

**O/714/19**

**TRADE MARKS ACT 1994**

**CONSOLIDATED PROCEEDINGS IN THE MATTER OF TRADE MARK  
APPLICATIONS NOS. 3149626, 3256451 AND 3256514  
IN THE NAME OF SCA INVESTMENTS LTD.**

**AND**

**OPPOSITIONS NOS. 406722, 411174 AND 411180  
BY GIULIANI S.P.A.**

## BACKGROUND AND PLEADINGS

1. This case consists of three oppositions by Giuliani S.P.A. (“the opponent”) to three applications by SCA Investments Ltd (“the applicant”) to register six trade marks consisting of, or containing, the word GOUSTO.

2. The first application under number 3149626 (“the First Application”) is for the mark Gousto. It was filed on 12 February 2016 and was published for opposition purposes on 4 March 2016.

3. The second application under number 3256451 (“the Second Application”) is for the following series of four marks. It was filed on 13 September 2017 and was published for opposition purposes on 29 September 2017:



4. The third application under number 3256514 (“the Third Application”) is for the following series of two marks. It was filed on 13 September 2017 and was published for opposition purposes on 29 September 2017:



5. The lists of goods and services for which the applicant wishes to register these marks are as follows:

## THE FIRST APPLICATION

*Class 29: Meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs, milk and milk products; edible oils and fats; prepared meals; soups and potato crisps; Almonds, ground; Almonds (prepared-); Anchovy; Apple chips; Apple purée; Artichokes; Aubergine paste; Bacon; Beans; Beefburgers; Blended butter; Blended cheese; Blended oil [for food]; Blood sausage; Blue cheese; Bottled fruits; Bottled vegetables; Bouillon; Broccoli; Broth; Bulgogi [Korean beef dish]; Burgers; Butter; Butter (Peanut -); Buttercream; Buttermilk; Caesar salad; Candied fruits; Canned cooked meat; Canned fruits; Canned tomatoes; Canola oil; Carrots; Cashew nuts (prepared-); Casseroles [food]; Charcuterie; Cheese; Cheese products; Cheese spreads; Cheeseburgers; Chick peas; Chicken; Chicken croquettes; Chicken nuggets; Chicken salad; Chili con carne; Chilled dairy desserts; Chilli; Chilli beans; Chilli oil; Chipped potatoes; Chips [french fries]; Chips (Fruit -); Chips (Potato -); Chitterlings; Chocolate milk; Chocolate nut butter; Chop suey; Chowder; Clams [not live]; Coated peanuts; Cocktail onions; Cocoa butter; Coconut; Coconut butter; Coconut, desiccated; Coconut fat; Coconut flakes; Coconut milk for culinary purposes; Coconut oil and fat [for food]; Coconut powder; Coconut shrimp; Cods [not live]; Coleslaw; Colza oil for food; Compotes; Concentrates (Bouillon -); Condensed milk; Condensed tomatoes; Consommés; Cooked dish consisting primarily of chicken and ginseng (samgyetang); Cooked dish consisting primarily of fermented vegetable, pork and tofu (kimchi-jjigae); Cooked dish consisting primarily of rich soybean paste and tofu (cheonggukjang-jjigae); Cooked dish consisting primarily of soybean paste and tofu (doenjang-jjigae); Cooked dish consisting primarily of stired-fried beef and fermented soy sauce (Sogalbi); Cooked dish consisting primarily of stir-fried chicken and fermented hot pepper paste (dak-galbi); Cooked meat dishes; Cooked snails; Cooking fats; Cooking oils; Corn dogs; Corn oil; Corn snacks [other than confectionery]; Corned beef; Corned beef hash; Cornichons; Cottage cheese; Cows' milk; Crab; Cranberry sauce [compote]; Crayfish, not live; Cream; Creme fraiche; Crisps; Crisps (Potato -); Croquettes; Crustaceans, not live; Crystallized fruits; Cucumber Kimchi [Oi-sobagi]; Curd; Curd cheese; Curdled milk; Currants; Custard style yoghurts; Dahls; Dairy desserts; Dairy produce; Dairy puddings; Dairy spreads;*

*Dairy-based beverages; Dairy-based dips; Dairy-based whipped topping; Dates; Deep-frozen poultry; Desserts made from milk products; Dill pickles; Dips; Dishes of fish; Dried beef; Dried coconuts; Dried cranberries; Dried dates; Dried durians; Dried edible mushrooms; Dried edible seaweed (hoshi-wakame); Dried edible tremella fuciformis; Dried eggs; Dried figs; Dried flakes of laver for sprinkling on rice in hot water (ochazuke-nori); Dried fruit mixes; Dried fruit products; Dried fruits; Dried mangoes; Dried meat; Dried pawpaws; Dried persimmon (Got-gam); Dried pieces of agar jelly (kanten); Dried pineapples; Dried prawns; Dried pulses; Dried soya beans; Dried squid; Dried truffles [edible fungi]; Drinking yogurts; Drinks made from dairy products; Dry whey; Duck eggs; Dulce de leche [condensed milk]; Edible birds' nests; Edible dried flowers; Edible fats; Edible frogs, not live; Edible oils and fats; Edible seaweed; Edible seeds; Eels, not live; Egg nog (Non-alcoholic -); Eggplant paste; Eggs; Extracts of poultry; Extracts of vegetables [juices] for cooking; Faggots [food]; Falafel; Fermented bamboo shoots boiled and preserved in salt (menma); Fermented bean curd; Fermented milk; Fermented soybeans (natto); Fermented vegetable foods [kimchi]; Fermented vegetables (kimchi); Ferments (Milk -) for culinary purposes; Filled potato skins; Fillets (Fish -); Fish; Fish crackers; Fish croquettes; Fish eggs for human consumption; Fish fillets; Fish (Food products made from -); Fish, not live; Fish, preserved; Fish stock; Fish, tinned [canned (Am.)]; Flavored nuts; Flavoured milk; Foie gras; Food pastes made from meat; Foods prepared from fish; Frankfurters; French fries; Fresh meat; Fresh poultry; Fresh unripened cheeses; Fromage frais; Fruit conserves; Fruit desserts; Fruit jams; Fruit jellies; Fruit juices for cooking; Fruit marmalade; Fruit paste; Fruit peel; Fruit, preserved; Fruit preserves; Fruit puree; Fruit rinds; Fruit salads; Fruit snacks; Fruit spread; Fruit-based snack food; Game, not live; Garden peas; Garlic butter; Garlic paste; Garlic [preserved]; Gelatine; Ghee; Gherkins; Goat milk; Guacamole; Guava paste; Gumbo; Haggis; Ham; Hamburgers; Hardened oils [hydrogenated oil for food]; Hash brown potatoes; Hazelnut spread; Hazelnuts, prepared; Herrings; Honey butter; Hotdog sausages; Hummus; Jerky; Kefir; Lamb products; Legume salads; Lemon curd; Lemon spread; Lentils; Liver; Margarine; Meat; Meat, preserved; Meat stocks; Meat substitutes; Meat, tinned [canned (Am.)]; Meatballs; Milk and milk products; Milk of almonds for culinary purposes; Milk products; Mincemeat [chopped meat]; Mixed pickles; Mould-ripened cheese; Mushrooms,*

*prepared; Mushrooms, preserved; Mushrooms puree; Mussels, not live; Nut oils; Nuts, prepared; Octopuses [not live]; Offal; Olive oil; Olive oil for food; Olive paste; Olives, [prepared]; Olives, preserved; Oysters [not live, for human consumption]; Packaged meats; Palm oil for food; Pastrami; Peanut butter; Peanut paste; Peeled tomatoes; Pickles; Pork cutlets; Pork loin; Pork preserves; Potato cakes; Potato chips; Potato crisps; Potato croquettes; Potato dumplings; Potato flakes; Potato fritters; Potato pancakes; Potato puffs; Potato salad; Poultry, not live; Powdered eggs; Prawns, not live; Preparations for making soups; Prepared coconut; Prepared dishes consisting principally of meat; Prepared entrees consisting primarily of seafood; Prepared fruits; Prepared meals consisting primarily of meat substitutes; Prepared meals consisting principally of game; Prepared meals consisting substantially of seafood; Prepared meals containing [principally] bacon; Prepared meals containing [principally] chicken; Prepared meals containing [principally] eggs; Prepared meals made from meat [meat predominating]; Prepared meals made from poultry [poultry predominating]; Prepared meat dishes; Prepared meat; Prepared pistachio; Prepared rootstocks; Prepared salads; Prepared snails [escargot]; Prepared walnuts; Preserved vegetables; Processed legumes; Processed lychee fruit; Processed olive puree; Processed olives; Processed peaches; Processed peas; Processed pumpkin seeds; Processed sweet potatoes; Pulp (Fruit -); Pulses [for food]; Quark; Quenelles; Ragouts; Raisins; Ready grated cheese; Ripened cheese; Roast beef; Roast chestnuts; Salads (Fruit -); Salads (Vegetable -); Salami; Salmon [not live]; Salted fish; Sauerkraut; Sausages; Seafood [not live]; Seafood products; Seasoned nuts; Shellfish, not live; Shepherd's pie; Shortening; Sliced meat; Smoked fish; Smoked meats; Snack food (Fruit-based -); Snack foods based on legumes; Snack foods based on nuts; Snack foods based on vegetables; Soft cheese; Soup cubes; Soup (Preparations for making -); Soup preparations (Vegetable -); Soups; Soya bean curd; Soya [prepared]; Stem ginger; Stewed fruits; Stock cubes; Stock [prepared]; Sultanas; Tofu; Tomato concentrates [puree]; Tomato paste; Tomato purée; Tripe; Tuna fish; Turkey; Vegetable burgers; Vegetable puree; Vegetable salads; Vegetable spreads; Vegetables, cooked; Yams; Yellow split peas; Yoghurt; Yoghurt desserts; Yogurt; Zucchini.*

Class 30: *Coffee, tea, cocoa, sugar, rice, tapioca, flour and preparations made from cereals, bread, pastry and confectionery; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; sandwiches; prepared meals; pizzas, pies and pasta dishes.*

6. The First Application is opposed in full<sup>1</sup>.

#### THE SECOND APPLICATION AND THE THIRD APPLICATION

Class 16: *Recipe cards; printed matter relating to food and drink; instructional and teaching material relating to food and drink.*

Class 21: *Kitchen equipment for cooking and baking; lemon squeezers; mixing bowls, chopping boards, cooking pots, cooking pans, ovenware; kitchen utensils; pastry brushes, mixing spoons, spatulas and sieves; oven gloves, rubber gloves for domestic use.*

Class 29: *Meat, fish, poultry and game; processed fruit; tinned fruit; dried fruit; processed vegetables; tinned vegetables, dried vegetables; pulses and legumes (processed, tinned or dried); prepared meals principally containing eggs, meat, fish, poultry or game; dairy produce namely eggs, milk, yoghurt, cheese; oils and fats for cooking and consumption.*

Class 30: *Coffee, tea, cocoa, sugar, rice, tapioca, flour and preparations made from cereals, bread, pastry and confectionery; honey; treacle; yeast; baking powder; salt, mustard, spices; vinegar; sauces (condiments); sandwiches; prepared meals consisting principally of rice or of pasta; pizzas, pies and pasta dishes.*

Class 31: *Agricultural, horticultural and forestry products; fresh fruit and fresh vegetables, seeds, natural plants and flowers.*

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<sup>1</sup> The application originally included other classes, namely classes 21, 31, 33 and 39. However, it was later divided into two applications with the application number 3181970 proceeding to registration (achieved on 02 September 2016) in relation to the classes 31, 31, 33 and 39 which were not opposed.

Class 33: Alcoholic beverages (except beers), namely, alcoholic wines, spirits and liqueurs, alcoholic cocktails.

Class 39: Transport; packaging and storage of goods.

7. The Second and the Third Application are partially opposed, with the oppositions being directed only against the goods in classes 29 and 30.

8. The opponent opposes the registration of these marks under Section 5(2)(b) of the Act. In each opposition, the opponent relies on the same three trade marks:

(i) GIUSTO

EUTM 14743918 (“the 918 Earlier Mark”)

Filing date 29 October 2015; registration date 2 May 2019.

Relying on some goods and services for which the mark is registered, namely:

Class 29: Fruit products; Jellies; Marmalade; Jams; Fruit sauce; Preserved, frozen, dried and cooked fruits and vegetables; Eggs; Milk and milk products; Edible oils and fats.

Class 30: Dietetic pastries and desserts; Sugar-free pastries and desserts; sugarless chocolate; Desserts and pastry for people with food intolerances; Desserts and pastry for diabetics; Sweeteners (Natural -); Coffee; Tea; Sugar; Rice; Tapioca; Sago; Artificial coffee; Flour and preparations made from cereals; Bread; Honey; Syrups and treacles; Yeast; Baking powders.

(ii) **Giusto**

International Registration 893777 (“the 777 Earlier Mark”)

Priority date 30 December 2005; International registration date 9 February 2006; Date protection granted in EU 19 July 2007.

Relying on some goods and services for which the mark is registered, namely:

Class 30: flour and preparations made from cereals, bread, pastry and confectionery.



(iii)

EUTM 12062642 (“the 642 Earlier Mark”)

Filing date 13 August 2013; registration date 24 October 2015.

Relying on some goods and services for which the mark is registered, namely:

Class 29: Fruit products; Jellies; Marmalade; Jams; Fruit sauce; Preserved, frozen, dried and cooked fruits and vegetables; Eggs; Milk and milk products; Edible oils and fats.

Class 30: Dietetic pastries and desserts; Sugar-free pastries and desserts; Desserts and pastry for people with food intolerances; Desserts and pastry for diabetics; Coffee; Tea; Sugar; Rice; Tapioca; Sago; Artificial coffee; Flour and preparations made from cereals; Bread; Honey; Golden syrup; Yeast; Baking powders.

9. The opponent’s marks have filing dates that are earlier than the filing dates of the applications and, therefore, they are earlier marks in accordance with Section 6 of the Act. The 918 Earlier Mark and the 642 Earlier Mark had not completed their registration process more than 5 years before the publication dates of the contested applications and are not subject to proof of use as per Section 6A of the Act. As regards the 777 Earlier Mark, since the conferring of protection had been completed more than 5 years before the publication of the contested applications, in order to rely on this mark, the opponent needs to show genuine use of the mark.

10. The opponent claims that there is a likelihood of confusion under Section 5(2)(b) because the respective goods are identical or similar and the marks are similar.



11. The applicant filed counterstatements defending its applications and denying all grounds relied upon by the opponent in respect of all three applications. It also requested that the opponent provides evidence of proof of use in respect of the 777 Earlier Mark for all the goods identified by the opponent. The applicant argues, in particular, that the word GIUSTO in the opponent's marks is a word of Italian origin which means "right", "quite right", "just" or "equitable". According to the applicant, it is widely used in Italy in relation to foodstuff and it is non-distinctive. The applicant also states that the word GOUSTO in the applications is a made-up word created by combining the English words "gusto" and "gourmet".

12. The proceedings were consolidated following the filing of the opponents' evidence. This decision, therefore, covers all three oppositions.

13. Both parties filed evidence in these proceedings. This will be summarised to the extent that is considered necessary. Neither party requested a hearing, but they both filed written submissions in lieu of a hearing.

14. The opponent is represented by Stevens, Hewlett & Perkins; the applicant by HGF Limited. I now make this decision after a careful consideration of the papers before me.

### **Preliminary issue**

15. At the time of writing this decision, there is an ongoing application for declaration of invalidity against the 918 Earlier Mark in the EUIPO. That application was brought by the applicant on the basis that the mark has a known meaning in Italian and is descriptive and/or non-distinctive. On 29 May 2019, the applicant requested suspension of these proceedings pending the resolution of the invalidity action. In a letter dated 16 July 2019, the opponent objected to the suspension claiming that the application is unfounded and that, in any event, the EUIPO decision will not affect the opponent's position in the UK because, even if the mark were to be invalidated, the opponent could still apply to convert the invalidated mark into a UK national mark. On 29 August 2019, the registrar wrote to the parties advising that the proceedings would continue on the basis that (1) should the invalidity action succeed, the opponent could,

under Article 139 of the new EUTMR, request the conversion of his EU trade mark into a national UK trade mark application; (2) the national trade mark application resulting from the conversion of the opponent's EU trade mark would enjoy, in respect of the UK, the date of filing of that trade mark and (3) there appeared to be no reasons why an application for conversion of the opponent's EUTM into a UK mark would be refused since the word GIUSTO had no meaning in English and the grounds for invalidity would not apply in the UK. The letter closed by stating that if either party disagreed they could request a hearing. No such hearing was requested.

### **The opponent's evidence**

#### *Witness statements of Mr Paolo Scaroni*

16. Mr Paolo Scaroni, the opponent's President, filed a witness statements dated 14 February 2018 accompanied by 8 exhibits. I have read Mr Scaroni's statements in their entirety and, in particular, I note as follows:

- (a) The opponent is an Italian company established in 1889. GIUSTO is one of the opponent's brands. It is used in relation to foodstuff intended for diabetics and celiacs. The brand was first used in 2003 by the opponent's predecessor and has been in continuous use ever since. The opponent acquired the brand in 2005;
- (b) The opponent's largest market is Italy, but it also has a number of outlets within the EU;
- (c) Turnover generated by the sale of GIUSTO branded products in the EU is as follows:

2011	Over £10,250,000
2012	Over £11,250,000
2013	Over £11,875,000
2014	Over £12,500,000
2015	Over £12,000,000

(d) EU advertising spend for GIUSTO branded products since 2011 is as follows:

2011 (March – December)	£673,000
2012	£735,000
2013	£874,000
2014	£973,000
2015	£1,053,000
2016 (January - March)	£ 216,000

(e) Exhibits PS2-3 contain a list of GIUSTO products available in 2015 supported by pictures of product packaging. They also include copies of the opponent's catalogues for the Irish (2010) and the Italian market (2010-2015). The Irish catalogue is in English and displays an Irish website incorporating both the brand GIUSTO and the opponent's name GIULIANI, i.e. [www.giustogiuliani.ie](http://www.giustogiuliani.ie). Mr Scaroni says that these products were available in Ireland between 2010 and 2016. Exhibit PS6 includes examples of advertising and press coverage in Italy for the period 2012-2016 (without translation). This material shows use of both the word GIUSTO and the marks shown below, on a range of gluten-free products, such as pasta, biscuits, cookies, bread, pizza bases, flour mixes, cereals, croissants, pastries, celebration cakes and cakes/snacks:



Although some of the documents produced are in Italian, it is still possible to see what are the categories of goods on which the marks are used;

(f) Exhibit PS5 consists of a selection of invoices relating to products sold in Bulgaria, Malta, Italy and Ireland dated between 2011 and 2016. The invoices are issued under the opponent's name GIULIANI. Although the brand Giusto does not appear on the invoices, Mr Scaroni points out that it is possible to cross-reference the article codes on the invoices with the list of articles codes for GIUSTO branded products exhibited at Exhibit PS2.

Witness statement of Gaetano Colabucci

17. Mr Colabucci, the opponent CEO, filed a witness statement dated 13 November 2018. He states that the opponent's GIUSTO food products are available in an increasing number of countries in the EU, but the opponent does not yet distribute its products in the UK.

Witness statement of Julie Gonard

18. Ms Gonard is a trade mark attorney at Stevens, Hewlett & Perkins. Her evidence includes two Internet searches for the word GIUSTO conducted using online English dictionaries (Exhibits JG1-2). One search produced no results, another showed that GIUSTO is a word of Italian origin which has, in English, a technical meaning in the field of music, i.e. *allegro giusto*. Ms Gonard also states that she asked 19 colleagues to pronounce the word GIUSTO and that suggested pronunciations included (1) "djioosto", "djisto" and "djiootso" with the first syllable being pronounced with a soft G like in "genius" and (2) "gioosto", "goosto" and "guy-oosto" with the first syllable being pronounced with a hard G like in "ga" or "giggle".

**The applicant's evidence**

Witness statement of Sharon Wilson

19. Sharon Wilson, the Vice President of Brand at the applicant, filed two witness statements dated 14 June 2018 and 5 July 2018 respectively. Ms Wilson explains that the applicant has operated under the brand GOUSTO since 2012 in relation to a range of recipe kits. She says that the applicant provides a weekly subscription service whereby consumers can select which recipe they require each week, and which delivers a box of ingredients for the meal consumers have selected. Ms Wilson also provide sales figures for the period 2016-2017 and details of marketing activity, all of which indicates that the applicant runs a successful business in the UK under the brand GOUSTO.

Witness statement of Jennifer Good

20. Ms Good is a trade mark attorney at HGF Limited. She provides at Exhibit JKG1 a print-out from the Collins English-Italian Dictionary showing that the word GIUSTO translates as “just”, “fair”, “right”, “correct” and “exact”.

21. As these proceedings were not consolidated until after the filing of the opponent’s evidence, the parties filed further witness statements. However, these witness statements were only a vehicle for re-introducing the evidence which had already been filed.

**Proof of use**

22. As I have already pointed out, the opponent’s 777 Earlier Mark is subject to proof of use. Consequently, Section 6A of the Act applies. The relevant parts are as follows:

“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 European Union 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 Union.

(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.”

### **Relevant period**

23. The relevant period in which genuine use must be established is the five-year period ending on the dates of publication of the applied for marks, i.e. 8 April 2016 – 9 April 2011 and 29 September 2017 – 30 September 2012. Under Section 100 of the Act, the onus is on the opponent to show what use it has made of its 777 Earlier Mark during the relevant periods.

## Case-law

24. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J summarised the law relating to genuine use as follows:

“114.....The CJEU has considered what amounts to “genuine use” of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bunderversvereinigung Kamaradschaft ‘Feldmarschall Radetsky’* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases may be summarised as follows:

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

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* at [29].

(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 to distinguish the goods or services from others which have another origin: *Ansul* at [36];

*Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14] and [22]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71]; *Reber* at [29].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at



[22]-[23]; *Sunrider* at [70]-[71], [76]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving 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. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72] and [76]-[77]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

25. As the 777 Earlier Mark is an IR which has been conferred protection in the EU, the comments of the Court of Justice of the European Union (“CJEU”) in *Leno Marken BV v Hagelkruis Beheer BV*, Case C-149/11, are relevant. The court noted that:

“36. It should, however, be observed that..... the territorial scope of the use is not a separate condition for genuine use but one of the factors determining genuine use, which must be included in the overall analysis and examined at the same time as other such factors. In that regard, the phrase ‘in the Community’ is intended to define the geographical market serving as the reference point for all consideration of whether a Community trade mark has been put to genuine use.”

And

“50. Whilst there is admittedly some justification for thinking that a Community trade mark should – because it enjoys more extensive territorial protection than a national trade mark – be used in a larger area than the territory of a single

Member State in order for the use to be regarded as 'genuine use', it cannot be ruled out that, in certain circumstances, the market for the goods or services for which a Community trade mark has been registered is in fact restricted to the territory of a single Member State. In such a case, use of the Community trade mark on that territory might satisfy the conditions both for genuine use of a Community trade mark and for genuine use of a national trade mark."

And

"55. Since the assessment of whether the use of the trade mark is genuine is carried out by reference to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark serves to create or maintain market shares for the goods or services for which it was registered, it is impossible to determine a priori, and in the abstract, what territorial scope should be chosen in order to determine whether the use of the mark is genuine or not. A *de minimis* rule, which would not allow the national court to appraise all the circumstances of the dispute before it, cannot therefore be laid down (see, by analogy, the order in *La Mer Technology*, paragraphs 25 and 27, and the judgment in *Sunrider v OHIM*, paragraphs 72 and 77)."

26. The court held that:

"Article 15(1) of Regulation No 207/2009 of 26 February 2009 on the Community trade mark must be interpreted as meaning that the territorial borders of the Member States should be disregarded in the assessment of whether a trade mark has been put to 'genuine use in the Community' within the meaning of that provision.

A Community trade mark is put to 'genuine use' within the meaning of Article 15(1) of Regulation No 207/2009 when it is used in accordance with its essential function and for the purpose of maintaining or creating market share within the European Community for the goods or services covered by it. It is for the referring court to assess whether the conditions are met in the main proceedings, taking account of all the relevant facts and circumstances,

including the characteristics of the market concerned, the nature of the goods or services protected by the trade mark and the territorial extent and the scale of the use as well as its frequency and regularity.”

27. In *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*, [2016] EWHC 52, Arnold J. reviewed the case law since the *Leno* case and concluded as follows:

“228. Since the decision of the Court of Justice in *Leno* there have been a number of decisions of OHIM Boards of Appeal, the General Court and national courts with respect to the question of the geographical extent of the use required for genuine use in the Community. It does not seem to me that a clear picture has yet emerged as to how the broad principles laid down in *Leno* are to be applied. It is sufficient for present purposes to refer by way of illustration to two cases which I am aware have attracted comment.

229. In Case T-278/13 *Now Wireless Ltd v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* the General Court upheld at [47] the finding of the Board of Appeal that there had been genuine use of the contested mark in relation to the services in issues in London and the Thames Valley. On that basis, the General Court dismissed the applicant's challenge to the Board of Appeal's conclusion that there had been genuine use of the mark in the Community. At first blush, this appears to be a decision to the effect that use in rather less than the whole of one Member State is sufficient to constitute genuine use in the Community. On closer examination, however, it appears that the applicant's argument was not that use within London and the Thames Valley was not sufficient to constitute genuine use in the Community, but rather that the Board of Appeal was wrong to find that the mark had been used in those areas, and that it should have found that the mark had only been used in parts of London: see [42] and [54]-[58]. This stance may have been due to the fact that the applicant was based in Guildford, and thus a finding which still left open the possibility of conversion of the Community trade mark to a national trade mark may not have sufficed for its purposes.

230. In *The Sofa Workshop Ltd v Sofaworks Ltd* [2015] EWHC 1773 (IPEC), [2015] ETMR 37 at [25] His Honour Judge Hacon interpreted *Leno* as establishing that "genuine use in the Community will in general require use in more than one Member State" but "an exception to that general requirement arises where the market for the relevant goods or services is restricted to the territory of a single Member State". On this basis, he went on to hold at [33]-[40] that extensive use of the trade mark in the UK, and one sale in Denmark, was not sufficient to amount to genuine use in the Community. As I understand it, this decision is presently under appeal and it would therefore be inappropriate for me to comment on the merits of the decision. All I will say is that, while I find the thrust of Judge Hacon's analysis of *Leno* persuasive, I would not myself express the applicable principles in terms of a general rule and an exception to that general rule. Rather, I would prefer to say that the assessment is a multi-factorial one which includes the geographical extent of the use."

28. The General Court (GC) restated its interpretation of *Leno Marken* in Case T-398/13, *TVR Automotive Ltd v OHIM* (see paragraph 57 of the judgment). This case concerned national (rather than local) use of what was then known as a Community trade mark (now a European Union trade mark). Consequently, in trade mark opposition and cancellation proceedings the registrar continues to entertain the possibility that use of an EUTM in an area of the Union corresponding to the territory of one Member State may be sufficient to constitute genuine use of an EUTM. This applies even where there are no special factors, such as the market for the goods/services being limited to that area of the Union.

29. Whether the use shown is sufficient for this purpose will depend on whether there has been real commercial exploitation of the EUTM, in the course of trade, sufficient to create or maintain a market for the goods/services at issue in the Union during the relevant period. In making the required assessment I am required to consider all relevant factors, including:

- i) The scale and frequency of the use shown
- ii) The nature of the use shown
- iii) The goods and services for which use has been shown

- iv) The nature of those goods/services and the market(s) for them
- iv) The geographical extent of the use shown

### Findings on proof of use

30. Although the turnover figures are not broken down by product, it is clear that the opponent has used the trade mark GIUSTO during the relevant periods in relation to a range of gluten-free products including pasta, bread and cakes. It is also clear that the opponent has sold in excess of £50 million worth of goods in the EU during the relevant periods and that the opponent's main market is Italy.

31. Turning to whether the mark has been used in an acceptable form, one of the



marks used on the goods is in this form

which is slightly different from the registered **Giusto**. The opponent has also used the plain word GIUSTO. Section 6A(4)(a) enables an opponent to rely on use of a mark *“in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered.”* In *Nirvana Trade Mark*, BL O/262/06, Mr Richard Arnold Q.C. (as he then was) as the Appointed Person summarised the test under Section 46(2) of the Act (which is analogous to Section 6A(4)(a)) as follows:

“33. [...] The first question [in a case of this kind] is what sign was presented as the trade mark on the goods and in the marketing materials during the relevant period...

34. The second question is whether that sign differs from the registered trade mark in elements which do not alter the latter's distinctive character. As can be seen from the discussion above, this second question breaks down in the sub-questions, (a) what is the distinctive character of the registered trade mark, (b) what are the differences between the mark used and the registered trade mark and (c) do the differences identified in (b) alter the distinctive character identified in (a)? An affirmative answer to the second question does not depend upon the average consumer not registering the differences at all”.

32. The distinctive character of the 777 Earlier Mark resides, in my view, in the word GIUSTO. The figurative element consists in a small symbol on the top of the lower case ‘i’ which might be perceived as a crown or a decorative element and has an ornamental function. Likewise, the stylisation in the mark used is minimal and the differences consist simply in the stroke of the letter ‘t’ being slightly elongated and in the decorative element being replaced by a tittle. The words GLUTEN FREE are merely descriptive and do not alter the distinctive character of the mark. The same goes for the Italian equivalent, i.e. SENZA GLUTINE. In my view, the word GIUSTO and the variant marks used can all be considered an acceptable variant of the 777 Earlier Mark.

33. I am satisfied that the opponent has demonstrated genuine use of its 777 Earlier Mark in the EU during the relevant periods in relation to a large range of gluten-free products. I therefore consider the following to be a fair specification:

*Class 30: gluten-free flour and gluten-free preparations made from cereals, bread, pastry and confectionery.*

## **DECISION**

34. Section 5(2)(b) of the Act reads:

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

[...]

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

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

35. 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:

- (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 greater 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.

### **Comparison of goods**

36. In comparing the respective specifications, all the relevant factors should be taken into account. In the judgment of the CJEU in *Canon*, (Case C-39/97), the Court stated at paragraph 23:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary”.

37. 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 uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;



- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

38. In *Kurt Hesse v OHIM* (Case C-50/15 P), the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v OHIM*, (Case T-325/06), the General Court (GC) stated that “complementary” means:

“...there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking”.

39. Further, the law requires that goods be considered identical where one party’s description of its goods encompasses the specific goods covered by the other party’s description (and vice versa): see *Gérard Meric v OHIM*, Case T-33/05.

40. The opponent filed, as part of its evidence,<sup>2</sup> a table identifying identical and similar goods. The applicant did not make any specific submissions in relation to the similarity of the goods.

## **The approach**

41. I shall start by comparing the goods of the First Application with the goods of the earlier marks. As the list of the opposed goods in the specification of the Second and

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<sup>2</sup> Witness statement of Mr Paolo Scaroni at Exhibit PS8

Third applications are identical, I will consider these applications together. Likewise, as the specifications relied upon under the 918 and 642 Earlier Marks are nearly identical, I will consider them together.

42. For the purposes of considering the issue of similarity of goods, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way for the same reasons<sup>3</sup>.

### **THE FIRST APPLICATION**

<b>The applicant's goods</b>	<b>The opponent's goods</b>
<p><u>Class 29</u>: Meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs, milk and milk products; edible oils and fats; prepared meals; soups and potato crisps; Almonds, ground; Almonds (prepared-); Anchovy; Apple chips; Apple purée; Artichokes; Aubergine paste; Bacon; Beans; Beefburgers; Blended butter; Blended cheese; Blended oil [for food]; Blood sausage; Blue cheese; Bottled fruits; Bottled vegetables; Bouillon; Broccoli; Broth; Bulgogi [Korean beef dish]; Burgers; Butter; Butter (Peanut -); Buttercream; Buttermilk; Caesar salad; Candied fruits; Canned cooked meat; Canned fruits; Canned tomatoes; Canola oil; Carrots; Cashew nuts (prepared-); Casseroles [food]; Charcuterie; Cheese; Cheese products; Cheese spreads;</p>	<p><b>The 918 Earlier Mark</b></p> <p><u>Class 29</u>: Fruit products; Jellies; Marmalade; Jams; Fruit sauce; Preserved, frozen, dried and cooked fruits and vegetables; Eggs; Milk and milk products; Edible oils and fats.</p> <p><u>Class 30</u>: Dietetic pastries and desserts; Sugar-free pastries and desserts; sugarless chocolate; Desserts and pastry for people with food intolerances; Desserts and pastry for diabetics; Sweeteners (Natural -); Coffee; Tea; Sugar; Rice; Tapioca; Sago; Artificial coffee; Flour and preparations made from cereals; Bread; Honey; Syrups and treacles; Yeast; Baking powders</p>
	<p><b>The 777 Earlier Mark</b></p> <p><u>Class 30</u>: gluten-free flour and gluten-free preparations made from cereals, bread, pastry and confectionery.</p>

<sup>3</sup> *Separode* Trade Mark BL O-399-10

*Cheeseburgers; Chick peas; Chicken; Chicken croquettes; Chicken nuggets; Chicken salad; Chili con carne; Chilled dairy desserts; Chilli; Chilli beans; Chilli oil; Chipped potatoes; Chips [french fries]; Chips (Fruit -); Chips (Potato -); Chitterlings; Chocolate milk; Chocolate nut butter; Chop suey; Chowder; Clams [not live]; Coated peanuts; Cocktail onions; Cocoa butter; Coconut; Coconut butter; Coconut, desiccated; Coconut fat; Coconut flakes; Coconut milk for culinary purposes; Coconut oil and fat [for food]; Coconut powder; Coconut shrimp; Cods [not live]; Coleslaw; Colza oil for food; Compotes; Concentrates (Bouillon -); Condensed milk; Condensed tomatoes; Consommés; Cooked dish consisting primarily of chicken and ginseng (samgyetang); Cooked dish consisting primarily of fermented vegetable, pork and tofu (kimchi-jjigae); Cooked dish consisting primarily of rich soybean paste and tofu (cheonggukjang-jjigae); Cooked dish consisting primarily of soybean paste and tofu (doenjang-jjigae); Cooked dish consisting primarily of stired-fried beef and fermented soy sauce (Sogalbi); Cooked dish consisting primarily of stir-fried chicken and fermented hot pepper paste (dak-galbi); Cooked meat dishes; Cooked snails; Cooking fats; Cooking oils; Corn dogs;*

**The 642 Earlier Mark**

Class 29: *Fruit products; Jellies; Marmalade; Jams; Fruit sauce; Preserved, frozen, dried and cooked fruits and vegetables; Eggs; Milk and milk products; Edible oils and fats.*

Class 30: *Dietetic pastries and desserts; Sugar-free pastries and desserts; Desserts and pastry for people with food intolerances; Desserts and pastry for diabetics; Coffee; Tea; Sugar; Rice; Tapioca; Sago; Artificial coffee; Flour and preparations made from cereals; Bread; Honey; Golden syrup; Yeast; Baking powders.*

*Corn oil; Corn snacks [other than confectionery]; Corned beef; Corned beef hash; Cornichons; Cottage cheese; Cows' milk; Crab; Cranberry sauce [compote]; Crayfish, not live; Cream; Creme fraiche; Crisps; Crisps (Potato -); Croquettes; Crustaceans, not live; Crystallized fruits; Cucumber Kimchi [Oisobagi]; Curd; Curd cheese; Curdled milk; Currants; Custard style yoghurts; Dahls; Dairy desserts; Dairy produce; Dairy puddings; Dairy spreads; Dairy-based beverages; Dairy-based dips; Dairy-based whipped topping; Dates; Deep-frozen poultry; Desserts made from milk products; Dill pickles; Dips; Dishes of fish; Dried beef; Dried coconuts; Dried cranberries; Dried dates; Dried durians; Dried edible mushrooms; Dried edible seaweed (hoshi-wakame); Dried edible tremella fuciformis; Dried eggs; Dried figs; Dried flakes of laver for sprinkling on rice in hot water (ochazuke-nori); Dried fruit mixes; Dried fruit products; Dried fruits; Dried mangoes; Dried meat; Dried pawpaws; Dried persimmon (Got-gam); Dried pieces of agar jelly (kanten); Dried pineapples; Dried prawns; Dried pulses; Dried soya beans; Dried squid; Dried truffles [edible fungi]; Drinking yogurts; Drinks made from dairy products; Dry whey; Duck eggs; Dulce de leche*

*[condensed milk]; Edible birds' nests; Edible dried flowers; Edible fats; Edible frogs, not live; Edible oils and fats; Edible seaweed; Edible seeds; Eels, not live; Egg nog (Non-alcoholic -); Eggplant paste; Eggs; Extracts of poultry; Extracts of vegetables [juices] for cooking; Faggots [food]; Falafel; Fermented bamboo shoots boiled and preserved in salt (menma); Fermented bean curd; Fermented milk; Fermented soybeans (natto); Fermented vegetable foods [kimchi]; Fermented vegetables (kimchi); Ferments (Milk -) for culinary purposes; Filled potato skins; Fillets (Fish -); Fish; Fish crackers; Fish croquettes; Fish eggs for human consumption; Fish fillets; Fish (Food products made from -); Fish, not live; Fish, preserved; Fish stock; Fish, tinned [canned (Am.)]; Flavored nuts; Flavoured milk; Foie gras; Food pastes made from meat; Foods prepared from fish; Frankfurters; French fries; Fresh meat; Fresh poultry; Fresh unripened cheeses; Fromage frais; Fruit conserves; Fruit desserts; Fruit jams; Fruit jellies; Fruit juices for cooking; Fruit marmalade; Fruit paste; Fruit peel; Fruit, preserved; Fruit preserves; Fruit puree; Fruit rinds; Fruit salads; Fruit snacks; Fruit spread; Fruit-based snack food; Game, not live; Garden peas; Garlic butter; Garlic paste; Garlic [preserved]; Gelatine; Ghee;*

*Gherkins; Goat milk; Guacamole; Guava paste; Gumbo; Haggis; Ham; Hamburgers; Hardened oils [hydrogenated oil for food]; Hash brown potatoes; Hazelnut spread; Hazelnuts, prepared; Herrings; Honey butter; Hotdog sausages; Hummus; Jerky; Kefir; Lamb products; Legume salads; Lemon curd; Lemon spread; Lentils; Liver; Margarine; Meat; Meat, preserved; Meat stocks; Meat substitutes; Meat, tinned [canned (Am.)]; Meatballs; Milk and milk products; Milk of almonds for culinary purposes; Milk products; Mincemeat [chopped meat]; Mixed pickles; Mould-ripened cheese; Mushrooms, prepared; Mushrooms, preserved; Mushrooms puree; Mussels, not live; Nut oils; Nuts, prepared; Octopuses [not live]; Offal; Olive oil; Olive oil for food; Olive paste; Olives, [prepared]; Olives, preserved; Oysters [not live, for human consumption]; Packaged meats; Palm oil for food; Pastrami; Peanut butter; Peanut paste; Peeled tomatoes; Pickles; Pork cutlets; Pork loin; Pork preserves; Potato cakes; Potato chips; Potato crisps; Potato croquettes; Potato dumplings; Potato flakes; Potato fritters; Potato pancakes; Potato puffs; Potato salad; Poultry, not live; Powdered eggs; Prawns, not live; Preparations for making soups;*

*Prepared coconut; Prepared dishes consisting principally of meat; Prepared entrees consisting primarily of seafood; Prepared fruits; Prepared meals consisting primarily of meat substitutes; Prepared meals consisting principally of game; Prepared meals consisting substantially of seafood; Prepared meals containing [principally] bacon; Prepared meals containing [principally] chicken; Prepared meals containing [principally] eggs; Prepared meals made from meat [meat predominating]; Prepared meals made from poultry [poultry predominating]; Prepared meat dishes; Prepared meat; Prepared pistachio; Prepared rootstocks; Prepared salads; Prepared snails [escargot]; Prepared walnuts; Preserved vegetables; Processed legumes; Processed lychee fruit; Processed olive puree; Processed olives; Processed peaches; Processed peas; Processed pumpkin seeds; Processed sweet potatoes; Pulp (Fruit - ); Pulses [for food]; Quark; Quenelles; Ragouts; Raisins; Ready grated cheese; Ripened cheese; Roast beef; Roast chestnuts; Salads (Fruit -); Salads (Vegetable -); Salami; Salmon [not live]; Salted fish; Sauerkraut; Sausages; Seafood [not live]; Seafood products; Seasoned nuts; Shellfish, not live; Shepherd's pie; Shortening; Sliced meat;*

*Smoked fish; Smoked meats; Snack food (Fruit-based -); Snack foods based on legumes; Snack foods based on nuts; Snack foods based on vegetables; Soft cheese; Soup cubes; Soup (Preparations for making -); Soup preparations (Vegetable -); Soups; Soya bean curd; Soya [prepared]; Stem ginger; Stewed fruits; Stock cubes; Stock [prepared]; Sultanas; Tofu; Tomato concentrates [puree]; Tomato paste; Tomato purée; Tripe; Tuna fish; Turkey; Vegetable burgers; Vegetable puree; Vegetable salads; Vegetable spreads; Vegetables, cooked; Yams; Yellow split peas; Yoghurt; Yoghurt desserts; Yogurt; Zucchini.*

*Class 30: Coffee, tea, cocoa, sugar, rice, tapioca, flour and preparations made from cereals, bread, pastry and confectionery; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; sandwiches; prepared meals; pizzas, pies and pasta dishes.*

**Comparison between the First Application and the 918 and 642 Earlier Marks**

**Class 29**

43. Since the 918 and 642 Earlier Marks cover identical specifications in class 29, the following findings apply to both earlier marks.



44. The following goods in the applicant's specification are either identical to or fall within the opponent's terms *Fruit products; Jellies; Marmalade; Jams; Fruit sauce; Preserved, dried and cooked fruits and vegetables* and so are identical on the principle outlined in *Meric*. To the extent that some of the goods listed below include nuts and pulses, if not identical, they are highly similar to the opponent's *preserved, dried and cooked fruit and vegetables*:

*Preserved, dried and cooked fruits and vegetables; jellies, jams, compotes; Almonds, ground; Almonds (prepared-); Apple chips; Apple purée; Artichokes; Beans; Bottled fruits; Bottled vegetables; Broccoli; Candied fruits; Canned fruits; Canned tomatoes; Carrots; Cashew nuts (prepared-); Chick peas; Chilli beans; Chips (Fruit -); Coated peanuts; Cocktail onions; Coconut; Coconut, desiccated; Coconut flakes; Coconut powder; Compotes; Cornichons; Cranberry sauce [compote]; Crystallized fruits; Cucumber Kimchi [Oi-sobagi]; Currants; Dahls; Dates; Dill pickles; Dried coconut; Dried cranberries; Dried dates; Dried durians; Dried edible mushrooms; Dried edible seaweed (hoshi-wakame); Dried edible tremella fuciformis; Dried figs; Dried flakes of laver for sprinkling on rice in hot water (ochazuke-nori); Dried fruit mixes; Dried fruit products; Dried fruits; Dried mangoes; Dried pawpaws; Dried persimmon (Got-gam); Dried pieces of agar jelly (kanten); Dried pineapples; Dried pulses; Dried soya beans; Dried truffles [edible fungi]; Edible dried flowers; Edible seaweed; Edible seeds; Flavored nuts; Fruit conserves; Fruit Desserts; Fruit jams; Fruit jellies; Fruit juices for cooking; Fruit marmalade; Fruit paste; Fruit peel; Fruit, preserved; Fruit preserves; Fruit puree; Fruit rinds; Fruit salads; Fruit snacks; Fruit spread; Fruit-based snack food; Garden peas; Garlic [preserved]; Gelatine; Gherkins; Hazelnuts, prepared; Legume salads; Lemon curd; Lemon spread; Lentils; Mixed pickles; Mushrooms, prepared; Mushrooms, preserved; Nuts, prepared; Peeled tomatoes; Pickles; Prepared coconut; Prepared fruits; Prepared pistachio; Prepared rootstocks; Prepared salads; Prepared walnuts; Preserved vegetables; Processed legumes; Processed lychee fruit; Processed peaches; Processed peas; Processed pumpkin seeds; Processed sweet potatoes; Pulp (Fruit -); Pulses [for food]; Raisins; Roast chestnuts; Salads (Fruit -); Salads (Vegetable -); Sauerkraut; Seasoned nuts; Snack food (Fruit-based); Snack food based on legumes; Snack food based on nuts; Snack food based on vegetables; Soya [prepared]; Stem ginger; Stewed fruits; Sultanas; Vegetable salads; Vegetables, cooked; Potato salad; Yams; Yellow split peas; Zucchini.*

45. Even if not identical to the opponent's *preserved, dried and cooked fruits and vegetables*, the following goods are, at least, similar to a high degree as they have a highly similar nature and purpose, can have the same producers and distribution channels and target the same end users:

*Aubergine paste; Chilli; Condensed tomatoes; Eggplant paste; Extracts of vegetables [juices] for cooking; Fermented bamboo shoots boiled and preserved in salt (menma); Fermented soybeans (natto); Fermented vegetable foods [kimchi]; Fermented vegetables (kimchi); Garlic paste; Guava paste; Mushrooms puree; Olive paste; Olives, [prepared]; Olives, preserved; Processed olive puree; Processed olives; Corn snacks [other than confectionery]; Tomato concentrates [puree]; Tomato paste; Tomato purée; Vegetable puree.*

46. The following goods are at least similar to a low degree to the opponent's *preserved, dried; and cooked fruits and vegetables* as they have the same nature (vegetables processed in some way), producers, distribution channels and might be in competition with each other:

*Soup and Potato crisps; Chipped potatoes; Chips [french fries]; Chips (Potato -); Coleslaw; Crisps; Crisps (Potato -); Croquettes; Dips; Filled potato skins; French fries; Guacamole; Hash brown potatoes; Hummus; Potato cakes; Potato chips; Potato crisps; Potato croquettes; Potato dumplings; Potato flakes; Potato fritters; Potato pancakes; Potato puffs; Preparations for making soups; Soup (Preparations for making -); Soup preparations (Vegetable -).*

47. The following goods in the applicant's specification are either identical to or fall within the opponent's terms *eggs; milk and milk products* and so are identical on the principle outlined in *Meric*:

*Eggs, milk and milk products; Blended butter; Blended cheese; Blue cheese; Butter; Buttercream; Buttermilk; Cheese; Cheese products; Cheese spreads; Chilled dairy desserts; Chocolate milk; Coconut milk for culinary purposes; Condensed milk; Cottage cheese; Cows' milk; Cream; Creme fraiche; Curd; Curd cheese; Curdled milk; Custard style yoghurts; Dairy desserts; Dairy produce; Dairy puddings; Dairy spreads;*

*Dairy-based beverages; Dairy-based dips; Dairy-based whipped topping; Desserts made from milk products; Dried eggs; Drinking yogurts; Drinks made from dairy products; Dry whey; Duck eggs; Dulce de leche [condensed milk]; Eggs; Fermented bean curd; Fermented milk; Ferments (Milk -) for culinary purposes; Fish eggs for human consumption; Flavoured milk; Fresh unripened cheeses; Fromage frais; Garlic butter; Ghee; Goat milk; Honey butter; Kefir; Milk and milk products; Milk products; Milk of almonds for culinary purposes; Mould-ripened cheese; Powdered eggs; Ready grated cheese; Ripened cheese; Soft cheese; Tofu; Yoghurt desserts; Yogurt.*

48. The following goods in the applicant's specification are either identical to or fall within the opponent's term *edible oils and fats* and so are identical on the principle outlined in *Meric*:

*Edible oils and fats; Blended oil [for food]; Butter (Peanut -); Canola oil; Chilli oil; Chocolate nut butter; Cocoa butter; Coconut butter; Coconut fat; Colza oil for food; Cooking fats; Coconut oil and fat [for food]; Cooking oils; Corn oil; Edible fats; Edible oils and fats; Hardened oils [hydrogenated oil for food]; Margarine; Nut oils; Olive oil; Olive oil for food; Palm oil for food; Peanut butter; Vegetable spreads.*

49. The applicant's *Hazelnut spread* is a sweet chocolate-flavored paste which is eaten mostly spread on breads and toasts. The purpose of the goods and the method of use is similar to the opponent's *jams* and the goods are likely to be found in close proximity in the same area of supermarkets and target the same consumers. In my view these goods are similar to a medium degree.

50. The following goods are considered dissimilar to all the goods of the earlier marks in classes 29 and 30, since they are either meat or fish products or prepared meals. Although all of these goods are foodstuffs or relate to foodstuffs, they cater for different dietary needs. Moreover, they are neither in competition with each other nor complementary and whilst they might all be sold in the same supermarkets they will not be found in particularly close proximity:

*Meat, fish, poultry and game; meat extracts; Prepared meals; Anchovy; Bacon; Beefburgers; Blood sausage; Bouillon; Broth; Bulgogi [Korean beef dish]; Burgers;*

Caesar salad; Canned cooked meat; Casseroles [food]; Charcuterie; Cheeseburgers; Chicken; Chicken croquettes; Chicken nuggets; Chicken salad; Chili con carne; Chitterlings; Chop suey; Chowder; Clams [not live]; Coconut shrimp; Cods [not live]; Concentrates (Bouillon -); Consommés; Cooked dish consisting primarily of chicken and ginseng (samgyetang); Cooked dish consisting primarily of fermented vegetable, pork and tofu (kimchi-jjigae); Cooked dish consisting primarily of rich soybean paste and tofu (cheonggukjang-jjigae); Cooked dish consisting primarily of soybean paste and tofu (doenjang-jjigae); Cooked dish consisting primarily of stired-fried beef and fermented soy sauce (Sogalbi); Cooked dish consisting primarily of stir-fried chicken and fermented hot pepper paste (dak-galbi); Cooked meat dishes; Cooked snails; Corn dogs; Corned beef; Corned beef hash; Crab; Crayfish, not live; Crustaceans, not live; Deep-frozen poultry; Dishes of fish; Dried beef; Dried meat; Dried prawns; Dried squid; Edible birds' nests; Edible frogs, not live; Eels, not live; Egg nog (Non-alcoholic -); Extracts of poultry; Faggots [food]; Falafel; Fillets (Fish -); Fish; Fish crackers; Fish croquettes; Fish fillets; Fish (Food products made from -); Fish, not live; Fish, preserved; Fish stock; Fish, tinned [canned (Am.)]; Foie gras; Food pastes made from meat; Foods prepared from fish; Frankfurters; Fresh meat; Fresh poultry; Game, not live; Gumbo; Haggis; Ham; Hamburgers; Herrings; Hotdog sausages; Jerky; Lamb products; Liver; Meat; Meat, preserved; Meat stocks; Meat substitutes; Meat, tinned [canned (Am.)]; Meatballs; Minced meat [chopped meat]; Mussels, not live; Octopuses [not live]; Offal; Oysters [not live, for human consumption]; Packaged meats; Pastrami; Pork cutlets; Pork loin; Pork preserves; Poultry, not live; Prawns, not live; Prepared dishes consisting principally of meat; Prepared entrees consisting primarily of seafood; Prepared meals consisting primarily of meat substitutes; Prepared meals consisting principally of game; Prepared meals consisting substantially of seafood; Prepared meals containing [principally] bacon; Prepared meals containing [principally] chicken; Prepared meals containing [principally] eggs; Prepared meals made from meat [meat predominating]; Prepared meals made from poultry [poultry predominating]; Prepared meat dishes; Prepared meat; Prepared snails [escargot]; Quark; Quenelles; Ragouts; Roast beef; Salami; Salmon [not live]; Salted fish; Sauerkraut; Sausages; Seafood [not live]; Seafood products; Shellfish, not live; Shepherd's pie; Shortening; Sliced meat; Smoked fish; Smoked meats; Soup cubes; Stock cubes; Stock [prepared]; Tripe; Tuna fish; Turkey; Vegetable burgers.

## Class 30

51. The class 30 specification of the 918 and 642 Earlier Marks is nearly identical, the only difference being that the specification of the 642 Earlier Mark does not cover *sugarless chocolate* and *treacles*.

52. The terms *Coffee, tea, sugar, rice, tapioca, flour and preparations made from cereals, bread, honey, treacle, yeast and baking-powder* are identically contained in the opposing specifications. These goods are identical. To the extent that the 642 Earlier Mark does not cover *treacle*, the applicant's *treacle* is either identical or highly similar the opponent's *Golden Syrup* (which is covered by the 642 Earlier Mark).

53. The applicant's *pastry and confectionery* encompass the opponent's *Dietetic pastries and desserts* and are identical on the principle outlined in *Meric*.

54. The applicant's *sauces (condiments)* are similar to a medium degree to the opponent's *fruit sauces* in class 29. The nature, purpose and uses and methods of use are similar, and the goods includes goods such as mango chutney which can have a fruit base.

55. The applicant's *cocoa* is highly similar to the opponent's *sugarless chocolate*. The nature of the goods is very similar, and the goods usually coincide in producer, relevant public and distribution channels. To the extent that the 642 Earlier Mark does not cover *sugarless chocolate* the applicant's *cocoa* is similar to a low degree to the opponent's bakery products in class 30 as they have a similar nature, are manufactured by the same companies and can be found in the same departments of large supermarkets.

56. The applicant's *sandwiches; prepared meals; pizzas, pies and pasta dishes* (in class 30) are considered dissimilar. Notably, the opponent's list produced at Exhibit PS8 (which identifies identical and similar goods) does not include any of these goods. The closest clash I can see is with the opponent's *bread and flour and preparations made from cereals*, which, in my view would include goods such as cereals, processed grains, and goods made thereof, such as baking preparations. However, whilst these goods may have some point of contact with the opponent's goods, they are not

sufficiently close to establish a similarity. The nature, purpose, uses and methods of use are different, the goods are neither complementary nor in competition and are not likely to be found in close proximity in supermarkets.

57. The applicant's *salt, mustard; vinegar, spices* are also considered dissimilar to all the goods of the 918 and 642 earlier marks in class 29 and 30. Although the goods under comparison all belong to the food industry, this fact alone cannot justify a finding of similarity between them. The nature, purpose, uses and method of use are not particularly similar, the goods are found in different sections in supermarkets and there is neither complementarity nor competition.

### Comparison between the First Application and the 777 Earlier Mark

#### Class 29

58. Under this earlier mark the opponent can rely only on *gluten-free flour and gluten-free preparations made from cereals, bread, pastry and confectionery* in class 30. In the absence of any specific submissions from the opponent on the similarity between the applicant's goods in class 29 and the opponent's gluten-free preparations in class 30, it is not obvious to me why these goods are similar. Accordingly, I find that these goods are dissimilar.

#### Class 30

59. The applicant's *flour and preparations made from cereals, bread, pastry and confectionery* encompass the opponent's *gluten-free flour and preparations made from cereals, bread, pastry and confectionery*. These goods are identical.

60. The applicant's *yeast and baking-powder* are similar to a medium degree to the opponent's *gluten free-flour* as the goods are complementary and are likely to be found in the same sections of supermarkets.

61. The applicant's *coffee, tea, cocoa, sugar, rice, tapioca, honey, treacle; salt, mustard; vinegar, sauces (condiments); spices* are dissimilar to all the opponent's

gluten-free products. The nature, purpose, uses, methods of use are different, the goods are neither complementary nor in competition and are unlikely to be found in the same sections of supermarkets. The same goes for the applicant's *sandwiches; prepared meals; pizzas, pies and pasta dishes*, for the same reasons outlined above.

## **THE SECOND AND THIRD APPLICATION**

<b>The Applicant's goods</b>	<b>The Opponent's goods</b>
<p><u>Class 29:</u> <i>Meat, fish, poultry and game; processed fruit; tinned fruit; dried fruit; processed vegetables; tinned vegetables, dried vegetables; pulses and legumes (processed, tinned or dried); prepared meals principally containing eggs, meat, fish, poultry or game; dairy produce namely eggs, milk, yoghurt, cheese; oils and fats for cooking and consumption.</i></p> <p><u>Class 30:</u> <i>Coffee, tea, cocoa, sugar, rice, tapioca, flour and preparations made from cereals, bread, pastry and confectionery; honey; treacle; yeast; baking powder; salt, mustard, spices and; vinegar; sauces (condiments); sandwiches; prepared meals consisting principally of rice or of pasta; pizzas, pies and pasta dishes.</i></p>	<p><b>The 918 Earlier Mark</b></p> <p><u>Class 29:</u> <i>Fruit products; Jellies; Marmalade; Jams; Fruit sauce; Preserved, frozen, dried and cooked fruits and vegetables; Eggs; Milk and milk products; Edible oils and fats.</i></p> <p><u>Class 30:</u> <i>Dietetic pastries and desserts; Sugar-free pastries and desserts; sugarless chocolate; Desserts and pastry for people with food intolerances; Desserts and pastry for diabetics; Sweeteners (Natural -); Coffee; Tea; Sugar; Rice; Tapioca; Sago; Artificial coffee; Flour and preparations made from cereals; Bread; Honey; Syrups and treacles; Yeast; Baking powders</i></p>
	<p><b>The 777 Earlier Mark</b></p> <p><u>Class 30:</u> <i>flour and preparations made from cereals, bread, pastry and confectionery.</i></p>
	<p><b>The 642 Earlier Mark</b></p> <p><u>Class 29:</u> <i>Fruit products; Jellies; Marmalade; Jams; Fruit sauce; Preserved, frozen, dried and cooked</i></p>

	<p><i>fruits and vegetables; Eggs; Milk and milk products; Edible oils and fats.</i></p> <p><u>Class 30:</u> <i>Dietetic pastries and desserts; Sugar-free pastries and desserts; Desserts and pastry for people with food intolerances; Desserts and pastry for diabetics; Coffee; Tea; Sugar; Rice; Tapioca; Sago; Artificial coffee; Flour and preparations made from cereals; Bread; Honey; Golden syrup; Yeast; Baking powders.</i></p>
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62. As the class 30 specification covered by the Second and Third application is (nearly) identical to that covered by the First Application, the findings I made above in relation to the class 30 specification of the First Application apply here.

63. Turning to the class 29 specification, my conclusion that the class 29 goods of the First Application are dissimilar to the class 30 goods covered by the 777 Earlier Mark also extends to the class 29 goods of the Second and Third applications.

64. Finally, as regard the comparison between the class 29 specification of the Second and Third Application (which are identical) and the class 29 specification of the 918 and 642 Earlier Marks (which are also identical) I find that:

65. The applicant's *processed fruit; tinned fruit; dried fruit; processed vegetables; tinned vegetables, dried vegetables; pulses and legumes (processed, tinned or dried); dairy produce namely eggs, milk, yoghurt, cheese; oils and fats for cooking and consumption* are either identical (self-evidently or on the principle outline in *Meric*) or highly similar to the opponent's *Fruit products; Preserved, frozen, dried and cooked fruits and vegetables; Eggs; Milk and milk products; Edible oils and fats*. The applicant's *Meat, fish, poultry and game; prepared meals principally containing eggs, meat, fish, poultry or game* are dissimilar to the opponent's goods. The goods are



neither in competition with each other nor complementary and whilst they might all be sold in the same supermarkets, they will not be found in particularly close proximity.

### **The average consumer and the nature of the purchasing act**

66. As the case law above indicates, it is necessary for me to determine who the average consumer is for the goods at issue; I must then determine the manner in which these goods will be selected 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.”

67. The goods in question are various foodstuffs. The average consumer of such goods will be a member of the general public. They will be purchased following a visual self-selection process, though aural considerations are not discounted. The level of attention paid upon purchasing the goods will range from below medium to medium.


### **Comparison of marks**






68. 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.”

69. It would be wrong therefore artificially to dissect the 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 marks to be compared are:

Applicant's marks	Opponent's marks
<p>The First Application</p> <p>Gousto</p>	<p>GIUSTO (the 918 Earlier Mark)</p> <p><b>Giusto</b> (the 777 Earlier Mark)</p>  <p>(the 642 Earlier Mark)</p>
<p>The Second Application</p> <p><b>gousto</b></p> <p><b>gousto</b></p> <p><b>gousto</b></p>	<p>GIUSTO (the 918 Earlier Mark)</p> <p><b>Giusto</b> (the 777 Earlier Mark)</p>

	 <p>(the 642 Earlier Mark)</p>
<p>The Third Application</p>  	<p>GIUSTO (the 918 Earlier Mark)</p> <p><b>Giusto</b> (the 777 Earlier Mark)</p>  <p>(the 642 Earlier Mark)</p>

## THE FIRST APPLICATION

### Overall impression

70. The First Application consists of the word Gousto written in title case. In terms of overall impression, the distinctiveness of the mark rests in the whole.

71. The 918 Earlier Mark consists in the word GIUSTO written in upper-case letters. Equally, the distinctiveness of the mark rests in the whole.

72. The 777 Earlier Mark consists in the word Giusto written in title case in a thick typeface with the title of the 'i' being replaced by the device of a small crown. The most distinctive component of the mark is the word GIUSTO with the small device performing an ornamental function and having a minimal visual impact.

73. The 642 mark is a figurative mark consisting of a number of components and presented in the colour green and yellow (predominantly). The first component is the word GIUSTO written in bold title case letters. This element is positioned centrally at the top of the mark and is presented in green, with the title of the 'i' in yellow. It is set against a yellow stripe, that runs vertically in the middle of a green rectangular background with the right-hand corner being uplifted as denoted by a human figure in an active pose. The stripe and the background are in different shades of yellow and green, which contribute to creating the impression of a stylised landscape. On the left-hand corner of the mark there are the Italian words 'linea' and 'EQUILIBRIO', written in cursive yellow letters and in capital white letters respectively. These words, which will be perceived by the relevant public as words of foreign origin, are positioned at a clear distance from the other word element of the mark, i.e. the word GIUSTO, and given their smaller size and positioning are unlikely to be pronounced or feature strongly in the average consumer's perception and recollection of the mark. In my view, both the word element GIUSTO and the synthesis of the figurative elements are the dominant and distinctive elements of the mark, with the words 'linea' and 'EQUILIBRIO' less likely to hold the attention of the relevant public.

#### The First Application and the 918 Earlier Mark

74. Visually, notional and fair use of the parties' word-only marks would include the word being presented in a variety of typescripts, in upper and lower case and in colour. Consequently, the differences created by the use of different casing will be irrelevant. The First Application and the 918 Earlier Mark are both word-only marks and contain the same number of letters, five of which are the same. They differ only in the second letter, which in the First Application is an 'o' and in the 918 Earlier Mark is an 'i'. The applicant states that the word GOUSTO *"is sufficiently different to the opponent's marks to be able to be distinguished"* because the UK public is not familiar with the combination GI but is familiar with the combination GOU from words such as gourmet. The opponent argues that since GIUSTO and GOUSTO appear to be names of foreign origin with which the average consumer is not familiar, it is less likely that the average consumer will remember the exact spelling of the opponent's mark, given the effect of imperfect recollection and considering that differences in the middle of names are less likely to be noticed. In my view, whilst the change of one vowel in relatively short marks

can make an impression, this is offset by the fact that the marks share all the other letters in the same positioning so, in my view, the marks are similar to a high degree.

75. Aurally, the applicant argues that the words GIUSTO and GOUSTO are unlikely to be vocalised in a similar manner. The opponent relies on the evidence that there are various possible pronunciations of the word GIUSTO, however, that evidence also corroborates the applicant's point that the average consumer is likely to struggle when vocalising the word GIUSTO. In my view, whilst some of the possible pronunciations of the word GIUSTO, i.e. GHISTO (like in "giggle"), means that the marks are not aurally identical, they are still similar to, at least, a medium to high degree.

76. Conceptually, the opponent argues that because both words sound Italian, the marks are conceptually similar. The applicant argues that inasmuch as the word GOUSTO will remind the relevant public of the word GUSTO, which means "hearty or keen enjoyment", the marks are conceptually different. I reject both submissions. The earlier mark is GOUSTO not GUSTO, and if one accepts that GOUSTO is evocative of GUSTO, the same could be said of GIUSTO, since there is one-letter difference in each mark. In my view, both marks are likely to be perceived as invented words or words of foreign origin with the conceptual position being neutral.

#### The First Application and the 777 Earlier Mark

77. The figurative element in the 777 Earlier Mark will be perceived as a small crown and an embellishment with minimal distinctive role in the impression of the mark. Whilst this element introduces a point of visual difference, it does not lower the degree of visual similarity to any material extent and I consider that my earlier finding that the marks are visually similar to a high degree stand here. Aurally, the device will not be verbalised, so the aural position is the same to that I found above, i.e. medium to high degree of aural similarity. Conceptually, as the concept of the crown will not affect the perception of GIUSTO and GOUSTO as invented words and will be perceived as laudatory, i.e. as indicative of a premium product, the conceptual position is still neutral.

## The First Application and the 642 Earlier Mark

78. Visually, whilst there are obvious differences between the marks, the element GIUSTO is still the only verbal distinctive element in the opponent's mark by which the mark will be referred to and plays an independent distinctive role within it. Taken overall, the marks have an above low (but not medium) degree of visual similarity. Aurally, as the words 'linea' and 'EQUILIBRIO' are unlikely to be verbalised, the position is the same to that I found above, i.e. medium to high degree of aural similarity. Conceptually, the colours and the figurative elements of the opponent's mark will be perceived as decorative and will not affect the perception of GIUSTO and GOUSTO as invented words, so the conceptual position is still neutral.

## **THE SECOND APPLICATION AND THE THIRD APPLICATION**

79. The Second Application and Third Application consist of two series of four and two marks respectively, all of which incorporate the dominant and distinctive word 'gousto' written in lower-case letters, in the same stylised script. The only difference between the marks is that in the First Application the word 'gousto' is presented either in red or black or in white against a red or black background and in the Second Application it is presented in white against a red or grey background with the words "Good food all around" in a smaller size underneath it. The backgrounds and the colours are banal and will be perceived as decorative whilst the words "Good food all around" are descriptive. Although these additions and the stylisation of the letters have a visual impact, it is not striking and does not alter the overall impression of the marks, which still resides primarily in the word 'gousto'.

80. Comparing these applications with the 918 Earlier Mark, I first reject the applicant's submission that the initial letter 'g' in 'gousto' "*is no longer obviously this letter and appears instead as a stylised 'o' and a smile*". In my view, whilst the letters display a degree of stylisation, the stylisation is not so complex that it makes the initial letter 'g' or the word 'gousto' illegible and will not prevent consumers from identifying the word element 'gousto' in each mark<sup>4</sup>. I also bear in mind that the earlier word mark could

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<sup>4</sup> BL-169-16, *ALTI Trade Mark*

be presented in the same colour and case and a similar typeface of that used in the contested marks. In my view, the marks are visually similar to a medium degree. Aurally and conceptually, the stylisation and the colour will not be verbalised and do not introduce any concept. Likewise, the words “Good food all around” will be perceived as descriptive and will not be pronounced. I therefore consider that the marks are aurally similar to a medium to high degree and conceptually neutral.

81. For similar reasons to those outlined at paragraph 76. I extend the above findings to the 777 Earlier Mark.

82. Finally, as regard the 642 mark, I find that the marks are visually similar to a low degree, aurally similar to a medium to high degree and conceptually neutral.

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

83. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*<sup>26</sup>, 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).”

84. The opponent’s earlier marks consist of or incorporate the word GIUSTO. It appears to be a word of Italian origin which is likely to be perceived by most consumers as an invented word with no meaning and, as such, is endowed with a high level of inherent distinctive character.

85. The opponent has provided evidence of the marks use, but this is all use outside the UK and therefore it cannot show that the marks have acquired an enhanced level of distinctive character through use in the UK.

### **Likelihood of confusion**

86. Similarity between the goods is a prerequisite for a finding of likelihood of confusion. Therefore, since I have not found any similarity to the following applied for goods, the oppositions fail to the following extent:

### **FIRST APPLICATION**

87. The opposition against the First Application fails in relation to the following goods (under all of the three earlier marks relied upon by the opponent):

Class 29: Meat, fish, poultry and game; meat extracts; Prepared meals; Anchovy; Bacon; Beefburgers; Blood sausage; Bouillon; Broth; Bulgogi [Korean beef dish]; Burgers; Caesar salad; Canned cooked meat; Casseroles [food]; Charcuterie; Cheeseburgers; Chicken; Chicken croquettes; Chicken nuggets; Chicken salad; Chili con carne; Chitterlings; Chop suey; Chowder; Clams [not live]; Coconut shrimp; Cods [not live]; Concentrates (Bouillon -); Consommés; Cooked dish consisting primarily of chicken and ginseng (samgyetang); Cooked dish consisting primarily of fermented vegetable, pork and tofu (kimchi-jjigae); Cooked dish consisting primarily of rich soybean paste and tofu (cheonggukjang-jjigae); Cooked dish consisting



*primarily of soybean paste and tofu (doenjang-jjigae); Cooked dish consisting primarily of stired-fried beef and fermented soy sauce (Sogalbi); Cooked dish consisting primarily of stir-fried chicken and fermented hot pepper paste (dak-galbi); Cooked meat dishes; Cooked snails; Corn dogs; Corned beef; Corned beef hash; Crab; Crayfish, not live; Crustaceans, not live; Deep-frozen poultry; Dishes of fish; Dried beef; Dried meat; Dried prawns; Dried squid; Edible birds' nests; Edible frogs, not live; Eels, not live; Egg nog (Non-alcoholic -); Extracts of poultry; Faggots [food]; Falafel; Fillets (Fish -); Fish; Fish crackers; Fish croquettes; Fish fillets; Fish (Food products made from -); Fish, not live; Fish, preserved; Fish stock; Fish, tinned [canned (Am.)]; Foie gras; Food pastes made from meat; Foods prepared from fish; Frankfurters; Fresh meat; Fresh poultry; Game, not live; Gumbo; Haggis; Ham; Hamburgers; Herrings; Hotdog sausages; Jerky; Lamb products; Liver; Meat; Meat, preserved; Meat stocks; Meat substitutes; Meat, tinned [canned (Am.)]; Meatballs; Mincemeat [chopped meat]; Mussels, not live; Octopuses [not live]; Offal; Oysters [not live, for human consumption]; Packaged meats; Pastrami; Pork cutlets; Pork loin; Pork preserves; Poultry, not live; Prawns, not live; Prepared dishes consisting principally of meat; Prepared entrees consisting primarily of seafood; Prepared meals consisting primarily of meat substitutes; Prepared meals consisting principally of game; Prepared meals consisting substantially of seafood; Prepared meals containing [principally] bacon; Prepared meals containing [principally] chicken; Prepared meals containing [principally] eggs; Prepared meals made from meat [meat predominating]; Prepared meals made from poultry [poultry predominating]; Prepared meat dishes; Prepared meat; Prepared snails [escargot]; Quark; Quenelles; Ragouts; Roast beef; Salami; Salmon [not live]; Salted fish; Sauerkraut; Sausages; Seafood [not live]; Seafood products; Shellfish, not live; Shepherd's pie; Shortening; Sliced meat; Smoked fish; Smoked meats; Soup cubes; Stock cubes; Stock [prepared]; Tripe; Tuna fish; Turkey; Vegetable burgers.*

Class 30: *salt, mustard; vinegar, spices; sandwiches; prepared meals; pizzas, pies and pasta dishes.*

88. Alternatively and cumulatively, the opposition against the First Application based on the 777 mark only, fails in relation to the entire class 29 specification and the following goods in the class 30 specification: coffee, tea, cocoa, sugar, rice, tapioca,

honey, treacle; salt, mustard; vinegar; sauces (condiments); spices; sandwiches; prepared meals; pizzas, pies and pasta dishes.

## **SECOND AND THRID APPLICATION**

89. The oppositions against the Second and the Third Application is a partial one. Consequently, regardless of the outcome of this decision, these two applications will proceed to registration in relation to the goods which have not been opposed, namely, class 16, 21, 31, 33 and 39.

90. The oppositions against the Second and Third Application (which are applied for in relation to an identical list of goods) fail in relation to the following goods (under all of the three marks relied upon by the opponent):

Class 29: Meat, fish, poultry and game; prepared meals principally containing eggs, meat, fish, poultry or game.

Class 30: salt, mustard; vinegar, spices; sandwiches; prepared meals consisting principally of rice or of pasta; pizzas, pies and pasta dishes.

91. Alternatively and cumulatively, the oppositions against the Second and Third Application based on the 777 mark only, fails in relation to the entire class 29 specification and the following goods in the class 30 specification: coffee, tea, cocoa, sugar, rice, tapioca, honey, treacle; salt, mustard; vinegar; sauces (condiments); spices; sandwiches; prepared meals consisting principally of rice or of pasta; pizzas, pies and pasta dishes.

92. I shall now turn to the remaining goods to determine if there is a likelihood of confusion. 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 marks may be offset by a greater degree of similarity between the respective goods and vice versa. 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 marks and must instead rely upon the imperfect picture of them he has retained in his mind.

93. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods and services down to the responsible undertakings being the same or related. This distinction was summed up by Mr Iain Purvis Q.C. sitting as the Appointed Person in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10:

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

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

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

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

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

94. Earlier in my decision, I found that most of the goods in question are identical or similar to a high degree with only a few goods being similar to a low and medium degree. The average consumer will select the goods visually, paying a degree of attention ranging from below medium to medium. The most distinctive component of the earlier marks, i.e. the word GIUSTO, is inherently distinctive to a high degree.

95. The opponent relies in each opposition on the same three earlier marks, all of which incorporate the dominant and distinctive word GIUSTO. The 918 Earlier Mark is the closer earlier mark in terms of visual comparison since the figurative elements of the other earlier marks introduce additional visual differences. However, neither the additional descriptive verbal elements, i.e. “Good food all around” and “Linea EQUILIBRIO”, nor the figurative elements (and colour) of the other earlier marks and of the Second and Third Applications, do much to avoid direct and indirect confusion if I proceed, as I must do, on the basis that (1) the words GIUSTO and GOUSTO are still the most (or one of the most) distinctive elements in the marks and (2) the verbal element in the applicant’s stylised marks is still recognisable as GOUSTO. This is because, even allowing for the average consumer who encounters the marks visually to notice the differences between the marks, the independent distinctive elements GIUSTO and GOUSTO are highly similar when taking account of the principle of imperfect recollection. This combined with the high distinctive character of the earlier marks, will lead the marks to *“become tangled up with one another in the perceptions and recollections of consumers exposed to concurrent use of [the marks] for [identical*

or highly similar goods]<sup>5</sup>". I extend the same conclusion to the goods which I found to be similar to a low and medium degree. **There is a likelihood of both direct and indirect confusion in relation to the three applications based on the three earlier rights.**

## CONCLUSIONS

96. The opponent has been more successful based on the 918 and 642 Earlier Marks. Based on these two earlier rights, the three oppositions succeed in relation to the following goods:

### FIRST APPLICATION

Class 29: Preserved, dried and cooked fruits and vegetables; jellies, jams, compotes; Almonds, ground; Almonds (prepared-); Apple chips; Apple purée; Artichokes; Beans; Bottled fruits; Bottled vegetables; Broccoli; Candied fruits; Canned fruits; Canned tomatoes; Carrots; Cashew nuts (prepared-); Chick peas; Chilli beans; Chips (Fruit -); Coated peanuts; Cocktail onions; Coconut; Coconut, desiccated; Coconut flakes; Coconut powder; Coleslaw; Compotes; Cornichons; Cranberry sauce [compote]; Crystallized fruits; Cucumber Kimchi [Oi-sobagi]; Currants; Dahls; Dates; Dill pickles; Dried coconut; Dried cranberries; Dried dates; Dried durians; Dried edible mushrooms; Dried edible seaweed (hoshi-wakame); Dried edible tremella fuciformis Dried figs; ; Dried flakes of laver for sprinkling on rice in hot water (ochazuke-nori); Dried fruit mixes; Dried fruit products; Dried fruits; Dried mangoes; Dried pawpaws; Dried persimmon (Got-gam); Dried pieces of agar jelly (kanten); Dried pineapples; Dried pulses; Dried soya beans; Dried truffles [edible fungi]; Edible dried flowers; Edible seaweed; Edible seeds; Flavored nuts; Fruit conserves; Fruit Desserts; Fruit jams; Fruit jellies; Fruit juices for cooking; Fruit marmalade; Fruit paste; Fruit peel; Fruit, preserved; Fruit preserves; Fruit puree; Fruit rinds; Fruit salads; Fruit snacks; Fruit spread; Fruit-based snack food; Garden peas; Garlic [preserved]; Gelatine; Gherkins; Hazelnuts, prepared; Legume salads; Lemon curd; Lemon spread; Lentils; Mixed pickles; Mushrooms, prepared;

<sup>5</sup> BL-O-566/19 PINKIES TRADE MARK at paragraph 33

*Mushrooms, preserved; Nuts, prepared; Peeled tomatoes; Pickles; Prepared coconut; Prepared fruits; Prepared pistachio; Prepared rootstocks; Prepared salads; Prepared walnuts; Preserved vegetables; Processed legumes; Processed lychee fruit; Processed peaches; Processed peas; Processed pumpkin seeds; Processed sweet potatoes; Pulp (Fruit -); Pulses [for food]; Raisins; Roast chestnuts; Salads (Fruit -); Salads (Vegetable -); Sauerkraut; Seasoned nuts; Snack food (Fruit-based); Snack food based on legumes; Snack food based on nuts; Snack food based on vegetables; Soya [prepared]; Stem ginger; Stewed fruits; Sultanas; Vegetable salads; Vegetables, cooked; Potato salad; Yams; Yellow split peas; Zucchini; Aubergine paste; Chilli; Condensed tomatoes; Eggplant paste; Extracts of vegetables [juices] for cooking; Fermented bamboo shoots boiled and preserved in salt (menma); Fermented soybeans (natto); Fermented vegetable foods [kimchi]; Fermented vegetables (kimchi); Garlic paste; Guava paste; Mushrooms puree; Olive paste; Olives, [prepared]; Olives, preserved; Processed olive puree; Processed olives; Corn snacks [other than confectionery]; Tomato concentrates [puree]; Tomato paste; Tomato purée; Vegetable puree; Soup and Potato crisps; Chipped potatoes; Chips [french fries]; Chips (Potato -); Crisps; Crisps (Potato -); Croquettes; Dips; Filled potato skins; French fries; Guacamole; Hash brown potatoes; Hummus; Potato cakes; Potato chips; Potato crisps; Potato croquettes; Potato dumplings; Potato flakes; Potato fritters; Potato pancakes; Potato puffs; Preparations for making soups; Soup (Preparations for making -); Soup preparations (Vegetable -); Eggs, milk and milk products; Blended butter; Blended cheese; Blue cheese; Butter; Buttercream; Buttermilk; Cheese; Cheese products; Cheese spreads; Chilled dairy desserts; Chocolate milk; Coconut milk for culinary purposes; Condensed milk; Cottage cheese; Cows' milk; Cream; Creme fraiche; Curd; Curd cheese; Curdled milk; Custard style yoghurts; Dairy desserts; Dairy produce; Dairy puddings; Dairy spreads; Dairy-based beverages; Dairy-based dips; Dairy-based whipped topping; Desserts made from milk products; Dried eggs; Drinking yogurts; Drinks made from dairy products; Dry whey; Duck eggs; Dulce de leche [condensed milk]; Eggs; Fermented bean curd; Fermented milk; Ferments (Milk -) for culinary purposes; Fish eggs for human consumption; Flavoured milk; Fresh unripened cheeses; Fromage frais; Garlic butter; Ghee; Goat milk; Honey butter; Kefir; Milk and milk products; Milk products; Milk of almonds for culinary purposes; Mould-*

*ripened cheese; Powdered eggs; Ready grated cheese; Ripened cheese; Soft cheese; Tofu; Yoghurt desserts; Yogurt; Edible oils and fats; Blended oil [for food]; Butter (Peanut -); Canola oil; Chilli oil; Chocolate nut butter; Cocoa butter; Coconut butter; Coconut fat; Colza oil for food; Cooking fats; Coconut oil and fat [for food]; Cooking oils; Corn oil; Edible fats; Edible oils and fats; Hardened oils [hydrogenated oil for food]; Margarine; Nut oils; Olive oil; Olive oil for food; Palm oil for food; Peanut butter; Vegetable spreads; Hazelnut spread.*

Class 30: *Coffee, tea, cocoa, sugar, rice, tapioca, flour and preparations made from cereals, bread, pastry and confectionery; honey, treacle; yeast, baking-powder; sauces (condiments).*

### SECOND AND THIRD APPLICATIONS

Class 29: *processed fruit; tinned fruit; dried fruit; processed vegetables; tinned vegetables, dried vegetables; pulses and legumes (processed, tinned or dried); dairy produce namely eggs, milk, yoghurt, cheese; oils and fats for cooking and consumption.*

Class 30: *Coffee, tea, cocoa, sugar, rice, tapioca, flour and preparations made from cereals, bread, pastry and confectionery; honey, treacle; yeast, baking-powder; sauces (condiments).*

97. The extent of the opponent's success in the oppositions based on the 777 Earlier Mark is more limited. Based on that earlier right, the three oppositions succeed in relation to the following goods in class 30 only:

### FIRST APPLICATION

Class 30: *Flour and preparations made from cereals, bread, pastry and confectionery; yeast, baking-powder.*

## SECOND AND THIRD APPLICATION

Class 30: *Flour and preparations made from cereals, bread, pastry and confectionery; yeast, baking-powder.*

### **Final remarks**

98. In reaching the above conclusions, I have not overlooked the applicant's submission that its marks have been used in the UK for some time whilst the opponent has not used its marks in the UK. In this connection, the applicant states that the mark GOUSTO has acquired a reputation in the UK and the relevant public is aware of it. I reject the argument. Firstly, it is possible to register a mark which is not being used. Secondly, it is possible to use an earlier EU (or IR EU) mark which has been put to genuine use outside the UK, in order to oppose an application to register a UK trade mark. Consequently, the opponent is entitled to protection based on the registration of its earlier EU and IR EU marks, even if it has not used these marks in the UK. Thirdly, there is no authority, as far as I am aware, that allows the reputation of a later mark to be taken into account in assessing the likelihood of confusion under Section 5(2)(b). The basic principle which underpins oppositions based on relative grounds is that owners of earlier registered rights can oppose identical or similar marks. The applicant cannot defeat an opposition under Section 5(2)(b) simply because it has used the contested mark prior to having acquired any registered rights in it, without also demonstrating that the public were sufficiently exposed to both marks to differentiate between them. In *Aceites del Sur-Coosur SA v OHIM*, Case C-498/07 P, the CJEU found that:

“82. First, although the possibility cannot be ruled out that the coexistence of two marks on a particular market might, together with other elements, contribute to diminishing the likelihood of confusion between those marks on the part of the relevant public, certain conditions must be met. Thus, as the Advocate General suggests at points 28 and 29 of his Opinion, the absence of a likelihood of confusion may, in particular, be inferred from the ‘peaceful’ nature of the coexistence of the marks at issue on the market concerned.



83. It is apparent from the file, however, that in this case the coexistence of the La Española and Carbonell marks has by no means been ‘peaceful’ and the matter of the similarity of those marks has been at issue between the two undertakings concerned before the national courts for a number of years.”

99. Accordingly, for the coexistence of the marks to be relevant, it must have taken place on the UK market, which, clearly, is not the case here since the opponent has not used the earlier marks in the UK.

100. The three oppositions have partly succeeded (to various degree) under all of the three marks relied upon by the opponent. Whilst the 918 Earlier Mark is subject to an invalidity action, the opponent has also succeeded to the same extent under the 642 Earlier Mark. The invalidity action might therefore become relevant only to the extent that the decision based on the 642 Earlier Mark is appealed, that the appeal is successful and that an application to convert the EUTM into a UK mark is refused. Accordingly, it does not affect, at this stage, this decision.

## **COSTS**

101. Since each party has succeeded in part, I consider that each side should bear its own costs associated with this opposition.

Dated this **22<sup>nd</sup> day November 2019**

**T Perks**

**For the Registrar**

**The Comptroller – General**