

O-346-03

**DECISION OF THE TRADE MARKS REGISTRY**

**TRADE MARKS ACT 1994**

**APPLICANT: RENOWN LEISURE LTD**

**OPPOSITION N<sup>o</sup>. 90228**

**AND**

**OPPONENT: 7-ELEVEN INCORPORATED**

**APPLICATION N<sup>o</sup>. 2283490**

**CLASSES 25 & 42**



## TRADE MARKS ACT 1994

### BACKGROUND

1. The mark is shown on the first page of this decision. It was applied for on 19<sup>th</sup> October 2001 by Renown Leisure Ltd Unit 5/6 Kingsmill Industrial Estate, Cullompton, Devon United Kingdom for:

Class 25: Clothing, headgear.

Class 42: Provision of food and drink.

The applicant claims the colours yellow and blue as elements of the mark.

2. Registration of the mark is opposed by 7-Eleven Incorporated under s. 5(2)(b) of the Act on the basis of the earlier mark CTM 110171 BIG BITES (filed 1<sup>st</sup> April 1996):

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.

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.

3. A Counterstatement was provided by the applicant denying the grounds asserted. Both parties ask for costs to be awarded in their favour.

### HEARING

4. At the hearing on 7<sup>th</sup> October 2003 Mr. Mandly of Wildman Harrold Allen & Dixon represented the opponent and Mr. Craske of Craske & Co. represented the applicant.

### EVIDENCE

#### The Opponent's Evidence

5. A Witness Statement by Sarah Jennifer Welch, an employee of the opponent's legal representatives, describes a visit to a number of restaurants and cafes in and around central London on 12<sup>th</sup> and 13<sup>th</sup> of September 2002. Items of clothing were purchased and are listed in her Exhibit 1:

Yo! Sushi	Blue Baseball Cap - £8.00 Also available to buy:- Bodywarmers Fleeces T-Shirts Womens T-Shirts
Rainforest Cafe	Black Baseball Cap - £6.99 Also available to buy:- T-shirts (childrens) Jumpers (childrens)
Sticky Fingers	T-shirt - £13.95 Also available to buy: - Polo shirts (with different Logos - also adult and child sizes) Hooded jumpers
Hard Rock Cafe	T-shirt - £8.50 Also available to buy:- Coats/jackets (Adult & child sizes) Jumpers (Adult & child sizes) Caps (Adult & child sizes) Baby Suits Womens T-shirts Shirts
Planet Hollywood	T-Shirt - £13.00 Also available to buy:- Coats (Adult & child sizes) Sweatshirts (Adult & child sizes) Vests Childrens Baseball shirts Womens T-shirts Baseball caps Baby Suits
TGI Friday's	Unable to buy any clothing
The Three Kings (Pub/restaurant) ) Clerkenwell	T-shirt - no cost

Honkers American Bar & Diner	T-shirt - £9.99 Also available to buy:- Halter neck tops Vests Polo shirts Jumpers
Ed's Easy Diner	T-shirt:- £15.00 No other merchandise available
Cheers	Baseball Cap - £9.95 Also available to buy:- T-shirts Jumpers Soft toys
Texas Embassy Cantina	T-shirt - £12.00 Also available to buy:- Caps Bags Jumpers

Some examples of the same were enclosed in Exhibit 2 to Ms. Welch's statement.

6. Also enclosed is a Witness Statement by Gavin Hyde-Blake of Carratu International who were instructed by the opponent to carry out an investigation into the use of the trade mark by the applicant. This document concludes:

“Renown Leisure Ltd. trades under the names Big Bites Sandwiches and Mid Devon Caterers. The company trades from two units at the Kingsmill Industrial Estate in Cullompton, Devon. The company make and distribute sandwiches in the mid-Devon area.

We have ascertained that the Big Bites device is present on the building at the Industrial Estate, as well as on the delivery vans owned by the company.

We have been informed by a Director, Michael Kelsall-Spurr, that the device was introduced in June 2001.”

#### The applicant's evidence

7. The applicant's main evidence comes in a Witness Statement from Mike Kelsall-Spurr, managing director of Renown Leisure Limited. He explains that Renown Leisure (the applicant) purchased Mid Devon Caterers from a Gary Neil Parkes on 5<sup>th</sup> January 2001 (see Exhibits MKS.1, MKS.2 and MKS.3). These document suggest that the latter traded under the names 'Mid Devon Caterers' and 'Big Bites Sandwiches' (see 'Trading As' on the first page of the Sales Particulars (Exhibit MKS.1) and 'the business names' in section 1.1 of the Sales Agreement (Exhibit MKS.2) and the first WHEREAS clause in the Deed of Assignment (Exhibit MKS.3)). Mr. Parkes also provides a Witness Statement, in which he states:

“1. In 1987 my wife and mother-in-law established a business in Basingstoke selling sandwiches under the name “Big Bites Sandwiches”. The business continued to grow in the Basingstoke area until 1994 when my wife and I decided to move to Devon.

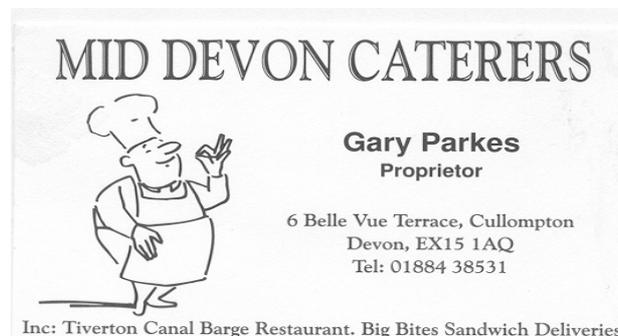
2. After moving to Devon my wife and I continued selling sandwiches under the name “Big Bites Sandwiches” which my wife had previously used. We decided to trade as a sole trader under the business name of Mid Devon Caterers with myself as the sole proprietor. Initially, we had a single van which carried the name “Big Bites Sandwiches” in very prominent letters, which we used to sell sandwiches in and around the Tiverton area, but the business became very popular and grew within a short space of time. In mid 1995 we added a second van, also prominently sign-written with the “Big Bites Sandwiches” name, and we continued to grow and expand delivering fresh sandwiches throughout mid Devon and South West Somerset from Taunton to Exeter. By 2001 we had a fleet of six vans, all similarly sign-written.

3. In 2001 I decided to retire from the business and we sold Mid Devon Caterers as a going concern to Renown Leisure Limited. We considered the goodwill in the name “Big Bites Sandwiches” was an important asset of the business, and the right to use the name “Big Bites Sandwiches” was specifically included in the contract of sale to Renown Leisure Limited.

4. Since selling the business I have disposed of most of the documentation relating to Mid Devon Caterers, although I still possess a few documents which are stored in my attic. I have searched through the remaining records to try and locate documentary evidence to show that the name “Big Bites Sandwiches” has been used throughout the period referred to but I have found nothing of use.

5. We did not, at any time, receive any complaints about our use of the name “Big Bites Sandwiches”.

8. It seems clear to me that, prior to the sale to the applicant, that the name MID DEVON CATERERS was an important mark of trade of the business established by Mr. Parkes. Nevertheless, it is also clear BIG BITES SANDWICHES was used as well, at least on the side of the delivery vehicles mentioned. Mr. Kelsall-Spurr includes in evidence (Exhibit MKS.4) a business card of the, now retired, Mr. Parkes:



This tends to suggest that, during the period that Mr. Parkes owned the business, BIG BITES SANDWICH DELIVERIES was something of a secondary mark to the main trading name of MID DEVON CATERERS. I have seen nothing to shepherd me away from this conclusion as, apart from this business card, there is material showing the extent of use of the mark before ownership changed hands, such as invoices, bills, receipts and the like.

9. Mr. Kelsall-Spurr states (paragraph 5) that, as part of his plans for expansion of his business, he decided in 2001 to have a more distinctive logo produced – for this reason the circular background and ‘the musical strap line’ were added, giving the mark in suit. The same appeared in advertising (Exhibit MKS.5 and MKS.6) and on the side of company vehicles (Exhibit MKS. 7). Mr. Kelsall-Spurr is unclear about when he introduced the redesigned sign. I note the investigation carried out by the opponent (see paragraph 6 above) concludes that this was June in 2001. This has not been challenged.

10. Mr. Kelsall-Spurr includes turnover for the business from 1999 onwards:

1999-2000	£287,197
2000-2001	£360,000
2001-2002	£453,000
2002-2003	£ 710, 000 (projected)

11. I note the following from Mr. Kelsall-Spurr’s statement:

“5. I do not regard the name ‘Big Bite’ or ‘Big Bites’ as being particularly distinctive in its own right, and I am aware that the phrase is commonly used in a descriptive sense and by businesses within the food industry to denote generous portions of food. .... I just wish to protect the term ‘Big Bites Sandwiches’, which describes our core business, in combination with the circular background with a bite removed and the musical strap line.”

12. The following is referred to as proof of his belief that the name BIG BITES is not distinctive in the food industry:

Exhibit MKS.8: a photograph of a mobile snack bar which, he says has been operating in the Exmouth area of Devon for at least six years.

Exhibit MKS.9: an advertisement which is placed in Yellow Pages by another sandwich and catering company in Yelverton near Plymouth. Mr. Kelsall-Spurr states that he understands ‘that this is a franchise, and there are a number of similar Big Bite companies operating throughout the United Kingdom’. Also included in the same Exhibit are various labels which have been supplied to Mr. Kelsall-Spurr by Wessex Labelling Systems’ who have supplied labels to Big Bite for 8 to 9 years’.

Exhibit MKS.10: a collection of material downloaded from the Internet.

13. Finally, also included are three ‘proforma’ Witness Statements by:

Robert James Clarke, who states that he has ‘been continually supplying Mid Devon Caterers and Renown Leisure Ltd. with Fruit, Vegetables & Salads for Big Bites Sandwiches, since 1995’.

Richard Bird, states that he has ‘supplied cooked meats to Big Bites from 95-97’.

Gerry Pickard (of the West Country Private Ambulance Co., Tiverton, Devon) states only that he is a ‘customer’.

14. Each states:

“I do not have any connection with the ‘Big Bites Sandwiches’ business which was formerly run by Mid Devon Caterers, now owned by Renown Leisure Limited of Unit 5/6 Kingsmill Industrial Estate, Cullompton, Devon..”

and

“I hereby affirm that the name ‘Big Bites Sandwiches’ has been continuously used by Mid Devon Caterers and Renown Leisure Limited within the county of Devon since 1995.”

## **LAW**

15. The relevant section of the Act is:

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

(a) ... , or

(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.”

## **DECISION**

### S. 5(2)(b)

16. In approaching s. 5(2)(b) I am mindful of the following decisions of the European Court of Justice (ECJ) on this provision (equivalent to Article 4(1)(b) of Directive 89/104/EEC) 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 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*, paragraph 22;

(b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV*, 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*, paragraph 27;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV*, 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*, 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*, 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*, 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*, 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*, 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*, paragraph 29.

### Honest Concurrent Use

17. I informed the parties at the hearing that I did not believe that this would influence my deliberations and nothing I heard there altered my view. Mr. Craske stated, correctly, in his skeleton argument that:

“11. Honest concurrent use is one of the relevant factors which has to be taken into account in determining whether there is a likelihood of confusion under S. 5(2). *CODAS Trade Mark* [2001] RPC 7, p 240.”

18. This is, of course, at variance with the position under the 1938 Act, where proof of honest concurrent use was a defence capable of saving an application. Under the new Act this is not the case (see s. 7(2)); however, where the public has been educated by marketplace experience that certain similar marks are indicative of different trade origins, then this would be a highly relevant factor in determining the likelihood of confusion. Nevertheless, evidence of the same must enable a hearings officer to come to such a conclusion confidently, on the balance of probabilities.

19. That I have seen here does not even come close. First, considering the application in suit, based on Mr. Kelsall-Spurr’s turnover evidence, and the investigation carried out by Carratu International (that this mark was introduced in June of 2001), I do not see how use of the mark as applied for helps at all. In respect of honest concurrent user, the presence of that mark on

the marketplace, before the material date in this case (19<sup>th</sup> October 2001), must be treated as minimal. Next, though I might, on the evidence I have seen, find that there had been use of the mark BIG BITES (or an undistinguished variation thereof such as BITES SANDWICH DELIVERIES) before 19<sup>th</sup> October 2001, and that this use might have built up some localised goodwill under the name, I have been given no measure of the extent of this. Use of the name has been declared by Mr. Parkes, but it is hard to assess its magnitude from the Statement he provides, where the business name MID DEVON CATERERS was also employed by him and, indeed, appears to have been his principle mark of trade (see paragraph 8 above). As for the evidence from Messrs. Clarke, Bird and Pickard, in terms of establishing honest concurrent user, this helps but little (leaving aside goodwill for the purposes of passing off and s. 11(3)). That ‘the name “Big Bites Sandwiches” has been continuously used by Mid Devon Caterers and Renown Leisure Limited within the county of Devon since 1995’, as each are witness, does attest to the creation of some goodwill under the name in the Devon area. However, the word ‘continuously’, without some material evidence, again, leaves me blind to the extent – and the manner – of trade under the name.

20. Third, there is no claim, and nothing to show, that the opponent has used their mark in the UK. Of course, absence of evidence is not evidence of absence, but I do need proof of use of their mark by the opponent if I am to come to any proper conclusion about the combined presence on the marketplace of the signs at issue. Even if they had used their mark, there are significant, unanswered questions: Was it geographically limited, so it would never have come into contact with the applicant’s mark? Was it used in a different sector of the marketplace, such that the respective businesses of the parties would never cross? In summary, honest concurrent user is not an ‘input’ in the ‘multi-factorial analysis’ (*Reef Trade Mark* [2003] R.P.C. 5, paragraph 13) indicative of s. 5(2)(b).

#### Distinctiveness of the earlier mark

21. It is the submission of Mr. Kelsall-Spurr that the mark BIG BITES is not distinctive in the food industry. At the hearing, Mr. Craske repeated this assertion:

“In our evidence we have endeavoured to show – we hope we have succeeded – that the BIG BITE name is in fact a fairly common name in this country that is used by a number of businesses. Certainly, from our point of view, we have never regarded that as a particularly distinctive mark. Indeed the whole point of our application was that we wanted to create a distinctive mark for ourselves, which is why we have added the additional logo material. We emphasise the fact that we sell prepared food in the logo by the addition of the word ‘sandwiches’. Our thought behind the application originally was that we were going to in fact reduce the level of confusion in the market place by using a logo that was more distinctive than the other traders that used the BIG BITE name.”

22. The evidence intended to indicate that BIG BITE is a fairly common name in the food industry in this country is not overwhelming. Considering the material downloaded from the Internet (Exhibit MKS.10), the first extract is from a Japanese website, admittedly in English, but is of the ‘Mainichi Daily News’, which also seems to be of Japanese origin. It is about a Belgium-style restaurant in Uchi Kanda, appearing in an article entitled ‘Champ de Soleil brews up a big bite of Belgium’. Though admittedly quotidian, and ordinary, this use of the phrase in Japan can hardly be indicative of the UK market.
23. Nevertheless, I am prepared to accept that the expression can be used, generally, to signify a

significant amount, as in – (I make this up) ‘Ford takes a big bite of the car market’. And, while ‘bite’ can mean ‘a light meal or snack’, a ‘big bite’ is suggestive of a sizeable example of the same. This possibly shows why the phrase might be adopted as a mark of trade in certain parts of the food industry – such as the business of the applicant and cafés – light meals are connoted, but so are generous portions.

24. Which may be the reason why a Café/Fish & Chip shop in Willesden Green has used the name (the second Internet hit, as well as the mobile snack bar (Exhibit MKS.8) in Exmouth. None of this is enough to demonstrate widespread use in the food industry, however. As for the last Internet download, this is not related to the food industry at all, but refers to a charity event.
25. Turning to the other evidence submitted by the applicant, I think the reference to the mobile snack bar and the advert in the Yellow Pages amount to proof of some localised use of the sign, but the latter begs as many questions as it answers: What was its date of publication? How long has this business operated? Was it before or after the relevant date? How extensive is the franchise mentioned by Mr. Kelsall-Spurr? As for the labels in Exhibit MKS.9, these do not appear to indicate anymore than the other evidence claiming use by the applicant’s predecessor in title.
26. In summary, it appears that more than one trader uses the name in the Devon area – two, at least, before the relevant date. But none of this material is enough for me to conclude, with Mr. Kelsall-Spurr, that the BIG BITES or BIG BITE is ‘commonly used .. by business within the food industry to denote generous portions of food’. I would have expected many more Internet ‘hits’ if this was the case, or evidence from specialist magazines showing common use of the expression. Nevertheless, the phrase is a descriptive expression of apparent meaning: a ‘big bite’ of something is a large or significant amount thereof. And, as I state above, it is easy to see why the name might be adopted by certain parts of the food industry.
27. So, against this background, what conclusion can I come to on the distinctiveness of this mark? Following the case law, a trade mark can have a capacity to distinguish by being inherently able so to do, or by gaining one through a consistent presence on the marketplace and constant consumer exposure (*Sabel*, paragraph 24). As the latter is not the case for the opponent’s mark (there is no ‘use’ evidence) they must rely on the inherent nature of the mark at issue. Mr. Mandly stated:

“The record clearly establishes that 7-Eleven’s BIG BITE mark was registered without showing an acquired distinctiveness, i.e. it is an inherently distinctive mark.”

and later:

“I suggest that BIG BITE has no literal meaning. With most food items – for example, take sandwiches – a sandwich is clearly on its face more than a BIG BITE. It is something which is multiple bites. While this may not be a level of distinctiveness of a coined term, or an arbitrary term, it certainly is I think suggestive of the quantity of the item but it is not descriptive. It does not immediately convey that information.”

28. I think Mr. Mandly is correct in stating that the opponent’s mark is inherently distinctive – at least enough to allow it to be registered as a CTM. However, registration sets a minimum level or standard – and I was not prepared at the hearing to compare the approach taken by OHIM to that of the UK Registry in assessing where this was – and many marks will clear the

latter with much to spare, while some will just about stumble over it.

29. As for the opponent's mark, I think I must conclude, with Mr. Mandly, that it has no directly descriptive meaning for goods and services in the food industry, though it does carry the clear laudatory suggestion of big portions (BIG) that, coupled with an association with consumption (BITE), puts it low on the distinctiveness scale in relation to food goods and services. In summary, *BIG BITE solus* is not a strong mark and, following the logic espoused by Mr. Craske, attracts less protection than marks with a greater inherent capacity to distinguish.

#### Similarity of marks

30. Mr. Mandly stated:

"I think that it is self-evident when you look at the respective marks that clearly the dominant element of the applicant's mark is BIG BITES, that the difference between BIG BITE and BIG BITES is the single letter S."

31. I agree that the dominant part of the applicant's mark is the BIG BITES element; certainly in terms of size, but also in terms of meaning. Though the excess in the applicant's mark should not be ignored, it is traditionally the case with trade marks that words speak louder than devices, and I believe that the distinctively memorable element in the application is this part of the sign. Though the 'jingle' consists of words (BIG BITES THE BETTER BITE, BETTER BUY A BIG BITES), they only serve to reinforce the BIG BITES element. The opposition mark lacks the 's' – it is BIG BITE – but, with Mr. Mandly, I do not see this as significant. The marks are similar to each other.

#### Similarity of goods

32. I need to set out a background of the relevant case law.

33. In the case of *Harding v. Smilecare Limited* [2002] F.S.R. 37, P. W. Smith Q.C. (sitting as a Deputy Judge of the High Court) stated:

"... for an action under section 10(2)(b) [equivalent to s. 5(2)(b)] to succeed there is a threshold which has to be crossed namely that the goods or services are identical with or similar to those for which the trade mark is registered."

There is a point at which goods or services become so dissimilar that confusion is unlikely, no matter the identity shared by the marks in issue. As the Appointed Person stated in *RALEIGH INTERNATIONAL Trade Mark* [2001] R.P.C. 11, paragraph 21:

"Similarities between marks cannot eliminate differences between goods or services; and similarities between goods and services cannot eliminate differences between marks."

34. Next, I must consider only the goods as they are set out in the specifications as listed; under s. 5(2)(b), notional and fair use of the respective marks for the goods/services contained within the specifications is assumed (see *Origins Natural Resources Inc v Origin Clothing Ltd* [1995] FSR 280, page 284. I will thus compare mark against mark and specification against specification.

35. In assessing the differences between the goods, I will apply the test set out by Mr. Justice Jacob in *British Sugar Plc v James Robertson & Sons Ltd* [1996] RPC 281, at page 296 (the *TREAT* case). He stated:

“I think the following factors must be relevant in considering whether there is or is not similarity:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

This is rather an elaboration on the old judicial test for *goods of the same description*. It seeks to take account of present day marketing methods. I do not see any reason in principle why, in some cases, goods should not be similar to services (a service of repair might well be similar to the goods repaired, for instance).”

These factors were referred to in the opinion of the Advocate General in *Canon*; page 127, paragraphs 45 - 48. In its judgment, the ECJ stated at paragraph 23:

“23. In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their end users and their method of use and whether they are in competition with each other or are complementary.”

36. A number of other authorities have dealt with the proper approach to the meaning of particular terms. Terms are to be given their ordinary and natural meaning. For example, *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267 puts a more recent gloss on the point.

“I should add that I see no reason to give the word “cosmetics” and “toilet preparations” or any other word found in Schedule 4 to the Trade Mark Regulations 1994 anything other than their natural meaning, subject, of course, to the normal and necessary principle that the words must be construed by reference to their context. In particular, I see no reason to give the words an unnaturally narrow meaning simply because registration under the 1994 Act bestows a monopoly on the proprietor.”

Also from *TREAT*:

“When it comes to construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of trade. After all, a trade mark specification is concerned with use in trade.”

37. Finally, the Registrar is entitled to treat the Class number as relevant to the interpretation of the scope of the specification of goods (*Reliance Water Controls Ltd v Altecnic Ltd* [2002] RPC 34).

The applicant's goods in Class 25: Clothing

38. On this point, Mr. Mandly said:

“With respect to the articles of clothing, clearly I believe that the uncontroverted evidence of record shows that it is a common practice to sell clothing in connection with providing food services. That is not limited to restaurant services. I think that is incorporated by the application of the applicant here. That clearly shows that they anticipate at some future date selling these kinds of products, so I think that there is a logical connection between the sale of food products through food services and the sale of clothing in the same mark.”

39. I am, of course, comparing the goods in Class 25 with those in the opponent's specification. And I immediately run into a number of problems, without need to apply the tests in *Treat*. Even if I was convinced that a trade in clothing was associated with the types of services investigated in the Welch Statement (café, bar and restaurant services) – and I am not (see below) – that is not what the opponent's registration specifies. Rather, ‘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’(Class 29) and ‘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 (Class 30) are, as has been pointed out, grocery products. Leaving aside the activities of the ‘big-supermarkets’ (which I will come to next), clothing is certainly not associated with the sale of such items, let alone being considered similar to them. To say that they were would be analogous to concluding that because some ferry companies sell alcohol, boats are similar to beer.
40. That the big supermarkets, such as Tesco, sell groceries and clothing in the same outlet is, in my view, irrelevant. They also sell insurance: is the latter thus similar to salt? I do not believe that one must be anything other than careful when using these organisations, now increasingly catering for a full spectrum of consumer needs, as a litmus test of similarity in goods and services. That is why, I believe, Jacob J in *TREAT* refers to the same shelf, in relation to self-service items (this was pointed out by Mr. Craske) and not to the same shop (see point (e), paragraph 35).
41. Turning back to the evidence submitted by the opponent, I do not see that a trade in clothing by certain types of café/bar/restaurant type establishments – the places that sell clothing usually accommodate all three and appeal to a certain type of consumer – and some pubs, means the such behaviour is now typical of all providers of food and drink. Most restaurants do not trade

in clothing (think of your local French, Italian, Indian or Chinese restaurant). Neither do most pubs. Or, for that matter, other providers of snacks such as sandwich bars and the like, despite the plans of the applicant in respect of headgear.

42. Further, for those that do sell clothing, such activity is an adjunct to their main function of provision of food and drink. It is a means of promotion and advertising (hence, I suspect, the Three Kings (Pub/restaurant) in Clerkenwell providing Ms. Welch with a free T-Shirt). And customers who purchase the headgear and t-shirts etc. from such venues do so as a token of their visit and would never, for one minute, think of the establishments they obtained them from as purveyors of apparel.
43. Finally, I do not accept a link of similarity between provision of food in cafes/restaurants/bars and clothing because it is now clear that some such businesses see the latter as an important revenue stream: returning to my cross channel ferry analogy, does anyone consider that P&O or the Sally Line are in a similar trade to Burtons because they also sell a lot of clothing?
44. In summary, clothing is not a similar good to the opponent's Classes 29 and 30 goods. To this extent, the opposition has failed.

#### Provision of food and drink

45. If the clothing is a problem for the opponent, the latter's goods in Classes 29 and 30 are more of a problem for the applicant. These are much clearly closer to the Class 42 services. But are they the same or similar? I need to examine this in some detail and I mean to go through the *TREAT* criteria, each in turn, but first I want to make some more general comments.
46. Following *Beautimatic*, words must be given their natural meaning, even if this is a wide meaning. I do not think, as Mr. Craske's skeleton invites me, I am able to limit the phrase 'Provision of food and drink' to a delivery service for pre-prepared food for immediate consumption. It seems to me that 'provision of food and drink' captures a number of activities – including those of restaurant services (from the Savoy Grill to one's local 'greasy spoon'), a road side 'burger bar' (as shown in Exhibit MKS.8) and the activities of businesses that prepare custom made sandwiches to their patrons order. These are indicative of Class 42 (now Nice Class 43: see The Trade Marks (Amendment) Rules 2001; SI 2001 No. 3832), and exclude pre-prepared 'sandwiches' (which are appropriate to Class 30). The common ground is that of a service providing, in respect of food (and some drink, such as coffee and tea), items that are prepared for consumption by customers to order. This might include 'take-away' items for later consumption. In other words, the phrase used by the applicant to describe their services is wide: it extends beyond what they actually do: described by Mr. Kelsall-Spur (paragraph 6 of his Statement) as 'the provision of fresh sandwiches'.
47. The other point to consider here, of course, is that the applicant is a service provider, and the opponent sells goods. In terms of the relationship between goods and services, I note Jacob J's comments in *TREAT* above that he '...do not see any reason in principle why, in some cases, goods should not be similar to services (a service of repair might well be similar to the goods repaired, for instance)'. See, also, the following from a Decision of the Appointed Person (*Balmoral* [1999] R.P.C. 297, page 301) that proximity of trading is a matter of fact and degree which should be given the weight and priority it deserves as part of the overall assessment (of confusion). In that case it was also stated (page 302), in relation to 'wines' and 'bar services':

“When the overall pattern of trade is considered in terms of the factors identified by Jacob J. in the *British Sugar* case (uses, users and physical nature of the relevant goods and services; channels of distribution, positioning in retail outlets, competitive leanings and market segmentation) it seems clear to me that suppliers of wines should be regarded as trading in close proximity ... to suppliers of bar services. In my view the degree of proximity is such that people in the market for those .. services would readily accept a suggestion to the effect that a supplier ...of bar services was also engaged in the business of supplying wines.”

48. At the hearing, Mr. Craske argued that the goods in class 29 and 30 were:

“... fairly specific and .. are broadly categorised as the sort of precursor products, if you like, that you would buy from a grocers or a delicatessen, or whatever, to produce other goods from rather than pre-prepared food and drink that we supply and we specify in our application. We do not see that there is necessarily a strong element of confusion in the goods themselves.”

49. Mr. Mandly’s comments were thus:

“I believe that there is a logical relationship between food products and the provision of food services. In that sense, clearly the goods have to be deemed highly related.”

and

“.. you cannot provide food services without providing food. It is a self-evident point that among the food products that are being utilised are foods that fall within international Classes 29 and 30. The witness statements which were submitted on behalf of the applicant recite, at least in the instance of two different producers, goods, all of which clearly fall within international Classes 29 and 30, including the products of salads, and other items. In that regard, there is a clear relationship between the two.”

50. In this respect, Mr. Mandly referred me to the applicant’s own evidence – in particular the Witness Statements of Mr. Bird (who supplied them with ‘cooked meats’) – to demonstrate an ‘association’ between provision of food and his client’s goods. Of course, this is not the same as similarity. There might be a logical relationship between food products and the provision of food, but is there a trade relationship as seen from the perspective of the average consumer?

51. That food products fall within Classes 29 and 30 is obvious. They also include sandwiches (see paragraph 46, above). But though the opponent’s specification includes bread and meat, they do not specify sandwiches, and certainly not the preparation of custom made (‘bespoke’?) sandwiches. It is the latter type of service I must compare with the opponent’s goods, as part of an overall comparison of a service of providing food and drink.

The respective uses of the respective goods or services

52. The same – sustenance and satiation. We all need to eat to live and the majority of us will consume food prepared at home with the so called ‘precursor products’ and outside the home, in restaurants and the like.

The respective users of the respective goods or services

53. The same. Consumers in general.

The physical nature of the goods or acts of service

54. I do not believe that this test is appropriate: one cannot compare an ‘act of service’ to a food ingredient.

The respective trade channels through which the goods or services reach the market

55. In his submissions, Mr. Mandly, referred me several times to the example of the supermarkets such as Tesco and Asda, which sell groceries as well as providing a variety of meals in their restaurants, and other foods prepared for immediate consumption – e.g. sandwiches to ‘take away’, cakes etc. As I stated above, I am unable to glean much from the habits of these large providers. Though most consumers now complete their weekly shop in such establishments, I consider I would need evidence showing proximity between the goods and services at issue. In fact, I have been provided with no material at all that establishes any species of trading link (from the perspective of the average consumer) between the provision of food and drink, and the goods in the opponent’s specification. I was asked, more than once, by Mr. Mandly to take judicial notice that, for example, prepared sandwiches are routinely sold in grocery stores. And, I must admit, this accords with my own experience. But I would need evidence to conclude that such establishments regularly provide food ‘made to order’ – as it is the service I am likening to the opponent’s grocery products. Do grocer shops regularly supply prepared meals? Do restaurants sell basic food items? I am not aware of this as common practice if they do, and the opponent has not supplied any evidence to enlighten me. The trade channels are not the same.

In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves ?

56. I think it generally the case that a service of providing food would not be found in the same vicinity in a supermarket as shelves containing coffee, tea, sugar, salt, mustard, vinegar, sauces (condiments), spices, jellies or milk. Or, indeed, meat and bread. Mr. Craske emphasised this point at the hearing and in his skeleton argument: he stated that the goods in the opponent’s specification were ‘in the nature of food ingredients which are likely to be purchased from a delicatessen, grocery store or supermarket.’ Again, I can take nothing from the observation that the ‘big’ supermarkets also usually accommodate restaurant services for the reasons I have already given: most smaller grocers, in my experience, do not. Once more, the response to this query is no.

### The extent to which the respective goods or services are competitive

57. I would suggest that the goods and services at issue can be competitive: someone seeking sustenance might go to a restaurant or a grocer shop to purchase meat and bread to make their own meal.
58. All in all, I do not believe that I can come to any other conclusion than that the opponent's goods must be considered as possessing only a small degree of similarity with the applicant's service of providing food and drink.
59. Before moving on, I want to deal briefly with a point raised by Mr. Mandly, in that he noted that restaurants such as MacDonald's and the like also supply their customers with salt and pepper (included within the opponent's specification). He thereby sought to make a link between his client's goods and the applicant's service of providing food. I do not find this convincing. The supply of such condiments is typical of many restaurants: but they are not in the business of trading in such items. No one would say that fish and chip shops deal in vinegar.

### Likelihood of confusion

60. I am left with goods and services of low similarity, and very similar marks. However, the mark is of low relative distinctiveness, and entitled to a lower protection footprint or penumbra of protection in the marketplace. This is a point I wish to say a few words about.
61. I think that it is generally accepted that marks are granted an 'umbra' and 'penumbra' of protection following registration under the 1994 Act. Protection within the umbra is confined to goods and services of the kind directly specified. Protection extends outwards – the penumbra – from and by reference to those good and services. The stronger the mark the more powerful is the extension of the protection (see the decision of the appointed person in *LE XV DU PRESIDENT* BL O/306/03, paragraphs 13 and 14). In my view the penumbra of the opponent's mark is of a pretty narrow kind. Nevertheless, it exists, and must envelop similar goods. I have found the services and goods at issue to share limited similarity. Would one confuse frozen burgers in Class 29 called BIG BITES and a restaurant trading under the applicant's mark? I have seen nothing to make me believe that this is likely.
62. Application of the *Balmoral* test above (see paragraph 47) tends to lead one, I believe, to the same conclusion. I am unable to accept that suppliers of groceries can be regarded as trading in close proximity to suppliers of the service of preparing food, so that origin confusion is likely to follow in the current case. In particular, I believe that a service of providing custom made sandwiches to consumers are not the same or similar to the opponent's goods. Even if they could be considered so, in my view, they are at the limits or the lower end of the similarity scale and, coupled with the narrow penumbra of protection I believe the earlier mark possesses, I find that confusion is unlikely. The opposition to registration of the applicant's mark therefore fails.

## **COSTS**

63. I was given no reason to make a costs award in excess of the usual scale. Nevertheless, this still will require the opponent to acknowledge the applicant's success by paying them £2000. This 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 12th Day of November 2003.**

**Dr W J Trott  
Principal Hearing Officer  
For the Registrar**