

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NUMBER 2130019
BY PIZZA PIZZA LIMITED TO REGISTER A TRADE MARK
IN CLASSES 25, 29, 30, 35, 39 AND 42**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER
NUMBER 48664 BY BRAKE BROS FOODSERVICE LIMITED**

TRADE MARKS ACT 1994

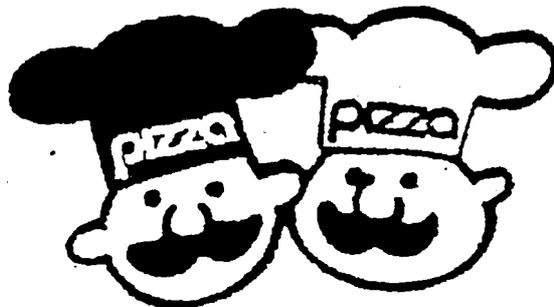
**IN THE MATTER OF Application Number 2130019
by Pizza Pizza Limited to register a trade mark
in Classes 25, 29, 30, 35, 39 and 42**

and

**IN THE MATTER OF Opposition thereto under
Number 48664 by Brake Bros. Foodservice Limited**

BACKGROUND

1. On 17 April 1997 Pizza Pizza Limited applied to register the following trade mark:



in the following Classes:

Class 25:

Articles of outer clothing; articles of under clothing; headgear.

Class 29:

Salads; pizza toppings; coleslaw, dips; meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; sauces; eggs, milk and milk products; mushrooms, prawns, shrimps, tuna, seafood, cheese, pineapple, sweetcorn, pork, pepperoni, salami, cured meats, peas, leeks, artichokes, nuts, beans and seeds, tomato, anchovies, ham, chicken, turkey, capers, asparagus, onion, garlic, peppers, beef, olives, chillies, bacon, herbs.

Class 30:

Pizzas, pizza pies; ingredients for making pizzas; pizza toppings and pizza

fillings; foodstuffs for use in the preparation of pizzas; pasta; prepared meals and constituents for meals; ice cream, ice cream products, frozen confections; confectionery; sugar, flour and preparations made from cereals; salt, vinegar, herbs, spices, bread, garlic bread, pastry; beverages; sandwiches; snack foods; sauces, dips; salad dressings.

Class 35:

Business advisory services relating to franchising.

Class 39:

Food delivery.

Class 42:

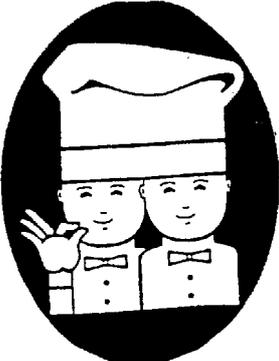
Restaurant, bar, cafeteria and snack bar services; catering services; professional consultations relating to franchising.

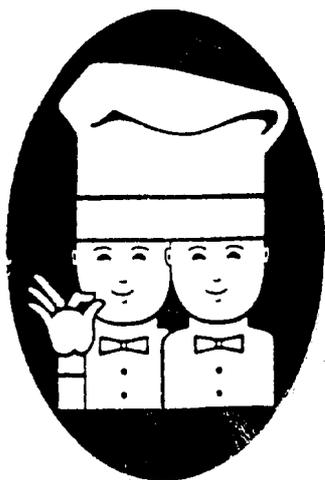
2. The application was subsequently accepted by the Registrar and published in the Trade Marks Journal. On 10 June 1998 Titmuss Sainer Dechert on behalf of Brake Bros. Foodservice Limited filed a Notice of Opposition. In summary the grounds were:-

(1) Under Section 3(1)(b) and (c) of the Act because the mark applied for is devoid of any distinctive character and/or it exists exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering the services, or other characteristics of goods or services.

(2) Under Section 3(6) of the Act by reason of the application being made in bad faith.

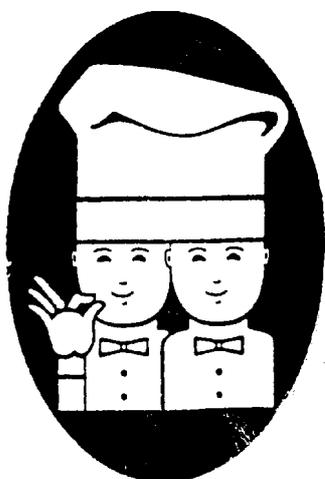
(3) Under Section 5(2)(b) of the Act because the mark applied for is similar to the following trade marks owned by the opponent and registered for the same and similar goods:-

MARK	REGISTRATION NUMBER	REGISTRATION DATE	CLASS	GOODS
	999812 (United Kingdom)	11 October 1972	29	Meat; fish, poultry and game, none being live; preserved dried or cooked fruits and vegetables.



999827 12 October 1972 30
(United Kingdom)

Preparations made from cereals for food for human consumption, bread, biscuits (other than biscuits for animals), cakes, pastry, non medicated confectionery, ices, sauces and ice.



207407 1 April 1996 29
(Office for the Harmonisation for the Internal Market)

Meat, meat products; fish; poultry and game; frozen and chilled food products made from meat, fish, poultry or game; prepared meals; fruit and vegetables all being preserved, dried, cooked or frozen; vegetarian prepared meals; eggs; milk based desserts.

30
Rice, pasta; pasta products, snack foods; prepared meals, dumplings; sauces, pastries, cakes and pastry mixes; potato chips; confectionery, frozen sauces, pastries, cakes and pastry mixes; potato chips; confectionery, frozen confectionery; ices and sweets; puddings; dessert products; ice creams; sorbet.

32 Non-alcoholic drinks.

(4) Under Section 5(4) (a) of the Act in that use of the trade mark applied for by Pizza Pizza Limited is liable to be prevented by virtue of a rule of law, including the laws of copyright and passing off, in view of the substantial reputation in the opponent's registered trade marks (above).

(5) That the opponent's trade mark THE TWIN CHEF is entitled to protection under Section 56 of the Act as it has become a well known trade mark in the United Kingdom.

3. On 24 July 1998 the applicants filed a counterstatement denying the above grounds. Both sides have asked for an award of costs in their favour and have filed evidence. The matter came to be heard on 15 March 2001 when the applicants for registration were represented by Mr Malynicz of Counsel instructed by Clifford Chance and the opponents by Mr Mellor of Counsel instructed by Titmuss Sainer Dechert.

Opponent's Evidence

4. This consists of a statutory declaration by Martin Terence Alan Purvis dated 29 January 1999. Mr Purvis is the Group Company Secretary of Brake Bros. PLC and, has been employed by the company for five years.
5. Mr Purvis states the Brake Bros. brand is renowned generally as a leading food supplier and that there are also a number of sub brands through which the catering industry recognise the Group's products, such as the Twin Chef division which is the Group's manufacturing business. He goes on to state that Twin Chef Foods is a major producer of recipe dishes for the catering industry and the Group and refers to Exhibit MP1 to his declaration which consists of copies of advertising promotional material relating to the various sub brands which are used in external marketing.
6. Next, Mr Purvis states that sales outside the Group by the Twin Chef division increased by £22 million to £30 million in 1997 and he refers to Exhibit MP2 to his declaration which is a recent copy of the Company's Report and Accounts for the year ended 31 December 1997 which contains financial highlights and some historical information concerning the company and its business operated under the TWIN CHEF mark. Mr Purvis draws particular attention to the annual turnover of the company, whose business is predominantly carried out under the BRAKE/BRAKE BROS. trade marks, which includes products manufactured by Twin Chef Foods, and which he summarises as follows:-

<u>YEAR</u>	<u>TURNOVER (£ million)</u>
1988	124.8
1989	145.3
1990	195.4
1991	223.0
1992	280.5
1993	353.9
1994	402.2
1995	466.3
1996	650.7
1997	691.6

7. Mr Purvis explains that in order to achieve sales, the Group has commissioned advertising

campaigns in various prestigious high value journals including The Caterer which is the leading trade journal and that the company is also vigorously involved in direct marketing activities. In addition, it also participates in a number of major catering exhibitions both nationally and regionally. At Exhibit MP3 to his declaration, Mr Purvis produces a list of the 1999 exhibitions throughout the United Kingdom in which the company proposed to take part and, in some instances, organise and host. He adds that as part of its marketing activities the Company took part, and in 1997 Twin Chef Foods took part, in an annual industry cruise known as The Catering Forum, which is essentially a three day marketing arena attended by catering suppliers and purchasers in the trade.

8. Mr Purvis goes on to state that the Twin Chef division targets, in particular, large catering establishments, and that its customers include Tesco, Sainsbury, BHS, Debenhams, Granada, Roadchef and JD Wetherspoon. At Exhibit MP4 to his declaration, Mr Purvis draws attention to a map of towns in the United Kingdom illustrating Brake Bros. Group coverage.
9. Mr Purvis concludes by stating that the TWIN CHEF device has become directly associated by the catering industry with the opponents.

Applicant's Evidence

10. This consists of five statutory declarations, one each by Pat Finelli, Donald Gordon Turner, and Caroline Teresa Bonella and two by Rachel Elizabeth Ambrose.
11. Mr Finelli's statutory declaration is dated 26 April 1999. He states that he is Vice-President of Marketing for Pizza Pizza Limited (the applicant), where he has been employed for the last fourteen years. Mr Finelli explains that the applicant is a corporation incorporated under the laws of Ontario and that the business of the applicant includes the operation and franchising of retail food outlets ("Pizza Pizza Stores") offering restaurant take-out, eat-in and delivery services (the "Pizza Pizza Services") and selling, among other things, ready to eat Italian-style food products including pizza (the "Pizza Pizza Wares"). He states that there are approximately 260 Pizza Pizza Stores operated by the applicant and its franchisees in Canada and that the applicant intends to operate or franchise similar Pizza Pizza Stores in the United Kingdom in association with the trade mark in the application.
12. Mr Finelli draws attention to the applicant's thirteen registrations in Canada of "Pizza Pizza" trade marks, details of which are contained in Exhibits A to M of his declaration.
13. Mr Finelli goes on to state that the applicant has also adopted and in Canada uses a family of trade marks that incorporate a drawing of one or two chefs' heads which display distinctive characteristics shared with the application in suit. He says that the applicant has been using such trade marks in Canada in excess of twenty three years and is the registered owner of three Canadian trade marks incorporating this design, the oldest being registered in 1980.
14. Mr Finelli explains that the chef design trade marks are an integral part of the applicant's marketing strategy and he believes that they have proved extremely successful. System wide revenues from Pizza Pizza Stores are approximately \$190,000,000 (Canadian) each year and the applicant spends approximately \$10,000,000 each year in promoting its trade marks,

including the chef design trade marks. Mr Finelli states that the applicant also promotes its trade marks through print advertising consisting of flyers and menus available in store and attached to pizza boxes. At Exhibits Q, R and S to his declaration are samples of how the applicant uses the chef design trade mark on paper goods, pizza boxes and brochures.

15. Mr Finelli concludes by drawing attention to the differences between the chef designs in the applicants and opponent's trade marks which he considers to be very marked and by pointing out that the applicant's mark also contains the words PIZZA PIZZA.
16. Ms Ambrose's first statutory declaration is dated 29 April 1999. She is the registered trade mark attorney acting for the applicants. Ms Ambrose commences by pointing out that while the fact that the applicant's mark has not been used in the United Kingdom means that instances of actual confusion are not possible there is, in her view, no likelihood of confusion on a comparison of the marks.
17. At Exhibit REA1 to her declaration, Ms Ambrose provides the results of a search of the United Kingdom trade marks register for marks consisting of or containing the device of a chef. She states that the results indicate that a plethora of chef devices co-exist in the relevant classes and therefore the consumer has to differentiate between the marks on what may be small differences.
18. Ms Ambrose goes on to deny that the applicant's mark was adopted in bad faith as, given the applicant's business, a trade mark containing the device of a chef or chefs is an obvious choice and she confirms that the goods and services claimed by the applicant are only those on which the trade mark will be used.
19. Finally, Ms Ambrose denies that the applicant's trade mark offends against Section 3(1) as it is highly stylised and fanciful. It is not an ordinary or conventional representation of the chefs, but a caricature.
20. The next statutory declaration is from Mr Turner and is dated 27 May 1999. Mr Turner is a registered trade mark attorney member and Past President of the Institute of Trade Mark Attorneys, a chartered patent agent and a solicitor. He is an independent intellectual property consultant who in relation to these proceedings has been asked by Clifford Chance, the agents for the applicant company, to give evidence in support of the application. Mr Turner confirms that he has no business connection with Clifford Chance, nor with the applicant company.
21. Mr Turner states that, particularly in the case of device marks, one's reaction is that of first impression. The applicant's mark consists of a drawing of male heads of Mediterranean appearance with the word PIZZA clearly visible on the hat of each character. On a comparison with the mark covered by UK registrations 999812 and 999827 and the European Community registration 207407, Mr Turner opines that when the marks are looked at as a whole there are prominent differences in the chef devices e.g. the hats, the lack of moustaches, the waving gesture; and he points out that neither the word PIZZA nor the words PIZZA PIZZA appear in the opponent's registrations.

22. Mr Turner concludes that the differences between the applicant's mark and the opponent's registrations are striking and because of the distinctive style of the drawing of the mark in suit, he cannot see that confusion could arise.
23. Ms Bonella's statutory declaration is dated 22 July 1999. She is a registered trade mark attorney, a member and fellow of the Institute of Trade Mark Attorneys and has acted as an examiner in the Institute's professional examinations. Ms Bonella is an independent trade mark consultant and has been asked by Clifford Chance, with whom she has no business connection, to give evidence in support of the application.
24. Ms Bonella states it is well established that, in marks containing both words and devices, greater emphasis is generally given to words. On a comparison of the applicant's mark with the mark of the opponent's registrations, Ms Bonella concludes that there are clear and striking differences, particularly in relation to the chefs' headgear and the gesture of approval given by the chef in the opponent's marks. She also bears in mind that devices of, or including chefs and the heads of chefs are frequently used in the classes for which the opponent's marks are registered.
25. The applicant's evidence concludes with a further (second) statutory declaration from Ms Ambrose, which is dated 31 August 1999.
26. Ms Ambrose states that she instructed Carratu International, a firm of commercial investigators, to undertake inquiries into the use in the UK of representations of chefs as trade marks for food products and related services and that the company undertook a mini-survey, including searches of the internet, Companies House and investigations of pizza parlours and supermarkets. She then draws attention to Exhibit REA1 to her declaration which contains examples of trade marks used on food products, and Exhibit REA2 which contains details of companies using references to chefs and examples of promotional literature.
27. Ms Ambrose concludes that the results show that use of trade marks incorporating representations of chefs, in some cases devices of two chefs, is common; that the opponents do not have exclusivity in the use of two chefs as a trade mark and that the subject trade mark was not adopted in bad faith; that the average consumer is accustomed to being able to distinguish between trade marks comprising devices of chefs by means of small differences and there is no likelihood of confusion in the current case.

Opponent's Evidence in Reply

28. This consists of a statutory declaration by Kathleen Rose O'Rourke which is dated 1 March 2000. Ms O'Rourke is a registered trade mark attorney, a member of the Institute of Trade Mark Attorneys and a solicitor, who is employed by Titmuss Sainer Dechert (the opponent's representatives).
29. Ms O'Rourke states that she has reviewed all the evidence filed in support of the application in suit and refers to the declaration by Rachel Elizabeth Ambrose dated 29 April 1999, in particular Exhibit REA1 to that declaration. She contends that none of the devices shown therein contain illustrations of two chefs or two chefs heads.

30. This concludes my summary of the evidence filed in this case. I now turn to the decision.

DECISION

31. Prior to the hearing Mr Mellor withdrew all grounds of opposition except for those under Section 5(2)(b) and Section 5(4)(a) of the Act.

32. The hearing commenced with the consideration of the evidence filed on behalf of the applicant by Mr Turner and Ms Bonella which comprises an "expert" assessment on the similarity of the respective marks in issue. In the view of Mr Mellor, the declarations of Mr Turner and Ms Bonella attempt to usurp issues which should be solely for submission at the hearing and for hearing officer decision. I share Mr Mellor's concerns in that the decision on the similarity of marks is one for the tribunal and should not be delegated to "experts". Mr Maynicz argued that I could consider the evidence of Mr Turner and Ms Bonella as a "non-expert" view of the overall impression given by the respective devices, but even on this basis I find their evidence of no assistance and I intend to give it no weight whatsoever in my decision.

33. I turn first of all to the ground of opposition under Section 5(2)(b) which reads as follows:

"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."

34. An earlier right is defined in Section 6, the relevant parts of which state:

"6.-(1)

(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,"

35. I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v. Puma AG* [1998] E.T.M.R. 1, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* [1999] E.T.M.R. 1, *Lloyd Schufabrik 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.

36. 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 of them he has kept in his mind; *Lloyd Schufabrik Meyer & Co. GmbH v. Klijsen Handel 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 Kaisha 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.
- (j)

37. The reputation of a mark is an element to which importance may be attached in Section 5(2) considerations. At the hearing Mr Malynicz rightly pointed out that the opponent's evidence on this issue should be treated with caution as much of it appears to post-date the date of application of the mark in suit (17 April 1997) and it is apparent that the opponent company's annual return and accounts filed under Exhibit "MP2" to Mr Purvis' statutory declaration are for the year ended 31 December 1997, that the list of exhibitions attached at Exhibit "MP 3" to the declaration relate to 1999 and that Brake Bros Foodservice Ltd manufacturing division commenced trading as Twin Chef Foods in 1998. While I take due cognisance of the above, it seems to me that the evidence nevertheless demonstrates that the opponents possessed a large share of the market for supplying ready made meals to catering establishments prior to the

relevant date (17 April 1997) and that much of this business was conducted under branding of the trade marks relied upon by the opponent in this case, albeit mostly as 'umbrella branding' in conjunction with other trade marks of the opponent. Overall turnover for Brake Bros. in 1996 was over £650 million and the company's annual report and accounts for 31 December 1997 at page 6, paragraph 4 states that Twin Chef Foods (the manufacturing division) increased external sales from a 1996 figure of £22 million. I will take this into account in my decision.

38. I must also compare the mark applied for and the opponent's registrations on the basis of notional and fair use and on this point Mr Malynicz argued that I should take account of the applicant's use of their mark in Canada and their intentions, as outlined in Mr Finelli's declaration, as this shows how the mark will be used in the United Kingdom, that is for goods and services in relation to "take-out pizza" and "pizza parlours". On the other hand, Mr Mellor submitted that use in Canada was not relevant to the application in suit and that notional and fair use should be considered in light of the full scope of the applicant's specification of goods and services contained in their application, which have not been limited in any way as to their use and that the average customer for the goods or services should be defined widely, given the width of these specifications. In my view, Mr Mellor's approach is the correct one as, in law, there is no limitation as to how the applicant's mark is to be applied to the goods or services and even if it is their current intention to restrict use to "take-out pizza" and "pizza parlour" goods and services, this cannot be enforced as there appears to be nothing to prevent the applicant widening its use at a later date or assigning the mark to another party who would not be constrained as to its use.
39. 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 this case I accept that identical goods and services are involved and that the opponent's mark possesses a reasonably high distinctive character, especially amongst the likely customers for their goods ie. the catering trade. However, it was held in *Marc Mode v Adidas AG* (2000) ETMR 723:
- "The reputation of a mark, where it is demonstrated, is thus an element which, amongst others, may have a certain importance. To this end, it may be observed that marks with a highly distinctive character, in particular because of their reputation, enjoy broader protection than marks with a less distinctive character (*Canon*, paragraph 18). Nevertheless, the reputation of a mark does not give grounds for presuming the existence of a likelihood of confusion simply because of the existence of a likelihood of association in the strict sense."
40. In my consideration of whether there are similarities sufficient to show that a likelihood of confusion I am guided by the recent judgements of the European Court of Justice mentioned earlier in this decision. The likelihood of confusion must be appreciated globally and I need to address the degree of visual, aural or conceptual similarity between the marks, evaluating the importance to be attached to those different elements, taking into account the category of goods in question and how they are marketed.
41. In the evidence and at the hearing, both parties have focussed on the state of the Trade Marks Register and the position in the market place in relation to chef devices and in particular, devices containing or comprising two chefs. I find the claims as to the state of the Register to

be of very little aid and mere evidence of entries on the Register without evidence of whether and to what extent the marks concerned are used, is of little or no value. Furthermore as conceded by Mr Malynicz at the hearing, the "mini-survey" conducted by the applicant's investigators does not really assist the issue. I would only add, from my own knowledge, I am aware that chef devices are commonly used on food and related products and services, and this explains the Registrar's practice, under Section 3(1)(b) and (d) of the Act, to object to chef devices for such goods or services in the prima facie unless, as in the current case, the devices are stylised. My decision involves a comparison of the applicant's and opponent's particular marks and must be made on its own merits.

42. Both marks contain stylised devices of two chefs. The mark applied for consists of a basic cartoon like drawing of two human heads with closely similar features and moustaches, one wearing a black chef's hat and the other wearing a white chef's hat upon which appear the words PIZZA PIZZA. The opponents' mark comprises a cartoon like drawing of two identical chefs consisting of their heads and upper bodies shown against a dark oval background. Their faces are round and boyish and they share the same outsize chef's hat. They both wear bow ties and buttoned tops. It is, of course, possible to over analyse marks and in doing so shift away from the real test which is how marks would be perceived by customers in the normal course and circumstances of trade and I must bear this in mind when making the comparisons.
43. At the hearing both counsel drew my attention to *Sabel BV v Puma AG* (mentioned earlier in this decision) which is of particular relevance. It states that where there is a similarity between two pictorial marks, one of which includes a text, the inclusion of a textual element in one of the marks does not in itself preclude a finding of likelihood of confusion (para 64(3)); that the registration of a trade mark may be opposed on the basis that the ideas conveyed by the pictorial elements of two trade marks are similar, provided that it is established that there is a likelihood of confusion (para 64 (4)); and it is not enough, because the idea behind the marks is the same, that there is a risk the public will associate the two marks, in the sense that one will simply bring the other to mind, without a likelihood of confusion (para 64 (2)).
44. Turning firstly to a visual comparison of the marks I find them quite different in that their overall visual impact is distinct from one another. Key aspects of the marks - the chefs and their hats - look very different, especially taking into account the striking moustaches on the applicant's chefs and that the opponent's chefs share an outsize hat. While both marks contain devices of two chefs the concept of a chef or chefs cannot be monopolised for the goods and services at issue, especially as such devices, when represented in a straightforward manner, are considered non-distinctive in the prima facie. The respective marks consist of stylised representations which, in my view, look very different and there is no likelihood of confusion in a visual context.
45. While both marks have a primarily visual identity I go on to consider aural use. Both marks contain stylised representation of two chefs and the opponent's case depends on the proposition that this will not be distinguished in aural use. However, it seems to me that the public are well able to differentiate in the market place between products bearing devices of a chef, or chefs, especially as, in relation to food products and services, customers normally

select by the eye rather than by placing orders by word of mouth. Even take-away pizza is normally ordered from a menu containing an indication of trade origin, or a trade mark and it seems to me likely that orders from caterers will be made from a list provided by the supplier.

46. Finally, I turn to a conceptual comparison of the marks which needs to be applied with respect to the likelihood of confusion between the particular pictorial components of the marks as, in my opinion, the concept of a device of chefs for the goods and services at issue is not original or deserving of a wide sphere of protection, notwithstanding the opponent's reputation in their particular device of chefs. As mentioned previously in this decision, the key elements of both marks - the chefs and their hats - look very different. Although there is an analogy between the pictorial components in that they both contain representations of two chefs, it cannot be adduced that there is a likelihood of confusion. The opponent has not established that the device of two chefs, per se, is distinctive of its goods and services.

47. To conclude, it is possible that some people encountering the applicant's mark may think it reminiscent of the opponents marks but it does not follow that a likelihood of confusion exists amongst the average customer for the goods and services. Given the overall differences between the marks and taking into account all the relevant factors, including imperfect recollection on a global appreciation I believe the possibility of confusion is sufficiently remote that it cannot be regarded as a likelihood. The opposition under Section 5(2)(b) fails.

48. I next consider the ground of opposition under Section 5(4)(a) which states:

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

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

(b)

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

(5) Nothing in this section prevents the registration of a trade mark where the proprietor of the earlier trade mark or other earlier right consents to the registration.

49. In deciding whether the mark in question offends against this section, I intend to adopt the guidance given by the Appointed Person, Mr Geoffrey Hobbs QC, in the WILD CHILD case (1998 14 RPC 455). In that decision Mr Hobbs stated that to succeed in a passing off action, it is necessary for the opponent's to establish, at the relevant date (19 April 1997), that: (i) they had acquired goodwill under their mark; (ii) that use of the mark would amount to a misrepresentation likely to lead to confusion as to the origin of their goods; and (iii) that such confusion is likely to cause real damage to their goodwill.

50. I have already found that the opponent has goodwill in the trade mark used as the basis of this opposition but concluded that this was not enough to result in a likelihood of confusion under

Section 5(2). It seems to me that the necessary misrepresentation required by the tort of passing off would not occur here, either. The ground of opposition under Section 5(4) therefore fails.

51. The applicants are entitled to a contribution towards their costs and I therefore order the opponents to pay them the sum of £700. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 19 day of April 2001

JOHN MACGILLIVRAY
For the Registrar
the Comptroller-General