding, pates and oatmeal.
- Exhibit ATK8 is a copy of European Community Trade Mark Application no. 819847 for the mark STAGG.
- Exhibit ATK9 comprises of website print outs from the Wikipedia entry for “Haggis” and MacSween, a UK based specialist producer of haggis. Both print outs are dated 4 September 2013.
- Exhibit ATK10 are copies of correspondence relating to the recordal of a licence at the UK Intellectual Property Office (UK IPO) and OHIM. The license is between Hormel and Tulip International A/S in relation to the mark STAGG.
- Exhibit ATK11 are printouts taken from the UK IPO website which confirms that the licence agreement was recorded.
- Exhibit ATK12 is a photograph of a STAGG product purchased after the relevant date (5 January 2015).

Witness statement of Elizabeth Michelle Dee

7. Ms Dee is a Brand Manager at Tulip Limited (“TL”). Ms Dee states that she has held this position for three years and has been employed by TL since January 2012. Since the witness statement is dated 22 January 2014 there appears to be a discrepancy with the dates. Nevertheless, Ms Dee has been the Brand Manager at TL for at least 2 years.

8. Ms Dee states that TL is the exclusive UK licensee for STAGG and SPAM branded products which are produced by the applicant. The license has been in place since 1999, and the STAGG product has been marketed in the UK since this date. Ms Dee states that she is responsible for marketing the STAGG product and that she reports directly to the applicant.

- Exhibit EMD1 consists of a number of invoices dated between 2009 and 2014. The invoices are addressed to various retailers across the UK. Ms Dee states that these sample invoices show trade sales for 35,000 STAGG branded products which have a total value of £41,118.02.

² Paragraphs 5 and 6 of Mr King’s witness statement

Year	Turnover
2012	£3,581,927.10
2013	£3,343,835.10
2014	£4,026,812.70
Total	£10,952,574.90

- Exhibit EMD2 are pictures of promotional materials bearing the mark “STAGG CHILI”. The advertisements are dated between 2012 and 2014.
- Exhibit EMD3 are copies of invoices relating to in-store promotional support activity for STAGG products. The invoices are from UK retailers to TL, and are dated between 2012 and 2014. They include references to STAGG.
- Exhibit EMD4 is a letter dated 21 May 2012 from Concord (London) Limited, a media company, to Ms Dee. It states that the STAGG Chilli brand was advertised on the television channel ITV in 2002, 2003 and 2005 (prior to the relevant period) at a cost of £530,000, £660,000 and £154,000 respectively.
- Exhibit EMD5 is a UK map which indicates the different regions for the ITV1 channel.
- Exhibit EMD6 comprises of a number of printouts from Tesco and Sainsbury. They are dated 4 September 2013 and show the STAGG mark on tinned chilli con carne.
- Exhibit EMD7 is an invoice from Kerbang, a marketing and promotional support activity company, to TL. The invoice is for £4,500 plus VAT which was for the monthly “Management fee”. The invoice is dated 31 January 2013.
- Exhibit EMD8 are a series of printouts from www.staggchilli.co.uk dated 8 and 24 May 2012. They show various tins of STAGG chilli (meat and vegetarian).
- Exhibit EMD9 comprises of STAGG brand publications for their chilli meat and vegetarian prepared meals. They appear to be after the relevant period.
- Exhibit EMD10 are three photographs of Tesco supermarket shelves showing the STAGG tins. Ms Dee states that these photographs were taken by a company sales representative in 2012. On one of the price tags it states that the “offer ends 15/04/2012”.

9. Ms Dee also provides a “Retail Store Distribution” list for between 2011 and 2012. It refers to STAGG classic, vegetable, dynamite, Silverado, BBQ, homestead and Pecos pasta.

Witness statement of Laurence Raskin and exhibits LR1 to LR13

10. Mr Raskin is the International Brand and Category Manager for the applicant. He has held this position for 6 years, and has been employed by the applicant since June 1978.

11. Mr Raskin states that the applicant has been using their STAGG brand in the UK since 1999. He also states that in addition to the canned and tinned chilli products, his company also use their STAGG brand on other products such as “vegetarian variants, microwaveable meal pots and a pasta product”.

12. Mr Raskin claims that the STAGG brand is the UK market leader for tinned chilli and that between March 2011 and March 2012 their market share was in the region of 50%. Further, between 2006 and 2011 they had gross UK sales of \$41.1 million.

Promotional and marketing spend

Year	Amount
2012	£344,881
2013	£336,913
2014	£794,562

- Exhibit LR1 comprises of an affidavit in the name of Mr Raskin and accompanying exhibits. This evidence was filed in opposition proceedings before OHIM relating to the mark STAGGIS.
- Exhibit LR2 consists of printouts from the website www.hormelfoods.com The print outs are dated 8 May 2012 and they refer to the STAGG brand.
- Exhibit LR3 comprises of printouts from www.tulipltd.co.uk Mr Raskin states that TL is a company owned by Danish Crown Group, which a limited company owned by the cooperative society Leverandorselskabet Danish Crown Amba.
- Exhibit LR4 are two pieces of correspondence. The first is a letter from the OHIM relating to trade mark application/registration no. 819847 and dated 07/09/99. The letter is headed “Notice of registration of a licence” and states “Pursuant to your request, the non-exclusive licence, limited for goods in Class 29 granted to TULIP INTERNATIONAL A/S has been entered on 07/09/99”.
- The second letter is from The Patent Office, as it was, (now trading as the UK Intellectual Property Office) relating to trade mark application/registration no. 2161906 and dated 17 June 1999. The letter confirms recordal of a licence for Tulip International A/S.
- Exhibit LR5 is a CD of a TV advertisement which Mr Raskin states was shown in the UK in 2002, 2003 and 2005. It is claimed that in 2002 the advertisement campaign covered 68% of the UK population.
- Exhibit LR6 is a map of the UK which indicates the different regions for the ITV1 television channel. Mr Raskin states that the coverage included Scotland, Wales and a large proportion of England.
- Exhibit LR7 is a copy of a promotional trailer agreement between the applicant and Tulip Food Company, dated 8 April 2004. The agreement

relates to three promotional trailers purchased by Tulip Food Company for the promotion of STAGG branded products. The Agreement states that the advertisements are for the benefit of Hormel.

- Exhibit LR8 is a table compiled by Niensens who are a global market research company. The table sets out the market share that the brands STAGG, STAGG “Classic” and STAGG “Dynamite Hot” (all of which are chilli con carne) have for the years 2012, 2013 and 2014. Mr Raskin states that this data shows that their STAGG chilli con carne brand has “an overall market share of around 35% by volume and 42% by value”.³
- Exhibit LR9 comprises of a number of invoices to customers in London, Slough and Leicestershire. It is noted that the items listed in the invoices include Stagg Classic, Dynamite, Pub style and rice. These are microwaveable meal pots.
- Exhibit LR10 comprises of a series of print outs from www.staggchilli.co.uk as taken from www.screenshot.com. The screenshots are dated 4 March 2013, 21 September 2013 and 19 April 2014. They show the mark STAGG on tinned and prepared meal chilli con carne and vegetable carne. It is noted that the evidence that has been filed was acquired from www.screenshot.com which I shall regard as being akin to evidence acquired from the Wayback Machine.

In the Patents County Court, His Honour Judge Birss, in *National Guild of Removers & Storers Ltd v. Silveria* [2011] F.S.R. 9, discussed evidence of this nature, at paragraph 33:

“Mr Hill submitted and I accept that the fair way to assess the damages appropriate in this case is again to consider the fees due under the rules and use them to gauge an appropriate level of damages. The first question arising is the period of infringing use/passing off. To assess this Mr Sheahan used a website called the “Internet Archive” which is run by a not for profit organisation in the United States. This has a service called the “Wayback Machine” which allows a user to find snapshots of how websites appeared in the past. The Wayback Machine is commonly used in intellectual property cases to see what old websites looked like even when the operators of the websites have changed them or removed them altogether.”

- Exhibit LR11 are further website printouts which are dated 8 and 24 May 2012. They show tins of “STAGG” chilli.
- Exhibit LR12 is a Wikipedia entry headed “Chili con carne”. Under the heading “Pre-made chilli” it states that “In the UK, the most popular brand of canned chilli is sold by Stagg, a division of Hormel foods”. The entry is dated 8 May 2012.

³ Paragraph 18 of Mr Raskin’s witness statement.

- Exhibit LR13 is a print out from the Google analytics website. It shows that between the period of 3 November 2013 and 30 September 2014 the website www.staggshilli.co.uk had 3,822 visits and 2,642 of those were from the UK, i.e. 69.13%.

Witness statement of Jacqueline Pang and exhibit JPA and JPB

13. Ms Pang is a trade mark attorney for Mewburn Ellis, the applicant's professional representatives. Ms Pang has been with Mewburn Ellis since September 2011 and has held her present position for three months. The witness statement is dated 24 May 2012.

- Exhibit JPA are copies of a witness statement and exhibits which Ms Pang filed in relation to opposition proceedings before OHIM. The opposition was against the mark STAGGIS (application no. 10271674).
- Exhibit JPB consists of a selection of prints from the website www.staggchilli.co.uk which Ms Pang states were lodged in relation to the opposition proceedings. Details of these are below.

Dated 29 December 2006, 13 October 2007, 15 October 2008, 5 December 2009 and 10 April 2010 are webpage print outs showing various tins of "STAGG". The advertisement states "Each STAGG® Chili flavour is made to Authentic American Chili recipes; SILVERADOTM Beef, Chicken Grande and Vegetable Garden –all with less than 5 per cent fat – plus Classic with tomatoes and kidney beans, and Dynamite Hot with fiery hot peppers."

Dated 24 October 2009, 15 September 2008 and 17 October 2007 are further web printouts advertising "STAGG CLASSIC chilli Con Carne". There are similar advertisements for Vegetable Garden (dated 25 October 2009, 15 September 2008 and 17 October 2007), Chicken Grande (dated 24 October 2009, 15 September 2008 and 16 September 2007), Silverado Beef (dated 10 February 2010, 24 October 2009, 19 December 2008, 15 October 2007 and 21 June 2006) and Dynamite Hot (24 October 2009, 15 September 2008 and 17 October 2007).

The exhibit also includes a "Whois" printout which states that staggchilli.co.uk was registered on 23 March 2000.

14. Exhibit JPB also includes printouts of their "Frequently Asked Questions". These have been acquired from the Wayback Machine website.

Proof of use

Preliminary point

15. Since the earlier relied upon registrations are old enough to be subject to proof of use the proprietor may request that evidence of use is filed. Subjecting the applicant to proof of use is triggered by them ticking "yes" in section 7 of the TM8 headed "Request for proof of use". The proprietor ticked the box but also made various submissions with regard to the applicant's use of the registrations. In the applicant's

submissions they queried whether they were required to provide proof of use. In my view, the comments made by the proprietor were ambiguous and not an express admission that the earlier mark has been used. Therefore, the proprietor was required to file evidence and it was correct for them to have done so.

Section 6A:

16. The relevant statutory provision states:

“Raising of relative grounds in opposition proceedings in case of non-use

6A. - (1) This section applies where -

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if -

(a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes -

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5) In relation to a Community trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.”

17. Section 100 of the Act states that:

“100. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

18. In *Stichting BDO v BDO Unibank, Inc.*, [2013] EWHC 418 (Ch), Arnold J. stated as follows:

“In *Pasticceria e Confetteria Sant Ambroeus Srl v G & D Restaurant Associates Ltd* (SANT AMBROEUS Trade Mark) [2010] R.P.C. 28 at [42] Anna Carboni sitting as the Appointed Person set out the following helpful summary of the jurisprudence of the CJEU in *Ansul BV v Ajax Brandbeveiliging BV* (C-40/01) [2003] E.C.R. I-2439; [2003] R.P.C. 40 ; *La Mer Technology Inc v Laboratoires Goemar SA* (C-259/02) [2004] E.C.R. I-1159; [2004] F.S.R. 38 and *Silberquelle GmbH v Maselli-Strickmode GmbH* (C-495/07) [2009] E.C.R. I-2759; [2009] E.T.M.R. 28 (to which I have added references to *Sunrider v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* (OHIM) (C-416/04 P) [2006] E.C.R. I-4237):

(1) Genuine use means actual use of the mark by the proprietor or third party with authority to use the mark: *Ansul*, [35] and [37].

(2) The use must be more than merely token, which means in this context that it must not serve solely to preserve the rights conferred by the registration: *Ansul*, [36].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish the goods or services from others which have another origin: *Ansul*, [36]; *Sunrider* [70]; *Silberquelle*, [17].

(4) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, i.e. exploitation that is aimed at maintaining or creating an outlet for the goods or services or a share in that market: *Ansul*, [37]-[38]; *Silberquelle*, [18].

(a) Example that meets this criterion: preparations to put goods or services on the market, such as advertising campaigns: *Ansul*, [37].

(b) Examples that do not meet this criterion: (i) internal use by the proprietor: *Ansul*, [37]; (ii) the distribution of promotional items as a reward for the

purchase of other goods and to encourage the sale of the latter: *Silberquelle*, [20]-[21].

(5) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including in particular, the nature of the goods or services at issue, the characteristics of the market concerned, the scale and frequency of use of the mark, whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them, and the evidence that the proprietor is able to provide: *Ansul*, [38] and [39]; *La Mer*, [22] -[23]; *Sunrider*, [70]-[71].

(6) Use of the mark need not always be quantitatively significant for it to be deemed genuine. There is no de minimis rule. Even minimal use may qualify as genuine use if it is the sort of use that is appropriate in the economic sector concerned for preserving or creating market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor: *Ansul*, [39]; *La Mer*, [21], [24] and [25]; *Sunrider*, [72]".

Although minimal use may qualify as genuine use, the CJEU stated in Case C-141/13 P, *Reber Holding GmbH & Co. KG v OHIM* (in paragraph 32 of its judgment), that "*not every proven commercial use may automatically be deemed to constitute genuine use of the trade mark in question*". The factors identified in point (5) above must therefore be applied in order to assess whether minimal use of the mark qualifies as genuine use.

Relevant date

19. As per section 6A(3)(a) of the Act, the relevant period in which genuine use must be established is the five period ending on the date of publication of the applied for mark, so, in these proceedings, the relevant period is 23 April 2006 to 22 April 2011.

Proof of use outcome

20. It is clear from the evidence filed that the applicant does not use their earlier mark on all of the goods that it is registered for. They clearly use the mark (to great success) for tinned chilli, mainly consisting of meat but also vegetables. Further, they use the registration for prepared chilli meals. Accordingly, I find that the existing specification is too wide and I must reach a fair specification.

21. In *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220, Kitchen L.J. (with whom Underhill L.J. agreed) set out the correct approach for devising a fair specification where the mark has not been used for all the goods/services for which it is registered. He said at paragraphs 63 to 65 that:

"The task of the court is to arrive, in the end, at a fair specification and this in turn involves ascertaining how the average consumer would describe the goods or services in relation to which the mark has been used, and

considering the purpose and intended use of those goods or services. This I understand to be the approach adopted by this court in the earlier cases of *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2002] EWCA Civ 1828, [2003] RPC 32; and in *West v Fuller Smith & Turner plc* [2003] EWCA Civ 48, [2003] FSR 44. To my mind a very helpful exposition was provided by Jacob J (as he then was) in *ANIMAL Trade Mark* [2003] EWHC 1589 (Ch); [2004] FSR 19. He said at paragraph [20]:

“... I do not think there is anything technical about this: the consumer is not expected to think in a pernicky way because the average consumer does not do so. In coming to a fair description the notional average consumer must, I think, be taken to know the purpose of the description. Otherwise they might choose something too narrow or too wide. ... Thus the "fair description" is one which would be given in the context of trade mark protection. So one must assume that the average consumer is told that the mark will get absolute protection ("the umbra") for use of the identical mark for any goods coming within his description and protection depending on confusability for a similar mark or the same mark on similar goods ("the penumbra"). A lot depends on the nature of the goods – are they specialist or of a more general, everyday nature? Has there been use for just one specific item or for a range of goods? Are the goods on the High Street? And so on. The whole exercise consists in the end of forming a value judgment as to the appropriate specification having regard to the use which has been made.”

Importantly, Jacob J there explained and I would respectfully agree that the court must form a value judgment as to the appropriate specification having regard to the use which has been made. But I would add that, in doing so, regard must also be had to the guidance given by the General Court in the later cases to which I have referred. Accordingly I believe the approach to be adopted is, in essence, a relatively simple one. The court must identify the goods or services in relation to which the mark has been used in the relevant period and consider how the average consumer would fairly describe them. In carrying out that exercise the court must have regard to the categories of goods or services for which the mark is registered and the extent to which those categories are described in general terms. If those categories are described in terms which are sufficiently broad so as to allow the identification within them of various sub-categories which are capable of being viewed independently then proof of use in relation to only one or more of those sub-categories will not constitute use of the mark in relation to all the other sub-categories.

It follows that protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider belong to the same group or category as those for which the mark has been used and which are not in substance different from them. But conversely, if the average consumer would consider that the goods or services for which the mark has been used form a series of coherent

categories or sub-categories then the registration must be limited accordingly. In my judgment it also follows that a proprietor cannot derive any real assistance from the, at times, broad terminology of the Nice Classification or from the fact that he may have secured a registration for a wide range of goods or services which are described in general terms. To the contrary, the purpose of the provision is to ensure that protection is only afforded to marks which have actually been used or, put another way, that marks are actually used for the goods or services for which they are registered.”

22. As previously stated, it is clear that the mark has been used on tinned chilli and prepared chilli meals, both being meat and vegetable based. However, a specification to this effect appears pernickety and not how the average consumer would fairly describe them. I must also retain the specification limitation that already applies to the registrations. Therefore, I consider a fair specification to be:

Class 29: Tinned meals; prepared meals; none of the aforesaid being made from or containing venison.

DECISION

SECTION 5(2)(b)

Legislation and relevant law

23. Sections 5(2)(b) of the Act is 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, or there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark”.

24. 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;

(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 might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Average consumer and the purchasing act

25. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer, Case C-342/97*.

26. 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 at paragraph 60 in these terms:

“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.”

27. The goods in question are various food items which would be purchased and consumed by the general public. They are inexpensive goods which are bought following a visual inspection of them on supermarket and shop shelves, or on a website for home delivery. Whilst they will predominantly be purchased following a visual inspection, I do not discount aural recommendations. Given the low cost of the goods, the level of care and attention paid when purchasing the goods will be low.

Comparison of goods

28. In the judgment of the Court of Justice of the European Union in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

“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”.

29. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- a) The respective users of the respective goods or services;
- b) The physical nature of the goods or acts of services
- c) The respective trade channels through which the goods or services reach the market
- d) 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;
- e) 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.

30. The respective goods are:

Goods of the earlier mark (following fair specification)	Proprietor's goods
Class 29: Tinned meals; prepared meals; none of the aforesaid being made from or containing venison.	Class 29: Meat, poultry and game; meat extracts; meat preserves; Haggis made with venison; compotes; pates; prepared meals; soups and potato crisps; lasagnes; raviolis; venison olives; spreadable pastes; fillings; stuffing.

Meat, poultry and game

31. These goods are covered by the applicant's earlier mark are various forms of meat. Since tinned and prepared meals may encompass meat, poultry and/or game, either in part or as the main ingredient, I find that the respective goods are highly similar.

Haggis made with venison

32. The applicant's evidence⁴ defines "haggis" as "a Scottish dish made from sheep's or calf's offal, oatmeal, suet, and seasonings boiled in a skin made from the animals' stomach". It is a form of meat which may be sold fresh, frozen, tinned or even as part of a prepared meal. Therefore, I find that these goods are highly similar to the goods covered by the earlier mark.

Meat extracts

33. My understanding is that "meat extracts" are akin to a broth or stock, such as Bovril. Whilst the users and trade channels may be the same, the respective goods are not in competition and they will not be found in the same area of a shop or supermarket. Therefore, I find that "Meat extracts" are not similar to goods covered by the earlier marks.

Compotes

34. Compotes are fruit based desserts. They differ in nature to the applicant's goods and are not in competition with one another. Therefore, I find that compotes are not similar to the applicant's goods.

Pates

35. Pates is a paste like substance made from meat and/or vegetables. It is often served as a starter, or eaten as a snack with bread or crackers. It is generally sold in the chilled section of a supermarket or shop so it would be in relatively close proximity to prepared meals. The goods are not in competition and their nature does differ. Accordingly, I do not consider the goods to be similar.

⁴ Exhibit ATK1 of Mr King's witness statement dated 26 January 2015

Prepared meals

36. The applicant's "prepared meals" are identical to "prepared meals containing chilli con carne, vegetable chilli". Whilst there are other "prepared meals" which do not contain chilli con carne or vegetable chilli, I do not consider there to be a suitable limitation to prepared meals.

Meat preserves

37. My understanding is that meat preserves are meat preserves which have been processed in some manner and preserved, for example, tinned corned beef, precooked ham, etc. On this basis, I find that they are similar in nature to tinned meals, sold in close proximity to one another and that there is a degree of competition between them. Therefore, they are highly similar to the applicant's goods.

Soups

38. Soups are sold either fresh in the chilled sections of supermarkets and shops or tinned in another area, possibly next to tinned meals. They are considered to be a meal either in itself or in conjunction with another food. Therefore, I find that soups and tinned meals are highly similar.

Potato crisps

39. Potato crisps are thin slices of potato which have been baked or fried, salted and usually flavoured. They are sold in packets or tubes and not tins or as prepared meals. They are eaten as snacks and not as a main meal. Therefore, they differ in nature to the applicant's goods. Further, they are sold in separate areas of a shop or supermarket and are not in competition with one another. I find that they are not similar goods.

Lasagnes

40. Lasagne is a meat and vegetable based meal which is sold as a prepared meal. Therefore, I consider them to be identical to the goods of the earlier registration.

Ravioli

41. Ravioli consists of two (possibly more) layers of pasta which are typically filled with meat, vegetables, or some other type of food. They are often sold as or within prepared meals or tins. Therefore, I find the respective goods to be identical.

Venison olives

42. Venison olives are venison wrapped in a roll, often around another meat or food item. These can be sold in or as prepared meals. Therefore, I find these to be highly similar.

Spreadable pastes

43. In my view, spreadable pastes is a viscous food flavoured item which would be spread on a cracker, biscuit, bread, etc. It is most likely to be edible without having to be cooked. They are likely to be sold in jars and possibly tins in the same area (possibly same shelf) as the applicant's goods. They are not in direct competition with one another but there is a degree of competition. Therefore, I am of the opinion that the goods are not similar.

Fillings

44. Fillings is a particularly broad term which may encompass a number of food items which are used to fill other food items. For example, filling could be a meat, vegetable or fish based food which would fill sandwiches, pies, jacket potatoes, etc. In my view, tinned meals could also be used in the same manner, e.g. a filling or tinned meal would be added to another food item.

45. As with the applicant's goods, the fillings may be sold tinned or chilled as part of a prepared meal. They are not in direct competition but there is a degree of competition. Accordingly, the goods are similar to a high degree.

Stuffing

46. Stuffing is akin to a filling in the sense that it is an edible substance or mixture, often a starch, used to fill a cavity in another food item. Many foods may be stuffed, including meats, vegetables, and egg. They are not in competition to the applicant's goods, but they are sold in close proximity to one another. Further, prepared meals may contain stuffing. Therefore, I find that there is a high degree of similarity.

Summary

47. *The following goods are identical:*

- Prepared meals
- Lasagnes
- Ravioli

48. *The following goods are highly similar:*

- Meat, poultry and game
- Haggis made with venison
- Meat preserves
- Soups
- Venison olives
- Fillings
- Stuffing

49. *The following goods are not similar:*

- Meat extracts
- Compotes
- Pates
- Potato crisps
- Spreadable pastes

Comparison of marks

50. It is clear from *Sabel BV v. Puma AG* (particularly 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 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.”

51. It would be wrong, therefore, to artificially dissect the trade marks, 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. The respective trade marks are shown below:

The earlier mark	The Registration
STAGG	STAGGIS

52. The registration comprises of one element, i.e. the invented word STAGGIS. Some consumers may see the registration as being a fanciful combination of “STAG” (the animal) and HAGGIS. In other words, they may see the mark as being a HAGGIS type food made of STAG meat (i.e. venison). However, I am of the opinion that consumers who view the mark in this way will be in the minority, particularly since the average consumer does not proceed to analyse trade marks for the goods in question to that extent. Therefore, I consider the earlier mark will predominantly be perceived as an invented word. The earlier mark is likely to be viewed as a misspelling of STAG: a male deer. Some may view the mark as a surname, though I believe this to be less likely.

53. The only visual differences between the respective marks are the letters IS at the end of the registration. This does not materially alter the visual similarities between the respective marks. Accordingly, I find that there is a high level of visual similarity between them.

54. Conceptually, the earlier mark may be perceived as STAG, the animal, which has been misspelt (deliberately or not). Since the registration would be seen as an invented word, it does not have any obvious meaning. Conceptual considerations are therefore neutral.

55. Aurally, the earlier mark would be pronounced with one syllable as STAGG. The applicant's mark would be pronounced as two syllables: STAG-IS. The respective marks share the same first syllable but since the registration does not have a second syllable they are not identical. The word STAGG is the prominent sound since it is at the beginning and more dominant sounding. Therefore, I find that the respective marks are aurally similar to an above average degree.

Distinctive character of the earlier trade mark

56. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated in paragraphs 22 and 23 that:

“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 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

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).”

57. The applicant has filed significant evidence which clearly demonstrates that due to the use made of the mark they have accrued an enhanced level of distinctive character.

58. From an inherent distinctiveness perspective, the earlier mark has no ordinary literal English meaning. However, it only comprises of one element and may be viewed as a misspelling of STAG, the inherent distinctive character is considered to be above average, but not high.

Likelihood of confusion

59. Where there is no similarity between the goods, there can be no likelihood of confusion. Therefore, the section 5(2)(b) against “meat extracts, compotes, pates, potato crisps; spreadable pastes” fails.

60. With regard to the remaining goods, I must now determine whether there is a likelihood of confusion. This is not a scientific process and it is a matter of considering all the factors, weighing them and looking at their combined effect, in accordance with the authorities set out earlier in this decision. One of those principles states that a lesser degree of similarity between the goods and services may be offset by a greater degree of similarity between the trade marks, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*). This is known as the interdependency principle.

61. In view of the above, I remind myself of the extent of similarity between the respective goods. I found that the applicant’s “prepared meals; lasagnes; ravioli” are identical; “meat, poultry and game; haggis made from venison, meat preserves; soups; venison olives; fillings; stuffing” are highly similar. I have also found that:

- The average consumers of the goods are the general public who will purchase the goods following a visual perusal. The level of care and attention is low.
- The initial impression of the registration is that it is an invented word.
- I have found that the respective marks are visually similar to a high degree, aurally similar to an above average degree and conceptually neutral.
- The earlier mark has an enhanced degree of distinctiveness due to the use made of the mark. It also has an above average degree of inherent distinctiveness.

62. The majority of the conclusions I have outlined above, indicate a likelihood of confusion. In particular, the average consumer of the goods will purchase the goods following a visual perusal which I found there to be a high degree of similarity. Furthermore, the applicant, due to their use, has an enhanced degree of distinctive character in the mark. Therefore, taking all of the above into consideration, I consider there to be a likelihood of direct confusion between the respective marks.

Section 5(2)(b) outcome

63. The claim under section 5(2)(b) succeeds against “Meat, poultry and game; meat preserves; haggis made from venison; prepared meals; soups; lasagnes; ravioli; venison olives; fillings; stuffing” **but not** against “meat extracts, compotes, pates, potato crisps; spreadable pastes”.

SECTION 5(3)

Relevant legislation and case law

64. Section 5(3) states:

“(3) A trade mark which-

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community trade mark or international trade mark (EC), in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

65. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, [1999] ETMR 950, Case 252/07, *Intel*, [2009] ETMR 13, Case C-408/01, *Addidas-Salomon*, [2004] ETMR 10 and C-487/07, *L’Oreal v Bellure* [2009] ETMR 55 and Case C-323/09, *Marks and Spencer v Interflora*. The law appears to be as follows.

a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman*, paragraph 29 and *Intel*, paragraph 63.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark’s reputation and distinctiveness; *Intel*, paragraph 42

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel*, paragraph 68; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel*, paragraph 79.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark’s ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the

goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77.*

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74.*

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV, paragraph 40.*

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora, paragraph 74 and the court's answer to question 1 in L'Oreal v Bellure*).

66. The conditions of section 5(3) are cumulative. Firstly, the applicant must show that its earlier mark (STAGG) has achieved a level of knowledge/reputation amongst a significant part of the public. Secondly, they must establish that the level of reputation and the similarities between the parties' marks will cause the public to make a link between the marks, in the sense of the earlier marks being brought to mind by the later marks.

67. Thirdly, assuming that the first and second conditions have been met, section 5(3) requires that one or more of three types of damage claimed by the applicant will occur. It is unnecessary for the purposes of section 5(3) that the goods and/or services to be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks.

68. Since the opposition has succeeded against some of the applied for goods, I only need to consider the section 5(3) ground in relation to the following goods:

Meat extracts, compotes, pates, potato crisps; spreadable pastes.

Reputation

69. 'Reputation' for the purposes of Section 5(3) means that the earlier mark is known by a significant part of the public concerned with the products or services

covered by that mark (paragraph 26 of the CJEU's judgment in *General Motors Corp v Yplon SA (CHEVY)* [1999] ETMR 122 and [2000] RPC 572).

70. It is clear from the evidence that the applicant has a significant reputation for tinned and prepared meals in the UK. Therefore, the applicant clears the reputation hurdle.

Link

71. Having established the existence and scope of a reputation, I need to go on to consider the existence of the necessary link. In order to determine whether a link exists, I remind myself of the guidance set out by the CJEU *Intel*.

72. The factors to be taken into account when considering whether a link exists include:

The degree of similarity between the conflicting marks

73. Clearly the marks are not identical. I consider there to be a high level of visual similarity, above average aural similarity and conceptually neutral. Therefore, I would place the level of similarity as being above average.

The nature of the goods or services for which the conflicting marks were registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public

74. I do not consider the goods to be similar.

The strength of the earlier mark's reputation

75. The earlier mark has a strong reputation for tinned meals. It has a significant market share, high turnover and advertises the mark on the television channels. In view of this, I find that the strength of the earlier mark's reputation is high.

The degree of the earlier mark's distinctive character, whether the inherent or acquired through use

76. The distinctive character of the earlier mark is enhanced given the level of use of the mark rather than its inherent qualities which I consider to be between medium and high.

The existence of the likelihood of confusion on the part of the public

77. There is no likelihood of confusion.

Will there be a link between STAGG and STAGGIS?

78. Having taken into account all of the above, I find that there is no link. Whilst I have found that the strength of the registration's reputation to be strong, since the

goods are not similar and the marks are not identical I am of the view that there will not be a link in the mind of the consumer.

Section 5(3) outcome

79. The claim under section 5(3) accordingly fails.

SECTION 5(4)(a)

80. The relevant legislation states:

“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

(b)...

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.”

81. The general case law relating to the law of passing off under section 5(4)(a) are as follows:

82. Halsbury’s Laws of England (4th Edition) Vol. 48 (1995 reissue) at paragraph 165 provides the following analysis of the law of passing off. The analysis is based on guidance given in 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. It 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.

The restatement of the elements of passing off in the form of this classical trinity has been preferred as providing greater assistance in analysis and decision than the formulation of the elements of the action previously expressed by the House. This latest statement, like the House’s previous statement, should not, however, be treated as akin to a statutory definition or as if the words used by the House constitute an exhaustive, literal definition of

passing off, and in particular should not be used to exclude from the ambit of the tort recognised forms of the action for passing off which were not under consideration on the facts before the House.”

Further guidance is given in paragraphs 184 to 188 of the same volume with regard to establishing the likelihood of deception or confusion. In paragraph 184 it is noted (with footnotes omitted) that:

“To establish a likelihood of deception or confusion in an action for passing off where there has been no direct misrepresentation generally requires the presence of two factual elements:

(1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and

(2) that members of that class will mistakenly infer from the defendant’s use of a name, mark or other feature which is the same or sufficiently similar that the defendant’s goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact.

In arriving at the conclusion of fact as to whether deception or confusion is likely, the court will have regard to:

(a) the nature and extent of the reputation relied upon;

(b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;

(c) the similarity of the mark, name etc. used by the defendant to that of the plaintiff;

(d) the manner in which the defendant makes use of the name, mark etc. complained of and collateral factors; and

(e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.”

In assessing whether confusion or deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action.”

83. The earlier use by the claimant must relate to the use of the sign for the purposes of distinguishing goods or services. For example, merely decorative use of

a sign on a T-shirt cannot found a passing off claim: *Wild Child Trade Mark* [1998] RPC 455 (AP)

The relevant date

84. The Court of Appeal recently considered the relevant date in a case such as this one under the analogous article of the Community Trade Mark Regulation⁵. Kitchen L.J. stated that:

“Under the English law of passing off, the relevant date for determining whether a claimant has established the necessary reputation or goodwill is the date of the commencement of the conduct complained of (see, for example, *Cadbury-Schweppes Pty Ltd v The Pub Squash Co Ltd* [1981] RPC 429). The jurisprudence of the General Court and that of OHIM is not entirely clear as to how this should be taken into consideration under Article 8(4) (compare, for example, T-114/07 and T-115/07 *Last Minute Network Ltd* and Case R 784/2010-2 *Sun Capital Partners Inc.*). In my judgment the matter should be addressed in the following way. The party opposing the application or the registration must show that, as at the date of application (or the priority date, if earlier), a normal and fair use of the Community trade mark would have amounted to passing off. But if the Community trade mark has in fact been used from an earlier date then that is a matter which must be taken into account, for the opponent must show that he had the necessary goodwill and reputation to render that use actionable on the date that it began.”

85. The applicant has made various submissions that they have used their mark in the course of trade prior to filing the trade mark application. Whilst this prior use may impact on assessing the relevant date, there is no evidence to support the submissions. Accordingly, the relevant date for determining the s.5(4)(a) claim is the date of application for registration: 18 March 2011.

Was there goodwill at the relevant date?

86. Goodwill was discussed in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (HOL):

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start.”

87. By virtue of the continual use, it is clear from the evidence filed that the proprietor of the earlier marks has goodwill in tinned meals and prepared meals. Therefore, they satisfy the first passing off requirement.

⁵ *Roger Maier v ASOS* [2015] EWCA Civ. 220 at paragraph 165

Misrepresentation

88. In *Neutrogena Corporation and Another v Golden Limited and Another*, [1996] RPC 473, Morritt L.J. stated that:

“There is no dispute as to what the correct legal principle is. As stated by Lord Oliver of Aylmerton in *Reckitt & Colman Products Ltd. v. Borden Inc.* [1990] R.P.C. 341 at page 407 the question on the issue of deception or confusion is

“is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the public will be misled into purchasing the defendants' [product] in the belief that it is the respondents'[product]”

The same proposition is stated in Halsbury's Laws of England 4th Edition Vol.48 para 148 . The necessity for a substantial number is brought out also in *Saville Perfumery Ltd. v. June Perfect Ltd.* (1941) 58 R.P.C. 147 at page 175 ; and *Re Smith Hayden's Application* (1945) 63 R.P.C. 97 at page 101.”

And later in the same judgment:

“... for my part, I think that references, in this context, to “more than *de minimis* ” and “above a trivial level” are best avoided notwithstanding this court's reference to the former in *University of London v. American University of London* (unreported 12 November 1993) . It seems to me that such expressions are open to misinterpretation for they do not necessarily connote the opposite of substantial and their use may be thought to reverse the proper emphasis and concentrate on the quantitative to the exclusion of the qualitative aspect of confusion.”

89. To clarify, since the opposition has already succeeded against some of the goods, the passing off claim is only being considered against the goods whereby the opposition has not succeeded, namely: class 29 “meat extracts, compotes, pates, potato crisps; spreadable pastes”.

90. In comparison to section 5(2)(b) of the Act, the test still requires consumers to believe that the goods are of the same (or related) staples. Albeit, the test is now one-directional in that those consumers must believe, applied to this case, that STAGGIS is the responsibility of the producer of STAGG tinned meals. I accept that there is a difference in the test in that under section 5(2)(b) one is making the assessment from the perspective of the average consumer whereas under passing-off one is concerned with a “substantial number of members of the public”. However, without debating how different these tests actually are, I consider that whichever way one looks at it, the applicant has not established that a substantial number of persons would be deceived. For similar reasons to that already expressed, I do not consider that a substantial number of members of the public will believe that the goods sold under the proprietor's mark are those of the applicant.

Section 5(4)(a) Outcome

91. The opposition fails under section 5(4)(a) for goods that section 5(2)(b) also failed.

OVERALL OUTCOME

92. The application for invalidation has succeeded against:

Class 29 “Meat, poultry and game; meat preserves; haggis made from venison; prepared meals; soups; lasagnes; ravioli; venison olives; fillings; stuffing”.

93. The application for invalidation fails against the following goods. Therefore, subject to a successful appeal, the registration is maintained for the following goods:

Class 29: “meat extracts, compotes, pates, potato crisps; spreadable pastes”.

COSTS

94. Both parties have shared a measure of success, therefore, I do not propose to make a costs award.

Dated this 15th day of September 2015

**Mark King
For the Registrar,
The Comptroller-General**