

O-163-09

TRADE MARKS ACT 1994

**IN THE MATTER OF REGISTRATION NO 2409049
IN THE NAME OF CHEESE & CO
OF THE TRADE MARK**

Fat Betty

IN CLASS 30

**AND THE APPLICATION FOR A DECLARATION OF INVALIDITY THERETO
UNDER NO 83231
BY BETTYS & TAYLOR GROUP LIMITED**

Trade Marks Act 1994

**In the matter of registration
No 2409049 in the name of
Cheese & Co of the trade mark
Fat Betty in class 30 and
In the application for a declaration
of invalidity thereto under No 83231
by Bettys & Taylors Group Limited**

Background

1. On 14 December 2005, Cheese & Co, which I will refer to as Cheese, applied for registration of the mark Fat Betty under No 2409049. The registration procedure was completed on 6 October 2006. It is registered for:

Biscuits, snacks, nibbles.

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

3. On 8 May 2008 Bettys & Taylors Group Ltd, which I will refer to as B&T, made an application for a declaration of the invalidation of the registration. B&T bases its claim upon sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (The Act) and the eight earlier rights it relies on are set out in Annex A to this decision.

4. Although some of the earlier marks relied on are registered in respect of services within classes 42 or 43, B&T does not rely on any such use of these services in its application but instead claims that the respective trade marks are similar and the respective goods are identical or similar. B&T states that its earlier marks have been used in relation to all goods as registered with the exception of "mixtures of coffee and chicory, coffee extracts, coffee essences; chicory and chicory mixtures, all for use as substitutes for coffee" where those goods are covered by the earlier registrations.

5. Cheese filed a counterstatement in which, essentially, it denied the grounds of attack.

6. Both sides filed evidence and the matter came before me on 20 March 2009 for hearing. Cheese was represented by Ms Jane Lambert of Counsel instructed by Bailey Walsh & Co, B&T by Mr Dick Waddington of Appleyard Lees, its trade mark attorneys.

Evidence

7. The following evidence was filed:

Applicant

Witness statement of Jonathan Wild
with 12 exhibits

Mr Wild is Chairman of B&T

Registered proprietor

Witness statement of Jonathan Kidd
with 11 exhibits

Mr Kidd trades as Cheese

B&T's evidence

8. B&T's business began in 1919 when Frederick Belmont, a baker and confectioner, opened a bakery and restaurant under the mark BETTY'S in Harrogate. Initially the bakery and confectionery goods were made in the same premises as housed the restaurant but in 1922 the business expanded and a separate bakery was built elsewhere in the town. The company still operates from those premises.

9. Between then and the start of the Second World War other restaurants (also referred to as cafés or tea rooms) and associated shops were opened in York, Leeds and Bradford. The premises at Leeds and Bradford were later closed down and new ones opened in Ilkley (1963) and Northallerton (1971).

10. In 1962 the business merged with Taylors, a supplier of teas and coffees. In 1986 B&T launched a mail order business, "Bettys by post" later expanding this to include an Internet presence. The bakery operation was expanded in 1999 and in 2001 BETTYS Cookery School was opened. There are now six BETTYS tea rooms, two each in Harrogate and York and one each in Ilkley and Northallerton.

11. Mr Wild explains that BETTYS business is accounted for under three headings, BETTYS catering, which relates to table sales of products, BETTYS retail, for over-the-counter sales and BETTYS mail order sales. Together, these headings provide the following total sales:

2000	£7,969,000
2001	£8,902,000
2002	£10,023,000
2003	£11,101,000
2004	£12,359,000
2005	£14,420,000
2006	£16,123,000
2007	£16,879,000 (est)

12. As part of the above, the mail order service itself, "BETTYS by post" is said to attract total sales of around £1.1m per year throughout the UK and elsewhere in the world.

13. Latest annual customer figures are said to be approximately 2.3m, with the tea rooms accounting for some 1.35m customers and the shops some 0.95m customers. The number of customers is said to have been in the region of at least 1-2 million per annum for many years.

14. In terms of advertising, Mr Wild says that B&T does employ public relations and marketing staff but does not tend to place many paid advertisements. It obtains its

publicity through articles in magazines, travel and restaurant guides, newspapers (UK and overseas) and other mass media as well as by word of mouth and has been mentioned in several other books. He says this shows that BETTYS has a high reputation for providing high quality foodstuffs and is well-known. The company and its outlets have gained national recognition through the presentation to it of many awards including various "Awards of Excellence" from the Tea Council. It is also a member of the Walpole Committee a consortium of British companies promoting goods or services with a reputation for excellence.

15. Attached to Mr Wild's witness statement are the following exhibits:

1. Details of the earlier rights relied upon
2. A copy of his company's accounts for year ending 31 October 2006
3. Press cuttings from "the earlier years" together with later publications reproducing earlier material relating to the tea rooms selling a range of foodstuffs and teas and coffees
4. More press cuttings as per exhibit 3 but from 1979 onwards
5. Extracts from various tourism, travel and restaurant guides
6. Extracts showing references to BETTYS in various contexts such as novels, travelogues and cartoons
7. Details of awards received by the company or individual shops or staff including Investors in People, National training awards and awards from the Tea Council
8. Extracts from various websites making reference to BETTYS
9. Mail order catalogues from 1988 to 2007 and printouts from B&T's website offering for sale a range of foodstuffs and tea/coffee
10. Advertising material for the former party-goods line
11. Course calendar from the BETTYS cookery school
12. Menus, labels and packaging.

Cheese's evidence

16. Mr Kidd carries on business on his own account under the name Cheese & Co. He supplies a range of "nibbles" and savoury biscuits. Mr Kidd states that the name Fat Betty comes from the name of a well-known local landmark on the Yorkshire Moors near to where he was born, a picture of which features on his advertising and packaging material. He says he thought of the idea for the Fat Betty nibbles when working with the bakery of the Camphill Village Trust which is located close to the

landmark. With the help of the Trust he developed the commercial recipe for his goods.

17. Mr Kidd states his nibbles were launched at the Speciality Food Show in Harrogate in September 2006. He supplies them through food wholesalers and they are on sale in supermarkets such as ASDA, Morrisons and Booths as well as at Harvey Nichols and the London Speciality Food Fair. Fat Betty products are also sold in a number of local stores, including one in Northallerton which, as was confirmed at the hearing, is opposite one of B&T's tea rooms. Up to the date of his witness statement (October 2008), just under 30,000 packs had been sold. No turnover or advertising figures have been provided.

18. Mr Kidd says that there are many recipes for dishes that include the name Betty and that there have been no instances of confusion between his goods and those of B&T.

19. Mr Kidd exhibits the following:

JK1: Advertising leaflet showing Fat Betty nibbles

JK2: Details of his registration from the trade mark register

JK3: Printouts from various websites

JK4: Printouts relating to the Fat Betty local landmark

JK5: Extracts from a recipe book of "Old Yorkshire Recipes" from 1974

JK6: Letters described as testimonials and other correspondence from the food marketing and wholesale trade

JK7: Copies of various extracts for recipes which contain the word BETTY in their names

JK8: Printouts from the Camphill Communities website

JK9: Extracts from wholesalers' catalogues

JK10: Press report

JK11: Record of outcome of the ex parte Hearing held during the application process of this registration.

20. No further evidence was filed by either party.

The law

21. The application for a declaration of invalidation of the registration is brought under the provisions of section 47(2) of the Act. This states:

Section 47

47.-(1)

(2) The registration of a trade mark may be declared invalid on the ground -

- (a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or
- (b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

(3) ...

(4) ...

(5) Where the grounds of invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made:

Provided that this shall not affect transactions past and closed.

22. I shall deal first with the grounds of objection under section 5(2)(b). Section 5(2) of the Act 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.

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,

- (b) a Community trade mark which has a valid claim to seniority from an earlier registered trade mark or international trade mark (UK), or
- (c) a trade mark which, at the date of application for registration of the trade mark in question or (where appropriate) of the priority claimed in respect of the application, was entitled to protection under the Paris Convention or the WTO agreement as a well known trade mark.

(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.

(3) A trade mark within subsection (1)(a) or (b) whose registration expires shall continue to be taken into account in determining the registrability of a later mark for a period of one year after the expiry unless the registrar is satisfied that there was no *bona fide* use of the mark during the two years immediately preceding the expiry.

23. I have set out at Annex A the marks relied on by B&T from which it is clear that each is an earlier trade mark within the meaning of section 6(1) of the Act. B&T's application for invalidation was filed on 8 May 2008. As each of the earlier marks relied on by B&T were registered more than five years prior to this date, the requirements of section 2A of The Trade Marks (Proof of Use, etc) Regulations 2004 are also relevant. This reads:-

(2A) But the registration of a trade mark may not be declared invalid on the ground that there is an earlier trade mark unless -

- (a) the registration procedure for the earlier trade mark was completed within the period of five years ending with the date of the application for the declaration,
- (b) the registration procedure for the earlier trade mark was not completed before that date, or
- (c) the use conditions are met.

(2B) The use conditions are met if -

- (a) within the period of five years ending with the date of the application for the declaration the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or
- (b) it has not been so used, but there are proper reasons for non-use.

(2C) For these purposes -

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(2D) In relation to a Community trade mark, any reference in subsection (2B) or (2C) to the United Kingdom shall be construed as a reference to the European Community.

(2E) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.

24. As I indicated above, the application for a declaration of invalidation was filed on 8 May 2008. B&T must therefore show use of the marks it relies on within the period 9 May 2003 to 8 May 2008. Although B&T rely on eight earlier registrations, they fall into three broad categories namely, the word BETTYS in plain text, the word BETTYS in cursive script (with one earlier right covering both forms) and the words BETTYS BAKERY. At the hearing, Mr Waddington did not seek to rely on the mark BETTYS BAKERY accepting that it put him in no stronger position than the other marks relied on. I will not therefore consider this mark any further. Similarly, I do not intend to take into account the earlier right No 1473887 relied on as this covers a more limited range of goods in class 29 only.

25. The requirements for “genuine use” have been set out by the European Court of Justice in its judgment in *Ansul BV v Ajax Brandbeveiliging BV*, Case C-40/01 [2003] RPC 40 and in its reasoned Order in Case C-259/02, *La Mer Technology Inc v Laboratoires Goemar S.A.* [2005] ETMR 114. From these cases I derive the following principles:

- genuine use entails use that is not merely token. It must also be consistent with the essential function of a trade mark; i.e. to guarantee the identity of the origin of goods or services to consumers or end users (*Ansul*, paragraph 36);
- the use must not be just internal to the undertaking concerned but must be “on the market” (*Ansul* paragraph 37);
- the use must be with a view to creating or preserving an outlet for the goods or services (*Ansul*, paragraph 37);
- the use must relate to goods or services already marketed or about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns (*Ansul*, paragraph 37)

- all the facts and circumstances relevant to determining whether the commercial exploitation of the mark is real must be taken into account (*Ansul*, paragraph 38);
- the assessment must have regard to the nature of the goods or services, the characteristics of the market concerned and the scale and frequency of use (*Ansul*, paragraph 39);
- the use need not be quantitatively significant for it to be deemed genuine (*Ansul*, paragraph 39);
- an act of importation could constitute putting the goods on the market (*Laboratoire de la Mer*, paragraph 25, referring to the earlier reasoned decision of the ECJ);
- there is no requirement that the mark must have come to the attention of the end user or consumer (*Laboratoire de la Mer*, paragraphs 32 and 48);
- what matters are the objective circumstances of each case and not just what the proprietor planned to do (*Laboratoire de la Mer*, paragraph 34);
- the need to show that the use is sufficient to create or preserve a market share should not be construed as imposing a requirement that a significant market share has to be achieved (*Laboratoire de la Mer*, paragraph 44).

26. B&T has already conceded in its application that it has not used its earlier marks in relation to the goods set out in paragraph 4 above (where covered by those earlier registrations). As to the remaining goods it has filed a substantial volume of evidence as detailed above. Some of the material exhibited at Exhibit 9 dates from a time before the relevant period, however there is much which dates from within it (for example, mail order catalogues from each season in 2003, 2004, 2005 and 2006). These clearly show use of the mark both in plain text and cursive script and in relation to a wide range of cakes, biscuits (both sweet and savoury) chocolates, jams, preserves, flans and other snack foods as well as various teas and coffees. It also shows use in respect of seasonal or more formal goods such as Christmas, Easter or Wedding cakes, seasonal chocolate confections such as Easter eggs or Christmas confections such as mince pies. The evidence at Exhibit 12 includes menus from the tea rooms which also show use of the mark in both forms in relation to a wide range of foodstuffs such as cakes, pastries, sandwiches, ice creams, snacks and light meals. Although these menus are not dated, when taken in combination with much of the dated publicity and advertorial material filed in Exhibits 3, 4 and 5, I am satisfied that they support the claim of use for the mark BETTYS in plain font and cursive script forms within the relevant period in relation to all the goods for which use has been claimed.

27. In determining the question under Section 5(2), 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 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*, 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) 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.

Comparison of goods

28. Cheese's registration is for "biscuits, snacks and nibbles". Whilst the term "biscuits" is clear, the terms "snacks" and "nibbles" are, as was accepted by both parties at the hearing, somewhat vague, and could mean different things to different people. I did not understand either party to dispute that they cover a wide range of items of food, whether sweet or savoury, to be eaten between or instead of more

formal meals. The term “biscuits” appears in each of the earlier marks I am taking into consideration. Biscuits could also be described as a snack or a nibble as could most, if not all, of the remaining goods covered by B&T’s earlier trade marks. I therefore find that identical goods are involved.

The relevant consumer and the nature of the purchasing process

29. The relevant consumer is deemed to be reasonably well informed, reasonably circumspect and observant. The goods at issue are foodstuffs which are everyday goods consumed by the general public. Whilst they are everyday goods, the relevant consumer is likely to take a reasonable, but not necessarily the highest, level of care with his purchase to ensure it meets his particular needs, tastes or dietary requirements. These are goods which may be selected, somewhat spontaneously perhaps, from a shelf in a shop or in a more considered way from a display or menu at a café or similar establishment. Both parties agreed at the hearing that the purchase of such goods will rely heavily on the visual impression the consumer has of the marks.

Comparison of marks and their distinctive and dominant components

30. There is considerable overlap between B&T’s earlier registrations and thus for the purposes of comparison I intend to consider them as single marks, subject to one being in plain font and the other in cursive script. For ease of reference the respective marks are:

Cheese’s Mark	B&T’s Marks
Fat Betty	BETTYS 

31. In *Medion AG v Thomson Multimedia Sales Germany & Austria GmbH* ECR 1-8551, it was stated:

“The global appreciation of the likelihood of confusion in relation to the visual, aural or conceptual similarity of the marks in question, must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components. The perception of the marks by the average consumer of the goods or services in question plays a decisive role in the global appreciation of the likelihood of confusion. In this regard, the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (see, in particular *SABEL*, paragraph 23, *Lloyd Schuhfabrik Meyer*, paragraph 25 and *Matratzen Concord*, paragraph 29”)

32. Cheese’s mark consists of an ordinary English word, the adjective Fat, and the common name Betty. I consider the word Fat and its meaning, and the fact that Betty is a name, to be well known by the public at large. The word Fat has somewhat negative connotations in relation to foodstuffs, as B&T submitted at the hearing, and is therefore somewhat unusual but the words hang together to create a distinctive whole. B&T’s marks are single words which are suggestive of the possessive form of

the name Betty (and perhaps more so in relation to the marks in cursive form). I say “suggestive” because of the absence of the necessary apostrophe. (I note that B&T say they originally used their marks in the possessive form but have since dropped the use of the apostrophe).

33. To the extent that the name BETTY is common to both marks, albeit in its (quasi) possessive form in the case of B&T’s marks, there is a degree of visual and aural similarity. In my view, the singular and the possessive forms are close in appearance and potentially more so in sound, given that when goods are referred to by their brand it is sometimes in the possessive form, as in “Fat Betty’s biscuits”. But there are other, quite clear differences. Cheese’s mark is not just the word Betty; it also contains the word Fat as the first element. Given its relative position in the mark, it is unlikely that the word Fat will be overlooked, either when the mark is referred to, or in its impact on the eye. Balancing the similarity of Betty and BETTYS with the differences in the marks as wholes, namely, that Cheese’s mark is composed of two words, the additional word Fat as the first part of the mark (which is generally considered as being of most significance) and, to a lesser extent, the addition of the letter “S” to B&T’s marks, I am of the view that the respective marks are visually and aurally distinct.

34. As I indicated above, Cheese have provided evidence that Fat Betty is a landmark on the North Yorkshire Moors. Whilst I am prepared to accept that some people, on hearing the mark, may bring the landmark to mind, for others not familiar with the area, the mark will simply bring to mind a female called Betty who is overweight. B&T’s marks bring to mind a business run by or having a connection with a woman called Betty. There is some degree of conceptual similarity between the respective marks but the inclusion of the word Fat in Cheese’s mark creates a specific impression of size which is absent from the earlier marks.

Distinctiveness of the earlier marks

35. I also have to take into account the distinctive character of the earlier trade marks having regard to their inherent characteristics and the reputation they enjoy with the public. I do not consider the mark BETTYS to have any particularly distinctive character per se. It is not uncommon for personal names to be used in relation to the manufacture and sale of food and Betty is a name in common use. Whilst the marks in cursive script have a degree of stylisation, that stylisation is quite unremarkable. The earlier marks are variants of the word BETTYS. As I indicated above, this is suggestive of the possessive form of the female name as the marks do not include the requisite apostrophe but its absence may not be noticed by some customers and would not, in any event, be noticed in oral use.

36. The evidence shows that B&T’s business has traded as a bakery and tea room under the mark BETTY’S since 1919. From its single initial premises in Harrogate, it has gradually expanded with six tea rooms now trading in Harrogate, York, Ilkley and Northallerton. Whilst these premises are all located within a relatively small geographic area, the evidence shows that its reputation is not so limited. B&T is a member of the Walpole Committee, it runs a website offering a mail order business, it has won a number of awards and it has generated significant publicity in a wide range of written media, radio and television. These are indicators that its reputation extends outside a localised area. Sales of goods for consumption on or off the

premises and via the Internet range from almost £8m in 2000 increasing steadily to almost £14.5m in 2005 . These are not insignificant sums in themselves but given the probable extent of the market for these goods they are likely to represent a very small market share. Taking the evidence as a whole it seems to me that the distinctiveness of the earlier marks has been enhanced by the reputation they enjoy with the public though not to the highest degree.

Likelihood of confusion

37. I need to consider both direct and indirect confusion. In relation to direct confusion, where the average consumer, who rarely has the chance to make direct comparisons between the marks but must instead rely upon the imperfect picture of them which he has kept in his mind, mistakes one mark for another, the visual, aural and conceptual differences outweigh the similarities and in my view mitigate strongly against any such likelihood. This finding is supported by the fact that no evidence of confusion has been filed despite the unchallenged fact that B&T has an outlet in very close proximity to where Cheese's products are sold.

38. As to indirect confusion, it is possible (and I put it no higher than that) there will be some consumers who, on seeing Cheese's mark may think of the earlier marks. As I indicated above, however, the word Fat has somewhat negative connotations and this makes the likelihood of association unlikely. In any event, mere association is not enough for those consumers to go on to be confused about the origin of the goods.

39. In his evidence Mr Wild states:

“our core trade mark is BETTYS but sometimes this is derivatised. As will be seen mainly from the documents in tab 4 of the bundle, sometimes we are called BETTYS Tea Rooms, or BETTYS Café, or BETTYS Restaurant, or BETTYS of Harrogate, or BETTYS of York, or BETTYS of Northallerton, or BETTYS of Ilkley, or BETTYS the Café, or BETTYS by post, or BETTYS bakery, or Bettys Café Tea Rooms and, of course, there are the references to BETTY's Bar. We or others may thus add other words to BETTYS but ultimately we are BETTYS and that is our distinctive trade mark. People clearly recognise the BETTYS mark, in all of the derivatised marks which we, and others, sometimes use.”

40. Whilst the evidence shows other elements are sometimes added to the words BETTYS, which itself always appears with the final letter S, this does not detract from the fact that these additional elements are descriptive in nature referring to the type, or location, of the relevant premises or service provided and are placed after the word BETTYS. There is nothing in the evidence to show that B&T have at any time in their many years of trading, used any adjectival prefixes particularly those with the negative connotations as stem from the word Fat.

41. As I indicated above, both parties agree the purchase of the relevant goods will be based primarily on the visual inspection of them. The visual comparison is therefore of greater importance though it was accepted that I have to consider the matter by way of global appreciation.

42. Taking all relevant factors into account and applying the global approach required of me, I find the respective marks are not likely to be indirectly confused even where identical goods are concerned.

43. The opposition based on section 5(2)(b) therefore fails.

44. The remaining objections are based on section 5(3) and 5(4)(a) of the Act. At the hearing, Mr Waddington submitted that his claim under section 5(4)(a) was the stronger of the two and I therefore intend to deal with this first.

45. Section 5(4)(a) reads:

“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.”

46. B&T rely on the common law tort of passing-off. It is well established that the necessary elements are threefold: there must be goodwill, misrepresentation and damage. (See *Erven Warnick BV v J Townend & Sons (Hull) Ltd* [1980] RPC 31).

47. Whilst I accept that B&T have a clear and established goodwill, I have already found that the marks themselves are not similar enough to cause the consumer to be confused about the economic origin of the goods in question. That being the case I fail to see how B&T can be in any better position to argue that goods sold under Cheese’s mark would be taken by the relevant consumer to be B&T’s goods and thus I do not consider there would be a misrepresentation; accordingly there is no likelihood of damage.

48. The opposition under section 5(4)(a) therefore also fails.

49. In his submissions, Mr Waddington stated that B&T’s case under 5(4)(a) is stronger than that under 5(3), accepting that if B&T did not succeed under the first ground, it would not succeed under the latter. Accordingly, the grounds under section 5(4)(a) having failed, I do not need to go on to consider the remaining ground. For the record, however, it is my view that had I done so, the outcome would have been as anticipated by Mr Waddington. The first requirement of getting an objection under Section 5(3) off the ground is that the respective marks should be the same or similar. I have found them to be neither, whether viewed from the perspective of a likelihood of direct confusion or from any real possibility of an association being drawn. This is the case when account is taken of the relevant “global” factors such as the reputation and distinctive character of the earlier marks and the similarity of the goods etc.

50. The application for a declaration of invalidity has failed and Cheese is entitled to an award of costs. I make the award on the following basis:

Considering application	£200
Filing counterstatement	£300
Filing evidence	£300
Considering B&T's evidence	£400
Preparation for and attendance at hearing	£400
Total:	£1600

51. I order Bettys & Taylor Group Limited to pay Cheese & Co the sum of £1600 as a contribution towards the costs of these proceedings. Such sum should 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 16th day of June 2009

**Ann Corbett
For the Registrar
The Comptroller-General**

Annex A

Registration No	Mark	Registration Date	Specification
CTM 87379	BETTYS	18.9.2001	Class 29 Pickles, chutneys Class 30 Coffee, tea; bread, biscuits, cakes, pastry and confectionery, all sold as ready-to-eat items; ices Class 42 Restaurant and catering services
2019782	BETTYS	14.6.1996	Class 30 Coffee, tea; bread, biscuits, cakes, pastry and confectionery, all sold as prepared, ready-to-eat items; ices Class 42 Restaurant and catering services; all provided in the counties of West Yorkshire, North Yorkshire, Greater Manchester, South Yorkshire, Lancashire, Cleveland, Durham and Humberside
2104810	BETTYS	2.1.2000	Class 30 Baked dough products, bread; loaves; rolls; baguettes; muffins; crumpets; cakes; stolen; cookies; gateaux; biscuits; tea breads; malt loaves; scones; teacakes; Danish pastries; croissants; brioche; fruit pies; sweet tarts; Christmas cakes; birthday cakes; wedding cakes; meringues; buns; fondants; pastries; gingerbread; puddings; celebration cakes; Christmas puddings; all the above being in prepared, ready-to-eat form; confectionery; sugar confectionery; chocolate confectionery; almond confectionery; confectionery for Christmas trees; chocolate; chocolates; pralines; savoury foodstuffs made from meat and/or vegetables, with or without pastry; sandwiches; savoury tarts; savoury products; savoury turnovers; savoury pies; vegetarian savoury pies; meat

			<p>pies; savoury pies containing meat; meat and vegetable pasties; vegetable pasties; quiches; savoury flans; pizzas; ices; ice cream; tea; coffee; drinking chocolate; coffee extracts; coffee essences; mixtures of coffee and chicory; chicory and chicory mixtures, all for use as substitutes for coffee</p> <p>Class 43 Restaurant, café and tea room services; catering services</p>
2133288B	<p>BETTYS <i>Bettys</i></p>	4.6.1999	<p>Class 29 Dairy produce; butter; cheese; cream; milk; yoghurt; eggs; herbs; spices; dried fruits; herbs; frosted fruits; crystallised fruits; nuts; dates; fruit peel; fruit jellies; fruit preserved in alcohol; jams; marmalades; preserves; pickles; chutneys; meat; charcuterie; paté; preserved meat; sausages; fish; shellfish; truffles; prepared meals.</p> <p>Class 30 Baked dough products, bread; loaves; rolls; baguettes; muffins; crumpets; cakes; stollen; cookies; gateaux; biscuits; tea breads; malt loaves; scones; teacakes; danish pastries; croissants; brioche; fruit pies; sweet tarts; Christmas cakes; birthday cakes; wedding cakes; meringues; buns; fondants; pastries; gingerbread; puddings; celebration cakes; Christmas puddings; confectionery; sugar confectionery; chocolate confectionery; almond confectionery; confectionery for Christmas trees; chocolate; chocolates; pralines; savoury foodstuffs made from meat and/or vegetables, with or without pastry; sandwiches; savoury tarts; savoury pasties; savoury turnovers; savoury pies; vegetarian savoury pies; meat</p>

			pies; savoury pies containing meat; meat and vegetable pasties; vegetable pasties; quiches; savoury flans; pizzas; ices; ice cream; tea; coffee; drinking chocolate; coffee extracts; coffee essences; mixtures of coffee and chicory; chicory and chicory mixtures, all for use as substitutes for coffee; not including any goods in the form of food mix products.
1107990		19.6.1985	Class 30 Biscuits (other than biscuits for animals), bread, buns, cakes, malt bread, pastries, christmas puddings, bread rolls and tarts, all being in prepared ready-to-eat form; chocolate, coffee, mixtures of coffee and chicory, coffee extracts, coffee essences; chicory and chicory mixtures, all for use as substitutes for coffee; chocolates, egg and meat pies and tea.
1473887		13.1.1995	Jams, marmalades, preserves; pickles, chutneys; all included in Class 29
1474409		17.3.1995	Jams, marmalades, preserves; pickles, chutneys; all included in Class 29 Coffee, tea; bread, biscuits, cakes, pastry and confectionery, all sold as prepared, ready-to-eat items; ices; all included in class 30
2111582	BETTYS BAKERY	9.1.1998	Class 30 Baked dough products, bread; loaves; rolls; baguettes; muffins; crumpets; cakes; stollen; cookies; gateaux; biscuits; tea breads; malt loaves; scones; teacakes; danish pastries; croissants; brioche; fruit pies; sweet tarts; Christmas cakes; birthday cakes; wedding cakes; meringues; buns; fondants; pastries; gingerbread; puddings; celebration cakes; Christmas puddings; all the above being in prepared, ready-to-eat form; confectionery; sugar

			<p>confectionery; chocolate confectionery; almond confectionery; confectionery for Christmas trees; chocolate; chocolates; pralines; savoury foodstuffs made from meat and/or vegetables, with or without pastry; sandwiches; savoury tarts; savoury pasties; savoury turnovers; savoury pies; vegetarian savoury pies; meat pies; savoury pies containing meat; meat and vegetable pasties; vegetable pasties; quiches; savoury flans; pizzas; ices; ice cream; tea; coffee; drinking chocolate; coffee extracts; coffee essences; mixtures of coffee and chicory; chicory and chicory mixtures, all for use as substitutes for coffee.</p> <p>Class 43 Restaurant, café and tea room services; catering services</p>
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