

O-097-06

**TRADE MARKS ACT 1994
IN THE MATTER OF APPLICATION No 2365369
BY ALDI STORES LIMITED
TO REGISTER THE TRADE MARK
CARLINI
IN CLASSES 29 & 30**

**AND IN THE MATTER OF OPPOSITION THERETO
UNDER No. 93008
BY FRATELLI CARLI S.P.A.**

BACKGROUND

1) On 9 June 2004, Aldi Stores Limited of Holly Lane, Atherstone, Warwickshire, CV9 2SQ applied under the Trade Marks Act 1994 for registration of the trade mark CARLINI, in respect of the following goods:

In Class 29: Milk products; butter; cheese; cream; yogurt; edible oils and fats; olive oil; preserved olives; tomato puree; chopped tomatoes in cans; peeled whole tomatoes in cans.

In Class 30: Prepared meals consisting mainly of pasta and/or rice, and/or meat, and/or fish, and/or vegetables, and/or potatoes; pasta; canned pasta; dried pasta; chilled pasta; balsamic vinegar; spaghetti bolognese; spaghetti hoops and shapes; salad vinaigrette; prepared and pre-packed macaroni cheese.

2) On 3 December 2004 Fratelli Carli S.P.A. of Via Garessio, 11/13, Imperia (IM), 18100, Italy filed notice of opposition to the application. The grounds of opposition are in summary:

a) The opponent is the proprietor of CTM 3181567 CARLI which is registered for goods and services in Classes 3, 16, 29, 30, 31, 32, 33, 39, 43 & 44. The opponent claims that the goods sought to be registered are identical or similar to those for which its mark is registered and the marks of the two parties are similar. The application therefore offends against section 5(2)(b) of the Trade Marks Act 1994.

3) The applicant subsequently filed a counterstatement denying the opponent's claims.

4) Both sides filed evidence in these proceedings. Both sides ask for an award of costs. Neither side wished to be heard nor did they provide written submissions.

OPPONENT'S EVIDENCE

5) The opponent filed two witness statements. The first, dated 25 July 2005, is by Sanjay Kapur their Trade Mark Attorney. He states that he is authorised to make the statement and that the details he provides come from the records held by his company, the records held by the opponent's Italian Trade Mark Attorneys, the opponent's website or from sources that are identified within the statement.

6) Mr Kapur states that the opponent has since 1911 been manufacturing and distributing olive oils and foodstuffs preserved in olive oils such as tuna and vegetables. He states that as a result of this trade the opponent enjoys a substantial global reputation. At exhibit SK1 he provides a copy of submissions made to OHIM in a case involving a third party. The submissions claim that the mark is well known in Italy and in corroboration there is provided a survey carried out in Italy and also numerous magazine and newspaper articles showing that in Italy and France the opponent has received the attention of the press. With regard to the extent of the reputation of the opponent amongst the Italian and French public, it is not clear quite how this evidence is relevant to how the marks would be perceived by consumers in

the UK. Even if I were to regard the evidence as relevant, the survey refers only to how the Italian public regard the brand “OLIO CARLI” and seems to refer solely to olive oils. The sales figures quoted in the newspaper and magazine articles whilst substantial are not broken down into sectors and given the breadth of the opponent’s specification the figures do not provide evidence of significant market share in any single sector or even as a conglomerate. Although it is claimed that some of the Italian newspapers would have been sold in the UK and the articles read by UK consumers, there is no evidence of sales or readership of such papers and magazines in the UK.

7) Mr Kapur further contends that the references to the olive oil museum in exhibit SK1 show that the museum receives a large number of visitors each year. He contends that a number of these visitors would be from the UK. However, there is no corroborative evidence to back up this assertion. Not even a simple visitors register which would show which country the visitors were from. Even if Mr Kapur’s assertion were true the number of UK visitors to an olive oil museum in Italy would presumably be relatively small in comparison to the population of the UK and would not translate into a reputation for anything in the UK except perhaps for olive oil museums, or at best a connection with Olive oils.

8) Mr Kapur provides his opinion that the marks of the two parties are similar. He also states that in the Italian language it is common for the letter “I” at the end of a word to be replaced by the letters “INI” to indicate a smaller version of the word such as “RAGAZZI” which means boys and “RAGAZZINI” which means small boys. He provides a number of exhibits to show that this is standard practice. The substitution is also applied to the end of surnames to refer to the “son of”.

9) Mr Kapur states that there are 155,000 Italians living in the UK, he also claims that “Given that Italy is one of the main EU countries (both culturally and economically) I think it fair to assume that the Italian language is likely to be known by a significant number of persons who reside in the UK”. He states that there are 673 courses offered in 41 Universities which involve the study of the Italian language. He claims that there would also be similar courses offered in night schools and on a part time basis. From this Mr Kapur deduces that there is an increasing number of UK residents who are fluent or knowledgeable in the Italian language. Mr Kapur also provides copies of a number of decisions from OHIM which he states corroborate his views.

10) The second witness statement, dated 22 February 2005, is by Professoressa Pamela Cecilia Miriam Willsher, a teacher of Italian language and literature since 1974. She is an Italian citizen who has lived in this country since 1974 and so is conversant with both the Italian and English languages. She states that the suffix INI is commonly used at the end of Italian words to describe smaller versions of products. She provides examples such as:

pane (bread) / panini (small bread)
carciofi (artichoke) / carciofini (small artichoke)
pesci (fish) / pesciolini (small fish)
biscotti (biscuit) / biscottini (small biscuits)

11) She states that “if I was to see the names CARLI and CARLINI applied to similar products, either on display shelving or listed in directories, including the application

of the names to foodstuffs, I would say that it could be assumed that the products in question sold under the CARLINI name are smaller versions of the products sole under the CARLI name”.

APPLICANT’S EVIDENCE

12) The applicant filed a witness statement, dated 14 October 2005, by David Houghton, the applicant’s Trade Mark Attorney. He points out that Professoressa Willsher is an Italian national and so is not a typical UK consumer. He states that the examples of Italian words where the suffix INI is used all relate to products not to company names to denote smaller products from that company. Mr Houghton states that the applicant is a significant supermarket chain with approximately 300 retail outlets throughout the UK. They have been using the name CARLINI on a range of products since 1992 and have registrations for the mark covering various products such as, inter alia, pasta, milk, butter, cheese and prepared meals. He states that sales of goods under the mark CARLINI now exceed £7 million per annum. He states that during the thirteen years that the products have been on sale there has not been a single instance of confusion.

OPPONENT’S EVIDENCE IN REPLY

13) The opponent filed a second witness statement by Mr Kapur, dated 16 January 2006. He contends that the statements of Professoressa Willsher are relevant and add weight to the opponent’s claim that the marks are similar. He points out that Ms Willsher states that a third party would assume that goods under the CARLINI mark would be associated with the opponent’s mark because of the suffix INI. In point of fact she did not state this, see the quote at paragraph 11 above.

14) Mr Kapur states that “I believe that the precedents that I have filed in support of the claim that these trademarks are confusingly similar should be considered binding on the UK Trade Marks Registry”.

15) That concludes my review of the evidence. I now turn to the decision.

DECISION

16) The only ground of opposition is under section 5(2)(b) which reads:

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

(a)...

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

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

17) An “earlier trade mark” is defined in section 6, 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 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,”

18) The opponent is relying upon its mark CTM 3181567 which has an effective date of 26 May 2003, and is clearly an earlier trade mark.

19) 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 BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.* [1999] E.T.M.R. 1, *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG* [2000] E.T.M.R. 723. 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) 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*;
- (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*;

(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.*

20) In essence the test under section 5(2)(b) is whether there are similarities in marks and goods which would combine to create a likelihood of confusion. In my consideration of whether there are similarities sufficient to show a likelihood of confusion I am guided by the judgements of the European Court of Justice mentioned above. The likelihood of confusion must be appreciated globally and I need to address the degree of visual, aural and conceptual similarity between the marks, evaluating the importance to be attached to those different elements taking into account the degree of similarity in the goods, the category of goods in question and how they are marketed. Furthermore, I must compare the applicant's mark and the mark relied upon by the opponent on the basis of their inherent characteristics assuming normal and fair use of the marks on a full range of the goods covered within the respective specifications.

21) The effect of reputation on the global consideration of a likelihood of confusion under Section 5(2)(b) of the Act was considered by David Kitchen Q.C. sitting as the Appointed Person in *Steelco Trade Mark* (BL O/268/04). Mr Kitchen concluded at paragraph 17 of his decision:

“The global assessment of the likelihood of confusion must therefore be based on all the circumstances. These include an assessment of the distinctive character of the earlier mark. When the mark has been used on a significant scale that distinctiveness will depend upon a combination of its inherent nature and its factual distinctiveness. I do not detect in the principles established by the European Court of Justice any intention to limit the assessment of distinctiveness acquired through use to those marks which have become household names. Accordingly, I believe the observations of Mr. Thorley Q.C in *DUONEBS* should not be seen as of general application irrespective of the circumstances of the case. The recognition of the earlier trade mark in the market is one of the factors which must be taken into account in making the overall global assessment of the likelihood of confusion. As observed recently by Jacob L.J. in *Reed Executive & Ors v. Reed Business Information Ltd & Ors*, EWCA Civ 159, this may be particularly important in the case of marks which contain an element descriptive of the goods or services for which they have been registered. In the case of marks which are descriptive, the average consumer will expect others to use similar descriptive marks and thus be alert for details which would differentiate one mark from another. Where a mark has become more distinctive through use then this may cease to be such an important consideration. But all must depend upon the circumstances of each individual case.”

22) I also have to consider whether the mark that the opponent is relying upon has a particularly distinctive character either arising from the inherent characteristics of the mark or because of the use made of it. The opponent's mark relates to a wide range of goods in a variety of classes. However, for the purposes of this opposition the opponent's strongest case is served by its Class 29 and 30 specifications which, broadly speaking relate to foodstuffs. The mark consists of the word “CARLI”. To my

mind, the opponent's mark is not descriptive of the goods in Classes 29 and 30 and must be regarded as having a high level of inherent distinctiveness.

23) The opponent has attempted to claim that its mark has a reputation. However, the evidence filed all relates to Italy or France, there is no evidence of any use in the UK. The opponent has not sought to rely upon section 56 of the Act, only section 5(2)(b). In my view the opponent cannot therefore benefit from an enhanced level of protection due to reputation in the UK.

24) The goods of both parties can be said to be foodstuffs. The average consumer must therefore be the general public who are deemed to be reasonably well informed and reasonably circumspect and observant. In my opinion foodstuffs are not purchased without some consideration as there are a considerable number of people with food allergies and dietary requirements and the general public is far more conscious of dietary needs, not least because of the various health campaigns exhorting them to reduce intakes of salts and saturated fats. However, when making the comparison I must take into account imperfect recollection.

25) I will first consider the specifications of the two parties which for ease of reference are as follows:

Applicant's specification		Opponent's specification	
Class 29	Milk products; butter; cheese; cream; yogurt; edible oils and fats; olive oil; preserved olives; tomato puree; chopped tomatoes in cans; peeled whole tomatoes in cans.	Class 29	Meat, fish, poultry and games; meat extract; preserved, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs; edible fats and oils.
Class 30	Prepared meals consisting mainly of pasta and/or rice, and/or meat, and/or fish, and/or vegetables, and/or potatoes; pasta; canned pasta; dried pasta; chilled pasta; balsamic vinegar; spaghetti bolognese; spaghetti hoops and shapes; salad vinaigrette; prepared and pre-packed macaroni cheese.	Class 30	Coffee, tea, cocoa, sugar, rice, tapioca, sago coffee substitutes; flour and preparations made from cereals, bread, pastry and confectionery, ices; honey, treacles; yeast, baking-powder; salt, mustard; vinegar sauces (condiments); relish; ice.

26) In Class 29 there is an overlap between the opponent's preservation of fruits and vegetables and the applicant's preservation of olives and canning of tomatoes. Also the identity of the edible oils and fats. The other goods in Class 29 and all those in Class 30 must be regarded as similar. In carrying out a comparison I will therefore regard the goods as identical or very similar.

27) I now turn to the comparison of the marks of the two parties. The applicant's mark is CARLINI whilst the opponent's mark is CARLI. Clearly, there is a degree of visual and aural similarity between the marks. The only difference being the ending with the applicant's mark having the letters NI added.

28) Conceptually, neither mark has any meaning in English and would appear to most UK consumers as names. The opponent has contended that the addition of the letters NI in Italian is commonplace to indicate a smaller version of something and have provided expert evidence to this effect. Whilst I accept that this is something which those fluent in Italian would understand and identify with its relevance when considering how the average UK consumer would understand the marks is questionable. The opponent has contended that there are an increasing number of people in the UK who are studying courses where Italian is taught as part of the course. However, it is not clear whether this is general tuition or whether it is merely teaching those Italian words which have relevance in the subject matter which is being taught. Even if I were to accept that the numbers are increasing I still do not accept that the average UK consumer is knowledgeable with regard to any foreign language, indeed it is debateable if they could be said to be knowledgeable with regard to grammatical nuances of the English language.

29) To my mind the applicant's mark CARLINI will be seen as a surname whilst the opponent's mark CARLI will be seen as a forename similar to Carly Simon. These days alternate spellings are not unusual in forenames. It is accepted that consumers are used to differentiating between names even those which are quite similar. In carrying out the global assessment of the likelihood of confusion I take note of the comments of Buckley, J. in the *Buler* trade mark case [1966 RPC 141]:

“It seems to me that surnames stand in a different position from the point of view of spelling from ordinary words in the English language, for spelling is a matter of considerable importance in distinguishing one surname from another. One may easily understand the meaning of an ordinary word in the English language, although it is misspelt; but if one finds a surname spelt in a way which one does not expect it to be spelt one is immediately put upon inquiry as to whether or not it is the name of some other person than the person to whom one supposes the name to belong.”

“I think that this aspect of the matter also involves some consideration of the phonetic aspect of the matter, for if the word as written would not appear *prima facie* to have the same sound as the name which it is said to be a misspelling of, then it seems to me more difficult to regard it as merely a misspelling of the name in question.”

30) Although these comments were made regarding a case under the 1938 Act I believe that the views expressed are still valid under the 1994 Act. Similarly, although the learned judge referred to surnames, I believe that his comments would extend to a comparison when dealing with a combination of forenames and surnames. Equally, if the opponent's mark were seen as a surname then the same criteria would apply, with I believe, the same end result that the average consumer is likely to easily differentiate between the two marks.

31) Taking account of all of the above when considering the marks globally, I believe that there is not a likelihood of consumers being confused into believing that the goods provided by the applicant are those of the opponent or provided by some undertaking linked to them. The opposition under Section 5(2)(b) therefore fails.

COSTS

32) As the applicant is successful it is entitled to a contribution towards its costs. I order the opponent to pay the applicant the sum of £1500. 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 10th day of April 2006

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