

O-001-10

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2413515
BY STEPHEN PAUL QUINN**

TO REGISTER THE TRADE MARKS (A SERIES OF TWO):

The word "Cucina" is written in a gold, serif font. The letter "A" is stylized with a small, gold, six-pointed starburst or citrus slice icon positioned above its top right corner.The word "Cucina" is written in a purple, serif font. The letter "A" is stylized with a small, purple, six-pointed starburst or citrus slice icon positioned above its top right corner.

IN CLASSES 29, 30 AND 43

AND

**THE OPPOSITION THERETO
UNDER NO 96143
BY LIDL STIFTUNG & CO KG**

Trade Marks Act 1994

**In the matter of application no 2413515
by Stephen Paul Quinn
to register the trade marks (a series of two):**



**in classes 29, 30 and 43
and the opposition thereto
under no 96143
by Lidl Stiftung & Co KG**

1) The application to register the above trade marks was made by Mr Stephen Paul Quinn on 10 February 2006. The application was published for opposition purposes on 9 November 2007 with the following specification:

meat, fish, poultry and game; products made from meat, fish, poultry or game; meat extracts; preserved, dried and cooked fruits and vegetables; products made from dried and cooked fruits and vegetables; vegetable salads; jellies, jams, fruit sauces; eggs and products made from eggs; milk and milk products; dairy products; edible oils and fats; pickles; fruit pulp; tomato juice for cooking, tomato paste, tomato puree; instant, prepared, cooked, chilled and ready meals and snacks included in Class 29; potato chips and crisps; snack foods; salads; soups; starters, entrees, all consisting of or based on egg, meat, fish, cheese, poultry, fruit and vegetables; desserts, puddings included in Class 29; cheese; fruit salads; milk and milk beverages in which milk predominates; onion products; pizza toppings; ingredients for all the aforesaid included in Class 29;

coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; beverages made from coffee, tea, cocoa, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery, ices; ice cream, frozen yoghurt, sorbets; desserts included in Class 30; maize meal, polenta; pasta, tortillas; pastries, flans, pies, biscuits, cakes; honey, treacle; yeast, baking-powder; salt, mustard; seasonings; vinegar, sauces (condiments); relishes (condiments); spices; ices; sandwiches; instant, prepared, cooked, chilled and ready meals and snacks included in Class 30; sauces; cooking sauces; pour over sauces; sauce powders; salad dressings; herbs; mixtures of herbs; tomato sauce; tomato ketchup; tomato based sauces; pizzas; pizza toppings; curry (spice), curry

powder, curry sauces, curry paste; ingredients for all the aforesaid goods included in Class 30;

services for providing food and drink; provision of food and drink; restaurant, takeaway, cafe and bar services; take away food and beverage services; take away food outlet; catering services; sandwich and snack bar services; preparation and serving of food and beverages; preparation of sandwiches, salads, snacks, soups, biscuits, cakes, desserts, ready meals and beverages; contract food services; information, consultancy and advisory services including helpline services relating to all the aforesaid services.

The above goods and services are in classes 29, 30 and 43 respectively of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

2) On 7 February 2008 Lidl Stiftung & Co KG (Lidl) filed an opposition to the registration of the trade mark. Lidl bases its opposition on section 5(2)(b) of the Trade Marks Act 1994 (the Act). According to section 5(2)(b) of the Act a trade mark shall not be registered if because:

“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.”

The earlier trade mark upon which Lidl relies is **Cusina**. The trade mark is the subject of international registration no 678053, its date of designation in the United Kingdom is 14 February 2001. It was protected in the United Kingdom from 22 January 2006, there being no opposition subsequent to the publication of the registration on 21 October 2005. The trade mark is protected for:

meat extracts, meat, fish, fruit and vegetable jellies; soups, also in dried form;

spices, spice preparations, spice flavorings, spice essences, spice extracts, fine herbs and aromatic leaves, aromatic oils, aromatic salts, spiced sauces, condiments, flavorings, spices, spice flavorings and spice preparations, spices and soup flavorings, vinegar, mustard, coarse salt, mayonnaise; yeast, baking powder, sauces (including salad dressings); prepared meals and dry mixtures for prepared meals, mainly consisting of rice, noodles, potatoes and/or vegetables.

The above goods are in classes 29 and 30 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended. Lidl considers that the respective trade marks are similar and that the respective goods are identical or similar. Consequently, there is a likelihood of confusion.

3) Mr Quinn filed a counterstatement. He claims that the respective trade marks are visually, phonetically and conceptually different. Mr Quinn claims that the second c in his trade marks have a hard sound, that cucina is an Italian word meaning kitchen, whilst Cusina has no meaning. He claims that his trade marks include a highly distinctive logo of a segment of fruit. Mr Quinn draws attention to the 81 trade marks (registered, advertised or pending) that include or comprise the word cucina in food related classes, printouts showing the basic details of these trade marks are attached to the counterstatement. Mr Quinn denies that there is a likelihood of confusion. He states that he has used the trade marks since December 2005 and is unaware of any use by Lidl of its trade mark. He states that there has not been any instance of confusion or association between his trade marks and that of Lidl.

4) Only Mr Quinn filed evidence. Neither side requested a hearing, they both furnished written submissions.

Evidence of Stephen Paul Quinn

5) Mr Quinn is the managing director of Cucina Restaurants Limited which he states uses his trade marks with his consent. He states that the trade marks have been used in relation to the provision of food and drink services in establishments such as schools and hotels as well as consultancy and educational services since December 2005. Most of his evidence relates to the use of his trade marks. I cannot see what relevance this has to the issues before me. If Lidl had used its trade mark, of which there is no evidence, there might be a purpose to filing evidence to show an absence of confusion. However, even then the relevance would be very doubtful; this is a matter that has been dealt with by the courts on several occasions and is the subject of Tribunal Practice Notice TPN 4/2009¹. In his evidence Mr Quinn states that he does not believe that Lidl sells its own branded goods other than in its own stores. If this is the case and Lidl had used the trade mark it would be an excellent example of why absence of confusion in the market place is seldom telling of anything; as Mr Quinn's services and the goods of Lidl would not have met. The issue before me is not as to if and/or how Lidl uses its trade mark now but whether there would be confusion arising from any notional and fair use of its trade mark and notional and fair use of Mr Quinn's trade marks for the gamut of goods encompassed by the specifications. This is a matter which has been dealt with by the Court of First Instance (CFI) on a number of occasions. In *Devinlec Développement Innovation Leclerc SA v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T- 147/03* the CFI stated:

“104 Consideration of the objective circumstances in which the goods covered by the marks are marketed is fully justified. The examination of the likelihood of confusion which the OHIM authorities are called on to carry out is a prospective examination. Since the particular circumstances in which the goods covered by the marks are marketed may vary in time

and depending on the wishes of the proprietors of the trade marks, the prospective analysis of the likelihood of confusion between two marks, which pursues an aim in the general interest, that is, the aim that the relevant public may not be exposed to the risk of being misled as to the commercial origin of the goods in question, cannot be dependent on the commercial intentions, whether carried out or not, and naturally subjective, of the trade mark proprietors.....

107 It follows that by taking into consideration in the assessment of the likelihood of confusion between the marks the particular circumstances in which the goods covered by the earlier mark are marketed, the temporal effect of which is bound to be limited and necessarily dependent solely on the business strategy of the proprietor of the mark, the Board of Appeal erred in law.”

In *Oakley, Inc v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Case T-116/06 the CFI held:

“75 Even supposing that, in the present case, the goods covered by the earlier trade mark THE O STORE are not sold by means of the O STORE services covered by the contested Community trade mark, the fact remains that the relevant public, when presented with retail services, concerning clothes or shoes in particular, and covered by the trade mark O STORE, could believe that those services are offered by the same undertaking as that which sells those same goods under the trade mark THE O STORE or by a related undertaking. In that regard, it must be recalled that, in the global assessment of the likelihood of confusion, the ‘usual’ circumstances in which the goods covered by the marks in dispute are marketed must be taken as a benchmark, that is, those which it is usual to expect for the category of goods or services covered by the marks in question (see, to that effect, T-147/03 *Devinlec v OHIM – TIME ART (QUANTUM)* [2006] ECR II-11, paragraph 103, upheld on appeal in Case C-171/06 P *T.I.M.E. ART/Devinlec v OHIM*, not published in the ECR).

76 Consideration of the objective circumstances in which the goods and services covered by the marks in dispute are marketed is fully justified. The examination of the likelihood of confusion which the OHIM authorities are called on to carry out is prospective. Since the particular circumstances in which the goods covered by the marks are marketed may vary in time, and depending on the wishes of the proprietors of the trade marks, the prospective analysis of the likelihood of confusion between two marks, which pursues an aim in the general interest, that is, that the relevant public may not be exposed to the risk of being misled as to the commercial origin of the goods in question, cannot be dependent on the commercial intentions, whether carried out or not – and which are

naturally subjective – of the trade mark proprietors (*QUANTUM*, paragraph 75 above, paragraph 104, and *T.I.M.E. ART/Devinlec v OHIM*, paragraph 75 above, paragraph 59).”

Similar findings can be found in *NHL Enterprises BV v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-414/05*, *Sadas SA v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-346/04*, *Georg Neumann GmbH v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-358/04*, *Daimlerchrysler AG v. Office for Harmonisation In the Internal Market (Trade Marks and Designs) [2003] ETMR 61* and *Phildar SA v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-99/06*. In *L’Oreal SA and others v Bellure NV and others [2007] EWCA Civ 968* Jacob LJ stated:

“110. I start with the latter point. He raised it in relation to the *Pink Wonder* box, held not to give rise to a link in either the historical or current version (the difference between the two is slight). *Miracle* is advertised on television with images of clouds. The *Pink Wonder* box, besides being generally pink (though a markedly different shade), shows some cloud images. Mr Carr says they should be taken into account by reason of the global appreciation test. I cannot agree. The test is, and must be, founded on the mark as registered, not material which forms no part of that. There is simply no warrant in the Directive for taking more than the registered mark into account. The global appreciation test does not amount to the proposition that once a registered mark is used in marketing, anything, extraneous to the mark used in marketing, comes in too – as though it formed part of the registered mark.”

This was considering section 10(3) of the Act but *mutatis mutandis* the reasoning would apply to section 10(2) of the Act and, consequently, by analogy section 5(2) of the Act.

6) Mr Quinn also refers to *cucina* being the Italian for kitchen. The question before me revolves around the average, relevant consumer for the respective goods and services in the United Kingdom. The consumer will not have a knowledge of Italian and there is nothing to suggest that *cucina* is a word that has transferred into the general knowledge of the average consumer; which might be said for some words such as *vin* and *vino*. I note that in his evidence, for example at 76a of bundle SPQ2, people visiting the website of *cucina.org.uk* are advised that *cucina* is pronounced ‘*cuchina*’. I have to consider whether the average consumer would have known this at the date of the application for registration. There is nothing to suggest that he or she would have. There is nothing to suggest that the average consumer would pronounce the word in this fashion, even at the date of the filing of the evidence. Despite its enormous fame, the majority of people that I hear referring to the car manufacturer Porsche,

pronounce the word in a non Germanic fashion, dropping the e at the end. This relationship between the orthography and pronunciation of German is standard as with the artist August Macke and the manufacturer Miele. There is nothing to suggest that the average consumer, who will not know that cucina is an Italian word, will pronounce it in an Italian fashion; logic would clearly dictate against such behaviour.

7) Mr Quinn states that Lidl's trade mark was not brought to his attention during its examination. Whether an examiner decided that another trade mark should be notified to an applicant cannot have a bearing upon my considerations. I have to consider the case brought by Lidl on the basis of its earlier trade mark within the parameters of the case law.

8) Consequent upon the above, the evidence of Mr Quinn has no bearing upon the case before me. In its submissions, Lidl queries the relevance of the evidence.

9) In his submissions Mr Quinn criticised Lidl for not filing evidence. It is for Lidl to decide what evidence it considers necessary to support its case, it stands and falls by that decision.

10) In his submissions Mr Quinn refers to the printouts of cases that were attached to his counterstatement. These were not filed as evidence. Even if they had been the details contained in them are sparse. Despite all of the evidence filed by Mr Quinn none of it relates to use of cucina by other traders in the United Kingdom. It is what is happening in the market place that is of importance not what is sitting on trade mark registers, as per the judgments of Jacob J in *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281 and the CFI in *Zero Industry Srl v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-400/06* and *GfK AG v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-135/04*. Even if there was use by other traders of cucina for the goods in question, any bearing that this might have would still turn on the degree of similarity between the trade marks of Mr Quinn and that of Lidl.

Average consumer, nature of purchasing decision and standard for likelihood of confusion

11) The goods of both the application and the earlier registration and the class 43 services of the application are all bought by the public at large. (The trade marks in use in relation to the contract food services of class 43 will potentially be presented to the general public when they, for example, visit a staff canteen or a visitors' restaurant, as with a museum restaurant for example.) They are not necessarily bought with a great deal of attention, however the average consumer is deemed to be reasonably well informed and reasonably circumspect and observantⁱⁱ. The goods and the class 43 services could be the subject of impulse

purchase. Owing to the nature of the purchasing process and the nature of the purchaser the possible effects of imperfect recollection are increased.

Comparison of goods

12) In “construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of tradeⁱⁱⁱ”. Words should be given their natural meaning within the context in which they are used, they cannot be given an unnaturally narrow meaning^{iv}. Consideration should be given as to how the average consumer would view the goods or services^v. The class of the goods and services in which they are placed may be relevant in determining the nature of the goods^{vi}. In assessing the similarity of goods and services it is necessary to take into account, inter alia, their nature, their intended purpose, their method of use and whether they are in competition with each other or are complementary^{vii}. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T- 325/06 the CFI explained when goods were complementary:

“82 It is true that goods are complementary if there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking (see, to that effect, Case T-169/03 *Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI)* [2005] ECR II-685, paragraph 60, upheld on appeal in Case C-214/05 *P Rossi v OHIM* [2006] ECR I-7057; Case T-364/05 *Saint-Gobain Pam v OHIM – Propamsa (PAM PLUVIAL)* [2007] ECR II-757, paragraph 94; and Case T-443/05 *El Corte Inglés v OHIM – Bolaños Sabri (PiraÑAM diseño original Juan Bolaños)* [2007] ECR I-0000, paragraph 48).”

In *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281, Jacob J also gave guidance as to how similarity should be assessed^{viii}. In considering the services of the application, the judgment of Jacob J in *Avnet Incorporated v Isoact Ltd* [1998] FSR 16 must be taken into account:

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

13) In its submissions Lidl refers to the goods: meat, fish and fruit as stand-alone, non-qualified terms. The natural reading of the specification is that the meat, fish and fruit refer to the jellies; meat, fish and fruit qualify the nature of the jellies. In confirmation of this one can look at the international registration’s specification (which encompass more goods than are protected in the United Kingdom) as recorded in French and Castellano:

“Extraits de viande, gelées de viande, de poisson, de fruits et de légumes, confitures de fruits, salades de viande, de poisson, de fruits et de légumes, pickles, conserves de viande, de poisson, de fruits et de légumes, consommés, aussi sous forme déshydratée.”

“Extractos de carne, gelatinas de carne, de pescado, de frutas y de legumbres, mermeladas a base de frutas, ensaladas de carne, pescado, frutas y verduras, encurtidos, conservas de carne, de pescado, de fruta y de verduras, consomés, también en forma deshidratada.”

This interpretation also conforms to the base German registration, no 396 43 490, which includes Fleisch-, Fisch-, Frucht- und Gemüsegelees, which translates as meat-, fish-, fruit- and vegetable jellies. Owing to this misinterpretation of the specification various of the submissions of Lidl in relation to the similarity/identity of the respective goods and services must fall.

14) Neither in his counterstatement nor in his written submissions has Mr Quinn commented on the issue of the similarity/identity of the respective goods and services. I have not assumed that the absence of denial is an acceptance of the claim of Lidl (despite his having legal representation), however, it must be noted that Mr Quinn has not taken the opportunity to put forward any arguments as to the issue of similarity/identity of the respective goods and services. He must stand by his silence.

15) In its submissions Lidl claims, inter alia, that certain of its goods are similar to those of the application as they could be used in the preparation and/or as an ingredient of the goods of the application. The CFI considered the relationship between finished article, their component parts and similarity in *Les Editions Albert René v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Case T-336/03:

“The mere fact that a particular good is used as a part, element or component of another does not suffice in itself to show that the finished goods containing those components are similar since, in particular, their nature, intended purpose and the customers for those goods may be completely different.”

The position was reiterated by the CFI in *Promat GmbH v Harmonisierungsamt für den Binnenmarkt (Marken, Muster und Modelle)* (HABM) Case T-71/08:

“33 Auch wenn, wie die Klägerin in der mündlichen Verhandlung ausgeführt hat, Mineralfasern und Werg denselben Ursprung haben können, genügt dies nicht, um die Ähnlichkeit der betreffenden Waren festzustellen. Die bloße Tatsache, dass ein Produkt als Einzelteil, Zubehör oder Komponente einer anderen Ware verwendet wird, reicht nicht als Beweis dafür aus, dass die diese Komponenten enthaltenden

Endprodukte einander ähnlich sind (Urteil des Gerichts vom 27. Oktober 2005, Éditions Albert René/HABM – Orange [MOBILIX], T-336/03, Slg. 2005, II-4667, Randnr. 61).”

These judgments do not state that a component cannot be similar to a finished product in which it appears; the matter is one that must be considered on the basis of the particular facts of the case.

16) *Meat extracts, soups and jellies* are rehearsed in both specifications and so are identical. Goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application^{ix}. The jellies referred to in the specification of Lidl’s registration will include aspic. *The Oxford Dictionary of English* defines aspic as:

“a savoury jelly made with meat stock, used as a garnish, or to contain pieces of food such as meat, seafood, or eggs, set in a mould.”

Poultry and game are forms of meat. *Products made from meat, fish, poultry or game, products made from dried and cooked fruits and vegetables; starters, entrees, all consisting of or based on egg, meat, fish, cheese, poultry, fruit and vegetables, desserts, onion products, ingredients for all the aforesaid included in Class 29* will encompass *meat extracts, meat, fish, fruit and vegetable jellies*, so the respective goods can be considered to be identical.

17) *Meat, fish, fruit and vegetable jellies and soups* could all be sold as ready meals and snacks and so will be encompassed by *instant, prepared, cooked, chilled and ready meals and snacks included in Class 29 and snack foods* of the application and so the respective goods can be considered to be identical.

18) *Prepared meals* of the class 30 specification of the earlier registration will have the same purpose, the same purchaser, would be found in the same area of a supermarket and would have a similar nature as *instant, prepared, cooked, chilled and ready meals and snacks included in Class 29 and snack foods*; the respective goods are fungible and so in competition. So *prepared meals* of the class 30 specification of the earlier registration are highly similar to *instant, prepared, cooked, chilled and ready meals and snacks included in Class 29 and snack foods*.

19) *Fruit and vegetable jellies* could be made from *dried and cooked fruits and vegetables* and so be described as *products made from dried and cooked fruits and vegetables*, consequently the respective goods can be considered to be identical.

20) Pudding has two common meanings, a food product in the form of a pudding and the dessert course of a meal. A fruit jelly could be the dessert course of a meal and so the former term encompasses the latter term and the respective

goods can be considered to be identical. If considered as a particular form of food, *puddings* encompasses puddings for desserts. *Puddings* and *fruit jellies* would be eaten at the end of a meal, so they would have the same purpose and are fungible and so in competition. The purchaser of the goods would be the same, someone seeking a dessert course. The respective goods could be found in the same area of a supermarket, in the same chiller cabinet. Application of the second definition of *puddings* would lead to the respective goods being highly similar.

21) *Vegetable salads* and *salads* are prepared meals. The prepared meals of the class 30 specification of the earlier registration will include rice and various vegetable salads and so there is a very high degree of similarity between the *vegetable salads* and *salads* of the application and the *prepared meals* of the earlier registration.

22) *Meat, fish, poultry and game* of the application will include such products which have been cooked, smoked, marinated etc eg roast beef and kippers; not just products in a completely unprocessed form. *Meat jellies* of the earlier registration will include jellies containing poultry and game, the other jellies include fish jellies. Both sets of products contain some form of flesh, fish or fowl which can be eaten without further cooking or heating. Although not directly fungible, the respective goods could be alternatives and so there is a degree of competition between them. As the respective goods contain some form of flesh, fish or fowl they have a similar nature. The respective goods could be found adjacent on a delicatessen counter. The respective goods are all used to satiate hunger and so have the same intended purpose. In their non-raw form *meat, fish, poultry and game* are not essential to the jellies of the application, there is no symbiotic or mutually dependent relationship; they are not complementary. The respective goods could come through the same channel of trade to arrive at the delicatessen counter. There is a good deal of similarity between *meat, fish, poultry and game* and the jellies of the earlier registration.

23) *Milk beverages in which milk predominates* are beverages. Soups are in a liquid form but are not normally described as beverages, even when purchased from a vending machine. *Meat extracts* will include a product such as Bovril®, which can have hot water added to it and be drunk as a beverage. However, owing to the different natures I cannot see that in any realistic sense that *milk beverages in which milk predominates* are fungible with *meat extracts*, or any of the other goods of the earlier registration. The goods of the application are milk based and consequently of a different nature of the goods of the earlier registration. The respective goods would not be found in the same area of a supermarket and would not normally follow the same channel of trade. *Soups*, from a vending machine, and *meat extracts*, with hot water added, would have the purpose as *milk beverages in which milk predominates*, slaking the thirst, and so have the same intended purpose and consequently the same end user. Despite some points of coincidence, owing to the fundamental difference in the

nature of *milk beverages in which milk predominates* and the goods of the earlier registration I do not consider that the aforesaid goods are similar to the goods of the earlier registration.

24) *Milk, eggs and cheese* are products that are sold in discrete areas of supermarkets, there are specific sections devoted to them. They have clearly defined channels of trade which do not coincide with those of the goods of the earlier registration. They have different natures to the goods of the earlier registration. Although potential ingredients of the goods of the earlier registration the average customer is not likely, as per *Boston Scientific Ltd*, to consider that the goods and services have the same source and so are not complementary. The respective goods certainly are not automatically mutually dependent on each other nor is there an automatic symbiotic relationship. The respective goods are not fungible, they are not in competition. The respective goods could all be used to slake the thirst or satiate the hunger. The enormous difference in nature of the product and where they would be found in retail outlets nullifies the points of coincidence and channels of trade which are at the most general level and tending toward the position of a *reductio ad absurdum*. *Milk, eggs and cheese* are not similar to the goods of the earlier registration.

25) *Aromatic oils are edible oils* which have had some form of aroma/flavouring added to them, consequently, they are similar in every way other than the addition of an aromatic element. *Aromatic oils* are, consequently highly similar to *edible oils*.

26) *Products made from eggs* will include a large number of goods, including pancakes, tortillas (of the Spanish variety) and egg custards. Such goods will have clear similarities with such goods as *fruit jellies* and *prepared meals* being, for instance, desserts and prepared meals themselves. It flows from this that there will be many conjunctions within the parameters of the case law eg same intended purpose, in competition, same nature, same end consumer, same channel of trade and for sale in the same area of a shop. *Products made from eggs* are similar to a high degree to *fruit jellies* and *prepared meals* of the earlier registration.

27) *Fats* are used in cooking either as an ingredient, eg in the making of pastry, or as a medium for cooking, eg for frying or roasting. Consequently, as a cooking medium, they can have the same purpose and the same end user as *aromatic oils* and be fungible and so in competition. In ordinary parlance *fats* will refer to products that are solid at room temperature, whilst *oils* refers to products that are liquid at room temperature, so they have a different nature. However, a fat and an oil, in terms of food, are ultimately one and the same thing; the difference in terminology reflects their different nature at room temperature. The respective goods are found in different, discrete areas of shops; *fats* will normally be in a refrigerated area. However, certain fats, such as suet, are often stored at the ambient temperature of the store; although they still will be found in a different

area of a store to *aromatic oils*. *Fats* enjoy a high degree of similarity with *aromatic oils*.

28) *Milk products* and *dairy products* are effectively one and the same thing. These terms, within the parameters of class 29, include goods such as yoghurt, cream, cheese and possets. Taking the last product as an example, it is eaten as a dessert and so in this regard will have points in conjunction with fruit jellies: they have the same purpose, they are alternatives for one another as a choice for a dessert and so are in competition, they could both be found in the chilled desserts section of a supermarket. Consequently, there is a good deal of similarity between *milk products* and *dairy products*, in the full panoply of their meaning, and *jellies*. (There may well be other goods for which there are similarities but it is not practical to conduct an exhaustive analysis in relation to every possible product covered by the terms *milk products* and *dairy products*.)

29) The same logic relating to desserts applies in relation to *fruit salads* of the application and *fruit jellies* of the earlier registration; as they are both fruit based products they are even closer owing to their common nature.

30) Other than at the most general level, of the products being foodstuffs, there are no material points of conjunction between *potato crisps*, which have a well developed and discrete part in the food industry, and the goods of the earlier registration; *potato crisps* are not similar to the goods of the earlier registration.

31) *Potato chips*, in normal United Kingdom usage, are chipped potatoes rather than crisps, as in American English. As far as I am aware, *potatoes* in chip form are only found as deep frozen products. They have their own discrete area of the freezer cabinets in supermarkets. They are not fungible with the goods of the earlier registration, there is no mutually dependent or symbiotic relationship with the goods of the earlier registration; so they are neither in competition with nor complementary to the goods of the earlier registration. Their purpose is to supply a vegetable accompaniment to a main dish, so they have a different intended purpose to the goods of the earlier registration. At the most general level they, like the goods of the earlier registration, are foodstuffs and so satiate hunger. The points of difference between *potato chips* and the goods of the earlier registration are such that the former goods cannot be considered to be similar to the latter goods.

32) *Pickles* are served as an accompaniment to various foods and dishes. The specification of the earlier registration includes *condiments* which encompasses sweet pickles and products such as chutneys; there is only a cigarette paper between these products. *Pickles* are highly similar to *condiments* of the earlier registration.

33) *Sauces* of the earlier registration includes sauces of all types, savoury and sweet. The term includes sauces for ice cream, which could include sauces made of fruit. *Fruit sauces* are highly similar to *sauces* of the earlier registration.

34) *Tomato juice for cooking, tomato paste and tomato puree* are all tomato products for use in cooking. In supermarkets these products have their own discrete area, in which they are found side by side. Tomato based sauces are in class 30 and will be included in the general term *sauces* of the earlier registration. They are not, in my experience, normally with the tomato products but with other sauce products. Tomato based sauces being tomato based and being in a non-solid form, will have the same nature as *tomato juice for cooking, tomato paste and tomato puree*. If making a tomato based dish, such as a sauce for pasta, the customer could use the goods of the application or those of the earlier registration so they are in competition and have the same intended purpose. The sequitur of having the same intended purpose is that the end user will be the same. *Tomato juice for cooking, tomato paste and tomato puree* are similar to a high degree to *sauces* of the earlier registration.

35) *Pizza toppings*, whether in class 29 or 30, are also likely to be a tomato based product and very similar to tomato based sauces for putting onto pizzas. Again the difference between the respective products is cigarette paper thin. *Pizza toppings*, in both classes 29 and 30, are highly similar to *sauces* of the earlier registration.

36) I have no idea what the nature and purpose of *fruit pulp* are, I assume that it is a pulp made of fruit. However, in the absence of evidence I do not know for what it is used, where it is sold, who uses the product, whether it is competition with or complementary to the goods of the earlier registration. In *Canon* the ECJ stated:

“22. It is, however, important to stress that, for the purposes of applying Article 4(1)(b), even where a mark is identical to another with a highly distinctive character, it is still necessary to adduce evidence of similarity between the goods or services covered. In contrast to Article 4(4)(a), which expressly refers to the situation in which the goods or services are not similar, Article 4(1)(b) provides that the likelihood of confusion presupposes that the goods or services covered are identical or similar.”

The court required evidence of similarity to be adduced. This finding has been reiterated by the ECJ and the CFI eg in *Commercy AG v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-316/07:

“43 Consequently, for the purposes of applying Article 8(1)(b) of Regulation No 40/94, it is still necessary, even where the two marks are identical, to adduce evidence of similarity between the goods or services

covered by them (see, to that effect, order of 9 March 2007 in Case C-196/06 P *Alecansan v OHIM*, not published in the ECR, paragraph 24; and Case T-150/04 *Mülhens v OHIM – Minoronzoni(TOSCA BLU)* [2007] ECR II-2353, paragraph 27).”

The above part of the *Canon* judgment has been more recognised in the breach than in the observance in this jurisdiction. It may not always be practical to adduce evidence of similarity; it may be that the nature of the goods is so well-known that it would be a waste of effort and resources to do so. In its evidence Lidl makes various submissions about why the respective goods and services are identical or similar, however, they are at a very general level and certainly do not place the arguments within the parameters of the case law. It asserts rather than analyses. In relation to the goods under consideration here it includes them in a general assertion as to similarity/identity; it does not specify whether the goods are identical or similar. Consequently, it has not dealt with the nature of the goods in question, As I can make no informed comparison in relation to goods about which I have no knowledge and as Lidl has put forward no argument in relation specifically to this product I cannot find that *fruit pulp* is either identical or similar to the goods of the earlier registration.

37) *Jams* are conserves that are used as spreads on bread products and as ingredients in various sweet products, such as jam tarts and doughnuts. They have their own discrete areas in shops. I cannot see that *jams* coincide in any meaningful way with any of the goods of the earlier registration within the parameters of the case law. *Jams* are not similar to the goods of the earlier registration.

38) *Preserved and dried and cooked fruits and vegetables* need to be split up in the consideration of their similarity with the goods of the earlier registration. *Cooked fruit and vegetables* have undergone a process that makes them ready to use without further preparation, other than possibly heating up. *Cooked fruits and vegetables* encompass goods such as tins of potatoes, tins of rhubarb, vegetables and fruits in the chiller cabinet that simply require heating up in a microwave. These are goods that are prepared for consumption without any action by the purchaser or where all that is necessary is for the product to be heated or where it is used as an ingredient, such as a pie filling. They share points of conjunction with prepared meals and fruit and vegetable jellies in that they include the same basis foodstuffs and so have the same nature, they are prepared ready for consumption, they can be found in the same areas of shops eg in the chiller and freezer cabinets for ready meals. The end user is someone who wants food products that do not require preparation, they could come through the same channels of trade. *Cooked fruit and vegetables* are similar to a good degree with the *prepared meals* and *fruit and vegetable jellies* of the earlier registration.

39) *Preserved and dried fruit and vegetables* will encompass goods that have been tinned, frozen and put into jars; as well as those that have been dried. Preserved fruit and vegetables may be in a state that means that they do not require further preparation; they may be eaten cold or heated up eg peaches and potatoes respectively. There are a limited number of vegetables that are dried eg peas, tomatoes and mushrooms (even if tomatoes are technically fruits and mushroom fungi, they are viewed and referred to as vegetables in the normal course of trade and purchase). With the exception of some dried tomatoes, which are sold in jars, dried vegetables require reconstituting with water and then cooking. Dried fruits encompass such things as prunes, figs, apricots, raisins, sultanas and bananas. Dried prunes and figs will normally be reconstituted with water before use. Raisins, sultanas, apricots and the like can be eaten from the packet or used as an ingredient, normally in sweet dishes but in some cooking from Asia Minor and the Middle East in savoury dishes also. *Preserved fruit and vegetables* could constitute a course of a meal, eg tinned fruit salad or jars of mixed anti-pasta, consequently, they would have all of the characteristics of prepared meals and so are highly similar to the last mentioned goods. *Dried fruit and vegetables* are found in discrete areas of stores. The specification of the earlier registration includes soups in dried form and dry mixtures for prepared meals. The nature of the last mentioned goods means that they will be in powdered form and so of a different nature to *dried fruit and vegetables*. Soups in dried form will be with tins of soups and dry mixtures for prepared meals will be with instant, powdered meals. The goods of the earlier registration at large are not fungible nor is there any symbiotic or mutually dependent relationship with *dried fruit and vegetables*, they are neither complementary nor in competition. The respective goods have a different nature. There is a conjunction at the most general level in that various of the goods of the earlier registration in class 30 will be ingredients in dishes but that potentially covers virtually all foodstuffs. The differences between *dried fruit and vegetables* and the goods of the earlier registration are such that they cannot be considered to be similar.

40) In its submissions Lidl no longer claims that all of the goods of the application are similar or identical to the class 30 goods of the earlier registration. The claim is now limited to:

rice, tapioca, sago; preparations made from cereals, maize meal, polenta; pasta, tortillas; pastries, flans, pies, salt, mustard; seasonings; vinegar, sauces (condiments); relishes (condiments); spices; instant, prepared, cooked, chilled and ready meals and snacks included in Class 30; sauces; cooking sauces; pour over sauces; sauce powders; salad dressings; herbs; mixtures of herbs; tomato sauce; tomato ketchup; tomato based sauces; pizzas; pizza toppings; curry (spice), curry powder, curry sauces, curry paste; ingredients for all the aforesaid goods included in Class 30;

The claim to similarity/identity in relation to the class 30 goods of the application is based solely on some of the class 30 goods of the earlier registration. In its

submissions Lidl does not claim that *yeast, baking powder, sauces (including salad dressings)* are identical or similar to the class 30 goods to which it refers. The parameters that Lidl has set exclude identical goods ie *yeast, baking powder* and *sauces*. My considerations are limited to the examination of the facts, evidence and arguments provided by the parties and to the relief sought^x and so my consideration of similarity/identity of the class 30 goods of the application is limited to the parameters set by the opponent and so I must accept this apparent oddity. I cannot second guess the intentions of the opponent.

41) *Salad dressings; cooking sauces; pour over sauces; instant, prepared, cooked, chilled and ready meals and snacks included in Class 30; sauces; spices; sauces (condiments); mustard; vinegar; seasonings; salt; herbs; mixtures of herbs; curry powder, curry sauces, curry paste; ingredients for all the aforesaid goods included in Class 30; curry (spice), tomato ketchup; relishes (condiments)* of the application are all encompassed by the class 30 goods upon which Lidl relies or are general categories of goods which include the specific class 30 goods upon which Lidl relies. Consequently, all of the aforesaid goods are identical or can be considered to be identical.

42) *Tomato sauce* and *tomato based sauces* could all be of a spiced variety and so would encompass *spiced sauces*; consequently, the first mentioned goods can be considered to be identical to the goods of the earlier registration.

43) The sole purpose of *sauce powders* is to make sauces, sauces that could be spiced. So the intended purpose of *sauce powders* and *spiced sauces* is the same. The respective goods are alternatives to each other and fungible, and so in competition with each other. The purchasers are the same, persons who want a sauce to be used with their food. The goods could be found in the same area of a supermarket. *Sauce powders* are highly similar to *spiced sauces*.

44) The earlier registration includes *prepared meals and dry mixtures for prepared meals, mainly consisting of rice, noodles, potatoes and/or vegetables*. There is potential ambiguity arising from the presence of *mainly*. It could be read as meaning that the main constituent of the meals is one or more of the ingredients that follows or that in the main the prepared meals will include one or more of these ingredients, ie the specification will encompass prepared meals that do not consist of one or more of these ingredients. I consider that the former is the more likely reading of the specification; this is supported by the other language versions of the international registration:

“mets prêts et mixtures sèche pour mets prêts, se composant essentiellement de riz, nouilles, pommes de terre et/ou légumes.”

“platos preparados y mezclas secas para platos preparados, principalmente a base de arroz, fideos, patatas y/o verduras.”

The German base registration also supports this interpretation:

“Fertiggerichte und Trockenmischungen für Fertiggerichte, im wesentlichen bestehend aus Reis, Nudeln, Kartoffeln und/oder Gemüse.”

The prepared meals of the earlier registration include those that mainly consist of rice and/or noodles. Noodles are a form of pasta. *Rice* and *pasta* appear in the specification of the application. The respective goods having the same main ingredient, have the same nature; although the goods of the application require processing to become edible. A customer could choose to buy the unprepared product and add other products to it or buy the prepared meal, so there is a degree of competition between the respective goods. The intended purpose of the products is very much the same, to supply a noodle or rice based meal. In my experience rice and pasta often occupy adjacent shelf space or the same shelf space as rice and pasta that is in the form of a ready meal, especially when the last mentioned goods are in dry form or vacuum packed. It follows from the above that the end user is the same. Rice and noodles (a form of pasta) are essential to the goods of the earlier registration, the average customer is likely, as per *Boston Scientific Ltd*, to consider that the respective goods have the same source, so they are complementary. *Rice* and *pasta* are similar to a high degree to *prepared meals and dry mixtures for prepared meals, mainly consisting of rice, noodles, potatoes and/or vegetables*.

45) *Preparations made from cereals* is a very loose and wide term. Rice is a cereal, noodles, being a flour product, are a cereal product. Consequently, *preparations made from cereals* will encompass *prepared meals and dry mixtures for prepared meals, mainly consisting of rice, noodles, potatoes and/or vegetables*; the respective goods must be considered to be identical.

46) *Tapioca, sago, maize meal, polenta* are raw staple foods that require the addition of some other substance, eg water, to become edible. They will normally be found in the same area as other dry, staple goods eg couscous. There are no goods in the class 30 specification of the earlier registration that are of the same nature or will be found in the same area of a supermarket. None of the goods of the class 30 specification of the earlier registration are fungible with *tapioca, sago, maize meal, polenta*; they are not mutually dependent nor do they have a symbiotic relationship; they are not in competition or complementary. The nature of these dry, staple goods is different to that of the class 30 goods of the earlier registration. *Tapioca, sago, maize meal, polenta* and many of the class 30 goods of the earlier registration will be used as ingredients for dishes, this however is a similarity at the most broad of levels. The same could be said of virtually any foodstuff that was not a prepared meal. The differences between *tapioca, sago, maize meal, polenta* and the class 30 goods of the earlier registration are such that they cannot be considered to be similar; the same would apply if Lidl had made the comparison also with the class 29 goods of its registration.

47) *Tortillas* in class 30 are of the Mexican rather than Spanish variety ie flat breads made of maize or wheat flour. Other than that the class 30 goods of the earlier registration are foodstuffs I can see no conjunction between *tortillas* and the goods of the earlier registration; they are not similar.

48) A pizza is a meal and so the *pizzas* of the application can be described as prepared meals. They are not, however, mainly of rice, noodles, potatoes and/or vegetables and so do not fall within the parameters of the prepared meals of the earlier registration. They do, however, share the characteristic of being a prepared meal. The purchaser of both sets of goods is someone who wishes to buy a meal that does not require preparation. Prepared meals are found in together in, for example, the chiller cabinets of supermarkets; in these cabinets the prepared meals are often categorised by reference to geographical origin of the dishes or the nature of the dishes. So one will find, for instance, Indian food lumped together and pizzas lumped together. The purchaser of the respective goods is looking for a prepared meal and so might choose a pizza or a pasta dish; there is, then, a degree of competition between pizzas and other prepared meals. There is a reasonable degree of similarity between *pizzas* and the prepared meals of the earlier registration.

49) *Flans* and *pies* normally have cases of some form of fat and flour mixture. *Flans* will encompass products such as quiches and *pies* will encompass meat pies. The arguments that apply to the comparison with pizzas similarly apply in relation to these goods and so there is a reasonable degree of similarity between *flans* and *pies* and the prepared meals of the earlier registration.

50) *Pastries* are various types of small cakes, often iced, filled or decorated and made of pastry or various sponge or cake mixtures. Other than that they are foodstuffs I cannot see in conjunction between these products and the class 30 goods of the application. *Pastries* are not similar to the goods of the earlier registration. (It is to be borne in mind that Lidl's submissions do not make any claim to similarity between the class 30 goods of the application and the class 29 goods of its registration.)

51) Lidl claims that the class 43 services of the application are complementary to the goods of its registration. It claims that the goods and services are identical in nature; I cannot see how a service can have the same nature as a product. Lidl submits that its goods could be used as ingredients or as principal food sources in the services of the application. Lidl submits that it is quite common nowadays for café and restaurant services to be provided within retail stores and so consumers are quite used to purchasing the goods and services on the same premises. It is common to be able to purchase a battery and a cauliflower in the same store, this does not give rise to similarity.

52) Lidl's registration includes *prepared meals* and *soups*. *Services for providing food and drink; provision of food and drink; restaurant, takeaway, cafe and bar*

services; take away food and beverage services; take away food outlet; catering services; sandwich and snack bar services; preparation and serving of food and beverages; preparation of sandwiches, salads, snacks, soups, biscuits, cakes, desserts, ready meals and beverages of the application all supply prepared meals or soups. The format of the specification does not suggest that the supply of beverages are supplied as a standalone service but are part of the general catering services; in making this analysis of the specification I bear in mind the *Avnet* principle. The purpose of services of the application is to satiate hunger as are the *prepared meals and soups* of the earlier registration. One could avail oneself of the service or buy a prepared meal or soup. Consequently, the respective goods and services have the same end users, the same purpose and are in competition. The supplying of prepared meals and soup is essential to the provision of the services; the average consumer is likely, as per *Boston Scientific Ltd*, to consider that the goods and services have the same source. The respective goods and services are complementary. There is a high degree of similarity between the *prepared meals and soups* of the earlier registration and the class 43 services of the application rehearsed above.

53) *Contract food services* will encompass the supplying of food to undertakings for use in their kitchens, as with *Brakes*, or the running of kitchens for undertakings, eg running a staff canteen. In the case of the former the supplying of food products is essential to the service and so the average consumer is likely to consider that the goods and services have the same source and so the goods of the earlier registration and *contract food services* are complementary to a high degree. The services and the goods have the same purpose to satiate hunger. There is a high degree of similarity between *contract food services* and the goods of the earlier registration.

54) *Information, consultancy and advisory services including helpline services relating to all the aforesaid services* are not catering services themselves but furnish services in relation to catering services. These services are not linked to the goods of the application, so they are two steps away from the goods of the earlier registration. The aforesaid services are not fungible with the goods of the earlier registration. Owing to their relating to catering services rather than food products there is no mutually dependent or symbiotic relationship between them and the goods of the earlier registration, they are not complementary. Being a service they have a different nature to goods. The intended purpose is to supply information and assistance, so they have a different purpose to foodstuffs and the respective customers will be different. The aforesaid services are not similar to the goods of the earlier registration.

Comparison of trade marks

55) The trade marks to be compared are:

Lidl's trade mark:

Mr Quinn's trade mark:

Cusina



The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details^{xi}. The visual, aural and conceptual similarities of the marks must, therefore, be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components^{xii}. Consequently, I must not indulge in an artificial dissection of the trade marks, although I need to take into account any distinctive and dominant components. The average consumer rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he/she has kept in his/her mind and he/she is deemed to be reasonably well informed and reasonably circumspect and observant^{xiii}. The assessment of the similarity of the trade marks must be made by reference to the perception of the relevant public^{xiv}.

56) Mr Quinn's trade marks are in colour. This does not have a bearing on the issue of similarity as Lidl's trade mark is registered without regard to colour, therefore, the presence of colour in Mr Quinn's trade mark cannot create a significant difference, the matter must be assessed on the similarity between the respective words and configurations without regard to colour^{xv}.

57) I have dealt with cucina being the Italian word for kitchen above. For the average consumer CucinA will have no meaning, nor will Cusina. So all of the trade marks are, for the average consumer, invented words without reference to the goods and services. So there can be neither conceptual dissonance nor conceptual similarity. This absence of meaning, as dealt with above, means that Mr Quinn's trade marks will not be pronounced in an 'Italian fashion'.

58) Mr Quinn refers to the distinctiveness of what he calls a slice of fruit in his trade marks. Like Lidl I saw this as an asterisk. It is a very minor part of the trade marks in terms of visual significance. If it is seen as a slice of fruit in relation to food products and food related services it will lack distinctiveness as it

will simply be seen as referring to the goods and services. The letters C and A in Mr Quinn's trade marks are in upper case and start from below the other letters. However, that is going to have little effect on the perception of the average consumer of the goods and services, and it is that perception that is key. The distinctive and dominant component of Mr Quinn's trade marks is the word element. Lidl's trade mark has no elements into which it would readily be divided, the whole of the trade mark is the distinctive and dominant component.

59) The two words are six letters long, only the third letters differ. There is no great stylisation of the lettering of Mr Quinn's trade marks. Taking into account the presence of the device element to the left of the letter A and the size of the letters C and A in Mr Quinn's trade marks, the respective trade marks are still similar to a very high degree.

60) The average consumer is likely to pronounce the first two and final three letters of the trade marks in the same manner. If, for instance, he/she pronounces the u in Lidl's trade mark as ewe, he/she will do the same with Mr Quinn's trade mark. Equally if he/she pronounces the u in Lidl's trade mark as oo, he/she will do the same with Mr Quinn's trade mark. Lidl submits that the letter c is often pronounced as a sibilant and so, effectively, the two trade marks will be phonetically identical. It gives examples of the words cinema and incinerate. There are few words in English that begin with cuc. I can think of cuckoo, cucumber and cuckold. In all of these cases the second c is pronounced as a hard c. This in itself is in no way definitive. The first and third words have a k following the letter c and the standard orthography leads to the ck sound being spoken as a hard c. The letters after, as well as before, may indicate how a word will be pronounced. In Lidl's example of incinerate, the letter c is followed by a letter i as is the case here. I do not consider that one can come to a hard and fast conclusion as to how the c in CucinA will be pronounced. My inclination is to pronounce it with a soft c. So for average consumers who pronounce it in this manner the respective trade marks are phonetically identical. For the average consumer who pronounces the c as hard c there is still a high degree of phonetic similarity between the respective trade marks.

61) The respective trade marks, taking into account the stylised element and device on the application, are similar to a high degree.

Likelihood of conclusion

62) Where I have found that the respective goods and services are not similar there cannot be a likelihood of confusion.

63) In considering whether there is a likelihood of confusion in relation to the goods that are identical or similar various factors have to be taken into account. There is the interdependency principle – a lesser degree of similarity between trade marks may be offset by a greater degree of similarity between goods, and

vice versa^{xvi}. In this case the respective trade marks are similar to a high degree. Certain of the goods are identical and certain of the goods and services similar to a high or reasonable degree.

64) It is necessary to consider the distinctive character of the earlier trade mark; the more distinctive the earlier trade mark (either by nature or nurture) the greater the likelihood of confusion^{xvii}. The distinctive character of a trade mark can be appraised only, first, by reference to the goods or services in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public^{xviii}. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the mark to identify the goods for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods from those of other undertakings^{xix}. Lidl's trade mark is an invented word, it is not allusive of the goods to which it relates. It will not have an evocative effect. Lidl's trade mark enjoys a high degree of inherent distinctiveness.

65) In *New Look Ltd v Office for the Harmonization in the Internal Market (Trade Marks and Designs)* Joined cases T-117/03 to T-119/03 and T-171/03 the CFI stated:

“49 However, it should be noted that in the global assessment of the likelihood of confusion, the visual, aural or conceptual aspects of the opposing signs do not always have the same weight. It is appropriate to examine the objective conditions under which the marks may be present on the market (*BUDMEN*, paragraph 57). The extent of the similarity or difference between the signs may depend, in particular, on the inherent qualities of the signs or the conditions under which the goods or services covered by the opposing signs are marketed. If the goods covered by the mark in question are usually sold in self-service stores where consumer choose the product themselves and must therefore rely primarily on the image of the trade mark applied to the product, the visual similarity between the signs will as a general rule be more important. If on the other hand the product covered is primarily sold orally, greater weight will usually be attributed to any aural similarity between the signs.”

In this case the goods are likely to be bought by the eye in self-service stores and so the visual similarity is of particular importance. In relation to the services of the application it is quite possible that the services will often be referred to orally. However, the trade marks will still be seen and used on advertising literature, promotional literature and signage, so visual similarity is of equal importance. Owing to the high degree of both visual and phonetic similarity nothing turns upon this issue.

66) As the respective trade marks are invented words there is no conceptual hook upon which the average consumer can rely upon in recalling the trade marks. Taking into account the nature of the goods and services, the proximity of the respective trade marks, the distinctiveness of the earlier trade mark in relation to all goods and services which are identical or similar there is a likelihood of confusion. Indeed confusion seems to be inevitable.

67) As referred to at the beginning of the decision the evidence of use by Mr Quinn is not relevant to whether there is a likelihood of confusion. Even if the trade marks did have a reputation for all of the goods and services at the material date this could not assist him. The question of confusion rests on whether the average consumer would believe that the goods and services sold under the respective signs came from the same or an economically linked undertaking^{xx} and any claimed reputation would not affect this. If the consumer considered that Mr Quinn was responsible for the Lidl products this would still be confusion ie the customer would believe that the goods came from the same or an economically linked undertaking. Of course there is no indication that Lidl have put goods on the market under its trade mark.

The application is to be refused in respect of the following goods and services:

meat, fish, poultry and game; products made from meat, fish, poultry or game; meat extracts; preserved and cooked fruits and vegetables; products made from dried and cooked fruits and vegetables; vegetable salads; jellies, fruit sauces; products made from eggs; milk products; dairy products; edible oils and fats; pickles; tomato juice for cooking, tomato paste, tomato puree; instant, prepared, cooked, chilled and ready meals and snacks included in Class 29; snack foods; salads; soups; starters, entrees, all consisting of or based on egg, meat, fish, cheese, poultry, fruit and vegetables; desserts, puddings included in Class 29; fruit salads; onion products; pizza toppings; ingredients for all the aforesaid included in Class 29;

rice; preparations made from cereals; pasta; flans, pies, salt, mustard; seasonings; vinegar, sauces (condiments); relishes (condiments); spices; instant, prepared, cooked, chilled and ready meals and snacks included in Class 30; sauces; cooking sauces; pour over sauces; sauce powders; salad dressings; herbs; mixtures of herbs; tomato sauce; tomato ketchup; tomato based sauces; pizzas; pizza toppings; curry (spice), curry powder, curry sauces, curry paste; ingredients for all the aforesaid goods included in Class 30;

services for providing food and drink; provision of food and drink; restaurant, takeaway, cafe and bar services; take away food and beverage services; take away food outlet; catering services; sandwich and snack bar

services; preparation and serving of food and beverages; preparation of sandwiches, salads, snacks, soups, biscuits, cakes, desserts, ready meals and beverages; contract food services.

Costs

68) Lidl, for the most party having been successful, is entitled to a contribution towards its costs. In its submissions Lidl asks the registrar to take into account the volume of evidence that Mr Quinn filed and its relevance. As I have indicated the evidence was not relevant to the case and could not have been relevant to the case. In these circumstances I will make an award of costs at the higher end of the scale in relation to Lidl's consideration of the evidence of Mr Quinn.

69) I award costs on the following basis:

Opposition fee:	£200
Preparing a statement and considering the counterstatement of Mr Quinn:	£300
Considering the evidence of Mr Quinn:	£1,000
Written submissions:	£300
Total:	£1,800

I order Mr Stephen Paul Quinn to pay Lidl Stiftung & Co KG the sum of £1,800. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 5th day of January 2010

**David Landau
For the Registrar
the Comptroller-General**

ⁱ Trade Mark Opposition and Invalidation Proceedings - Defences

Defences including a claim that the applicant for registration/registered proprietor has a registered trade mark that predates the trade mark upon which the attacker relies for grounds under sections 5(1) and 5(2) of the Act.

1. A number of counterstatements in opposition and invalidation actions have prayed in aid that the applicant for registration/registered proprietor has a registered trade mark (or trade mark application) for the same or a highly similar trade mark to that which is the subject of the proceedings that predates the earlier mark upon which the attacker relies.

2. Sections 5(1) and 5(2) of the Act turn upon whether the attacker has an earlier trade mark compared to the mark under attack, as defined by section 6 of the Act. Whether the applicant for registration/registered proprietor has another registered trade mark (or trade mark application) that predates the earlier mark upon which the attacker relies cannot affect the outcome of the case in relation to these grounds.

3. The position was explained by the Court of First Instance in *PepsiCo, Inc v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) T-269/02*:

“24 Nor did the applicant claim, and even less prove, that it had used its earlier German mark to obtain cancellation of the intervener’s mark before the competent national authorities, or even that it had commenced proceedings for that purpose.

25 In those circumstances, the Court notes that, quite irrespective of the question whether the applicant had adduced evidence of the existence of its earlier German mark before OHIM, the existence of that mark alone would not in any event have been sufficient reason for rejecting the opposition. The applicant would still have had to prove that it had been successful in having the intervener’s mark cancelled by the competent national authorities.

26 The validity of a national trade mark, in this case the intervener’s, may not be called in question in proceedings for registration of a Community trade mark, but only in cancellation proceedings brought in the Member State concerned (Case T-6/01 *Matratzen Concord v OHIM – Hukla Germany (MATRATZEN)* [2002] ECR II-4335, paragraph 55). Moreover, although it is for OHIM to ascertain, on the basis of evidence which it is up to the opponent to produce, the existence of the national mark relied on in support of the opposition, it is not for it to rule on a conflict between that mark and another mark at national level, such a conflict falling within the competence of the national authorities.”

The position with regard to defences based on use of the trade mark under attack which precedes the date of use or registration of the attacker’s mark

4. The viability of such a defence was considered by the Ms Anna Carboni, sitting as the appointed person, in *Ion Associates Ltd v Philip Stainton and Another*, BL O-211-09. Ms Carboni rejected the defence as being wrong in law.

5. Users of the IPO are therefore reminded that defences to section 5(1) or (2) grounds based on the applicant for registration/registered proprietor owning another mark which is earlier still compared to the attacker’s mark, or having used the trade mark before the attacker used or registered its mark are wrong in law. If the owner of the mark under attack has an earlier mark or right which could be used to oppose or invalidate the trade mark relied upon by the attacker, and the applicant for registration/registered proprietor wishes to invoke that earlier mark/right, the proper course is to oppose or apply to invalidate the attacker’s mark.

Reliance on the Absence of Confusion in the Marketplace

6. Parties are also reminded that claims as to a lack of confusion in the market place will seldom have an effect on the outcome of a case under section 5(2) of the Act.

7. In *Compass Publishing BV v Compass Logistics Ltd* [2004] RPC 41 Laddie J held:

“22. It is frequently said by trade mark lawyers that when the proprietor’s mark and the defendant’s sign have been used in the market place but no confusion has been caused, then there cannot exist a likelihood of confusion under Article 9.1(b) or the equivalent provision in the Trade Marks Act 1994 (“the 1994 Act”), that is to say s. 10(2). So, no confusion in the market place means no infringement of the registered trade mark. This is, however, no more than a rule of thumb. It must be borne in mind that the provisions in the legislation relating to infringement are not simply reflective of what is happening in the market. It is possible to register a mark which is not being used. Infringement in such a case must involve considering notional use of the registered mark. In such a case there can be no confusion in practice, yet it is possible for there to be a finding of infringement. Similarly, even when the proprietor of a registered mark uses it, he may well not use it throughout the whole width of the registration or he may use it on a scale which is very small compared with the sector of trade in which the mark is registered and the alleged infringer’s use may be very limited also. In the former situation, the court must consider notional use extended to the full width of the classification of goods or services. In the latter it must consider notional use on a scale where direct competition between the proprietor and the alleged infringer could take place.”

8. (In *Rousselon Freres et Cie v Horwood Homewares Limited* [2008] EWHC 881 (Ch) Warren J commented:

“99. There is a dispute between Mr Arnold and Mr Vanhegan whether the question of a likelihood of confusion is an abstract question rather than whether anyone has been confused in practice. Mr Vanhegan relies on what was said by Laddie J in *Compass Publishing BV v Compass Logistics Ltd* [2004] RPC 41 at paragraphs 22 to 26, especially paragraph 23. Mr Arnold says that that cannot any longer be regarded as a correct statement of the law in the light of *O2 Holdings Ltd v Hutchison 3G Ltd* [2007] RPC 16. For my part, I do not see any reason to doubt what Laddie J says....”

9. In *The European Limited v The Economist Newspaper Ltd* [1998] FSR 283 Millett LJ stated:

“Absence of evidence of actual confusion is rarely significant, especially in a trade mark case where it may be due to differences extraneous to the plaintiff’s registered trade mark.”

ⁱⁱ *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV* [2000] FSR 77.

ⁱⁱⁱ *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281.

^{iv} *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267.

^v *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32 dealt with a non-use issue but are still pertinent to the consideration of the meaning and effect of specifications:

“In my view that task should be carried out so as to limit the specification so that it reflects the circumstances of the particular trade and the way that the public would perceive the use. The court, when deciding whether there is confusion under section 10(2), adopts the attitude of the

average reasonably informed consumer of the products. If the test of infringement is to be applied by the court having adopted the attitude of such a person, then I believe it appropriate that the court should do the same when deciding what is the fair way to describe the use that a proprietor has made of his mark. Thus, the court should inform itself of the nature of trade and then decide how the notional consumer would describe such use”

^{vi} *Altecnic Ltd's Trade Mark Application* [2002] RPC 34.

^{vii} *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117.

^{viii} He considered that the following should be taken into account when assessing the similarity of goods and/or services:

- “(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.”

^{ix} See *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-133/05* paragraph 29:

“In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 *Oberhauser v OHIM – Petit Liberto (Fifties)* [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 *Vedial v OHIM – France Distribution (HUBERT)* [2002] ECR II-5275, paragraphs 43 and 44; and Case T-10/03 *Koubi v OHIM – Flabesa (CONFORFLEX)* [2004] ECR II-719, paragraphs 41 and 42).”

The above is a translation from the French. There is no variation in the judgment in French:

“29 En outre, des produits peuvent être considérés comme identiques lorsque les produits que désigne la marque antérieure sont inclus dans une catégorie plus générale visée par la demande de marque [arrêt du Tribunal du 23 octobre 2002, Institut für Lernsysteme/OHMI – Educational Services (ELS), T 388/00, Rec. p. II 4301, point 53], ou lorsque les produits visés par la demande de marque sont inclus dans une catégorie plus générale visée par la marque antérieure [arrêts du Tribunal du 23 octobre 2002, Oberhauser/OHMI - Petit Liberto (Fifties), T 104/01, Rec. p. II 4359, points 32 et 33 ; du 12 décembre 2002, Vedial/OHMI - France Distribution (HUBERT), T 110/01, Rec. p. II 5275, points 43 et 44, et du 18 février 2004, Koubi/OHMI - Flabesa (CONFORFLEX), T 10/03, Rec. p. II 719, points 41 et 42].”

This is also the position of Professor Annand, sitting as the appointed person in *Galileo International Technology LLC v Galileo Brand Architecture Limited* BL 0/269/04:

“13. I agree with Mr. Onslow that the issue raised by this appeal is whether, when considering the test of identity for section 5(1), it is sufficient that goods or services overlap or must they be co-

extensive. Like Mr. Onslow, I am unaware of any authority supporting a co-extensive test. Kerly's Law of Trade Marks and Trade Names, 13th Edition, states at para. 8-10:

"... the goods or services must be the same as those the subject of the earlier trade mark. Although not explicit, it would seem that this provision can only sensibly be interpreted as prohibiting registration where there is an overlap of goods or services."

A footnote indicates that such interpretation is in accordance with Article 13 of Council Directive 89/104/EEC. Although not expressly included, it is well established that the TMA must be read subject to Article 13, which provides:

"Where grounds for refusal of registration or for revocation or invalidity of a trade mark exist in respect of only some of the goods or services for which that trade mark has been applied for or registered, refusal of registration or revocation or invalidity shall cover those goods or services only."

14. The equivalent to section 5(1) in Council Regulation (EC) No. 40/94 on the Community trade mark ("CTMR") is Article 8(1)(a). Mr. Onslow referred me to two decisions of the Opposition Division of the Office for Harmonisation in the Internal Market (Trade Marks and Designs) ("OHIM") concerning Article 8(1)(a) of the CTMR where identity of goods and services was found to subsist through overlaps in specifications. In WALLIS, Decision No. 1978/2004, identity was found inter alia between Class 14 specifications even though the contested CTM application covered additional goods in that class. The Opposition Division said:

"There is identity between the goods or services that are subject to comparison if they either have the same wording or can be considered synonyms. The identity is also found if the specification of the earlier mark includes a generic term that covers the specific goods of the contested application. Similarly if the goods specifically designated in the earlier mark are covered by a generic term used in the contested application, such goods are identical, to the degree that they are included in the broad category. Finally, in case that the goods in question overlap in part they are also to be considered as identical."

A similar decision was arrived at in PACE, Decision No. 1033/2003. Again, the Class 41 services in the CTM application were wider than those in the earlier CTM registration. In addition, there was held to be identity between some of the applicant's Class 42 services namely, "computer programming; providing of expert opinion". The opponent's registration was in respect of "consulting services related to improving and expediting product development, industrial research services, computer programming services" in Class 42. The Opposition Division observed:

"In particular, the applicant's expression providing of expert opinion in class 42, is broad enough to encompass any consulting services registered by the opponent in class 42, which makes them equivalent to the extent that the one includes the other."

15. The overlap test for identity of goods and services is also applied by the OHIM in connection with priority and seniority claiming under Articles 29, and 34 and 35 of the CTMR respectively. Indeed, it is recognised that partial priority claiming (i.e. where the subsequent application is for a narrower or wider specification than in the application(s) from which priority is claimed) is a possibility under section 33 of the TMA, which speaks of a right of priority "for some or all of the same goods or services" in a Convention application.

16. I believe that overlapping specifications satisfy the test for identical goods or services in section 5(1) of the TMA. There is no necessity for such specifications to co-extend."

I do not consider that the judgment of Norris J is in *Budejovický Budvar, národní Podnik v Anheuser-Busch Inc* [2008] EWHC 263 (Ch) is in conflict with the above. In that case he stated:

“41. There is however one respect in which this appeal succeeds. AB's application for a declaration of invalidity extended to the whole of BB's registration in respect of "beer ale and porter; malt beverages;" (although its own registration related only to "beer ale and porter"). In his decision the Hearing Officer regarded it as obvious that in respect of "beer, ale and porter" the respective specifications encompassed the same goods (and the contrary has not been argued before me). He said:-

"The only possible area of contention is the description "malt beverages" in the mark in suit. The term covers all beverages made with malt, including "malt beers" and the like. Accordingly the specification of the registration that is the subject of these proceedings is covered in its entirety by the specifications of [AB's] earlier mark"

This is a determination of a mixed question of fact and law which I must approach with caution. But in my judgement this passage discloses an error of principle. AB's earlier mark covered only "beer, ale and porter". BB's included "malt beverages". The specification of AB's earlier mark simply did not cover entirely the specification of the mark in suit. It is necessary to decide whether "malt beverages" can only be "beer ale and porter", or whether "malt beverages" can include goods which are not identical with or similar to "beer ale and porter".

42. I do not consider that "malt beverages" can only be (and are therefore identical with) "beer ale and porter". The form of the specification would indicate that "beer, ale and porter;" is one category and "malt beverages" another, with possibly an overlap between the two. One is not simply an alternative description for the other."

In the above judgment Norris J was considering whether the respective goods could be described as being identical, not whether they should be considered to be identical. There is a deal of difference between stating that goods **are** identical and stating that they are considered to be identical.

If one did not follow the principles laid down by the CFI and Professor Annand considering similarity of goods in certain cases would become virtually impossible. If, for example, an earlier registration was for wedding dresses and an application for clothing one would have to consider the degree of similarity between the former goods and every potential product covered by the term clothing as there would be varying degrees of similarity and the global appreciation of the likelihood of confusion requires consideration of the degree of similarity between goods and/or services.

An applicant has plenty of time to amend a specification which includes a portmanteau term so that the term list goods which are of specific interest. If the applicant does not do so then it must expect to bear the consequences.

^x *Iudex judicare debet secundum allegata et probata partibus.*

^{xi} *Sabel BV v Puma AG* [1998] RPC 199.

^{xii} *Sabel BV v Puma AG* [1998] RPC 199.

^{xiii} *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV* [2000] FSR 77.

^{xiv} *Succession Picasso v OHIM - DaimlerChrysler (PICARO)* Case T-185/02.

^{xv} *Mary Quant Cosmetics Japan Ltd v Able C & C Co Ltd* BL O/246/08 Mr Geoffrey Hobbs QC, sitting as the appointed person:

“10. The present oppositions under Section 5(2)(b) are based on the rights conferred by registration of a device mark recorded in the register in black-and-white. It follows that colouring is immaterial to the distinctiveness of the Opponent’s device mark as registered and therefore irrelevant for the purposes of the assessment of similarity in both oppositions.”

^{xvi} *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117.

^{xvii} *Sabel BV v Puma AG* [1998] RPC 199.

^{xviii} *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91.

^{xix} *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

^{xx} *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117.