

O-075-10

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NOS 2476844 AND 2492439  
IN THE NAME OF AUNT BESSIE'S LIMITED TO REGISTER A SERIES OF TWO  
TRADE MARKS IN CLASSES 29, 30 AND 32**

**AND**

**IN THE MATTER OF OPPOSITION THERETO UNDER NOS 97026 AND 98551  
IN THE NAME OF GOOD FOOD GRAPHICS LTD**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF Application Nos. 2476844 and 2492439  
In the name of Aunt Bessie's Limited  
to register a series of two Trade Marks in Classes 29, 30 and 32**

**AND**

**IN THE MATTER OF Opposition thereto under Nos. 97206 and 98551  
in the name of Good Food Graphics Ltd**

**BACKGROUND**

1. On 14 January 2008 and 11 July 2008, Aunt Bessie's Limited made applications to register the following series of two marks:

**2476844**

**2492439**



2. Applications No. 2476844 is in respect of goods in Classes 29 and 30, with application No.2492439 covering Classes 29, 30 and 32, in respect of the following specifications of goods:

**2476844**

**Class 29** Meat, fish, poultry and game; products made from meat, fish, poultry and game, prepared meals; desserts consisting predominantly of milk and dairy products; preserved, dried, cooked and frozen fruit and vegetables; cauliflower cheese; sausages in batter; prepared stuffing and stuffing mixes; frozen, cooked, preserved and dried peas, sprouts, carrots, swedes, parsnips, onion rings, potatoes; foodstuffs consisting wholly or principally of potatoes.

**Class 30** Yorkshire puddings; preparations and substances, all for making Yorkshire puddings; prepared meals; puddings; desserts; pancakes, and batter and batter mixes for making pancakes; sweet and savoury dumplings; pastry; bread; biscuits; cakes; cookies; muffins; fruit pies; meat pies; confectionery; products

made from or consisting of batter; cereal preparations for use as fillings, stuffings or as garnishes for foodstuffs; sauces; gravy and gravy mixes; custards and custard mixes; stuffing and stuffing mixes; cottage pies, egg custards, puddings with a milk base.

**2492439**

**Class 29** Meat, fish, poultry and game; products made from meat, fish, poultry and game, foodstuffs consisting predominantly of meat, fish, poultry, vegetables or fruits; foodstuffs made principally of fruit or dairy products and combinations thereof; trifles, yoghurt, mousses, syllabub, fools, blancmange, creme caramel, creme brulee; desserts consisting predominantly of milk, dairy products or fruit; puddings; preserved, dried, cooked, frozen or otherwise prepared fruit and vegetables; prepared meals; prepared dishes: cauliflower cheese; sausages in batter; cottage pie, meat, fish and poultry pies; prepared stuffing and stuffing mixes; frozen, cooked, preserved, dried or otherwise prepared peas, sprouts, carrots, swedes, parsnips, onion rings, potatoes; foodstuffs consisting wholly or principally of potatoes; preparations consisting principally of vegetables, fruits and combinations thereof for use in cooking; marinades, jus, stocks made from meat, fish, poultry or vegetables; sauces for use in preparing food; preserves; jams; pickles; milk drinks; pie and cake fillings.

**Class 30** Yorkshire puddings; preparations and substances, all for making Yorkshire puddings; prepared meals; prepared dishes; puddings; desserts; egg custards; ice and ice cream products; sweet and savoury foodstuffs principally of rice; pancakes and batter and batter mixes for making pancakes; sweet and savoury dumplings and preparations for making said goods; pastry, pastry dough, pastry mixes and pastry cases; pizza bases; pizzas; bread and bread mixes; biscuits, cakes, cookies, muffins, crumpets; pies including fruit pies and savoury pies; confectionery; dough including dough for making bread, cakes, biscuits, pizza bases; products made from or consisting of batter; cereal preparations for use as fillings, stuffings or as garnishes for foodstuffs; sauces; gravy and gravy mixes; custard and custard mixes; stuffing and stuffing mixes.

**Class 32** Soft drinks; non-alcoholic beverages, preparations for making non-alcoholic beverages.

3. On 1 May 2008, Good Food Graphics Ltd filed notice of opposition to application No. 2476844, and on 5 January 2009 to application No. 2492439, the ground of opposition being identical, read as follows:

**Under Section 5(2)(b)** because the marks applied for are similar to an earlier mark and is in respect of goods that are the identical to those of the earlier mark.

4. The earlier mark relied upon, No. 2470302 is for the following series of two marks:



and is registered for the following goods:

**Class 29** Meat, fish, poultry and game; pork; tripe; sausages; sauerkraut; sea-cucumbers; shellfish; seafood; liver; anchovy; caviar; crustaceans; charcuterie; black pudding; bouillon; meat extracts; broth; soup; preserved, dried and cooked fruits and vegetables; fruit chips; crystallized fruits; frosted fruits; potato chips; preserved beans; nuts; jellies, jams, compotes, marmalades; pickles; purees; eggs, albumen, milk and milk products; yoghurt; dairy products; cream; edible oils and fats; butter; margarine; cheese; fatty substances for the manufacture of edible fats; foods prepared from fish; preserved herbs; gelatine for foods; hummus; soya beans; preserved truffles; jellies for food; lard for food; lentils; processed peanuts; raisins; preserved peas; pollen prepared as foodstuff; protein for human consumption; salads; suet for food; tahini; tofu; whey; weed extracts for food.

**Class 30** Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; coffee flavourings; coffee substitutes; chicory; beverages; flour and preparations made from cereals, bread, pastry and confectionery, ices; muesli; flour-milled products; binding agents for ice cream; biscuits; macaroons; cookies; bread; buns; cake paste; cakes; marzipan; candy for food; caramels; honey, treacle; golden syrup; gravies; yeast, baking-powder; custard; salt, mustard; vinegar, sauces (condiments); chutneys; ketchup; mayonnaise; spices; allspice; almond confectionary and paste; aniseed; ice; aromatic preparations for food; barley; chewing gum; chocolate; chips; corn flour; corn meal; couscous; crackers; edible decorations for cakes; dressings for salads; essences for foodstuffs; flavourings, other than essential oils; fondants; glucose for food; gluten for food; infusions, not medicinal; jellies; royal jelly; macaroni; maize; malt extract for food; maltose; meat pies; meal; meat tenderizers; mint for confectionary; molasses; noodles; oatmeal; pancakes; oat-based food; pasta; pepper; pastry; pasty; petits fours; pies; pizzas; popcorn; potato flour for food; pralines; puddings; quiches; ravioli; rice; rice cakes; rolls; rusks; sago; salt; sandwiches; sausage binding materials; semolina; sherbets; sorbets; soya flour; soya sauce; spaghetti; spring rolls; starch for food; sugar; sugar confectionary; sushi; sweeteners; tabbouleh; tacos; tarts; thickening agents for cooking foodstuffs; tortillas; unleavened bread; waffles; weeds; yeast.

5. The matter came to be heard on 4 February 2010, when the opponents were represented by Ms Katrina Peebles of Ablett & Stebbing, their attorneys. The applicants were represented by Ms Jennifer Maddox of W.P. Thompson & Co, their trade mark attorneys. Both sides filed one set of evidence covering both sets of proceedings which insofar as it contains fact I have summarised below. I have not summarised the written submissions but have taken them fully into account in my determination of the case.

### **Opponent's evidence**

6. This consists of a Witness Statement dated 1 December 2008 from Noel Davis, Managing Director of King Parrot Foods Limited. Mr Davis says that he has 17 years experience in the manufacturing, sales and marketing fields. He confirms that he is aware of the products sold under the AUNT BESSIE'S and Device, and the BETTY SMITH'S and Device brands being sold in the frozen foods section of a food retailer. Mr Davis says that the products cost between £1 and £5 per item, and that it well known in the frozen food sector that customers do not take a significant amount of time to study the packaging before purchasing because of the cold nature of the area of the store.

### **Applicant's evidence**

7. This consists of two Witness Statements. The first comes from Adrian Crookes, Finance Director of Aunt Bessie's Limited, a position he has held for 10 years. Mr Crookes says that the company was incorporated in 2000 under the name Tryton Foods Limited changing to its current name on 1 May 2008.

8. Mr Crookes gives the history of his company and the AUNT BESSIES brand stating that this had been created by an agency for a range of frozen Yorkshire pudding products. He says that the first sales were made in 1995 with the range expanding by 2007 to include pancakes, potato products, vegetable products, cauliflower cheese, cottage pie and toad-in-the-hole, and deserts such as steamed puddings, stuffing and dumplings.

9. Mr Crookes gives the following details of the approximate annual sales for AUNT BESSIE'S products in the years 2000 to 2008 apportioned to the classes of the application:

<b>YEAR</b>	<b>Class 29 goods £'000</b>	<b>Class 30 goods £'000</b>
2000	6087	26674
2001	11195	25506
2002	15443	27320
2003	25583	33790
2004	37098	36995
2005	50538	39023
2006	57210	38227
2007	59713	39755
2008	67691	43499

10. Mr Crookes goes on to give the approximate amounts spent on advertising and promoting AUNT BESSIE'S products in the same years, again divided by class:

<b>YEAR</b>	<b>Class 29 goods £'000</b>	<b>Class 30 goods £'000</b>
2000	1166	5111
2001	2241	5105
2002	2897	5126
2003	4548	6517
2004	6615	6597
2005	9207	7110
2006	12024	8034
2007	11497	7654
2008	12619	8109

11. Mr Crookes says that from day one AUNT BESSIE'S Yorkshire puddings have been aggressively advertised, with increasing amounts spent as the range has grown. He goes on to mention various in-store promotions, Press, TV and radio advertising, the AUNT BESSIE'S website, sponsorship and participation in trade fairs. The details given are very limited and although some can be dated and/or linked to a product, there is nothing that shows how the AUNT BESSIE'S mark may have featured.

12. Mr Crook lists Tesco, ASDA, Morrison's, J Sainsbury, Somerfield, Iceland, Co-op, Farmfoods, Nisa and Waitrose, Booker, Makro, and Palmer & Harvey as being amongst the stockists of AUNT BESSIE'S products. Exhibit AC1 is introduced as AUNT BESSIE'S Yorkshire puddings on display in the freezer compartment of J Sainsbury's prior to the change of packaging in Summer 2007. The exhibit consists of a photograph of a section of a frozen food display cabinet in which can be seen AUNT BESSIE'S Yorkshire puddings, and AUNT BESSIE'S Pork Sausage-meat stuffing balls. These show the image of a woman holding a mixing bowl on the left-hand upper-corner of the packaging, with the name AUNT BESSIE'S in a white italicised script contained within a red banderole (the old logo).

13. Mr Crookes sets out details of the evolution of the AUNT BESSIE'S mark from 1995 onwards, Exhibit AC2 being the results of a survey dated 19 April 2007 to test the effectiveness of various packaging options including one bearing the version of the mark that is the subject of these proceedings (the new logo) which Mr Crookes describes as "...its blue packaging with the new oval-shaped red logo and younger looking Aunt Bessie." Exhibit AC3 consists of a Powerpoint presentation dating from May 2007 relating to the mark. Mr Crookes says that consumer testing took place in May/June 2007 with the first products bearing the new logo reaching the shelves of retailers in August 2007. Exhibit AC3 is introduced as a Powerpoint presentation dated May 2007 relating to Version 3 of the AUNT BESSIE'S packaging which is the new logo, the front page of which refers to "Tryton Foods – Category Vision".

14. Mr Crookes next goes to a market survey into the awareness of the AUNT BESSIE'S brand, Exhibit AC4 being an extract from the report. Mr Crookes highlights the 72% awareness of AUNT BESSIE'S frozen/chilled Yorkshire puddings, and whilst accepting that the survey occurred after the relevant date, draws attention to the fact that the change of logo did not affect the level of consumer awareness. Exhibit AC5 consists of various items that Mr Crookes says shows use of the 3 versions of the AUNT BESSIE'S logo. Pages 1-5 consists of invoices dating from January 2008 relating to sales to major supermarkets that mention AUNT BESSIE'S in the product descriptions but do not show the mark. The next five pages

are similar invoices from July 2009 but this time they have the new logo on the top left-hand corner. Then there are five pages of advertisements for products bearing the new logo, the first marked “2006 Press”. Two further pages endorsed “draft artwork 2007” depict the lady shown in the new logo. An article from The Grocer shows AUNT BESSIE’S to be in the top 10 of “frozen potato brands”, “frozen ready meal brands”, “frozen desert brands” and “frozen pie brands”.

15. Apart from a Powerpoint presentation and some promotional leaflets (both undated) the remainder of the exhibit either refers to AUNT BESSIE’S without showing a mark, or show the old mark.

16. Mr Crookes refers to his company finding out about the opponent’s use of their BETTY SMITH’S logo, describing BETTY SMITH’S as “...highly derivative of AUNT BESSIE’S” and the logo of a “...device of an old lady holding her baking which she has just removed from the oven...” as being “highly reminiscent of all three versions of AUNT BESSIE’S logos.” He explains why they took no action, referring to the issuance of a Preliminary Indication, a copy of which is shown as Exhibit AC6. Mr Crookes next mentions the connection between Mr Eric Herd, a Director of the opponents and Farmfoods retail outlets, Exhibits AC7 consisting of records from the Companies House website.

17. Mr Crookes goes to Exhibit AC8 which consists of three Farmfoods promotional leaflets, drawing attention to the absence of BETTY SMITH’S products in the one dating from 30 September 2007, and their appearance in the remaining two from July and August 2009 alongside AUNT BESSIE’S products bearing the new logo. Mr Crookes says that Farmfoods has sold Yorkshire pudding products bearing the new logo since the launch on 28 August 2007. Mr Crookes states that the most important products in the AUNT BESSIE’S range are Yorkshire puddings, prepared potato products and toad-in-the-hole. Exhibit AC9 consists of examples of BETTY SMITH’S packaging, Mr Crookes drawing attention to a similarity in the product range (Yorkshire puddings, toad-in-the-hole, apple pie, prepared potato and vegetable products), and asserting that it is the opponent’s who have adopted elements of the AUNT BESSIE’S trade mark. Mr Crookes also refers to the opponent’s selling of fish products under the name HARRY SMITHS.

18. A Witness Statement dated 18 August 2009 from Jennifer Maddox, a partner in W P Thompson & Co, the applicant’s representatives in these proceedings corrects a typographical error in paragraph 16 of Adrian Crookes’ Statement in that the second mention of Exhibit AC9 should in fact read Exhibit AC8.

### **Opponent’s evidence in reply**

19. This consists of a further Witness Statement from Noel Davis dated 16 October 2009. Being evidence in reply it is not surprising that this consists primarily of submissions rather than evidence of fact, and as such it is not appropriate that I summarise them here. I will, of course take them fully into account in my decision. As Exhibit ND1 Mr Davis provides a copy of the Notice of Opposition used in a previous opposition, noting that the earlier marks relied upon were Aunt Bessie’s Limited’s previous “red banner” device. Mr Davis states that there is no dispute that these are not similar to the opponent’s registered mark. As Exhibit ND2 Mr Davis provides an invoice dated 27 March 2007 from Impact Murals for “Betty Smith Sketches” some of which include depictions of the woman used in the opponent’s earlier marks.

20. That concludes my review of the evidence insofar as it may be relevant.

## Decision

21. The objection is made under Section 5(2)(b) which reads as follows:

“5. - (1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected

(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.”

22. An earlier trade mark is defined in Section 6 of the Act as follows:

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

(a) a registered trade mark, international trade mark (UK), 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,”

23. The applicants rely on one trade mark, number 2470302 applied for on 23 October 2007 and registered on 23 May 2008. This is an earlier mark within the meaning above. The date of registration of this earlier mark is within five years of the relevant date so the provisions of The Trade Marks (Proof of Use, etc.) Regulations 2004 do not apply.

24. In my consideration of a likelihood of confusion, I take into account the guidance from the settled case law provided by the ECJ in *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] FSR. 77, *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] ETMR 723, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) C-334/05 P (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*,

(b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v Puma AG*, who is deemed to be reasonably

well informed and reasonably circumspect and observant - but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind; *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*,

(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*,

(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*,

(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 Kaisha v Metro-Goldwyn-Mayer Inc*,

(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*,

(g) in determining whether similarity between the goods or services covered by 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*,

(h) 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*,

(i) 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 and Adidas Benelux BV*,

(j) 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*.

(k) 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*, Case C-3/03P *Matratzen Concord GmbH v Office for Harmonisation in the Internal Market* [2004] ECR I-3657 at 32, That is the case where the component in the complex is likely to dominate, by itself, the image of that mark which the relevant public keeps in mind, with the result that all the other components of the mark are negligible within the overall impression created by it (Case T-6/01 *Matratzen Concord v OHIM – Hukla Germany (MATRATZEN)* [2002] ECR II-4335, paragraph

33, and Case T-28/05 *Ekabe International v OHIM – Ebro Puleva (OMEGA3)* [2007] ECR II-4307, paragraph 43, *Shaker di L. Laudato & C. Sas v OHIM (LIMONCELLO)*

25. Both the opponent’s earlier marks and the marks that are the subject of these proceedings are composed of words combined with graphical elements. As can be seen from the above cases, where composite marks are involved the contribution of the individual elements to the mark as a whole and in the impression conveyed to the public are important factors when considering whether two marks are similar and the potential for confusion. It therefore seems necessary to look first at the distinctiveness and dominance of the component parts of the marks before moving to assess the factors relevant as part of the global appreciation. Relevant to the “distinctive, dominant or negligible” assessment is that the marks are sought to be registered in respect of a range of foodstuffs and beverages.

26. The opponent’s marks are as follows:



27. When asked whether the words are distinctive Ms Peebles stated that whilst they conjure up an idea of some homely person baking, they are distinctive because they do not actually relate to the goods in question.

28. In their skeleton argument the applicants submit that a representation of a woman/man “in the process of cooking food or taking food out of the oven is non-distinctive for foodstuffs that require cooking or are cooked” asserting that such descriptions are commonplace in the food industry. On its face this seems a reasonable assertion; the device emphasises that the goods are foodstuffs drawing in a perception of good old-fashioned home-cooking, but whether such use is “commonplace” is not supported by evidence. Additionally, such a bald assertion does not take account of any stylisation that may create distinctiveness in the element or its significance to the mark as a whole. In its contribution to the overall impression of the mark I would not say that this representation of a woman falls to be described as negligible.

29. The parties also focus on the oval border. The applicants contend that this is an element that is devoid of distinctive character which as a stand-alone shape would usually be the case.

However, as the opponent's highlight in their skeleton argument, in this case the oval "...has a different coloured line therein forming a border...". In fact it also has a different coloured/shade outer-line forming a border and two small circles on the short ends that create the impression of rivets or nails. To my mind this element has distinctive value in the mark.

30. Whilst I would agree with the applicant's submission that in a composite mark it is the words (if not merely descriptive) that speak, and consequently act as the dominant source of reference, I am led to the position that none of the three elements referred to can be considered "negligible" in the contribution that they make to the mark. To varying degrees all elements add to the distinctive whole created.

31. Turning to look at and ask the same question of the applicant's marks which are as follows:



32. My earlier comments regarding the potential for the representation of a woman cooking/preparing food to be taken as emphasising a characteristic of the goods, and the question over commonality of the use of such images hold good for the applicant's mark. The applicant's mark does contain an oval although as more as a background than a border, so in that respect I would place its distinctive significance as low. This leaves the words AUNT BESSIE'S. Subject to Ms Peebles submission that these conjure up an idea of some homely person baking, there is no dispute that they are distinctive because they do not actually relate to the goods in question. The applicants contend that this is the dominant element because it spreads across two-thirds of the mark, and as previously stated "words speak". On my assessment the word element adds most to the distinctive whole, followed some way back by the representation of the woman, with negligible distinctiveness added by the oval.

33. Having determined the position on the contribution that the individual elements make to the marks as a whole, the next question is whether the respective marks are similar? The opponent's submit that Mr Crookes (in paragraph 14 of his Statement) agrees that the respective marks are similar. Mr. Crookes' states, "Not only have they adopted the word BETTY SMITH'S, which is highly derivative of AUNT BESSIE'S, but they have also adopted the idea of having in their logo a device of an old woman holding her baking which she has just removed from the oven, which is highly reminiscent of all three versions of AUNT BESSIE'S logo." Referring to elements as being "highly derivative" and "highly reminiscent" to elements in the applicant's mark indicates that Mr Crookes considers there to

be similarity, but this is not quite the same as saying that they are individually or more importantly, collectively similar such as to create a likelihood of confusion.

34. In her skeleton argument Ms Maddox referred me to the decision of Millet L.J. in *The European Limited v The Economist Newspaper Limited* [1998] ETMR 307, arguing that in the marks in suit the device of a woman "...is a non-distinctive pictorial adjunct to what is principally a word mark. It plays a distinctly subordinate role in the marks." Ms Maddox was inviting me to treat the representation of the women in the same way as the word "European" which had been deemed non-distinctive. Whether something is an adjunct or subordinate is not the question. As Ms Peebles correctly stated, what matters is the overall impression created in the mind of the relevant public by a complex trade mark, which may be dominated by one or more of its components but it is only if all the other components of the mark are negligible that the assessment of the similarity can be carried out solely on the basis of the dominant element. (*Aceites de Sur Coosur SA v Koipe Corporacion SL and OHIM, Advocate General Opinion*, Case C-498/07 citing *OHIM v Shaker*, paragraphs 41 and 42, and Case C-193/06 P *Nestlé v OHIM* [2007] ECR I-114, paragraphs 42 and 43)

35. In their skeleton arguments the parties conduct an almost forensic analysis of the marks. The opponents describe their earlier mark as "...a **prominent oval device**, which has a different coloured line therein **forming a border**, contained in the oval is writing and a female character holding a cooking item and **facing to her left**." They contrast this with the subject mark saying that this consists of "...a **prominent oval background**" with a border with writing therein and with a female character holding a cooking item and **facing to her left**." The applicants counter stating that their mark is "...an elliptical shape containing the words AUNT BESSIE'S across two thirds of the mark with a depiction of a woman holding a mixing bowl in the other third of the mark." They submit the opponent is focusing on two non-distinctive elements and disregarding the words which are distinctive and different, both in themselves and the style in which they are represented.

36. Referring to the earlier versions of the applicant's mark, and in particular the "red banner" device, Mr Davies states that "There is no dispute that these marks are not similar to our registered trade mark." The only inference that can be drawn from this is that it is the removal of the banner background to the words and its replacement with an oval, and the reconfiguration of the elements that moves the marks to a position of similarity. Unless this has altered the way in which the consumer will perceive the mark (which I do not consider to be the case) all that can have altered is the visual similarity.

37. Other than being two words with the latter being in the possessive form, AUNT BESSIE'S and BETTY SMITH'S and that the first names (BESSIE'S and BETTY'S) both begin with the letter B, the word elements do not look the same. There is an obvious visual similarity in the use of the representation of a woman of a certain age, and appearance features such as the hair in a bun, wearing a pinafore and engaged in a food preparation. In the colour versions there is also the blue of the upper clothing. The opponents place this image in the centre of a strong oval border with the word BETTY at the top and SMITH'S at the bottom. Being central to the mark the image of the woman does catch the eye, but contained within the confines of a strong border and surrounded by the words. The applicant's marks place the woman to one side with only the words AUNT BESSIE'S in a handwritten script and wholly contained within a definable border, which although also oval in shape is, as stated by the opponents, no more than a background. Balancing the similarities with the differences, and in particular the configuration and relative dominance and

distinctiveness of the elements, I am led to the view that the marks are not similar in appearance.

38. Other than perhaps when the words are in the “Soap for Soap” category it is most unlikely that when encountering marks composed of words and graphical elements that the consumer will embark upon a description of the graphical features. As Ms Maddox put it, words speak; it will be the words that are the point and means of reference. Ms Peebles accepted that if there is any aural similarity it is limited to the first names (BESSIE’S and BETTY’S) both beginning with the letter B, but that in any event, these are goods that are a visual purchase and the matter is one of overall not individual similarity. Whilst Ms Peebles is correct the difference in AUNT BESSIE’S and BETTY SMITH’S are such that the conclusion must be that the respective marks are aurally distinct.

39. I have previously mentioned the potential for the representations of the women to emphasise that the goods are foodstuffs, drawing an image of home-cooking. The names AUNT BESSIE’S and BETTY SMITH’S add to this image and potentially will be seen as a reference to the lady. The other graphical matter serves to add the appearance of a logo. In combination I consider that if the respective marks convey a message it will be very similar.

40. Taking all of these three factors into account I am led to the view that whilst there are similarities these do not outweigh the differences such that there is a likelihood of them being confused; these are different marks.

41. In a reference to *L’Oréal SA v OHIM*, Case C-235/05 P, Ms Peebles submitted that the concept of overall impression or global appreciation is linked to a consideration of the category of goods in question. In this case the goods are sold in the freezer or fridge sections of the supermarket where the consumer spends very little time assessing the trade mark due to the very cold nature of the area and the marks can often be partly obscured by a film of frost or by freezer doors. Ms Peebles argued that consumers spend little time in comparing marks in such an environment and do not make a detailed comparison thus making the overall visual aspects of the marks important. Ms Peebles further contended that at the supermarket the consumer would make the selection of foodstuffs by the “overall impression and not the individual components and not necessarily the word parts of the mark.” (*Aceites de Sur Coosur SA v Koipe Corporacion SL and OHIM*)

42. Whilst I have no argument with the contention that as self-serve items it will be the visual aspects of the mark that initially attract the consumer’s attention I am mindful of the decisions in *Claudia Oberhauser v OHIM (Fifties)* [2003] E.T.M.R. 58, and *Criminal Clothing Ltd v Aytan’s Manufacturing (UK) Ltd*, [2005] EWHC 1303. From these it is clear that the circumstances in which the relevant goods and the trade marks are encountered by the consumer, particularly at the point at which the purchase is made is an important consideration, but the assessment must consider all relevant factors.

43. To my mind today’s consumers have been well educated (particularly through the supermarket shopping experience) to expect to be presented with a choice from a range of manufacturers, in similar packaging styles and bearing marks that have elements that overlap in appearance and/or concept. Furthermore, I do not think it is going too far to say that consumers are price conscious. Foodstuffs and beverages may be of a relatively low monetary value but as one of, if not the most frequent purchasing activities probably accounts for a significant proportion of expenditure, so in these days of price-comparison, promotions, own-brands and the range of styles and sizes of packaging the consumer will pay attention to

ensure they get the best value for money. There is also the matter that not all brands taste the same, and having acquired a taste or liking for a particular foodstuff the consumer will exercise some care and concentration when making a purchase. So whilst there may be a superficial attraction to Ms Peebles arguments, there is no evidence that consumers will not be “*well informed*” so as to know that a frozen food display will contain goods of a similar type from a variety of producers, and will be less than “*observant*” or “*circumspect*” to the extent that they pay little regard to the detail and simply buy something that looks familiar with no regard to the brand name in making their selection. It may well be that they will not choose to linger in the frozen food area, but this does not mean that they will become the mythical morons in a hurry.

44. Ms Maddox conceded that there is identity in some of the goods of the application when compared with the specification of the opponent’s earlier mark and some similarity. She additionally stated that there may be different goods but would leave that decision to me. Given the concession that there are identical and similar goods involved I propose to proceed on this premise; it represents the opponent’s best case. In the event of the opposition being successful I will then need to go on to consider the question of what is identical, similar or different. So starting from the position that the respective goods are either identical or similar I note that there is nothing in the wording of the specifications that would separate them in the market, or in the course of trade. Accordingly, I must notionally assume that they operate in the same sector, and share the same channels of trade, from manufacture to retail. I can see no reason why the consumer of the respective goods should be any different, in this case being the public at large.

45. Whilst there is evidence that the opponent’s have used their mark, there is none of the information that is required to be able to gauge its impact, the extent of any reputation or whether the mark has become any more distinctive through its commercial exposure.

46. The applicants point to their registrations for earlier versions of the mark which they have used for ten years without any confusion. They also mention the extent of this use and the likely reputation that this has built up. Ms Peebles stated that whilst the opponents did not dispute the applicants had a reputation in the totality of the earlier versions these are not the same as the mark applied for.

47. An objection under Sections 5(2) of the Act turns upon whether the attacker has an earlier trade mark (as defined by section 6 of the Act) that is the same or similar to the subject mark and where the subject mark is sought to be registered for the same or similar good/services as that earlier mark, such that there is a likelihood of confusion. I acknowledge that there are other factors that go into the “global appreciation” melting pot but these are the essentials. There is no defence based on a claim that the applicant has a registration or application for the same mark (or one that does not differ in its material particulars) that predates the earlier mark relied upon by an opponent. This was explained by the General Court in *PepsiCo, Inc v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) T-269/02* and is part of Registry practice (See TPN 4/2009):

"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."

48. The applicants having used the mark and established a reputation would not, of itself, save the application in the face of an objection, but could be taken into account as part of the "global appreciation". The issue of "concurrent use" was dealt with by Ms Anna Carboni sitting as the Appointed Person in the opposition to register the trade mark MUDDIES (BL O-211-09):

"51. Finally, I should mention that the Applicant did not pursue an argument on appeal that section 7 of the Act supported the case for registration based on honest concurrent use. As is clear from the section, honest concurrent use only assists an applicant until the point at which the owner of the conflicting right that had been provisionally overcome in the examination process (as it stood prior to the changes 6 There was no suggestion by the Applicant that the MUDDIES trade mark should be registered subject to a geographical limitation.7 Section 11(1) provides that a registered trade mark is not infringed by the use of another registered trade mark in relation to goods or services for which the latter is registered. referred to above) opposes the application. At that point, section 7 is of no further assistance and the question of relative rights has to be assessed by reference to the relevant part of section 5. Mr Groom accepted this position, but made a general submission that the fact of honest concurrent use was something that could be taken into account in applying the global appreciation test to determine the likelihood of confusion.

52. As the hearing officer said (at paragraph 39), for honest concurrent use to be of assistance to an applicant, it must be possible for the tribunal to be satisfied that the effect of concurrent trading is such as to suggest that the relevant public has shown itself able to distinguish between goods bearing the marks in question without any confusion as to trade origin. That sort of evidence was not presented and the argument therefore did not assist."

49. There was mention of the absence of any evidence of confusion but as can be seen from the comments of Laddie J. in *Compass Publishing BV v Compass Logistics Ltd* [2004] RPC 41 (to which Ms Peebles referred) 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.

"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."

50. In a case earlier cited by the applicants (*The European Limited v The Economist Newspaper Ltd*) 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."

51. Whilst there appears to have been concurrent trading in respect of the version of the mark applied for, this was for but a couple of months. More significantly there is an almost complete lack of detail relating to the opponent's use on which to base an assessment of whether any overlap in trading has tested the consumer's ability to distinguish the respective marks, but in any event, I do not consider that anything would turn on this.

52. Taking all of the aforesaid into account and adopting the "global" approach as advocated, I come to the position, and I will say with little difficulty, that the facts of this case are such that I do not consider there to be a likelihood of confusion. Use of the mark applied for in relation the goods for which registration is sought will not cause the public to wrongly believe that these are the goods of the opponent or economically linked undertaking. That is the case whether the marks are in colour or greyscale, and whether the goods are identical and/or similar.

53. The opposition having failed, the applicants are entitled to a contribution towards their costs. In her submissions Ms Peebles asserted that in considering the issue of costs I should take account of Aunt Bessie's "unreasonable behaviour" in filing of a second and identical application some six weeks after the commencement of these proceedings. Ms Maddox countered that the applicants had realised they intended to use the mark for goods not covered by the earlier application, and as is customary, filed for the full range in order to gain a few months advantage in case of an attack within the first five years. I do not see that there is anything implausible in this explanation or inherently wrong in the applicant's actions, nor is there any evidence or claim that through their actions they have caused the opponents to any additional expense or inconvenience. The opponents also cite the inclusion of "unnecessary"

evidence as a factor for consideration. I do not see that there is any justification for a reduction in costs on such a basis. I therefore order that the opponents pay the applicants the sum of £2,900 towards their costs. This sum 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 26 day of February 2010**

**Mike Foley  
for the Registrar  
the Comptroller-General**