

O-022-11

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS BEING:

AN APPLICATION FOR REGISTRATION BY NISA-TODAY'S (HOLDINGS)
LIMITED AND OPPOSITION THERETO UNDER NO 99313 BY WM MORRISON
SUPERMARKETS PLC

AND

REGISTRATION NO 2244532A IN THE NAME OF WM MORRISON
SUPERMARKETS PLC AND AN APPLICATION FOR A DECLARATION OF
INVALIDITY THEREOF BY NISA-TODAY'S (HOLDINGS) LIMITED

AND

REGISTRATION NO 2437925 IN THE NAME OF WM MORRISON
SUPERMARKETS PLC AND AN APPLICATION FOR A DECLARATION OF
INVALIDITY THEREOF BY NISA-TODAY'S (HOLDINGS) LIMITED

Background

1. This decision concerns three related proceedings:

1: Opposition 99313 against application 2509033

i: Application No 2509033 stands in the name of Nisa-Today's (Holdings) Limited ("Nisa") and is for the following mark:

The logo for 'FreshGo' features the word 'Fresh' in a bold, brown, sans-serif font. The letter 'h' in 'Fresh' is partially overlapping with the word 'Go', which is written in a lighter, rounded, brown font.

ii: It has a filing date of 18 February 2009 and was published in the Trade Marks Journal on 17 April 2009 for the following specification of goods:

Class 29:

Food and drinks products, foodstuffs and drinks, ingredients thereof and supplements therefore, including: meat, fish, seafoods, poultry and game; meat, fish, vegetables and fruit extracts; preserved, dried and cooked fruits and vegetables; extracts of fruit and/or vegetables; meat products; sausages; prepared meals; snack foods; jellies, jams, fruit preserves, vegetable preserves; sauces; desserts; eggs; milk; dairy products; yoghurt; frozen yoghurt; edible protein derived from soya beans; edible oils and fats; nuts and nut butters; pickles; herbs; tofu; weed extracts for foods; food spreads consisting wholly or substantially wholly of vegetables, milk, meat, poultry, fish, seafoods or of edible fats; soups; bouillons; vegetable salads; fruit salads; fruit chips; vegetable chips; potato chips; potato crisps

Class 30:

Food and drinks products, foodstuffs and drinks, ingredients thereof and supplements therefore, including: coffee, coffee essences, coffee extracts; mixtures of coffee and chicory, chicory and chicory mixtures, all for use as substitutes for coffee; tea, tea extracts; cocoa; preparations made principally of cocoa; chocolate; chocolate products; sugar, maltose, rice, tapioca, sago, couscous, tabbouleh; flour and preparations made from cereals and/or rice and/or flour; nut paste, confectionery and candy, breakfast cereals; pastry; pizza, pasta and pasta products; bread; bread products; biscuits; cookies; cakes; ice, ice cream, water ices, frozen confections; preparations for making ice cream and/or water ices and/or frozen confections; honey; syrup, treacle, molasses; sauces and preparations for making sauces; custard powder; prepared meals; mousses; desserts; puddings; yeast, baking powder; salt, pepper, mustard; vinegar; chutney; spices and seasonings; meat pies; mayonnaise; natural sweeteners; salad dressings; snack foods; sandwiches; sushi

Class 31:

Agricultural, horticultural and forestry products and grains not included in other classes; fresh fruit and vegetables; seeds, natural plants and flowers; foodstuffs for animals; malt.

Class 32:

Beers; mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages; vegetable preparations for use as drinks.

iii: Following its publication, a notice of opposition to the registration of the mark was filed by Wm Morrison Supermarkets Plc (“Morrisons”). The grounds of opposition are, briefly, as follows:

- Under section 5(2)(b) of the Act based on earlier trade mark no 2437925 and against all goods of the application. The earlier mark relied upon completed its registration process on 25 May 2007 and is not subject to the proof of use provisions set out in section 6 of the Act;
- Under section 5(3) of the Act based on earlier trade mark no 2437925 and against all goods of the application. Morrisons claim its mark has a reputation in respect of the following goods:
 - 29: Foodstuffs and drinks; food and drink products; ingredients thereof and supplements therefor;
 - 30: Foodstuffs and drinks; food and drink products; ingredients thereof and supplements therefor;
 - 31: Fresh fruit and vegetables; nuts;
 - 32: Drinks and preparations for making them; juices.

Morrisons claim that registration of the mark applied for is calculated to take advantage, without due cause, of the significant reputation it enjoys. It claims that Nisa will gain significant unfair advantage from using a mark ‘so similar to the mark of the well known opponent’ which would be detrimental to that marks’ distinctive character and would cause harm to Morrisons’ reputation for providing high quality fresh food.

- Under section 5(4)(a) of the Act based on use, since July 2007, of the mark FRESH TO GO in relation to *foodstuffs and drinks, food and drink products; ingredients thereof and supplements therefor; drinks and preparations for making them; juices.*

iv: Nisa filed a counterstatement in which it denies its application should be refused on the basis of the grounds claimed. It admits that the component parts of its mark appear in the earlier mark. It also admits that the respective goods are identical or closely similar, that both parties produce food and drink

to be stocked in retail outlets and that Morrisons is a leading supermarket chain in the UK. It otherwise denies the claims made and puts Morrisons to proof that the use it claims to have made of its earlier mark leads it to be distinctive and have a reputation.

2: Declaration of invalidity no 83565 against registration no 2244532A

i: Registration No 2244532A stands in the name of Morrisons and is for the following series of two trade marks:

FRESH TO GO
fresh to go

ii: The mark was registered with effect from 5 September 2000 in relation to the following goods:

Class 29

Foodstuffs and drinks; food and drink products; ingredients thereof and supplements therefor;

Class 30

Foodstuffs and drinks; food and drink products; ingredients thereof and supplements therefor;

Class 31

Fresh fruit and vegetables; nuts, herbs and seeds; natural plants, flowers and grasses; foodstuffs for domestic pets; cat litter; malt; supplements for animal foodstuffs;

Class 32

Drinks and preparations for making them; juices.

iii: On 20 August 2009 Nisa filed an application to declare this registration invalid. The application is made under the provisions of section 47 of the Act based on section 3(1)(b),(c) and (d) of the Act. In its statement of grounds Nisa puts its claims as follows:

2. The first mark in the series consists of the phrase "FRESH TO GO" in plain capitals and the second mark consists of the same phrase but in lower case in what appears to be a handwritten script.

3. Although the second mark is stylised, the degree of stylisation is so slight that it will simply be perceived by consumers as the phrase

“FRESH TO GO” and in this regard is no more visually distinctive than the first mark in the series.

4. The word FRESH is a commonly used English word, the dictionary meaning of which is; “not stale or deteriorated; newly made etc” or “not canned, frozen or otherwise preserved”.

5. The phrase TO GO is likewise commonly used and, as well as being the infinitive form of the verb “go”, is also widely used in respect of food and drink products to indicate that the products are to be taken from the premises in which they are sold, rather than consumed on the premises.

6. The composite phrase FRESH TO GO will therefore be perceived by consumers as an indication that the products in respect of which the trade mark is used are newly made and available to be consumed off the premises in which they are being sold.

7. The Trade Mark should therefore be declared invalid according to the provisions of Section 3(1)(b) and (c) of the Act.

8. The phrase FRESH TO GO is used by traders in the food sector in respect of food and drink products.

9. The Trade Mark should therefore be declared invalid according to the provisions of Section 3(1)(d) of the Act.

iv: Morrisons filed a counterstatement in which it denied the claims made. Further, and in the alternative, it claims that if there is a difference in the distinctiveness of the two marks in the series then the stylisation of the second mark in the series adds to its distinctiveness under section 3(1)(b). It also claims in the alternative, that the mark has been in continuous and extensive use since 2006 and has acquired distinctiveness through that use.

3: Declaration of invalidity no 83566 against registration no 2437925

i: Registration no 2437925 stands in the name of Morrisons and is for the following series of two marks:

FRESH TO GO

fresh to go

ii: The mark was registered with effect from 6 November 2006 in relation to the following goods:

Class 29

Foodstuffs and drinks; food and drink products; ingredients thereof and supplements therefor

Class 30

Foodstuffs and drinks; food and drink products; ingredients thereof and supplements therefor

Class 31

Fresh fruit and vegetables; nuts, herbs and seeds; natural plants, flowers and grasses; foodstuffs for domestic pets; cat litter; malt; supplements for animal foodstuffs.

iii: On 20 August 2009 Nisa filed an application to declare this registration invalid. Its application against this registration is identical to that set out above as is the counterstatement that Morrisons filed in defence.

2. The three sets of proceedings were consolidated. Both parties filed evidence and the matter came before me for hearing on 23 November 2010. Mr Guy Hollingworth of Counsel, instructed by Marks & Clerk LLP represented Morrisons whilst Mr Martin Krause, of Haseltine Lake, represented Nisa.

Preliminary issue

3. On 15th November 2010, Nisa filed a request to amend its statements of grounds. I dealt with this as a preliminary point at the hearing. By the requested amendment Nisa sought to change the wording of paragraph 6 of its statement of grounds (as set out above) so as to read: 'The composite phrase FRESH TO GO will therefore be perceived by consumers as an indication that the products in respect of which the trade mark is used are fresh and available to be taken away from the premises in which they are being sold.'

4. Mr Krause indicated that the requested amendment was purely a minor point of clarification. Mr Hollingworth confirmed that he had no objection to the amendment. Whilst the amendment was requested at a very late stage in the proceedings, it seemed to me that it was more a change of style than substance and did not necessitate the filing of any amended counterstatement. I allowed the amendment.

The evidence

5. Evidence was filed by Michael Bates who is marketing director for Morrisons and by Zoë Gaye, a trainee trade mark attorney with Haseltine Lake on behalf of Nisa.

Morrisons' evidence

6. Mr Bates has filed two witness statements (one as evidence in reply). In them, he gives evidence that Morrisons traded for many years before becoming incorporated as a registered entity in 1940. It operates over 422 stores in the UK which between them serve over 10 million customers each week. In 2004 Morrisons acquired the supermarket chain Safeway along with goodwill and all intellectual property rights.

7. Registration no. 2244532A was originally obtained by Safeway in 2000 and, whilst he believes the mark was used by that firm, Mr Bates states that he is unable to provide any evidence of any such use. He states that Morrisons itself first used the mark Fresh to Go in May 2007.

8. Mr Bates states that Fresh To Go products are stocked in over 300 Morrisons stores all across the UK (see exhibit MB1) and that a wide variety of salads, pasta pots, rolls, wraps, baguettes, sandwiches and bottled drinks have been sold under the mark (see MB 3). Indicating that the figures provided reflect special offer reductions, Mr Bates gives turnover figures for these goods as follows:

Date	Turnover £s
May 2007-3 Feb 2008	14,703,253
4 Feb 2008-1 Feb 2009	11,852,238
2 Feb 2009-22 Nov 2009	10,217,314

9. Mr Bates states that the mark has been promoted via in-store leafleting and on the Morrisons' website. Whilst he indicates that the website received 8.8 million visitors in 2008, he gives no further details of these visitors or the pages they may have accessed. He states that in 2007, leaflets (as shown in exhibit MB4) were distributed in 8 new stores at a cost of £72k, in 9 new stores in 2008 at a cost of £84k and in 6 new stores in 2009 at a cost of £50k. In 2009 some 5000 leaflets in the form of a guide showing the mark were distributed into each of 250 stores at a cost of £93k. Mr Bates also states that advertisements were placed in Morrisons' own magazine of which over a million were distributed in store. He exhibits an extract from one of these magazines at MB8 (see below).

10. Mr Bates exhibits the following:

MB1: a list of the location of Morrisons' stores;

MB2: A selection of prints of photographs taken in a number of stores. The photographs show either food preparation and serving counters or self-service fridges. Above the food preparation and serving counter are the words Fresh to go. Other signs indicate that a variety of salads are available which are "so fresh you can pick it yourself!" The other photographs show fridges displaying a range of drinks, food containers, sandwiches and baguettes. Signage above the fridges show the mark 'Fresh to go...' with the word Fresh (in green) with the initial letter capitalised, with the words *to go* in lower case italicised letters and the whole followed by an ellipsis;

MB3: A schedule of products sold under the mark;

MB4: Pages 1-8 are parts of leaflets said to have been prepared for the Stratford, Walderslade and Skipton stores. I do not know whether these were in fact issued as some contain typographical errors, however, on pages 1, 2 and 3, which are essentially the same, there is a picture of a man selecting a sandwich from a fridge which bears the words 'Fresh to go...' again as described above. The text of the leaflet indicates there is "A wider choice at Fresh to go". Pages 4-8 and 10 make no reference to the mark. Page 9 is in

greyscale but shows 'Fresh to go...' with fresh being in lighter tone than the remainder. The text indicates the "Fresh to go counter is the perfect place to grab a tasty takeaway salad or freshly made sandwich..."

MB5: This is a copy of a newspaper advertisement which ran in the week commencing 5 October 2009. Mr Bates says the advertisement was placed in the Sun, Daily Mail and Daily Express newspapers at a cost of £30,526.80. The exhibit is a printer's copy of an advertisement showing three wrapped baguettes. Each wrapper bears a label with the word Morrisons and an 'M' device above the words 'Fresh to go...'. The page is presented in greyscale but the 'Fresh' is in a lighter tone than that of the words and ellipsis 'to go...'

MB6: This is a selection of store guides. The exhibit consists of 6 pages. Pages 1 and 2, relating to the Westbury store, do not show the mark. The remaining pages relate to the Eccles and Small Heath stores. Pages 3, 5 and 6 show the same picture as shown in the material at MB4 of a man selecting a sandwich from a fridge which bears the words and ellipsis Fresh to go... as described above. Underneath the picture are the words "improved Fresh to go". Pages 4 and 7 both show a store layout plan which includes the location of a 'Fresh to go...' area in the form described above. The location is between the 'Your Fishmonger' and 'The delicatessen' areas;

MB7: This exhibit is said to consist of sample packaging. Pages 1 to 5 show design artwork for sandwich wrappers and salad cartons. All five pages show the mark as Fresh to go... with the reference at page 5 again showing the word fresh in green and the remainder in black. Pages 6-9 are photographs of plastic salad cartons which have the words Fresh to go... underneath the word Morrisons on the lid;

MB8: This consists of an extract from an undated 'morrisonsmagazine'. It contains an interview with a staff member from the Johnstone store. The article is headed Fresh to go... again in green and black. The staff member is described as the "Fresh to Go Supervisor". She describes how one customer "loves the takeaway food because "it's so fresh"". The article states that "There's a huge variety of Fresh to Go food [available];

MB9: This is a page from the Morrisons' website which shows it was downloaded on 21 December 2009. It advertises that the 'Fresh to Go counter is the perfect place to grab a takeaway at any time of day' and describes how staff "make sandwiches fresh in-store every day and the "same goes for our salads: our coleslaw, for example, is prepared fresh each day" and "our pizzas are freshly prepared in-store".

Nisa's evidence

11. Ms Gaye's evidence is the result of what she calls "research work to support the invalidity challenge". She says she has "looked at the use of the words FRESH and the phrases TO GO and FRESH TO GO together with the use of the word and phrases in the UK of trade mark registration numbers 2437925 and 2244532A (the "Registrations") at the date of application, from the date of application until the date

of registration and from the date of registration until the date of the invalidity action No. 83565 and No. 83566”.

12. Ms Gaye explains how, in September 2000, she was a student at the University of Reading. She says that she was familiar at that date with the use of the phrase ‘to go’ to mean buying food or drink in a restaurant, shop or café and to take it away to eat or drink elsewhere. She exhibits the following:

ZCG1 and ZCG2: extracts from the Collins English Dictionary 3rd Ed and the Compact Oxford English Dictionary showing the entries for ‘fresh’;

ZCG3: a copy of the guidance to the Food Standards Agency Criteria for the use of term fresh (and others) in food labelling. No details are given to allow me to establish when this guidance was published or its relevance;

ZCG4: a copy of an ASA adjudication given on 21 November 2007. It refers to a number of complaints made against a Morrisons’ television advertisement and shows the complaints were made in relation to bread (whether it was made from scratch and freshly baked in store), fish (whether it had ever been frozen), meat (only pre-packed available) and sandwiches (whether they were pre-packed or not). None of the complaints were upheld. Ms Gaye gives no explanation of the relevance of this material;

ZCG5 and ZCG6: a copy of an article published by The Telegraph on 3 Feb 2009 about a company called Salads To Go and said to have been set up in 2000, along with a print out from Companies House giving details of that company. Ms Gaye says this shows ‘to go’ was used by the company which was established on 15 June 2000;

ZCG7: a printout from encyclopedia.com referring to an article in the Journal of Environmental Health on 1 July 2000. The printout appears to provide a link to an article entitled “Holding Food-to Go Hot and Fresh (Brief Article)” but the article is not exhibited and I have no idea what it might have contained;

ZCG8: a copy of an article from The Guardian’s website published on 11 July 2001. It relates to ““coffee to go” outlets from the United States [which have] been invading” the coffee houses of Vienna;

ZCG9: an extract from the Retail Week website which refers to an article dated 27 August 2004 which itself refers to Tesco’s intention to “capture a significant share of the UK coffee-to go market”;

ZCG10: a copy of an article published on 27 March 2007 on the cnet.co.uk website entitled ‘Hyperactive Bob gets fries to go’. The article itself refers to a computer system designed to “manage the kitchens at so-called quick-service restaurants”;

ZCG11: an extract from the scavenger.net website dated November 2007 which indicates it is “for start up and small business research”. Ms Gaye highlights that it explains how “A sandwich shop provides sandwiches and a

range of other goods such as savouries, cakes, sweets, crisps and drinks for people buying their lunch or eating on the go' but again she provides no explanation of the relevance of this material;

ZCG12: an extract from the Devon Deli company's website. There is a reference to the café and sandwich bar guaranteeing good service if you want "a quick sandwich to go". It bears a copyright date of 2005;

ZCG13: a Wolverhampton City Campus website extract. It gives details of on-campus catering and where one can get "a fresh coffee and sandwich to go" Whilst it is not dated the print shows the page to have a clickable list on the left hand side which refers to Christmas 2009;

ZCG14: a Discountcoffee.co.uk website extract downloaded on 21 December 2009 referring to "takeaway "Coffee To Go" disposable cups";

ZCG15: an extract from Elliesdeli.co.uk website. The print is incomplete (in that it shows only the left hand part of the page) but begins "As the "food to go" market place increases..." . It was downloaded on 28 January 2010;

ZCG16: an extract from IGD.com website. Again the print is incomplete but it appears to offer purchasers a report entitled Food to Go and mentions "retail food-to go offers". It was downloaded on 27 January 2010;

ZCG17: an extract from lucas-ingredients.co.uk website. Above some pictures of various foods there are the words Food to go! It was downloaded on 27 January 2010;

ZCG18: an extract from Greggs website downloaded on 20 January 2010. It refers to 'baker-fresh food on the go' and 'food on the go';

ZCG19: an extract from the kamcity.com website. It refers to an article about an A C Nielsen report and shows it was published on 25 February 2003. The article is entitled 'Fast, Fresh and Frequent: The Future of Convenience Retailing' and makes references to Jamie Oliver teaching "us how to create food again while demonstrating the convenient ready to go lifestyle" and how the shopping experience has "a focus on good and fresh food-to-go";

ZCG 20: an article from the howto.techworld.com website with a publication date of 15 April 2005. It describes how Prêt-a-Manger's customers want "good and fresh food to go";

ZCG 21: details of a community mark registration in the name of a third party.



fresh food ready to go...
fresh food ready to go...
fresh food ready to go...

;

The mark has an application date of 29 September 2006.

ZCG22: a copy of a press release dated 25 March 2008 giving details of Marks & Spencer's launch of its "new Food to Go range of sandwiches and snacks" and which indicates that 'Gourmet to Go' Deli Stacks, Deli Wraps and Asian style salads are just some of the new Food to Go lunches which have been created";

ZCG23: an extract from packaging news website dated 2 July 2008 entitled "Exhibition for the 'food to go' market to be expanded";

ZCG 24: an extract from the nacsonline website dated July 2009 and which refers to a petroleum company launching a standalone convenience format offering "fresh, food-to-go in busy metropolitan environments" in the UAE and Egypt;

ZCG 25: an extract from a web chatroom where bloggers are discussing a Japanese supermarket in London as a place suitable for purchasing "the fresh food to go". The entry is dated 11 October 2009;

ZCG 26: an extract downloaded on 16 November 2009 from the daltonsbusiness website advertising a property for sale in Devon. The property is described as a "busy food to go outlet" in Barnstaple;

ZCG27: details of an expired UK registration, in the name of a third party, which was applied for on 24 January 2000 for the following mark;



ZCG28: an extract taken on 21 December 2009 from the eatanddrink website. It provides a recipe for a Vegetable Layer Press which is introduced as- 'something bright, light, appetizing and fresh to go with the pasta'. No explanation is given of the relevance of this material;

ZCG29: a copy of Norwich council's Environmental Health Food Team's report following a visit to Morrison's Riverside store which mentions the 'Fresh to Go/Fresh to go' areas of the store. The date of the inspection was 3.2.09;

ZCG30: a copy of a newsletter of the Elvetham Heath development dated Autumn 2003. It refers to locals 'taking advantage of [Safeway's] Pizzeria Fresh to Go Pizza and coffee shop';

ZCG31: an extract from the Trovit job website downloaded on 21 December 2009 showing an advertisement for staff at Morrisons in County Londonderry. It refers to 'our range of fresh to go products';

ZCG32: an extract from The Architects' Journal website dated 20 February 2003. It appears to be a comment from a reader about an earlier published

article. The comment criticises how ‘The food that we are sold as being ‘fresh to go’ has often travelled from the other side of the world”;

ZCG33: an extract dated 30 May 2003 from RetailWeek which refers to a new Budgens Quickstop store opening in Brighton which has an ‘emphasis on top-up shopping and a strong fresh-to-go range’;

ZCG34: an extract dated 9 July 2007 from thegrocer website. It contains an article about a new store chain in London which it says has placed its coffee and juice bar ‘alongside the fresh-to-go deli and sandwich bar...’;

ZCG 35: an extract from the Colorado Springs Gazette and dated 4 June 2008. It refers to the local 7-Eleven store’s new Fresh to Go cabinet;

ZCG 36: an article dated 3 February 2009 from the Northants Evening Telegraph advertising the opening of a new petrol station in Corby which has a ‘selection of fresh-to-go food and self-serve coffee’;

ZCG 37: an extract from the Londis.ie website which was downloaded on 21 December 2009 and indicates that the company has a ‘commitment to provide healthy fresh food to go’;

ZCG38: an extract from the iss caterhouse website downloaded on 15 October 2009 which describes how the school meals provider has incorporated “Fresh to Go” into its café areas;

ZCG39: this is a duplicate of one of the pages exhibited in ZCG38:

ZCG 40: extract from the saladfayre (Newtownards) website downloaded on 27 January 2010. It is not easy to read but appears to indicate that ‘our Fresh to Go range is available in handy take-home packs...’;

ZCG41: this is a duplicate of ZCG33;

ZCG42: an article dated 1 March 2007 from the bakeryinfo website. It reports how Greggs is experimenting with ‘a Fresh to Go branded shop’ but that it is very unlikely to add a new sub-brand such as Fresh to Go to its business:

ZCG43: a flyer for the annual Edinburgh & District Riding Club show which took place on 2 September 2007. It bears a line which states “First Aid, “Fresh to Go” Catering.”;

ZCG44: a copy of a newsletter of a construction and property consultancy and dated December 2008. An article within it describes how ““Fresh to Go” has arrived in Bristol” through the opening of a new coffee bar;

ZCG45: an extract from the Yell.com website downloaded on 27 January 2010 giving contact details for a café/ coffee shop in Ormskirk called Fresh To Go;

ZCG46: an extract from the qype website downloaded on 15 October 2009 giving contact details of a Fresh to Go café/coffee shop in Lincoln;

ZCG47: an extract from the qype website downloaded on 27 January 2010. It appears to be a page reviewing various cafés and coffee shops. Ms Gaye states it refers to a food related company called Fresh 2 Go but I can see no such reference on the exhibit;

ZCG48: an article published on 5 March 2005 on the living.scotsman website. The article makes reference to a 'Fresh To Go Travel Kit';

ZCG49: an extract downloaded on 27 January 2010 and from the Seaside Company website. It offers for sale a Fresh2go insulated wine carrier;

ZCG50: an extract downloaded on 21 December 2009 from the John Lewis website offering for sale a Fresh 2 Go lunch bag;

ZCG51: an extract from a blog on the netmums website. 'Gemma B' posted, on 22 September 2009, that she made a sauce and "cooked pasta fresh to go with it". No explanation is given of the relevance of this material;

ZCG52: an extract from the Nissan 350ZOC owners' blog. The message was posted on 14 August 2009 and asks the reader "Want your car fresh to go for the summer?";

ZCG53: a copy of a food hygiene report relating to a Somerfield store in Glasgow and dated 8 January 2007. The report refers to an inspection "within the "Fresh to Go" area";

ZCG54: an article from the Guardian published on 24 November 2009. It refers to Safeway's plans to "remodel its smaller outlets as convenience stores concentrating on "fresh food to go"";

ZCG55: an article dated 14 December 2000 from the Independent which refers to the Safeway's Wapping store having a "fresh to go" area;

ZCG56: an article from The Grocer dated 6 January 2001 referring to Safeway's in-store fresh to go section;

ZCG57: an article from The Telegraph dated 17 May 2001 referring to Safeway's Fresh to Go departments;

ZCG58: an article dated 17 May 2001 from the Reading Post referring to Safeway introducing Fresh to Go cafés :

ZCG59: an article from the Edinburgh Evening News dated 4 June 2001 referring to Safeway's fresh to go areas;

ZCG60: an article from the citywire website dated 5 June 2001 referring to Safeway's fresh-to go areas;

ZCG61: an article from The Grocer dated 9 June 2001 referring to the Safeway fresh to go section;

ZCG62: an article from The Grocer dated 29 September 2001 referring to a Safeway hypermarket and its new range of fresh to go foods;

ZCG63: an article dated 25 September 2001 published on the business.scotsman website referring to Safeway's Fresh to Go theme/strategy';

ZCG64: an article from The Observer dated 25 November 2001 referring to Safeway's "move to catering with the fresh-to-go instant meals campaign";

ZCG65: an extract from the Morrisons' website downloaded on 27 January 2010 referring to "our Fresh to Go counter";

ZCG66 and ZCG67; copies of documentation taken from the Trade Mark Registry's files of the two registered marks the subject of the invalidation actions.

13. That completes my summary of the evidence filed by both parties.

Decision

The invalidation actions

14. I intend to consider the invalidation actions first. This is because the earlier mark relied on by Morrisons (no 2437925) in its opposition against Nisa's application is itself the subject of one of the invalidity actions. Nisa seeks to invalidate two registrations which are both for a series of two marks each comprising the words Fresh To Go. The parties agree that the marks of each registration are identical. The goods covered by each registration are likewise identical. In each case the first mark in the series is presented in plain block capitals. The second mark in each series is presented in what Mr Krause submitted was "simply a lower case cursive script [which] does not add any distinctiveness at all to the trade mark." He went on to say that "it would not be seen as noteworthy at all by the average consumer". Mr Hollingworth indicated that he did not dispute this and I proceed on this basis. As the two registrations differ only in respect of their application and registration dates, I intend to deal with both of them together by referring to them as one mark and one registration, where appropriate, whilst taking into account the different material dates of the two registrations as necessary.

15. Section 47 of the Act sets out the grounds under which a registration may be declared invalid. It states:

"47.-(1) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 3 or any of the provisions referred to in that section (absolute grounds for refusal of registration).

Where the trade mark was registered in breach of subsection (1)(b), (c) or (d) of that section, it shall not be declared invalid if, in consequence of the use which has been made of it, it has after registration acquired a distinctive character in relation to the goods or services for which it is registered.”

16. Nisa’s claim that the trade mark should be declared invalid under section 47 of the Act is itself based on section 3(1)(b)(c) and (d) of the Act. At the hearing, Mr Krause confirmed that the objection based on section 3(1)(d) was to be withdrawn. He indicated that the objection made under section 3(1)(c) was his primary ground of objection. Again, I proceed on that basis.

17. Section 3 of the Act states:

“3.-(1) The following shall not be registered-

(a) ...

(b) trade marks which are devoid of any distinctive character,

(c) trade marks which consist exclusively of signs or indication which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,

(d) ...

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.”

18. As explained by the ECJ in *DOUBLEMINT* Case C-191/01 at paragraphs 30 and 31, the purpose of this exclusion from registration of such signs is the public interest in precluding any individual trader from obtaining a monopoly in a sign which other traders might legitimately wish to use because of its descriptiveness. The presumption is that such signs do not fulfil the primary function of a trade mark i.e. they do not indicate the origin of the goods or services.

19. The proviso to section 3(1) of the Act, however, provides an exception to this exclusion. If a trader can demonstrate that through the use made of it his mark has become sufficiently distinctive so that it does in fact serve as an indication of origin in the minds of the relevant public or a significant proportion thereof (see *Windsurfing Chiemsee* C-108/97) then registration may be granted.

20. In *POSTKANTOOR* C-363/99 and in relation to Article 3(1)(c) (the equivalent of section 3(1)(c) of the Act), the ECJ stated;

“97... A word must therefore be refused registration under that provision if at least one of its possible meanings designates a characteristic of the goods or services concerned...

98 As a general rule, a mere combination of elements, each of which is descriptive of characteristics of the goods or services in respect of which registration is sought, itself remains descriptive of those characteristics for the purpose of Article 3(1)(c) of the Directive. Merely bringing those elements together without introducing any unusual variations, in particular as to syntax or meaning, cannot result in anything other than a mark consisting exclusively of signs or indications which may serve, in trade, to designate characteristics of the goods or services concerned.”

21. The mark is made up of the words FRESH TO GO, all of which, individually, are common English words used in everyday language. There is no dispute as to the meaning of the word FRESH, a word which is very commonly used and associated with foodstuffs and other products such as flowers. As to the words TO GO, whilst there was no dispute that it means the opposite of ‘to stay’, there was disagreement as to how it would have been seen by the average consumer at the relevant dates.

22. Mr Krause submitted that the term would have been widely understood at both dates of application, to mean “for taking away”. He referred me to Ms Gaye’s own evidence of her knowledge of the term in September 2000. Of course, I have to consider what the relevant public would have made of it. He also referred me to exhibits ZCG5 and ZCG6 which was evidence of a company trading at that time and called Salads to go. In addition, he referred me to exhibits ZCG27 and ZCG66 which include details of other applications made by third parties between 1995 and 2001. Mr Krause conceded that he had no evidence that any of the marks referred to had actually been used but submitted that the fact they had been applied for by a number of third parties in relation to foodstuffs, showed that the term was widely understood in the UK at the earliest relevant date. Mr Hollingworth disagreed and submitted that these applications (some of which had progressed to registration) merely showed that traders were using “x’ to go’ in a brand sense. I do not consider that the existence of these other applications and/or registrations particularly assist me. I have no details of the circumstances of their acceptance (where appropriate) but in any event, they are different marks. I have to consider the mark before me afresh and in relation to the goods for which it is registered.

23. Much was made by both parties of dictionary references for the term ‘to go’ shown in exhibits ZCG66 and ZCG67. These show extracts from the Collins English Dictionary 3rd Ed. 1994 update and the later, 5th Ed. 2000 publication of the same dictionary. In the earlier extract, the term is defined in the following way:

“U.S. and Canadian informal; (of food served by a restaurant) for taking away”.

In the latter edition, it is defined thus:

“U.S. and Canadian; informal; (of food served by a restaurant) for taking away”.

24. Mr Krause submitted that these extracts also supported his claim that the meaning of the term would have been widely understood in the UK at the dates of the applications.

25. For his part, Mr Hollingworth submitted that the absence of the semicolon in the earlier dictionary extract showed the term was an Americanism which was not in use in the UK at that date. He submitted that as this definition was “the 61st possible meaning of the phrase...it was hardly consistent with it being something that is in common use at the time”. He submitted that “simple ideas are often the best” and that whilst the phrase FRESH TO GO might be apt or comprehensible that did not mean it was not acceptable as a trade mark. That said, he also submitted that the phrase was syntactically unusual and needed some explanation to make it understood. He referred to exhibits ZCG54 and ZCG55. These show articles with publication dates of November 2000 and December 2000 respectively. The articles show the terms ‘fresh food to go’ and ‘fresh to go’ both in inverted commas which, he submitted, showed that they were unusual terms which needed some explanation to be given to the reader to enable him to understand the phrase.

26. Whatever the semantic niceties of the two differing dictionary entries, the fact remains that the term ‘to go’ essentially meaning ‘takeaway food’ appears in both editions, the latter of which was published in 2000, i.e. the same year in which the earliest of the applications now under consideration was made. The fact that the definition is a long way down the list of possible definitions does not, in my view, make it any less understandable (I note, for example, that another definition even later in the list gives another meaning of ‘go’ as “a turn: e.g. it’s my go next”). I disagree that the use of inverted commas in the articles referred to means that an explanation is needed to enable the reader to understand the term; (exhibit ZCG32, for example, presents both ‘fresh to go’ and ‘local produce’ in this way) but in any event, in no case is any explanation provided by the authors. And even if the term ‘to go’ was an Americanism, there is a long tradition of the American interpretation of language quickly reaching these shores and becoming part of the United Kingdom’s vernacular. It is also the case that the use of the word ‘may’ in section 3(1)(c) indicates that the assessment of descriptiveness is not confined to what is already in common usage but what is reasonably likely to come into descriptive use in the foreseeable future.

27. Of course, I have to consider the mark as a whole. That mark is FRESH TO GO. I do not consider the mark FRESH TO GO was, at either relevant application date, in any way syntactically unusual when used in relation to food products which are made or prepared fresh to go nor do I consider that the average consumer would have needed any explanation of the mark to understand its meaning. It describes the goods as being fresh takeaway products. I believe there is (and was at both dates of application) a ‘direct and specific’ relationship between the words which make up the mark and all of the goods included within the specification within classes 29, 30 and 32 as well as *fresh fruits and vegetables; nuts, herbs and seeds* within class 31, all of which are foodstuffs of one sort or another which are sold as fresh, ready to eat takeaway items. As regards the remaining goods, the position is somewhat different even where those goods could be described as fresh. Whilst all goods are taken away from e.g. a shop, after purchase not all of them would be described as

'takeaway' goods. In my view, and supported by the dictionary references referred to above, 'takeaway' goods are food and drink items for human consumption off the premises. The remaining goods are *Natural plants, flowers and grasses; foodstuffs for domestic pets; cat litter; malt; supplements for animal foodstuffs*. In my view these are not what the average consumer would describe as being takeaway goods. I do not consider that the direct and specific relationship exists in respect of these goods.

28. Taking all matters into account, I find that the mark was registered in breach of section 3(1)(c) of the Act in relation to all goods with the exception of *Natural plants, flowers and grasses; foodstuffs for domestic pets; cat litter; malt; supplements for animal foodstuffs*.

29. As I indicated above, Morrisons submit that if and to the extent that I find against them under this ground, then the mark has acquired distinctiveness through the use made of it. In *Windsurfing Chiemsee Produktions-und Vertriebs GmbH (WSC) v Boots-und Segelzubeh r Walter Huber and Franz Attenberger* Joined Cases C-108/97 and C-109/97, the ECJ stated:

“51. In assessing the distinctive character of a mark in respect of which registration has been applied for, the following may also be taken into account: 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 class of persons who, because of the mark, identify goods as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations.

52. If, on the basis of those factors, the competent authority finds that the relevant class of persons, or at least a significant proportion thereof, identify goods as originating from a particular undertaking because of the trade mark, it must hold that the requirement for registering the mark laid down in Article 3(3) of the Directive is satisfied. However, the circumstances in which that requirement may be regarded as satisfied cannot be shown to exist solely by reference to general, abstract data such as predetermined percentages”.

30. In *Bach and Bach Flower Remedies Trade Marks* Morrit LJ stated, at paragraph 49:

“First, use of a mark does not prove that the mark is distinctive. Increased use, of itself, does not do so either. The use and increased use must be in a distinctive sense to have any materiality.”

31. In the same judgment, Chadwick LJ states, on page 535 at line 11 et seq:

“As Morrit L.J. has pointed out, a reasonably well informed and reasonably observant and circumspect consumer would know, if it be the case, that the words or word are widely used in a generic or descriptive sense-even if he is, himself, aware that they are also used in a distinctive sense. With that knowledge, it seems to me impossible for him to say that the words identify,

for him, the goods as originating from a particular undertaking. Knowing, as he does, that the words may be intended as descriptive, he cannot assert that he understands them as necessarily distinctive.”

32. The mark FRESH TO GO has an obvious descriptive relevance to freshly made or freshly prepared goods for taking away which is the way the average consumer will view the mark. The more descriptive or non-distinctive a mark is, the more important it is to consider what, if anything, the proprietor has done to educate consumers that the mark is, in fact, a trade mark.

33. Mr Bates gives evidence that Morrisons first used the mark in May 2007. That use has been made in respect of salads, wraps, baguettes, sandwiches and bottled drinks. Sales are said to have been made in over 300 stores across the UK with turnover figures said to have been £14.7m (May 2007 to Feb 2008), £11.8m (Feb 08-Feb 09) and £10.2m (Feb 09 to Nov 09) though these figures are not further particularised e.g. to explain what sales relate to food items (and which food items) rather than drink. And whilst these are significant figures of themselves, I am given no information that would allow me to consider them in terms of the relevant market, a market which is likely to be of immense size.

34. The mark is said to have been promoted via leaflets, an in-store magazine and in newspaper advertising. The leaflets were distributed in 8 new stores in 2007, in 9 new stores in 2008 and in 6 new stores in 2009 at a total cost of just over £200k. In addition some 250 stores each distributed some 5000 store guides (at a cost of £93k) in 2009. Whilst just over a million magazines are said to have been distributed to all stores, I have not been given any details that would allow me say when this distribution took place. In terms of the content of the magazine, the only details I have been given relate to a single extract from a magazine which reported an interview under the title ‘Fresh to go’ with the Fresh to Go Supervisor from the Johnstone store. This appeared below a similar interview with the Assistant Bakery Manager from the York store under the title ‘The Bakery’. The leaflets and guides contain various mentions of Fresh to go. At MB4, for example, the leaflet at page 1 refers to a ‘new At Home range’ an ‘improved Health & Beauty department’ and ‘improved Fresh to go’ and indicates that there is ‘A wider choice at Fresh to go’. Page 9 of the same exhibit is a leaflet which is entitled ‘Enjoy fresh food prepared in store every day’ and shows four departments within the store. The four departments are shown as ‘Family Butcher’, ‘The Bakery’, ‘Your Fishmonger’ and ‘Fresh to go’ all of which appear to be presented under the Morrisons’ ‘Market Street’ banner. Store guides, such as that shown at page 4 of exhibit MB6, show the Fresh to go area on the external wall of a store along with other areas such as ‘YOUR FISHMONGER’ (where the word YOUR is presented in smaller letters and placed between two horizontal lines), ‘The Delicatessen’ (where the word THE is in smaller superscript letters), ‘The Cake Shop’ (where the word CAKE is in a stylised font) and ‘The Bakery’ (where again the word THE is in smaller letters). Whilst Mr Hollingworth said these presentations were understood as “individualising a particular part of the Morrisons’ store”, Mr Krause went slightly further and submitted that this highlighted the fact that Morrisons has a “practice of effectively taking a descriptive term and tweaking it a bit to individualise it for a particular part of the store.” Mr Krause went on to say that “what it does not do is to change the perception from a descriptive one into a trade mark perception and indication of origin”. In his view, that is what had

happened with the mark FRESH TO GO. The mark was simply non distinctive and whether presented as registered or in the colours and format shown on some of the exhibits, it remained non distinctive. He referred me to exhibits MB9 and ZCG31 as examples of how Morrisons itself used the mark descriptively. The former exhibit states that the reader can “find out which sandwich was chosen as the winner in your region and is now available fresh to go at **your local Morrisons**”. The latter refers to “our range of fresh to go products”.

35. For his part, Mr Hollingworth accepted that exhibit MB9 was an example of use of the mark in a non trade mark manner but submitted that this one ‘a one-off’ that was ‘a play on words’. The same, he submitted, was true about the descriptive mention in exhibit ZCG31. He accepted that use of the mark FRESH TO GO had taken place alongside the mark MORRISONS, whether on the packaging or in the store but argued that it was well known that supermarkets use sub-brands which is how FRESH TO GO is recognised.

36. I have no evidence from the trade or from the public to show how they view the mark. What is shown in the evidence is that Morrisons have used the mark in a combination of colours and fonts and with an ellipsis which is suggestive perhaps that Morrisons itself considers more would need to be added to its registered form in order to give it an element of distinctiveness. Also shown in the evidence is that others have used the words FRESH TO GO to describe takeaway foods. For example, exhibits ZCG33 and ZCG41 which date from 30 May 2003, show that Budgens supermarket had a fresh to go range at that time and ZCG42 dated 1 March 2007, shows that Greggs Bakers had been trialling a fresh to go healthy eating range in a number of its stores. Both of these exhibits pre-date Morrisons’ first claimed use of the mark. Other exhibits show use by a variety of other undertakings since that time (see, for example, ZCG34, ZCG36, ZCG38 and 39, and ZCG40)

37. In summary, there is evidence that the mark is used as a descriptive term in relation to foodstuffs. Advertising which has been carried out by Morrisons is overwhelmingly carried out in store and with other signs. Whilst there is no evidence from the trade or the public, there is evidence of use (some of it pre-dating the use by Morrisons) by a number of other undertakings in a descriptive and generic manner which has the effect of educating the public to see the term in this way rather than as an indicator of origin. In all the circumstances, I do not consider that Morrisons has discharged the onus on it and I reject the claim that the mark has acquired distinctiveness as at the date of the hearing in relation to any of the goods for which it was registered in classes 29, 30 and 32 nor for *fresh fruits and vegetables, nuts, herbs and seeds* in class 31.

38. The claim that the mark has acquired distinctiveness through use has failed. The objection under section 3(1)(c) therefore succeeds in respect of all goods except *natural plants, flowers and grasses; foodstuffs for domestic pets; cat litter; malt; supplements for animal foodstuffs* in relation to registration Nos 2244532A and 2437925.

The objection under section 3(1)(b)

39. In *Koninklijke KPN Nederland NV v Benelux Merkenbureau* the ECJ stated:

“86. In particular, a word mark which is descriptive of characteristics of goods or services for the purposes of Article 3(1)(c) of the Directive is, on that account, necessarily devoid of any distinctive character with regard to the same goods or services within the meaning of Article 3(1)(b) of the Directive. A mark may none the less be devoid of any distinctive character in relation to goods or services for reasons other than the fact that it may be descriptive.”

40. Article 3(1)(b) of the Directive is the equivalent of section 3(1)(b) of the Act. Insofar as I have found that registration of the trade mark was contrary to section 3(1)(c) of the Act I must find that it was also contrary to section 3(1)(b) of the Act.

Summary-invalidations

41. In accordance with section 47(6) of the Act, both of the registrations are to be partially invalidated. The registrations are deemed never to have been made for all goods other than *natural plants, flowers and grasses; foodstuffs for domestic pets; cat litter; malt; supplements for animal foodstuffs*.

The opposition action

42. Morrison brings its opposition to Nisa's application under grounds based on section 5(2), 5(3) and 5(4)(a) of the Act. At the hearing, Mr Hollingworth submitted that the “main case is under section 5(2)(b) and 5(4)(a)”, though he did not go so far as to drop the objection under section 5(3) instead indicating that he considered the evidence of use filed was “sufficient to qualify the mark for protection under section 5(3)”.

43. I will deal with the objection founded upon section 5(2)(b) of the Act first. Section 5(2) states:

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

(a) ...

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

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

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

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

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

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

45. In these proceedings, Morrisons is relying on trade mark no 2437925 which, as it has an application date of 6 November 2006 which is prior to that of the application for registration, qualifies it as an earlier trade mark under the above provisions. The application for registration was published for opposition purposes on 17 April 2009 and the earlier mark was registered on 25 May 2007. As the earlier mark was not registered more than five years before the publication date of the mark for which registration has been applied, the provisions of section 6A of The Trade Marks (Proof of Use, etc) Regulations 2004 are not relevant and Morrisons is not required to prove use of its registration.

46. In determining the question under Section 5(2)(b), I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel v Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] R.P.C. 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R 77, *Marca Mode CV v Adidas AG* [2000] E.T.M.R.723, *Medion AG v Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di Laudato & C. Sas v OHIM* C-334/05 (Limoncello). It is clear from these cases that:

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors: *Sabel BV v Puma AG*, paragraph 22;
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question: *Sabel BV v Puma AG*, paragraph 23, 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 he has kept in his mind; *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen B. V.* paragraph 27;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details: *Sabel BV v Puma AG*, paragraph 23;

- (d) 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; *Sabel BV v Puma AG*, paragraph 23;
- (e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki v Metro-Goldwyn-Mayer Inc*, paragraph 17;
- (f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v Puma Ag*, paragraph 24;
- (g) in determining whether similarity between the goods or services covered by the two trade marks is sufficient to give rise to the likelihood of confusion, the distinctive character and reputation of the earlier mark must be taken into account; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer inc*; mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v Puma AG*, paragraph 26;
- (h) further, 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; *Marca Mode CV v Adidas AG*, paragraph 41;
- (i) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, paragraph 29;
- (j) assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark; the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components; *Medion AG v Thomson Multimedia Sales Germany & Austria GmbH*;
- (k) it is only when all other components of a complex mark are negligible that it is permissible to make the comparison on the basis of the dominant element; *Shaker di L Laudato & C. Sas v OHIM*.

47. In essence, the test under Section 5(2)(b) is whether there are similarities in marks and goods which, when taking into account all the surrounding circumstances, would combine to create a likelihood of confusion. The likelihood of confusion must be appreciated globally and I need to address factors such as the degree of visual, aural and conceptual similarity between the marks, evaluating the importance to be

attached to those different elements and taking into account the degree of similarity in the goods, the category of goods in question and how they are marketed.

Comparison of goods

48. Following my decision in respect of the invalidation proceedings, Morrisons' earlier mark remains registered for a limited specification of goods all of which are included within class 31. Nisa's application covers a wide range of goods in classes 29, 30, 31 and 32 as set out earlier in this decision. All of the goods applied for by Nisa in classes 29, 30 and 32 are food and drinks. Whilst the now limited specification of Morrisons' earlier mark includes *foodstuffs for domestic pets*, I do not consider these to be similar goods. The trade channels and end users differ greatly in respect of goods for human as opposed to those for animal consumption; they are not complementary goods nor are they in competition. I do not consider any of the goods in class 29, 30 or 32 as applied for to be similar to any of the goods which remain in the earlier mark. The comparison therefore rests on the goods of the respective marks as specified in class 31. For ease of reference, the goods to be compared are:

Nisa's application	The earlier mark
<i>Agricultural, horticultural and forestry products and grains not included in other classes; fresh fruit and vegetables; seeds, natural plants and flowers; foodstuffs for animals; malt.</i>	<i>Natural plants, flowers and grasses; foodstuffs for domestic pets; cat litter; malt; supplements for animal foodstuffs</i>

49. *Agricultural, horticultural and forestry products* is a broad term that includes *natural plants, flowers and grasses*. These are therefore identical goods. The term *grain* includes *malt* (malt being a grain) but in any event the term *malt* appears in both specifications and thus these are also identical goods. I do not consider *fresh fruit and vegetables* to be similar to any of the goods of the earlier mark (for the reasons given above). *Seeds* are the propagative parts of plants but are not plants in themselves so these are not similar goods. *Seeds* may be eaten and can be purchased as foodstuffs for pets and thus these are identical goods. *Natural plants and flowers* appear in both specifications and thus these goods are identical. That leaves *foodstuffs for animals* which would include *foodstuffs for domestic pets* and thus these are also identical goods. In summary, I find all of the goods as included within class 31 of Nisa's application to be identical to goods within the remaining specification of the earlier mark with the exception of *fresh fruit and vegetables*.

The average consumer and nature of the purchasing process

50. *Agricultural, horticultural and forestry products; seeds and natural plants and flowers* are such that will be bought by professionals in those particular areas (e.g. landowners, farmers, smallholders and gardeners) but may also be bought by the general public for use e.g. in their gardens or home. Similarly, *foodstuffs for animals* may be bought by professionals or the general public. All of the other goods are such as will be bought by the general public. The price of the goods is likely to vary from the relatively cheap e.g. for a pack of seeds, to the relatively expensive e.g. a rare exotic plant. All of the goods will be bought with some, though not necessarily the highest, degree of care to ensure that the product meets the purchaser's

requirements and is suitable for its intended use. Professionals buying goods in the course of their business may pay a slightly higher degree of care.

Comparison of marks

51. For ease of reference the marks to be compared are as follows:

Nisa's application	Morrisons' earlier mark
	

52. The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (*Sabel BV v Puma AG*). I have to consider the visual, aural and conceptual similarities of the respective marks with reference to the overall impressions created by the marks and bearing in mind their distinctive and dominant components (*Sabel BV v Puma AG*). The average consumer, who rarely has the chance to make a direct comparison between marks but must instead rely upon the imperfect picture of them he has kept in his mind, is deemed to be reasonably well informed and reasonably circumspect and observant (*Lloyd Schuhfabrik Meyer & Co GmbH*).

53. Nisa's application is for the words FRESH GO with the word FRESH above and to the left of the word GO and with the letters H and G slightly overlapping. Whilst the two words are presented in different shades of what appears to me to be a brown colour, the mark is not subject to any claim to colour. Despite the positioning of the two words, neither is dominant. Whilst the two words are both in everyday use and each has a well known meaning, the mark as a whole is grammatically incomplete. Both of the words FRESH and GO appear within the earlier mark, in this case separated by the very short word TO. As I indicated earlier in this decision, the words FRESH TO GO are ordinary everyday words in the English language. Whilst they are descriptive of freshly prepared takeaway goods, they do not have a direct and specific relationship with the goods which remain within the specification of the earlier mark as these are not goods which would generally be considered takeaway items. They are therefore distinctive of these goods. The words 'hang together' so that there is no dominant element.

54. The commonality of the words FRESH and GO within each mark means that there is a high level of visual and aural similarity between them. To the extent that both marks include the word FRESH (as their first word) and GO (as their last word) there is a degree of conceptual similarity between them.

55. In my view, the respective marks are similar to a high degree.

Likelihood of confusion

56. In reaching a decision on whether there is a likelihood of confusion, I must make a global assessment based on all relevant factors. The decision of the General Court in *New Look Ltd v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* Joined cases T-117/03 to T-119/03 and T-171/03, indicates that the circumstances in which the relevant goods and the marks are encountered by the consumer, particularly at the point at which the purchase is made, is an important consideration. But I also have to make an assessment of all relevant factors and take into account the fact that the consumer will rarely have an opportunity to compare marks side by side but will instead rely on the imperfect picture of them he has kept in his mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.* paragraph 27).

57. Another factor to be taken into account is the distinctive character of the earlier trade mark having regard to its inherent characteristics and the reputation it enjoys with the public. There is no evidence of any use of the earlier mark in relation to the goods which remain and I am therefore unable to find that its distinctive character has been enhanced through use. I consider the mark has a reasonable degree of distinctive character in relation to the relevant goods.

58. I have found that the respective marks have a high degree of visual and aural similarity and a degree of conceptual similarity. I have also found all of the goods to be identical with the exception of *fresh fruit and vegetables*; which are not similar. Taking all matters into account and applying the global approach as I am required to do, I find that the opposition succeeds under the grounds of section 5(2)(b) in respect of *Agricultural, horticultural and forestry products and grains not included in other classes; seeds; natural plants and flowers; foodstuffs for animals; malt* but fails in respect of *fresh fruit and vegetables*.

The objection under section 5(4)(a)

59. Section 5(4)(a) reads as follows:

“5.-(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented –

- (a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or
- (b) ...

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an “earlier right” in relation to the trade mark.”

60. The requirements for the ground of opposition under Section 5(4)(a) have been restated many times and can be found in the decision of Mr Geoffrey Hobbs Q.C., sitting as the Appointed Person, in *WILD CHILD Trade Mark* [1998] RPC 455. Adapted to opposition proceedings, the three elements that must be present can be summarised as follows:

- (1) That the opponent's goods have acquired a goodwill or reputation in the market and are known by some distinguishing feature;
- (2) That there is a misrepresentation by the applicant (whether or not intentional) leading or likely to lead the public to believe that goods offered by the applicant are goods of the opponent; and
- (3) That the opponent has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the applicant's misrepresentation.

61. To the above I add the comments of Pumfrey J in *South Cone Incorporated v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* [2002] RPC 19:

"27 There is one major problem in assessing a passing off claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the Registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under Section 11 of the 1938 Act (See *Smith Hayden (OVAX)* (1946) 63 RPC 97 as qualified by *BALI* [1969] RPC 472). Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.

28 Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed at the relevant date. Once raised, the applicant must rebut the prima facie case. Obviously he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the hearing officer that it is not shown on the balance of possibilities that passing off will occur".

62. I must assess whether *Morrison's* has acquired any goodwill and, if so, what the extent of that goodwill is at the relevant date. Goodwill has long been accepted as "the attractive force that brings in custom" (see the comments of Lord MacNaughton in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217, HL). Furthermore, in *Reuter v Mulhens* [1953] 70 RPC 234, the court stated that goodwill in the context of passing off represents the value of the attraction to customers which the name and reputation possesses.

63. The material date at which I have to consider the matter is the date of the filing of the application for registration. However, if the opposed application has been used before this date then this must also be taken into account. *Nisa* does not claim to have used its mark and therefore the relevant date is the date of the filing of the application for registration i.e. 18 February 2009.

64. In its Notice of Opposition, Morrisons claims to have used the mark FRESH TO GO since July 2007 in relation to *foodstuffs and drinks, food and drink products; ingredients thereof and supplements therefor; drinks and preparations for making them; juices.*

65. I have already found the words FRESH TO GO to be descriptive of fresh takeaway food and drinks. And, as I indicated above at paragraph 36, the evidence shows that at least as early as May 2003, others were using the mark FRESH TO GO to describe their ranges of food and drinks. I do not consider that the evidence shows there to be any “attractive force” enjoyed by Morrisons in relation to the mark relied upon. That being the case, the objection based on section 5(4)(a) must fail.

The objection under section 5(3) of the Act

66. Section 5(3) of the Act states:

“(3) A trade mark which –

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

67. As I indicated above Mr Hollingworth did not consider this to be his strongest ground of opposition though he did not go so far as to withdraw the ground. Under this ground, Morrisons rely on its earlier registration No 2437925, the same as that relied on under section 5(2)(b). In my view, Morrisons’ position under this ground can be no better than that under section 5(2)(b) and I decline to deal with it in any great detail. I will say, however, that section 5(3) of the Act gives exceptional rights to a trade mark owner and thus it is necessary for any party claiming such rights to put forward a strong case. Whilst Morrisons’ evidence gives some details of sales said to be made under the mark, there is no evidence which particularises that use in relation to the specific goods sold nor is there any evidence which contextualises that use within the market as a whole. There is no evidence from the trade or the public. And, the fact remains that the evidence also shows the mark was used by others prior to Morrisons’ own use. The objection under section 5(3) fails.

Summary

68. Nisa’s application for invalidation of registration Nos 2244532A and 2437925 succeeds and each of the registrations is invalidated in respect of all goods except *natural plants, flowers and grasses; foodstuffs for domestic pets; cat litter; malt; supplements for animal foodstuffs.* To this extent each of the registrations is deemed never to have been made.

69. Morrisons’ opposition to registration of 2509033 succeeds in relation to *agricultural, horticultural and forestry products and grains not included in other*

classes; seeds; natural plants and flowers, foodstuffs for animals; malt. The application is free to proceed to registration in respect of all other goods.

Costs

70. Both sides have achieved a measure of success. I therefore consider that each should bear its own costs.

Dated this 27 day of January 2011

**For the Registrar
The Comptroller General**