

O-515-15

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 3062031
BY FOODREEF LIMITED T/A BIONITA
TO REGISTER THE TRADE MARK**



**IN CLASS 30
AND**

**IN THE MATTER OF OPPOSITION
THERE TO UNDER No. 403102 BY
NOEL MCDONALD**

BACKGROUND

1) On 30 June 2014, Foodreef Limited t/a Bionita (hereinafter the applicant) applied to register the trade mark shown above in respect of the following goods in class 30: Alimentary pasta; Calzones; Cannelloni; Chilled pizzas; Deep frozen pasta; Dried pasta; Dried pasta foods; Dried sauce in powder form; Dried tortellini; Extruded savory snackfoods; Filled pasta; Fresh pasta; Fresh pizza; Frozen pizzas; Gnocchi; Instant noodles; Instant pudding mixes; Lasagna; Lasagne; Macaroni; Macaroni cheese; Macaroni [uncooked]; Noodle-based prepared meals; Noodles; Pasta; Pasta containing eggs; Pasta containing fillings; Pasta containing stuffings; Pasta dishes; Pasta preserves; Pasta products; Pizza; Pizzas; Pizzas [prepared]; Pre-cooked dishes; Prepared meals containing [principally] pasta; Prepared meals containing [principally] rice; Prepared meals in the form of pizzas; Prepared pasta dishes; Prepared pasta meals; Prepared rice dishes; Puffed corn snacks; Ravioli; Ravioli [prepared]; Ready-made dishes containing pasta.

2) The application was examined and accepted, and subsequently published for opposition purposes on 25 July 2014 in Trade Marks Journal No.2014/031.

3) On 23 October 2014 Noel McDonald (hereinafter the opponent) filed a notice of opposition, subsequently amended. The ground of opposition is in summary:

a) The opponent is the proprietor of the following trade mark:

Mark	Number	Date of application / registration	Class	Specification relied upon
BIONA	2449765	16 March 2007 14 September 2007	29	Edible oils and fats, milk products, canned beans & pulses, baked beans in tomato sauce, cheese, butter, margarines and spreads, nut butters, canned tomatoes, pickled vegetables, olives, tofu, creamed coconut, tomato concentrate, bouillon, prepared soups, tahini, vegetarian sausages and burgers, hummus, potato crisps, peanut butter, herb salt, pates and spreads, relishes, yogurt, snack bars, savoury snacks, dried herbs, coconut milk.
			30	Coffee, cocoa, tea, rice, artificial coffee, flour and preparations made from cereals, bread, pastries, cookies, honey, yeast, mustard, vinegar, sauces, boiled sweets, cereal food bars, chocolate bars, chutneys, herb teas, crispbread, flapjacks, mayonnaise, pasta, pizza bases, pretzels, rice cakes, pasta sauces, ketchup, marinades, marzipan, muesli bars, peppermint sweets, pesto sauce, cakes, cereal based snacks, curry sauces, salad dressings, muesli, candy bars, puffed rice.
			32	Beers, bottled waters, vegetable juices.

a) The opponent states that its authorised licensee, Windmill Organics Ltd (WOL) has since 1978 sold a range of organic produce under the mark BIONA in the UK. The opponent contends that as its mark and the goods for which it is registered are identical or similar to the mark in suit, the application offends against Section 5(2)(b) of the Act.

4) On 20 December 2014 the applicant filed a counterstatement, subsequently amended. It basically denies all the grounds of opposition, and points out that it already owns the registered mark 3061035 BIONITA for goods in class 30 and which was not challenged by the opponent. The applicant makes the point that the term BIO is commonly known and used in the food/drink industry as meaning healthy. The opponent is put to strict proof of use of its marks.

5) Both sides filed evidence. Both parties seek an award of costs in their favour. The matter came to be heard on 19 October 2015 when the opponent was represented by Ms Chantrielle of Counsel instructed by Messrs Russell Cooke Solicitors LLP; the applicant was represented by Mr Ros, a director of the company.

OPPONENT'S EVIDENCE

6) The opponent filed a witness statement, dated 10 April 2015, by Christopher David Williams the opponent's solicitor. He states that he is authorised to make the statement and that he has been supplied with documents and information by the opponent. He provides the following exhibits:

- CDW1 pages 1-7: This is a schedule of the opponent's 313 products under the BIONA mark.
- CDW1 pages 8-28 copies of two invoices issued by Windmill Organics Ltd (hereinafter WOL) to retailers in respect of sales of products under the BIONA mark. These dated 2 February 2015, addressed to Ocado Ltd, and 13 February 2015, addressed to Nature's Store Ltd.

APPLICANT'S EVIDENCE

7) The applicant filed a witness statement, dated 6 July 2015, by Marco Fontana Ros, a Director of the applicant company. His statement mainly deals with the contact and discussions between the two parties which do not assist my decision.

OPPONENT'S FURTHER EVIDENCE

8) The opponent filed two further witness statements. The first, dated 9 October 2015, is by Noel McDonald. He states that he is a director of WOL and that WOL has an exclusive license to use the mark BIONA. He states that turnover in the mark was £11.8 million in 2013 and £15 million in 2014. He provides the following exhibit:

- NM1: This consists of three invoices to Nature's Store Ltd dated 8 April 2013, 29 April 2013 and 7 October 2013 and one invoice dated 2 December 2013 to Ocado Ltd. This evidence was not paginated, nor was there any reference as to which invoice and description was being relied upon to defend which part of the specification. The opponent's skeleton contained an annex which purported to provide the link but simply referred to a page number (which did not exist on the invoices and even referred to "the last invoice" when presumably meaning the last page as despite there being only four invoices reference was made to "invoice 29". In my opinion the invoices show use on the following:

Class	Goods	Item description /invoice number and page reference.
29	Edible oils and fats	Virgin olive oil 108691 page 1 Hazelnut butter 108691 page 8
	milk products	Yoghurt /whit choc. Apricot pieces 108986 page 19
	canned beans & pulses	Mexican refried beans 108691 page 5
	baked beans in tomato sauce	Baked beans in Tom. sauce 111273 page 22
	butter, margarines and spreads, nut butters	Hazelnut butter 108691 page 8
	canned tomatoes	Dried tomatoes in olive oil 108691 page 2
	pickled vegetables	Gherkins 108691 page 4

	creamed coconut	Creamed coconut 108691 page 2
	tomato concentrate	Tomato ketchup 108691 page 2
	prepared soups	Spiced pumpkin soup 111273 page 27
	yogurt	Yoghurt /whit choc. Apricot pieces 108986 page 19
	snack bars	Pure oat granola 108986 page 16
	coconut milk	Coco nut milk 112161 page 34
30	Rice	Red camargue rice 108691 page 1
	flour	Coconut flour 112161 page 35
	preparations made from cereals	Wheat lasagne 108691 page 1
	bread	Rice and sunflower bread 108691 page 1
	cookies	Sunflower cookie 108691 page 8
	honey	Agave nectar 108691 page 4
	mustard	Wholegrain mustard 108691 page 1
	vinegar	Cider vinegar 108691 page 4
	sauces	Pepper sauce 108691 page 1
	boiled sweets	Sour snakes 108691 page 5. These are jellies not boiled sweets.
	cereal food bars	Pure oat granola 108986 page 16
	chocolate bars	milk chocolate almonds 108691 page 7
	mayonnaise	mayonnaise 108691 page 2
	pasta	Wheat lasagne 108691 page 1
	pizza bases	Mini pizza bases 108986 page 10
	pasta sauces	Tuscan pasta sauce 108691 page 1
	Ketchup	Tomato ketchup 108691 page 2
	Marinades	Wasabi style paste 108986 page 12
	muesli bars	Pure oat granola 108986 page 16
	peppermint sweets	Peppermints 108691 page 2
	pesto sauce	Pesto 111273 page 21
	cereal based snacks	Amaranth wild berry museli 108691 page 2
	curry sauces	Thai curry paste 108986 page 15
	Muesli	Amaranth wild berry museli 108691 page 2
	candy bars	milk chocolate almonds 108691 page 7
32	vegetable juices	Vegetable juice 108986 page 16

9) The second witness statement, dated 9 October 2015, is by Mr Williams who has provided evidence earlier in this case. He simply states that the additional evidence was filed after it was noticed by Counsel that the earlier evidence did not meet the Proof of Use requirements.

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

DECISION

11) At the hearing there was an initial discussion as to whether the further evidence of the opponent filed less than a week prior to the hearing should be accepted into the case. The applicant did not oppose the evidence being allowed in as it believes that the marks and goods are dissimilar.

12) There is only one ground of opposition which is under section 5(2)(b) which reads:

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

(a)

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

13) An “earlier trade mark” is defined in section 6, the relevant part of which states:

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

(a) a registered trade mark, international trade mark (UK) or Community trade mark which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks.”

14) The opponent is relying upon its trade mark listed in paragraph 3 above which is clearly an earlier trade mark having been applied for on 16 March 2007. The applicant requested that the opponent provide proof of use and, given the interplay between the date that the opponent’s mark was registered (14 September 2007) and the date that the applicant’s mark was published (25 July 2014) then Section 6A comes into play. Section 6A of the Act states:

“6A Raising of relative grounds in opposition proceedings in cases of non-use.

(1) This section applies where-

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

(b) there is an earlier trade mark 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, 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.

(7) Nothing in this section affects –

(a) the refusal of registration on the grounds mentioned in section 3 (absolute grounds for refusal) or section 5(4) (relative grounds of refusal on the basis of an earlier right), or

(b) the making of an application for a declaration of invalidity under section 47(2) (application on relative grounds where no consent to registration).”

15) I must first consider whether the opponent has fulfilled the requirement to show that genuine use of its mark has been made. In the instant case the publication date of application 3062031 was 25 July 2014, therefore the relevant period for the proof of use is 26 July 2009 – 25 July 2014. In *Stichting BDO v BDO Unibank, Inc.*, [2013] F.S.R. 35 (HC), Arnold J. stated as follows:

“51. Genuine use. 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]".

16) 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.

17) Also in *Laboratoire de la Mer* Trade Mark [2006] FSR 5, the Court of Appeal held that sales under the mark to the trade may qualify as genuine use. Mummery L.J. stated that:

“31. After some hesitation I have reached a different conclusion from Blackburne J. on the application of the Directive, as interpreted in *Ansul* and *La Mer* , to the rather slender facts found by Dr Trott.”

32. Blackburne J. interpreted and applied the rulings of the Court of Justice as placing considerably more importance on the market in which the mark comes to the attention of *consumers and end users* of the goods than I think they in fact do. I agree with Mr Tritton that the effect of Blackburne J.'s judgment was to erect a quantitative and qualitative test for market use and market share which was not set by the Court of Justice in its rulings. The Court of Justice did not rule that the retail or end user market is the only relevant market on which a mark is used for the purpose of determining whether use of the mark is genuine.

33. Trade marks are not only used on the market in which goods bearing the mark are sold to consumers and end users. A market exists in which goods bearing the mark are sold by foreign manufacturers to importers in the United Kingdom. The goods bearing the LA MER mark were sold by Goëmar and bought by Health Scope Direct on that market in arm's length transactions.

The modest amount of the quantities involved and the more restricted nature of the import market did not prevent the use of the mark on the goods from being genuine use on the market. The Court of Justice made it clear that, provided the use was neither token nor internal, imports by a single importer could suffice for determining whether there was genuine use of the mark on the market.

34. There was some discussion at the hearing about the extent to which Goëmar was entitled to rely on its intention, purpose or motivation in the sales of the goods bearing the mark to Health Scope Direct. I do not find such factors of much assistance in deciding whether there has been genuine use. I do not understand the Court of Justice to hold that subjective factors of that kind are relevant to genuine use. What matters are the objective circumstances in which the goods bearing the mark came to be in the United Kingdom. The presence of the goods was explained, as Dr Trott found, by the UK importer buying and the French manufacturer selling quantities of the goods bearing the mark. The buying and selling of goods involving a foreign manufacturer and a UK importer is evidence of the existence of an economic market of some description for the goods delivered to the importer. The mark registered for the goods was used on *that* market. That was sufficient use for it to be genuine use on the market and in *that* market the mark was being used in accordance with its essential function. The use was real, though modest, and did not cease to be real and genuine because the extinction of the importer as the single customer in the United Kingdom prevented the onward sale of the goods into, and the use of the mark further down, the supply chain in the retail market, in which the mark would come to the attention of consumers and end users.”

18) Whilst Neuberger L.J. (as he then was) stated:

“48. I turn to the suggestion, which appears to have found favour with the judge, that in order to be “genuine”, the use of the mark has to be such as to be communicated to the ultimate consumers of the goods to which it is used. Although it has some attraction, I can see no warrant for such a requirement, whether in the words of the directive, the jurisprudence of the European Court, or in principle. Of course, the more limited the use of the mark in terms of the person or persons to whom it is communicated, the more doubtful any tribunal may be as to whether the use is genuine as opposed to token. However, once the mark is communicated to a third party in such a way as can be said to be “consistent with the essential function of a trademark” as explained in [36] and [37] of the judgment in *Ansul*, it appears to me that genuine use for the purpose of the directive will be established.

49. A wholesale purchaser of goods bearing a particular trademark will, at least on the face of it, be relying upon the mark as a badge of origin just as much as a consumer who purchases such goods from a wholesaler. The fact that the wholesaler may be attracted by the mark because he believes that the consumer will be attracted by the mark does not call into question the fact that the mark is performing its essential function as between the producer and the wholesaler.”

19) When considering the evidence filed I take into account the comments in *Awareness Limited v Plymouth City Council*, Case BL O/230/13, where Mr Daniel Alexander Q.C. as the Appointed Person stated that:

“22. The burden lies on the registered proprietor to prove use..... However, it is not strictly necessary to exhibit any particular kind of documentation, but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of

use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public.”

and further at paragraph 28:

“28. I can understand the rationale for the evidence being as it was but suggest that, for the future, if a broad class, such as “tuition services”, is sought to be defended on the basis of narrow use within the category (such as for classes of a particular kind) the evidence should not state that the mark has been used in relation to “tuition services” even by compendious reference to the trade mark specification. The evidence should make it clear, with precision, what specific use there has been and explain why, if the use has only been narrow, why a broader category is nonetheless appropriate for the specification. Broad statements purporting to verify use over a wide range by reference to the wording of a trade mark specification when supportable only in respect of a much narrower range should be critically considered in any draft evidence proposed to be submitted.”

20) I also look to the case of *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*, Case BL 0/404/13, where Mr Geoffrey Hobbs Q.C. as the Appointed Person stated that:

“21. The assessment of a witness statement for probative value necessarily focuses upon its sufficiency for the purpose of satisfying the decision taker with regard to whatever it is that falls to be determined, on the balance of probabilities, in the particular context of the case at hand. As Mann J. observed in *Matsushita Electric Industrial Co. v. Comptroller- General of Patents* [2008] EWHC 2071 (Pat); [2008] R.P.C. 35:

[24] As I have said, the act of being satisfied is a matter of judgment. Forming a judgment requires the weighing of evidence and other factors. The evidence required in any particular case where satisfaction is required depends on the nature of the inquiry and the nature and purpose of the decision which is to be made. For example, where a tribunal has to be satisfied as to the age of a person, it may sometimes be sufficient for that person to assert in a form or otherwise what his or her age is, or what their date of birth is; in others, more formal proof in the form of, for example, a birth certificate will be required. It all depends who is asking the question, why they are asking the question, and what is going to be done with the answer when it is given. There can be no universal rule as to what level of evidence has to be provided in order to satisfy a decision-making body about that of which that body has to be satisfied.

22. When it comes to proof of use for the purpose of determining the extent (if any) to which the protection conferred by registration of a trade mark can legitimately be maintained, the decision taker must form a view as to what the evidence does and just as importantly what it does not ‘show’ (per Section 100 of the Act) with regard to the actuality of use in relation to goods or services covered by the registration. The evidence in question can properly be assessed for sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use.”

21) All of the use of the opponent’s mark is by WOL but this is with the consent of the opponent (*Einstein Trade Mark*, [2007] RPC 23). Although no agreement was filed in evidence the issue of the consent was not challenged by the applicant. In its submissions the opponent accepted that it had not

used its mark upon certain goods. This was added to at the hearing following a discussion regarding the evidence provided. The amended list of goods upon which the opponent's mark has not been used is as follows:

- Class 29: cheese, olives, tofu, bouillon, tahini, vegetarian sausages and burgers, hummus, potato crisps, peanut butter, relishes, dried herbs; herb salt; pates and spreads; savoury snacks.
- Class 30: coffee, cocoa, tea, artificial coffee, pasties, yeast, chutneys, herb teas, flapjacks, pretzels, marzipan, cakes, salad dressing and puffed rice; crispbread, rice cakes, boiled sweets.
- Class 32: beers and bottled water.

22) In its statement of grounds the opponent contended that it had used its mark in the UK since 1978. However, in the initial evidence of its solicitor the only use put forward was a list of products, and two invoices. Both of the invoices were dated February 2015 seven months after the period of use which is the five years prior to the publication of the mark in suit. In its further evidence the opponent showed that it had used its mark upon the following (see paragraph 8):

- Class 29: Edible oils and fats, milk products, canned beans & pulses, baked beans in tomato sauce, butter, margarines and spreads, nut butters, canned tomatoes, pickled vegetables, creamed coconut, tomato concentrate, prepared soups, yogurt, snack bars, coconut milk.
- Class 30: rice, flour and preparations made from cereals, bread, cookies, honey, mustard, vinegar, sauces, cereal food bars, chocolate bars, mayonnaise, pasta, pizza bases, pasta sauces, ketchup, marinades, muesli bars, peppermint sweets, pesto sauce, cereal based snacks, curry sauces, muesli, candy bars.
- Class 32: Vegetable juices

23) This evidence was not challenged and no cross examination sought. Although all sales shown were to two retailers, this is acceptable as genuine use. Both retailers are well known and have outlets throughout the UK. In determining the specification upon which the opponent has used its mark I take into account the views of Mr Justice Arnold (as he now is) in his judgments as The Appointed Person in *Nirvana Trade Mark BL O-262-06* and *Extreme Trade Mark BL O-161-07* where he comprehensively examined the case law in this area. In the instant case it is simply a matter of blue lining the original specification. Therefore, for the purposes of the comparison the opponent's specification will be as follows:

- Class 29: Edible oils and fats, milk products, canned beans & pulses, baked beans in tomato sauce, butter, margarines and spreads, nut butters, canned tomatoes, pickled vegetables, creamed coconut, tomato concentrate; prepared soups, yogurt, snack bars, pesto sauce; coconut milk.
- Class 30: rice, flour and preparations made from cereals, bread, cookies, honey, mustard, vinegar, sauces, boiled sweets, cereal food bars, chocolate bars, mayonnaise, pasta, pizza bases, pasta sauces, ketchup, marinades, muesli bars, peppermint sweets, cereal based snacks, curry sauces, muesli, candy bars.

- Class 32: vegetable juices.

24) When considering the issue under section 5(2)(b) I take into account the following principles which 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.

(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 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 and the nature of the purchasing decision

25) As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods; I must then determine the manner in which these goods are likely to be selected by the average consumer in the course of trade. 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.”

26) Both parties' specifications cover, broadly speaking food items in class 30. As such they would be aimed at both the general public and also at businesses retailing the products. Such goods will be sold in, inter alia, traditional retail outlets on the high street, and on the Internet. The applicant contended that they would be sold in different parts of the shop, the applicant's goods in the ambient aisle and the opponent's goods in the chilled aisle. However, neither parties' specification is limited in this manner, and so both specifications must be viewed as covering both types of goods (ambient and chilled). The average consumer of the goods at issue is a member of the general public including businesses who is likely, in my opinion, to select the goods mainly by visual means, although I accept that in certain outlets e.g. delicatessens, the sales assistant may be spoken to in relation to the selection process. Clearly, the average consumer's level of attention will vary considerably depending on the cost and nature of the item at issue. However, to my mind even when selecting routine inexpensive items of food, the average consumer will pay attention to considerations such as quality, origin, taste and cost. Overall the average consumer is likely to pay a reasonable degree of attention to the selection of items of food.

Comparison of goods

27) In the judgment of the Court of Justice of the European Union (CJEU) 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”.

28) 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.

29) For ease of reference the goods of the two parties are as follows:

Applicant's goods	Opponent's goods
Class 30: Alimentary pasta; Calzones; Cannelloni; Chilled pizzas; Deep frozen pasta; Dried pasta; Dried pasta foods; Dried sauce in powder form; Dried tortellini; Extruded savoury snackfoods; Filled pasta; Fresh pasta; Fresh pizza; Frozen pizzas; Gnocchi; Instant noodles; Instant pudding mixes; Lasagna; Lasagne; Macaroni; Macaroni cheese; Macaroni [uncooked]; Noodle-based prepared meals; Noodles; Pasta; Pasta containing eggs; Pasta containing fillings; Pasta containing stuffings; Pasta dishes; Pasta preserves; Pasta products; Pizza; Pizzas; Pizzas [prepared]; Pre-cooked dishes; Prepared meals containing [principally] pasta; Prepared meals containing [principally] rice; Prepared meals in the form of pizzas; Prepared pasta dishes; Prepared pasta meals; Prepared rice dishes; Puffed corn snacks; Ravioli; Ravioli [prepared]; Ready-made dishes containing pasta.	Class 29: Edible oils and fats, milk products, canned beans & pulses, baked beans in tomato sauce, butter, margarines and spreads, nut butters, canned tomatoes, pickled vegetables, creamed coconut, tomato concentrate; prepared soups, yogurt, snack bars, pesto sauce; coconut milk. Class 30: rice, flour and preparations made from cereals, bread, cookies, honey, mustard, vinegar, sauces, boiled sweets, cereal food bars, chocolate bars, mayonnaise, pasta, pizza bases, pasta sauces, ketchup, marinades, muesli bars, peppermint sweets, cereal based snacks, curry sauces, muesli, candy bars. Class 32: vegetable juices.

30) To my mind:

- “Alimentary pasta; Deep frozen pasta; Dried pasta; Dried pasta foods; Dried tortellini; Fresh pasta; Instant noodles; Lasagna; Lasagne; Macaroni; Macaroni [uncooked]; Noodles; Pasta; Pasta containing eggs; Pasta preserves; Pasta products” are identical to the terms “pasta; preparations made from cereals,” in Class 30 of the opponent’s specification.
- “Cannelloni; Filled pasta; ; Macaroni cheese; Noodle-based prepared meals; Pasta containing fillings; Pasta containing stuffings; Pasta dishes; Prepared meals containing [principally] pasta; Prepared pasta dishes; Prepared pasta meals; Ravioli; Ravioli [prepared]; Ready-made dishes containing pasta” are identical or very similar to the terms “pasta, pizza bases” in the opponent’s specification.
- “Calzones; Chilled pizzas; Fresh pizza; Frozen pizzas; Pizza; Pizzas; Pizzas [prepared]; Prepared meals in the form of pizzas” are identical or very similar to the term “pizza bases” in Class 30 of the opponent’s specification.

- “Dried sauce in powder form” is identical to the terms “Sauces; curry sauces” in Class 30 of the opponent’s specification.
- “Extruded savory snackfoods; Puffed corn snacks” are similar to the term “cereal based snacks” in Class 30 of the opponent’s specification.
- “Pre-cooked dishes; Instant pudding mixes:” are similar to the terms “pizza bases; marinades” in Class 30 and “soups” in class 29 of the opponent’s specification.
- “Prepared meals containing [principally] rice; Prepared rice dishes” are similar to the terms “rice” in Class 30 and “soups” in class 29 of the opponent’s specification.

31) However, the applicant disputed that “Gnocchi” was a form of pasta. The applicant contended that its’ Gnocchi was made of potato mixed with corn or rice flour to bind it together, creating a gluten free product. Whilst the opponent contended that Gnocchi is a form of pasta or at least is an alternative to pasta. To my mind, gnocchi is at least an alternative to pasta in which case it would be viewed as highly similar. Alternatively it could be seen as a different type of pasta as corn crisps and potato crisps are different types of crisps and therefore identical. I also note that the opponent’s specification has no restriction and so would encompass gluten free products.

Distinctive character of the earlier trade mark

32) 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 *Windsurfing Chiemsee 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).”

33) The opponent’s mark consists of the single word “BIONA” in plain block capitals. In its’ counterstatement the applicant stated that the term BIO is commonly known and used in the food/drink industry as meaning healthy. This was accepted by the opponent as in its submissions it stated:

“30. Conceptually, both marks relate to something being “bio” which is comply [sic] known in the food/drink industry a [sic] meaning healthy”.


34) Although the opponent also contends that its mark is inherently distinctive as “it is a made up word”. It also contends that its mark has acquired distinctiveness as a result of the use made of the mark. Whilst I accept that although the beginning of the mark is the term BIO the whole mark consists of an invented word. It therefore has a high degree of inherent distinctiveness. However, I do not accept that the mark can benefit from enhanced distinctiveness as a result of the use shown in evidence. In the witness statement, Mr McDonald states that the turnover in the mark was £11.8 million in 2013 and £15 million in 2014. I note that the mark is registered for, broadly speaking, foodstuffs in classes 29 & 30 as well as beers and water in class 32. MsChantrielle contended that as no use of the mark on beer or water had been demonstrated then all the use should be regarded as being on goods in classes 29 & 30. I do not accept this contention. The witness does not state clearly that the turnover relates only to the goods for which the mark is registered in classes 29 and 30. It is possible that the mark may have been used on other goods which may or may not include beers and water, there is an absence of clarity. If the sales figures related solely to the goods for which the opponent had provided proof of use it would have been quite easy for Mr McDonald to state this restriction. However, even if the figures do only relate to the sales of those items for which evidence of use has been provided, I can take judicial note that the market for such foodstuffs in the UK would be very significant. Although the sales figures provided are not insignificant they do not amount to an enhanced distinctiveness, but merely average reputation and distinctiveness.

Comparison of trade marks

35) 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 them, bearing in mind their distinctive and dominant components. The CJEU 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.”

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

Opponents’ trade mark	Applicant’s trade mark
BIONA	

37) I note firstly that the applicant's mark is not subject to a colour limitation and no use of the mark in suit has been provided. I shall therefore consider the applicant's mark in suit as black and white.

38) The opponent contended:

"27. The Earlier Mark consists of one word 'BIONA'. The Trade Mark consists of the word 'BIONITA' and the device is a green oval-shaped border around the word. The word element of the Trade Mark is the distinctive and dominant element of the mark. The dominant element of the Earlier Mark is the word BIONA.

28. The first four letters of the marks, B,I,O,N as well as the last letter, A, are the same. The Trade Mark has an extra I and T in the middle of the word. They are visually similar to a high degree.

29. Aurally, the marks only differ by one syllable, created by the extra letters, I and T, in the Earlier Mark. They are aurally similar to a high degree.

30. Conceptually, both marks relate to something being "bio", which is commonly known in the food/drink industry a meaning healthy (§5 of the Amended Counterstatement, [tab 4]). They are conceptually identical."

39) The applicant contended that its device mark consists of a bright green oval with the word BIONITA written in white in a slightly undulating banner. The applicant states that the first three letters of the opponent's mark is the well known word BIO which is commonly used in the food/drink industry as meaning healthy. The applicant draws attention to the differences in the two marks in terms of length and pronunciation.

40) I do not regard the device element or the undulating script of the applicant's mark to be dominant or particularly distinctive. Although these elements must be taken into account in the overall comparison test. Visually the word elements of the competing marks share the first four letters and the last letter. The difference between these elements is that the applicant's mark has two additional letters in the middle of the mark. Aurally the beginnings and endings of the marks are similar, BIONAR and BIONEETAR, and the device element does not come into play. Conceptually the marks both have a healthy connotation as they start with BIO but overall neither mark has a meaning. **Despite the differences between the marks, and the stylisation and device element, the marks are, to my mind, visually and aurally similar to at least a medium degree and conceptually neutral.**

Likelihood of confusion

41) In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is 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 goods and vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the opponents' trade marks as the more distinctive this trade mark is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind. Earlier in this decision, I concluded that:

- the average consumer is a member of the general public (including businesses), who will select the goods by predominantly visual means and who will pay only a reasonable degree of care when doing so;
- As set out in paragraph 30 above the following items of the applicant’s specification are identical to the opponent’s goods: Alimentary pasta; Deep frozen pasta; Dried pasta; Dried pasta foods; Dried tortellini; Fresh pasta; Instant noodles; Lasagna; Lasagne; Macaroni; Macaroni [uncooked]; Noodles; Pasta; Pasta containing eggs; Pasta preserves; Pasta products; Dried sauce in powder form”
- Whilst the following items are, at least, highly similar: “Cannelloni; Filled pasta; ; Macaroni cheese; Noodle-based prepared meals; Pasta containing fillings; Pasta containing stuffings; Pasta dishes; Prepared meals containing [principally] pasta; Prepared pasta dishes; Prepared pasta meals; Ravioli; Ravioli [prepared]; Ready-made dishes containing pasta; Calzones; Chilled pizzas; Fresh pizza; Frozen pizzas; Pizza; Pizzas; Pizzas [prepared]; Prepared meals in the form of pizzas; Gnocchi”
- The following goods are merely similar to those of the opponent: “Extruded savory snackfoods; Puffed corn snacks; Pre-cooked dishes; Instant pudding mixes; Prepared meals containing [principally] rice; Prepared rice dishes”
- In comparing the mark in suit to the opponent’s mark they are visually and aurally similar at least to a medium degree and conceptually neutral.
- the opponent’s earlier trade mark has a high level of inherent distinctiveness but cannot benefit from an enhanced distinctiveness.

42) In view of the above and allowing for the concept of imperfect recollection, even when those goods which are merely similar are taken into account, there is a likelihood of consumers being confused into believing that the goods provided by the applicant are those of the opponent or provided by some undertaking linked to it. The applicant has contended that it has the mark BIONITA registered already and has been using the mark for some time, but these are no defence in an opposition under section 5 of the Act. **The opposition under Section 5(2) (b) therefore succeeds in full.**

CONCLUSION

43) As the opponent has been successful it is entitled to a contribution towards its costs. I note that the opponent filed evidence only days before the hearing, which gave the unrepresented applicant little time to digest the contents or consider its position. I also note that in the skeleton argument and during the hearing reference was made to invalidity and revocation despite the case being a simple opposition. This again would have caused the applicant undue stress. I have therefore adjusted the costs awarded to the opponent slightly downwards.

Expenses	£100
Preparing a statement and considering the other side’s statement	£200
Preparing evidence	£300
Preparing for and attending a hearing	£600
TOTAL	£1,200

44) I order Foodreef Limited t/a BIONITA to pay Noel McDonald the sum of £1200. This sum to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 5th day of November 2015

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