

O-203-10

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO 2485913  
IN THE NAME OF APPETITE RETAIL LIMITED**

**AND**

**OPPOSITION THERETO UNDER NO 98357 BY APETITO AG**

## TRADE MARKS ACT 1994

**IN THE MATTER OF application  
No 2485913 in the name of  
Appetite Retail Limited and  
Opposition thereto under  
No 98357 by apetito AG**

### Background

1. On 24 April 2008 Appetite Retail Limited (“ARL”) applied to register the following mark:



2. Registration was sought in respect of the following specification of goods and services:

Class 29:

Meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies, jams, fruit sauces; eggs, milk and milk products; edible oils and fats; prepared meals, desserts and snacks comprising the aforesaid goods; beverage ingredients, flavourings, food supplements and additives in this class; syrups.

Class 30:

Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee, flour and preparations made from cereals, bread, pastry and confectionery, ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice; prepared meals and snacks comprising the aforesaid goods; beverage ingredients, flavourings, food supplements and additives in this class; gravy; thickening agents for cooking food; frozen food products in this class.

Class 43:

Services for providing food and drink; temporary accommodation; catering services; restaurant, café and bar services.

3. Following publication in the *Trade Marks Journal* on 5 September 2008, apetito AG (“AAG”) filed Notice of Opposition on grounds based on section 5(2)(b) and 5(3) of the Act. In support of its objections, AAG relies on the following community trade mark registration:

No.	Mark	Specification
385237	apetito	Goods and services in classes 5, 11, 21, 29, 30, 37, 39, 41 and 42

4. The mark relied on by AAG has a registration date of 24 September 2004 which is less than five years before the date of publication of the application in suit. That being the case, the provisions of Section 6A of the Act do not apply and AAG is not required to prove use of its earlier mark.

5. ARL filed a counterstatement in which, essentially, it denied the grounds of opposition.

6. Both parties filed evidence. Neither party requested to be heard but both filed written submissions in lieu of attendance at a hearing. I give this decision on the basis of all the material before me.

## **The evidence**

### **AAG's evidence**

7. AAG's evidence consists of a witness statement by Richard Peter Ring, Financial Director of apetito Limited since 7 July 2002. Mr Ring explains that apetito Limited ("his company") is the wholly-owned, UK subsidiary of apetito UK Holdings Ltd which itself is a wholly-owned subsidiary of apetito AG (the opponent in these proceedings). He states that his company acquired an existing business, Waldens Wiltshire Foods Limited, in 1996 and the mark apetito was first used in the UK in 1997 in respect of the following goods:

Dietetic food for children and the sick (class 5).

Cooked meals, including frozen or quick-frozen products, for feeding large groups of people in canteens, hospitals, kindergartens, youth centers, nursing homes, retirement homes and other establishments, chiefly consisting of meat, sausages, fish, vegetables, potatoes, mashed potatoes, potato dumplings, prepared dry legumes, mushrooms, fruit, soups, meat jellies, fish jellies, fruit jellies, vegetable jellies, eggs, milk jellies, with the addition of meat salad, sausage salad, fish salad and potato salad, prepared fruit, milk, cheese, fromage blanc (class 29).

Cooked meals, including frozen or quick-frozen products, for feeding large groups of people in canteens, hospitals, kindergartens, youth centers, nursing homes, retirement homes and other establishments, chiefly consisting of flour, husked barley, semolina, groat, oatmeal, oat flakes, rice, sago, tapioca, pasta, also with the addition of meat salad, sausage salad, fish salad and potato salad, puddings, pastries, confectionery, ices, coffee, honey, sauces, cocoa, chocolate, confectionery (class 30).

Fruit drinks (class 32).

8. Since that time, the company has expanded to provide a range of services as Mr Ring goes on to state that his company's business is related to providing pre-prepared meals for the elderly through a meals on wheels service and to the hospital market and that it is the strongest and largest entity on the UK meals on wheels market with a 60% market share. He says that goods sold have exceeded £20 million since the date of first use of the mark. I presume he must mean this to be an annual figure as he also gives the following details:

Year	1997	1998	1999	2000	2001	2002	2003	2004	2005
£m	22.1	23.4	25.9	28.3	31.7	36.4	44.6	52.0	51.8

9. These figures are said to be wholesale figures but they are not presented in a way that allows me to determine how much relates to e.g. the sale of goods as opposed to the provision of services nor how much relates to the different markets sectors in which the company deals.

10. Mr Ring gives the following details of marketing spend within the UK:

Year	2003	2004	2005	2006	2007	2008
£	313,114	475,169	481,226	423,599	453,148	583,986

11. Advertisements are said to have been placed in *Caterer & Hotelkeeper*, *Cost Sector Catering*, *The Taster (In-house)*, *CaterCare Handbook* and *Hospital Caterer*. At RPR 3 Mr Ring exhibits two advertisements though no details are given of where or when these were published. Mr Ring says that promotional literature is prepared and distributed by post, direct mail and email, via sales teams, at exhibitions and at its own premises and by customer visits and at RPR 7 he exhibits some examples of such literature. Most are undated though one bears a date of 2000 and another 2001.

12. Mr Ring says that in 1997 and 1998 his company sponsored the Social Services Award at the Cost Sector Catering Awards and at RPR 4 exhibits a number of magazine articles referring to these awards. No details are given of the specific magazines from which these articles may have been taken nor when or where they were published. The company also regularly attends and sponsors the Public Sector Caterer of the Year Award at the Caterer & Hotelkeeper Awards known as *The Cateys* which have been running since 1984. At RPR 5 he exhibits a print from the awards' website. This refers to the 2009 awards and is therefore after the relevant date in these proceedings.

13. Mr Ring states that his company has attended both the National Association of Care Catering and National Children and Adult Services Conference exhibitions since 1998 and the Hospital Caterers Association and Health estate facilities management Association events from 2000.

14. Mr Ring states that his company has a fleet of around 300 specialist delivery vans and 40 commercial vehicles all of which feature his company's mark. He exhibits material showing some of these vehicles at RPR 4, 7 and 8. I will comment further on these later in this decision.

15. Mr Ring says that his company has won many awards for its products and gives details of gold awards won for one meal at the British Frozen food Federation awards and exhibits an extract at RPR 9 in support. The extract appears to be a publicity leaflet (undated) and indicates that the award is made for a “recently relaunched Waldens multi-portion Sweet and Sour Chicken dish”.

### **ARL’s evidence**

16. ARL’s evidence is given by Michael Milan, its Director. Mr Milan states that it began use of its mark in July 2007, in the London area, retailing its own-branded food and drink products. The following details are given of turnover and promotional spend, again, none of which are broken down in any way as regards the goods or services to which it relates:

Year	Turnover	Marketing
2007	£2.5	£30,000
2008	£2.75	£35,000

17. Mr Milan says that promotional activities take place through leafleting to offices local to the company’s outlets, in the outlets themselves and via its website. The mark is also printed on the packaging of food and drink products and on carry bags. At MM1 is exhibited a selection of this promotional material which appear to be prints from the company’s website and at MM2 are photocopies of photographs of packaging material. The remainder of Mr Milan’s witness statement consists of submissions regarding either AAG’s evidence or a comparison of the marks and goods or services. This being the case it is not appropriate for me to summarise them as this is not evidence, though I do take them into consideration in reaching my decision and will refer to them as necessary.

### **AAG’s evidence in reply**

18. Mr Ring filed a further witness statement. In response to comments made in Mr Milan’s witness statement he provides the following details of turnover:

Year	Turnover
2006	51.7
2007	48.6
2008	50.2

19. Though not stated, I take it that these figures are also given in £m, as Mr Ring states they show no decline in sales.

20. Mr Ring confirms that all of the advertisements exhibited to his first witness statement and exhibited at RPR 3 were placed between 2000 and 2009. This exhibit in fact consists of just two such advertisements. Both refer to “the apetito group” and Waldens, with the first showing a picture of a van in “Wiltshire Farm Foods” livery and the second referring to “Waldens’ new multi-portions” and also explaining that “Thanks to the buying power of apetito, one of Europe’s leading frozen food suppliers, and investment in a new, purpose-built laboratory, Waldens multi-portions now guarantee....”

21. At RPR 10 are exhibited copies of invoices said to relate to work carried out by an advertising agency for advertising design work. These invoices indicate they have been raised in relation to a wide range of matters including “chefmobile ad”, “Waldens Logo” “pureed brochures” and “leadership Forum logo”. Only three bear indications they have been raised in relation to what I shall call apetito work. The first is dated 28 November 2002 and relates to the “supply of datafiles of apetito picture”, the second, dated 31 January 2003 is for “concept development of the apetito recruitment” and the third, which refers to “apetito leaflet” is dated 18 December 2009 and therefore after the relevant date.

22. At RPR 11 Mr Ring exhibits articles relating to industry awards and, at RPR 12, a typewritten list to show how promotional literature is distributed.

23. That concludes my summary of the evidence filed to the extent I consider it necessary.

### **The objection under section 5(2)(b)**

24. This section of the Act reads:

(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.

25. In determining the question under Section 5(2)(b), I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel v Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] R.P.C. 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R 77 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) when considering composite marks, it is only if all the other components of the mark are negligible that the assessment of the similarity can be carried out solely on the basis of the dominant element; *Shaker di L.Laudato & Co. Sas* (C-334/05), paragraph 42,
- (f) an element of a mark may play an independent distinctive role within it without necessarily constituting the dominant element; *Medion AG v Thomson multimedia Sales Germany & Austria GmbH*, paragraph 30;
- (g) 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;
- (h) 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;
- (i) 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;
- (j) 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;
- (k) 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.

26. In essence the test under Section 5(2)(b) is whether there are similarities in marks and goods and services which, when taking into account all the surrounding circumstances, would combine to create a likelihood of confusion. The likelihood of confusion must be appreciated globally and I need to address the degree of visual, aural and conceptual similarity between the marks, evaluating the importance to be attached to those different elements and taking into account the degree of similarity in the goods and services, the category of goods and services in question and how they are marketed.

## Comparison of goods and services

27. For ease of reference I set out below the respective goods and services:

ARL's application	AAG's earlier mark
<p>Class 29: Meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies, jams, fruit sauces; eggs, milk and milk products; edible oils and fats; prepared meals, desserts and snacks comprising the aforesaid goods; beverage ingredients, flavourings, food supplements and additives in this class; syrups.</p>	<p>Class 5: Dietetic foodstuffs adapted for medical use</p>
<p>Class 30: Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee, flour and preparations made from cereals, bread, pastry and confectionery, ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice; prepared meals and snacks comprising the aforesaid goods; beverage ingredients, flavourings, food supplements and additives in this class; gravy; thickening agents for cooking food; frozen food products in this class.</p>	<p>Class 11: Cooking, refrigerating, freezing and defrosting apparatus.</p>
<p>Class 43: Services for providing food and drink; temporary accommodation; catering services; restaurant, café and bar services.</p>	<p>Class 21: Deep-freezing containers and heat-insulated containers.</p>
	<p>Class 29: Prepared meals, mainly of meat, sausage, fish, game, poultry, prepared fruit and vegetables, potatoes, mashed potatoes, potato dumplings, prepared pulses, mushrooms, meat salads, fish salads, fruit salads, vegetable salads, soups, meat jellies, fruit jellies, vegetable jellies, eggs, cheese, quark, milk, butter, cream, yoghurt and ingredients for the aforesaid meals in prepared form.</p>
	<p>Class 30:</p>

	Prepared meals, mainly of pearl barley, semolina, groats, oat flakes, cereal preparations (except foodstuffs for animals), rice, pasta, bread, pastries, confectionery, blancmanges, chocolate, ices, honey and/or jam (including honey and/or jam being desserts), and ingredients for the aforesaid meals in prepared form, sauces, including salad dressings, snacks with a potato and cereal product base; non-alcoholic coffee, tea, cocoa and chocolate drinks.
	Class 37: Cleaning of kitchen equipment and delivery vehicles.
	Class 39: Providing of food and drink to the public and mobile food delivery services, namely the delivery of meals, route planning for mobile food delivery services.
	Class 41: Conducting of seminars for the management and employees of services providing food and drink to the public; conducting seminars on nutrition for athletes.
	Class 42: Providing of food and drink to the public and mobile food delivery services, namely serving meals, providing of food and drink, cooking or heating meals; technical and organisational planning of kitchen equipment for providing food and drink to the public; computer programming for customer and consumer files, order list accounts; nutrition consultancy for individuals and groups, planning of menus; nutrition consultancy for management and employees of services providing food and drink to the public.

28. In its Notice of Opposition, AAG states:

“The goods of the application are, in the main, identical to those covered by the earlier mark. The additional goods and services covered by the earlier mark are similar to the goods in the application. The factors to consider (nature, end users, method of use, competitive/complimentary, intended purpose, manufacture, distribution channels, retails outlets, etc) when

comparing the goods and services which are not identical show that they are similar. Given the identity of the goods and on the basis that the opponent provides all of the goods and services covered by their earlier mark, it is logical that the applicant's goods are similar to all of the opponent's goods and services beyond those which are identical".

29. For its part, in its counterstatement ARL indicates that it:

"denies that the goods covered by the respective marks are, for the most part, identical as the Opponent claims. The goods covered by the Opponent's mark in classes 5, 11 and 21 are clearly unrelated to the Applicant's good in classes 29 and 30, bearing in mind their nature, uses, trade channels and the manner in which they are sold. Moreover, to the extent that the class 29 and 30 goods of the respective marks may be considered similar or identical, these similarities would be outweighed by the obvious differences between the marks themselves. As far as the services are concerned, the Applicant denies that there is any overlap between the Opponent's class 37, 39 and 41 services and the Applicant's class 43 services, and to the extent that the Opponent's class 42 services may be seen as being similar to the Applicant's class 43 services, again, these similarities are offset by the clear differences between the marks themselves, as outlined above."

30. And in its written submissions it says:

"[T]here are very fundamental differences between the types of goods and services covered by the respective marks. More specifically, the goods and services of [AAG's] registration are generally in the nature of pre-prepared meals, apparatus for storing these meals, including deep-freezing containers, as well as the retail and delivery of these meals to consumers. Educational services in the field of food and drink are also covered.

Thus, whilst these goods and services fall within the very general category of food and beverages, they are in sharp contrast to those provided by [ARL] and for which [ARL] seeks protection, which in line with its strap-line, are prepared for customers fresh to order everyday. We strongly refute [AAG's] suggestion that a prepared meal could include sandwiches. The very notion of a prepared meal implies a meal that requires cooking prior to consumption. Further, as seen from the evidence put forward by both parties, the goods and services offered by the respective parties are aimed at very different segments of the market and are distributed via different trade channels"

31. Whilst it is not disputed that AAG trades in the meals on wheels and hospital/care sector markets whilst ARG trades through outlets selling what might be described as takeaway food, this distinction is not reflected in the specification of goods as registered under the earlier mark and in the mark applied for. In *McQueen Clothing Co Trade Mark Application* [2005] RPC 2, Geoffrey Hobbs Q.C., sitting as the Appointed Person said:

“When assessing the objections to registration in the present case, it is necessary to assume normal and fair use of the marks for which registered trade mark protection has been claimed”.

32. Even if the specifications were worded to reflect this market distinction, I am mindful of the findings of the Court of First Instance (now General Court) in *Saint-Gobain SA v OHIM* Case T-364/05 where it said:

“67...With regard to the conditions under which the goods at issue are marketed, the applicant’s argument that the goods covered by the earlier marks are sold almost exclusively in shops and supermarkets, whereas the mark applied for refers solely to goods sold by mail order, is without foundation. As has already been held, on a comparison of the goods, nothing prevents the goods covered by the earlier mark from also being sold by mail order.....Furthermore, it is important to reiterate that the comparison between the goods in question is to be made on the basis of the description of the goods set out in the registration of the earlier mark. That description in no way limits the methods by which the goods covered by the earlier mark are likely to be marketed.”

33. Thus, I must consider the comparison in light of the specification of goods and services as registered and applied for. In carrying out the comparison I will take into account the principles set out in *British Sugar Plc v James Robertson & Sons Ltd* (TREAT) RPC 281. This identified the following as elements to be considered: their uses, their users, their natures, the trade channels through which they reach the market, where the items are to be found and whether they are in competition with each other. I must also consider the issue of whether the goods and services are complementary. In *Boston Scientific Ltd v Office for Harmonisation in the Internal Market (Trade Marks and Designs)(OHIM)* Case T-235/06 the CFI (now General Court) explained:

“82. It is true that goods are complementary if there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking (see, to that effect, Case T-169/03 *Sergio Rossi v OHIM –Sissi Rossi (SISSI ROSSI)* [2005] ECR II-685, paragraph 60, upheld on appeal in Case C-214/05 *P Rossi v OHIM* [2006] ECR I-7057; Case T-364/05 *Saint-Gobain Pam v OHIM –Propamsa (PAM PLUVIAL)* [2007] ECR II-757, paragraph 94; and Case T-443/05 *El Corte Inglés v OHIM-Bolaños Sabri (PiraÑAM diseño original Juan Bolaños)* [2007] ECR I-0000, paragraph 48).”

34. As each of the respective marks covers goods in classes 29 and 30, I will consider these goods first. In doing so, I take into account the findings in *Gérard Meric v OHIM* Case T-133/05 that goods can be considered as identical when those designated by the earlier mark are included in a more general category designated by a trade mark application (and vice versa).

35. *Meat, fish, poultry and game* as appears in ARL’s application could be sold as a prepared meal and so are identical to *prepared meals, mainly of meat, sausage, fish,*

*game and poultry* as is included within AAG's earlier mark. *Meat extracts* are commonly used in prepared meals containing meat and thus I consider them identical to *ingredients for prepared meals*. Preserving, drying and cooking are all forms of food preparation and thus *preserved, dried and cooked fruits and vegetables* are identical to *prepared fruit and vegetables*. The term *jellies* includes jellies made from a variety of ingredients and are therefore identical to *meat jellies, fruit jellies and vegetable jellies*. *Jams and fruit sauces* are prepared from fruit and may be used for the same purposes (e.g. as an ingredient or topping for a pudding) and thus are identical to *prepared fruit*.

36. *Eggs and milk* appear in the specifications of each of the respective marks and thus are identical. As *milk products* include *cheese, quark, butter, cream and yoghurt*, these goods are also identical. *Prepared meals, desserts and snacks* as included within ARL's application are identical to the *prepared meals and prepared fruit and vegetables* included within the earlier mark.

37. Drinks can be made from fruit, vegetables or milk and thus I consider *beverage ingredients* to be identical to *prepared fruit and vegetables and milk* of the earlier mark. This leaves *edible oils and fats; flavourings, food supplements and additives and syrups* which I consider to be identical to *ingredients for the aforesaid meals in prepared form* given that they are used in this capacity.

38. In summary, each of the goods as specified in class 29 of ARL's application are identical to goods as appear in class 29 of AAG's earlier mark and I go on to compare the respective goods in class 30.

39. *Coffee, tea, cocoa, rice, bread, confectionery, ices, honey, sauces, prepared meals and snacks* appear in each of the respective marks and are clearly identical. *Artificial coffee* and *coffee* are substitutes for each other and are also identical. *Sugar, flour and preparations made from cereals, pastry, treacle, yeast, baking-powder, salt, mustard, vinegar, spices, flavourings, food supplements and additives, gravy and thickening agents* are all used as ingredients for meals and are therefore identical to *ingredients for meals* as appear in the earlier mark. *Tapioca* and *sago* are both used as thickening agents and may also form part of a meal and thus are identical to *ingredients for prepared meals* with *sago*, being a cereal, also being identical to *cereal preparations*.

40. *Beverage ingredients* include *coffee, tea, cocoa and chocolate drinks* and thus these goods are identical. *Frozen food products* will be included within the term *prepared meals* and are also identical goods. This leaves *ice* which can also be used as an ingredient in various drinks and thus these are also identical goods.

41. Again, in summary, I find that each of the goods as specified in class 30 of ARL's application are identical to goods as appear in class 30 of AAG's earlier mark.

42. ARL's application also seeks registration of a number of services in class 43. AAG's earlier mark does not include any services which have been classified in this class. I take note of the recent case of *Omega Engineering Inc v Omega SA , (Omega AG) (Omega Ltd)* [2010] EWCH 1211 (Ch) where Mr Justice Arnold explained:

“5. Trade marks may be registered for any of the vast range of goods and services which are traded. For administrative reasons, in particular so as to facilitate searching, it has long been the practice of trade mark registries throughout the world to classify those goods and services into numbered classes. Although the United Kingdom adopted a classification system in conjunction with the first Trade Marks Act in 1875, the present system has its origins in an international conference in London in 1934 when an internationally-agreed list of classes was drawn up. This was adopted in the United Kingdom as Schedule IV to the Trade Marks Rules 1938 made under section 40(1)(c).

6. In 1957 an international convention concerning the classification of goods and services, the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks, was agreed. The Nice Agreement provides for the establishment and periodic revision of a Classification consisting of: (i) a numbered list of classes (each of which consists of a “class heading” which describes the goods or services in that class) together with explanatory notes; and (ii) an alphabetical list of goods and services with an indication of the class into which each of the goods or services falls: see Article 1(2). The Nice classification is based on that drawn up at the London conference in 1934.”

43. Due to the periodic revision of the Nice Agreement, services applied for at one time and which would have been classified in one class may, on a later-filed application, be appropriately classified in a different class. The fact that services may have been classified in different classes does not therefore mean, of itself, that the respective services are dissimilar.

44. ARL’s application seeks registration in respect of *services for providing food and drink* and *catering services* which have been classified in class 43. In my view they are highly similar if not identical to *providing of food and drink to the public and mobile food delivery services, namely the delivery of meals* in class 39 and *providing of food and drink to the public and mobile food delivery services, namely serving meals, providing of food and drink, cooking or heating meals* in class 42 of the earlier mark. *Restaurant, café and bar services* are clearly *providing food and drink to the public* and thus these are also highly similar if not identical services.

45. This leaves *temporary accommodation*. The provision of these services could include providing board and lodging (and therefore meals as well as somewhere to stay) and thus I consider them to be highly similar to *providing of food and drink to the public* as included within the earlier registration.

46. In summary, I find each of the services specified in class 43 of ARL’s application to be highly similar or identical to the identified services within classes 39 and 42 of the earlier mark. As I have found each of the goods and services as applied for to be highly similar or identical to identified goods and services within classes 29, 30 and 42 of the earlier mark I do not intend to give detailed consideration to the remaining goods and services covered by the earlier mark save to say that with the exception

of goods in class 5, I do not consider them to be similar. Their nature, method of use, users and trade channels differ.

**The relevant public and the purchasing act**

47. The respective goods are all bought by the public at large and are everyday purchases which may be made in a variety of ways including through a retail outlet including a kiosk, shop or restaurant or ordered online or by telephone for home delivery. Prices will vary from a relatively low cost item such as a pint of milk to a relatively high cost for e.g. a multi-course gourmet meal for a party of diners . The goods are also such as may be purchased by businesses such as cafés, clubs and by care providers. For the general public, they are not necessarily bought with the highest degree of attention and may indeed be subject to purchase on impulse, however I bear in mind that the average consumer is deemed to be reasonably well informed and reasonably circumspect. Where bought by businesses or care providers, more attention is likely to be paid and will involve taking into account such matters as the cost of the product, the ease with which it can be stored or prepared and the dietary preferences or nutritional needs of the eventual consumer. Given the nature of the goods and the average consumer, greater reliance is likely to be placed on the visual aspects of the marks however that does not mean that the other aspects would be ignored, particularly where goods are ordered by telephone. As regards the respective services, these may also be bought by individual members of the public e.g. when needing somewhere to stay for the night or when organising the catering for a family member’s wedding reception or by a business with similarly wide ranging levels of attention being given to their purchase.

**Comparison of marks and dominant and distinctive components**

48. For ease of reference I set out below the respective marks to be compared:

ARL’s application	AAG’s earlier mark
	<p style="text-align: center;">apetito</p>

49. ARL’s mark consists of a number of elements. The largest element is the word APPETITE presented in lower case. Underneath this, the words FRESHLY PREPARED EVERY DAY, in lower case lettering of a smaller font, extend from the second letter p and terminate in line with the final letter of the word APPETITE. In its written submissions ARL say the letter A “has been made to resemble an apple, complete with an apple stem, leaf and a bite taken out of it”. I agree that the letter A as presented is indicative of its having been partially eaten and is suggestive of its being an apple.

50. The word “appetite” means a desire for food or drink and, as ARL admit in its submissions “is perfectly apt to describe the types of goods and services covered by the marks at issue”. Commenting on ARL’s mark, AAG submits that “[t]he bite out of the letter A often appears simply as a printing error and the tag line is very small and descriptive and therefore should be disregarded”. Whilst I agree with AAG that the words “freshly prepared every day” are descriptive of things which are freshly prepared on a daily basis, I am not persuaded by the “printing error” argument. Printing errors, by their nature, are unintentional and highly unlikely to lead to something as clearly identifiable as shown here. In my view, whilst the words FRESHLY PREPARED EVERY DAY will not be ignored, given its relative size and boldness of type, the word APPETITE is the dominant element of ARL’s mark with the bite marks, stem and leaf element of the letter A giving the mark its distinctiveness.

51. AAG’s earlier mark consists of the word apetito presented in lower case and as such, it does not have a distinctive and dominant element. Rather, the distinctiveness in the mark rests in its totality.

### **The visual comparison**

52. In its written submissions, AAG says:

“The essential elements of the marks to be compared are “appetite” and “apetito”, importantly both in all lower case lettering. The only difference between the marks is the last letter of each.”

53. For its part, ARL says:

“Whilst it is true that some of the letters forming the Opponent’s mark APETITO are found in the element APPETITE, the elements differ in that the word APPETITE is spelt with two letter “P”s....and ends in the letter “E”, and has added stylisation.”

54. I have to compare the marks as wholes. ARL’s mark consists of a number of elements: the word APPETITE, the words FRESHLY PREPARED EVERY DAY and the stylisation of the initial letter A. The earlier mark consists of a single word apetito. Given the presence in both marks of words beginning with the letters AP and sharing the letters PETIT within them, there is, in my view, a degree of similarity between the respective marks however when comparing the marks as wholes, as I am required to do, I find they also have significant differences.

### **The aural comparison**

55. From an aural perspective AAG says:

“The only difference between the marks is the last letter of each. There is well-established case law to the effect that the ends of words are often dropped in spoken English, thus rendering the marks orally virtually identical.”

56. ARL says:

“the Applicant’s mark is noticeably longer in length and has a greater number of syllables, the mark being pronounced AP-PE-TITE-FRESH-LY-PRE-PARED-EV-ER-Y-DAY. In contrast, the Opponent’s mark would be pronounced simply A-PE-TI-TO. It is seen here that the double “P” in the APPETITE element of the Applicant’s mark makes a significant difference aurally, as the first two syllables of the Applicant’s mark are AP-PE, but in the Opponent’s mark they are A-PE. Further, the emphasis in the Applicant’s mark falls on the last syllable DAY. Even if the comparison is limited to APPETITE and APETITO, it is the last syllable of the word APPETITE, -TITE, which would be stressed in speech. In contrast, the syllables forming the Opponent’s mark APETITO would all be given equal emphasis when spoken.

57. In my view, each of the respective marks is likely to be pronounced in such a way that they will both begin with the syllables A (pronounced with either a long (as in “art”) or short (as in “cat”) vowel sound) and PET (I do not consider the fact that one mark has a double P will have any marked affect on this pronunciation). Whilst I accept the fact that ends of words are often slurred in spoken English, in my view this is highly unlikely when that word ends in the letter O, as is the case with the earlier mark before me. AAG’s earlier mark consists of four syllables which I consider will be pronounced AH-PEAR-TEE-TOE whilst the word APPETITE appearing in ARL’s mark has three syllables and will be pronounced AH-PUH-TIGHT. ARL’s mark also includes the words FRESHLY PREPARED EVERY DAY, though this may not always be articulated by the average consumer given its relative size within the mark and its clear descriptive nature. Thus, whilst there are some similarities between the respective marks in that each begins with a similar sound, there are also significant differences between them when considered as wholes.

### **The conceptual comparison**

58. Whilst AAG is silent on this aspect, ARL submits that its mark:

“evokes the notion of food that is prepared daily, and using only natural and wholesome ingredients. This conceptual meaning is reinforced by the unique styling of the letter “A” in the mark, which has the appearance of an apple. No such conceptual scope can be found in the Opponent’s mark APETITO, which would be completely meaningless to the average consumer in the UK....”

59. As I indicated above, the word APPETITE means the desire for food or drink. In my view, ARL’s mark is likely to bring to mind food or drinks which are freshly prepared every day or from ingredients which are fresh. The word apetito has no meaning in English though I am aware it is a Spanish word meaning appetite. Whilst the majority of UK consumers cannot be assumed to be fluent in a foreign language, many will have an appreciation of some of the more common foreign words, especially when they bear a resemblance to the equivalent English word. Apetito bears a resemblance to the English word appetite and may bring that word to the mind of some consumers which would lead to a degree of conceptual similarity between the respective marks.

## **Distinctiveness of earlier mark**

60. I also have to take into account the distinctive character of the earlier trade mark having regard to its inherent characteristics and the reputation it enjoys with the public and the goods and services on which it has been used. As set out in paragraph 9 above, although turnover figures of upwards of £20m annually have been provided, there is no explanation of how much of this relates to the sale of goods as opposed to services nor indeed is there any breakdown of figures from which I can apportion turnover between even the goods classes given the breadth of the registration extends to a range of very different goods. Marketing spend is said to have increased year on year from a low of £313,114 in 2003 to a high of £453,148 in 2007 (the last complete year before the relevant date in these proceedings) but is similarly unexplained.

61. As at the date the evidence was prepared (June 2008) some 300 vans and 30 commercial vehicles are said to have featured the trade mark. Exhibits RPR4 (undated but referring elsewhere to a 1998 award ceremony) refers to the company having a new livery for its fleet of 28 vehicles and pictures one of those vehicles. I note that the livery prominently features the name Waldens. The evidence of the awards made which appear at RPR 9 also refer to its having being awarded for Waldens' products. Whilst it is not disputed that the company has a 60% share of the meal on wheels market within the UK, it is not clear that this relates to trade conducted under the mark relied on (the exhibits at RPR 3 which shows a van bearing only "Wiltshire Farm Foods" suggests not) nor, given that the company's trade extends further than the meals on wheels market, how much of the company's turnover this 60% share represents.

62. As far I am able to see from all the exhibited material, there is little which shows the earlier mark as registered. Instead what is shown is a composite mark presented in red and green and includes a heart-shaped device element. That is not the mark relied on in these proceedings. In any event, as explained above, much of the material places significant emphasis on Waldens and other marks.

63. As I indicated above, the word *apetito* has no meaning in English but is likely to be recognised as having a meaning and may bring the word *appetite* to mind. The word *appetite* is, and as ARL submit, inherently weak for the goods and services concerned. In my view the word *apetito* being a non-English word, has an increased degree of inherent distinctiveness though that distinctiveness is not raised to any significant degree. Whilst it is clear that the earlier mark has been used, given my comments regarding the deficiencies in the evidence, I am not provided with sufficient information on which to base an assessment of the extent of any reputation AAG has acquired. Likewise, it is not possible to say to what extent the distinctive character of the earlier mark might have been enhanced as a result of its use. The earlier mark has a relatively low distinctive character.

## **Likelihood of confusion**

64. 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 marks but must instead rely upon the imperfect picture of them he has kept in his mind, mistakes one mark for the other, the clear visual and aural differences between the marks mitigates strongly against any such likelihood given the relatively low distinctive character of the earlier mark. This is the case even taking into account that identical goods and services are involved. I find there is no likelihood of direct confusion.

65. As I indicated above, it is possible that some people, on seeing the earlier mark, may bring the word appetite to mind. But I do not consider the reverse to be true-the average consumer on seeing the mark applied for would not bring to mind the word appetito. Even if they did, mere association is not enough and the position is not altered by the use made of the earlier mark. I do not consider the consumer would go on to be confused about the economic origin of the goods and services. Taking all relevant factors into account, I find the respective marks are not likely to be indirectly confused.

66. The opposition under section 5(2)(b) fails.

### **The objection under section 5(3) of the Act**

67. AAG remaining ground of opposition is founded on section 5(3) of the Act. Section 5(3) of the Act reads:

(3) A trade mark which -

(a) is identical with or similar to an earlier trade mark,

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

68. AAG relies on the same earlier right as it did under section 5(2)(b) and, in view of my finding under that ground can be in no stronger position here and I decline to deal with it further.

### **Costs**

69. The opposition has failed in its entirety and the application is free to proceed to registration. ARL is entitled to an award of costs in its favour. In reaching my decision, I take into account that both parties filed evidence and written submissions in lieu of a hearing. I therefore make the award on the following basis:

Preparing a statement and reviewing the other side's statement	£300
Preparing/reviewing evidence and submissions	£800
<b>Total</b>	<b>£1100</b>

70. I order apetito AG to pay Appetite Retail Limited the sum of £1100. 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 23 day of June 2010**

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