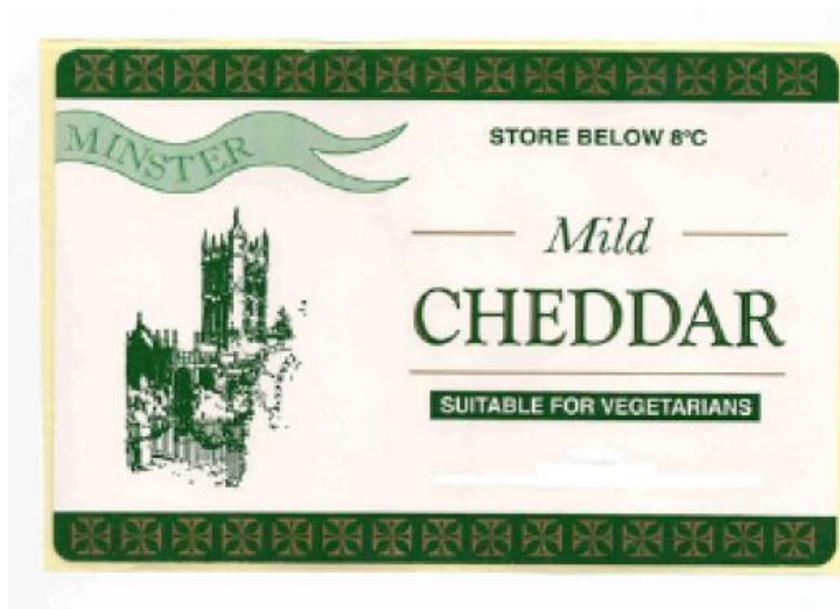


O-467-12

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK REGISTRATION NO. 2571522
IN THE NAME OF
THE DAIRY KOMPANY LTD
IN RESPECT OF THE TRADE MARK



AND

AN APPLICATION FOR A DECLARATION OF INVALIDITY THERETO
UNDER NO 84292 BY
FAYREFIELD FOODS LIMITED

Background

1. Trade mark No. 2571522 shown on the cover page of this decision stands registered in the name of The Dairy Kompany Ltd (“Dairy”). It was applied for on 8 February 2011 and completed its registration procedure on 3 June 2011. It is registered for the following goods in class 29:

Cheese product.

2. On 30 January 2012, Fayrefield Foods Ltd (“FFL”) filed an application to have this trade mark declared invalid under the provisions of sections 47(2)(a) and section 5(2)(b) of the Trade Marks Act 1994 (“the Act”) which state:

“47(2) The registration of a trade mark may be declared invalid on the ground-

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

(b)...

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

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

(a) the registration procedure for the earlier trade mark was completed within the period of five years ending with the date of the application for the declaration,

(b) the registration procedure for the earlier trade mark was not completed before that date, or

(c) the use conditions are met.

(2B) The use conditions are met if—

(a) within the period of five years ending with the date of the application for the declaration the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) it has not been so used, but there are proper reasons for non-use.

(2C) For these purposes—

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

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

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

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

.....

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

Provided that this shall not affect transactions past and closed.”

And:

“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, or

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

3. FFL directs its application against all of the goods for which Dairy’s trade mark stands registered. It relies upon the following trade mark registration, which it states has been used in relation to all of the goods upon which it relies as shown below:

Trade mark	No.	Application Date	Registration Date	Goods relied upon:
MINSTREL	1304750	10.3.1987	17.1.1992	29 – Cheese and cheese spreads.

4. In its application FFL said:

“The dominant and distinctive element of [Dairy’s] trade mark is the word MINSTER. Aside from the pictorial representation of a church (or minster), which merely reinforced (sic) the concept of the mark, the other element i.e. the words Mild Cheddar – suitable for vegetarians are descriptive of the goods covered by the registration. The word MINSTER is confusingly similar to [FFL’s trade mark]. These marks are visually, and aurally similar as both marks contain two syllables. The first syllable is identical, MINST, and the second syllables contain the letter E and R. The goods [are identical]. As

cheese is sold as both self-service items and over a deli counter in a retail outlet the aural similarity of the marks is very important. As English speakers tend to slur the endings of words, the differences in the second syllable of the mark, would not be enough to distinguish the marks.”

5. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

“6.-(1) In this Act an “earlier trade mark” means -

(a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) 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,

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

FFL’s registration qualifies as an earlier trade mark under the above provisions.

6. On 10 April 2012, Dairy filed a counterstatement. As these are the only comments I have from Dairy, they are reproduced below in full:

“The trade mark is a combination of the words **minster mild cheddar** and the pictorial representation of the abbey or church. They are used in conjunction with each other and not separately.

The design and layout of the representation of the word **minster** in the trade mark is not similar to the word **minstrel** and would not be confused visually when seen.

The minster label is not sold as a self-service item nor is it sold in a retail pack. It is a one size product sold for slicing and generally would not be displayed in a deli counter with its label. The trade mark minster has been in use for 20 years in an unregistered form by competitors of [FFL].

[FFL] states that slurring will make the words indistinguishable. There is a clear difference in the emphasis on how each word is spoken. The split for emphasis is MIN-STER with STER being a definite syllable and not easy to slur. Similarly [FFL’s trade mark] ends in STREL again a word that will not slur easily.

When taken as a whole [Dairy’s trade mark] is different to [FFL’s trade mark] in representation, is different in font, colour and design, aurally contains an ending that is distinctive and not prone to slurring.”

In addition, Dairy asks FFL to prove that it has used the trade mark upon which it relies. In view of Dairy's request, and as FFL's application for invalidation was filed on 30 January 2012 and its earlier trade mark completed its registration procedure on 17 January 1992, it is necessary, as per section 47(2)(B) above, for FFL to show genuine use of the goods upon which it relies.

7. Only FFL filed evidence and submissions. Neither party asked to be heard nor did they file written submissions in lieu of attendance at a hearing.

EVIDENCE

FFL's evidence

8. This consists of a witness statement, dated 11 June 2012, from Daniel Harper, FFL's Retail Sales Director. Having stated that the trade mark MINSTREL has been in continuous use within the UK in the five year period preceding the application for invalidation, he goes on explain that the MINSTREL trade mark has been used on cheese which is sold to the food service industry.

9. Exhibit DH1 consists of: (i) a page from Totalfoodservice solutions limited's 2010 Provisions Directory, in which the word MINSTREL presented in a stylised script and accompanied by an integrated device element, comprising a silhouette of a minstrel playing a flute presented against a yellow circular background, can be seen in the bottom left hand corner of the page (page 3), and (ii) 2 pages from King Brothers Foodservice Caterers Guide 2011, on the first page of which (page 5) the word MINSTREL (presented in yellow block capital letters against a black background) can be seen on the left hand edge of the packaging of a block of Mature Cheddar cheese; a circular device element similar (but less elaborate) than that mentioned above can also be seen in the centre of the packaging. In the bottom left hand corner of the page the word MINSTREL presented in white block capital letters against a black background appears above a device element similar to that found on the packaging of the cheese. On the second page under the heading "Cheese – Block" there is a reference to "Minstrel Mature Cheddar" priced at £5.15 per kilogram.

10. Mr Harper explains that MINSTREL branded cheese is sold to the general public through retail outlets such as COSTCO. Exhibit DH2 consists of what Mr Harper describes as: "copies of labels used in the packaging of cheese for the self-serve product as well as copies of the packaging used for cheese for over-the-counter cheese products..." All of the labels/packaging provided (which as far as I can tell are undated) relate to cheese of one sort or another and all bear, inter alia, the word MINSTREL and a device presented in a number of formats and, on occasion, integrated with the word MINSTREL. Exhibit DH3 is described by Mr Harper as: "a leaflet advertising the size and type of cheeses available to retailers". The 2 page leaflet (which again appears to be undated) contains a photograph of a block of Mild Cheddar cheese the packaging of which (as does the bottom right hand corner of both pages) bears the stylised version of the word MINSTREL integrated with the more elaborate of the minstrel devices. The leaflet also bears, inter alia, the following

text: “Minstrel Deli Cheese”. Finally, exhibit DH4 consists of 2 invoices issue by FFL to Costco Wholesale UK Limited on 9 December 2007 and 31 August 2008 which contain references all but one of which begin “MIN” and which are followed by, for example, “MAT W CHEDDAR”; I take this reference to mean MINSTREL Mature White Cheddar. It appears that all of the products in the first invoice (value £73,420.01) and all but one in the second invoice (value £58,479.42) are cheese.

Proof of use

11. In reaching a conclusion on this point, I must apply the same factors as I would if I were determining an application for revocation based upon grounds of non-use; the relevant period for present purposes is the five year period ending with the date of FFL’s application for invalidity i.e. 31 January 2007- 30 January 2012.

The authorities on genuine use

12. The leading authorities on the principles to be applied in determining whether there has been genuine use of a trade mark are: *Ansul BV v Ajax Brandbeveiliging BV* [2003] RPC 40 and *Laboratoire de la Mer Trade Mark* [2006] FSR 5. The general principles were summarised by the Appointed Person in *Pasticceria e Confetteria Sant Ambroeus Srl v G & D Restaurant Associates Ltd (Sant Ambroeus Trade Mark)* [2010] RPC 28 as follows:

“(1) Genuine use means actual use of the mark by the proprietor or third party with authority to use the mark: *Ansul*, [35] and [37].

(2) The use must be more than merely “token”, which means in this context that it must not serve solely to preserve the rights conferred by the registration: *Ansul*, [36].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish the goods or services from others which have another origin: *Ansul*, [36]; *Silberquelle*, [17].

(4) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, i.e. exploitation that is aimed at maintaining or creating an outlet for the goods or services or a share in that market: *Ansul*, [37]-[38]; *Silberquelle*, [18].

(a) Example that meets this criterion: preparations to put goods or services on the market, such as advertising campaigns: *Ansul*, [37].

(b) Examples that do not meet this criterion: (i) internal use by the proprietor: *Ansul*, [37]; (ii) the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle*, [20]-[21].

(5) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including in particular, the nature of the goods or services at issue, the characteristics of the market concerned, the scale and frequency of use of the mark, whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them, and the evidence that the proprietor is able to provide: *Ansul*, [38] and [39]; *La Mer*, [22] -[23].

(6) Use of the mark need not always be quantitatively significant for it to be deemed genuine. There is no de minimis rule. Even minimal use may qualify as genuine use if it is the sort of use that is appropriate in the economic sector concerned for preserving or creating market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor: *Ansul*, [39]; *La Mer*, [21], [24] and [25].”

13. I will also keep in mind the guidance in *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32 in relation to determining what constitutes a fair specification, namely:

“29 I have no doubt that Pumfrey J. was correct to reject the approach advocated in the Premier Brands case. His reasoning in paras [22] and [24] of his judgment is correct. Because of s.10(2), fairness to the proprietor does not require a wide specification of goods or services nor the incentive to apply for a general description of goods and services. As Mr Bloch pointed out, to continue to allow a wide specification can impinge unfairly upon the rights of the public. Take, for instance, a registration for "motor vehicles" only used by the proprietor for motor cars. The registration would provide a right against a user of the trade mark for motor bikes under s.10(1). That might be understandable having regard to the similarity of goods. However, the vice of allowing such a wide specification becomes apparent when it is envisaged that the proprietor seeks to enforce his trade mark against use in relation to pedal cycles. His chances of success under s.10(2) would be considerably increased if the specification of goods included both motor cars and motor bicycles. That would be unfair when the only use was in relation to motor cars. In my view the court is required in the words of Jacob J. to "dig deeper". But the crucial question is--how deep?

30 Pumfrey J. was, I believe, correct that the starting point must be for the court to find as a fact what use has been made of the trade mark. The next task is to decide how the goods or services should be described. For example, if the trade mark has only been used in relation to a specific variety of apples, say Cox's Orange Pippins, should the registration be for fruit, apples, eating apples, or Cox's Orange Pippins?

31 Pumfrey J. in *Decon* suggested that the court's task was to arrive at a fair specification of goods having regard to the use made. I agree, but the court still has the difficult task of deciding what is fair. In my view that task should be carried out so as to limit the specification so that it reflects the

circumstances of the particular trade and the way that the public would perceive the use. The court, when deciding whether there is confusion under s.10(2), adopts the attitude of the average reasonably informed consumer of the products. If the test of infringement is to be applied by the court having adopted the attitude of such a person, then I believe it appropriate that the court should do the same when deciding what is the fair way to describe the use that a proprietor has made of his mark. Thus, the court should inform itself of the nature of trade and then decide how the notional consumer would describe such use.”

14. The comments of Mr Justice Jacob (as he then was) in *Animal Trade Mark* [2004] FSR 19 are also relevant and read:

“20 The reason for bringing the public perception in this way is because it is the public which uses and relies upon trade marks. I do not think there is anything technical about this: the consumer is not expected to think in a pedantic way because the average consumer does not do so. In coming to a fair description the notional average consumer must, I think, be taken to know the purpose of the description. Otherwise they might choose something too narrow or too wide. Thus, for instance, if there has only been use for threeholed razor blades imported from Venezuela (Mr T.A. Blanco White's brilliant and memorable example of a narrow specification) "three-holed razor blades imported from Venezuela" is an accurate description of the goods. But it is not one which an average consumer would pick for trade mark purposes. He would surely say "razor blades" or just "razors". Thus the "fair description" is one which would be given in the context of trade mark protection. So one must assume that the average consumer is told that the mark will get absolute protection ("the umbra") for use of the identical mark for any goods coming within his description and protection depending on confusability for a similar mark or the same mark on similar goods ("the penumbra"). A lot depends on the nature of the goods--are they specialist or of a more general, everyday nature? Has there been use for just one specific item or for a range of goods? Are the goods on the High Street? And so on. The whole exercise consists in the end of forming a value judgment as to the appropriate specification having regard to the use which has been made.”

15. Finally, the comments of the Court of First Instance (now the General Court) in *Reckitt Benckiser (Espana), SL v OHIM*, Case T- 126/03 are also relevant where it held that:

“45 It follows from the provisions cited above that, if a trade mark has been registered for a category of goods or services which is sufficiently broad for it to be possible to identify within it a number of sub-categories capable of being viewed independently, proof that the mark has been put to genuine use in relation to a part of those goods or services affords protection, in opposition proceedings, only for the sub-category or subcategories to which the goods or services for which the trade mark has actually been used belong. However, if a trade mark has been registered for goods or services defined so precisely and narrowly that it is not possible to make any significant sub-divisions within the category concerned, then the proof of genuine use of the mark for the

goods or services necessarily covers the entire category for the purposes of the opposition.

46 Although the principle of partial use operates to ensure that trade marks which have not been used for a given category of goods are not rendered unavailable, it must not, however, result in the proprietor of the earlier trade mark being stripped of all protection for goods which, although not strictly identical to those in respect of which he has succeeded in proving genuine use, are not in essence different from them and belong to a single group which cannot be divided other than in an arbitrary manner. The Court observes in that regard that in practice it is impossible for the proprietor of a trade mark to prove that the mark has been used for all conceivable variations of the goods concerned by the registration. Consequently, the concept of „part of the goods or services’ cannot be taken to mean all the commercial variations of similar goods or services but merely goods or services which are sufficiently distinct to constitute coherent categories or sub-categories.”

16. FFL’s unchallenged evidence is that it has used the trade mark the subject of its registration in the five year period preceding its application for invalidation. Its evidence (exhibits DH2 and DH3 of which appear to be undated) indicate that it has used the word MINSTREL presented in both upper case and in a stylised script (but which would still be read and understood as the word MINSTREL), and that for the most part the word MINSTREL is used either integrated with, or in varying degrees of proximity to, a circular device element which depicts a minstrel playing a flute. However, there is also use from 2011 of the word Minstrel in title case without the device element (exhibit DH1 page 6) and in the form “Minstrel Deli Cheese” in the undated leaflet at exhibit DH 3 (page 21). Almost all of the use shown is on cheeses of varying types. Although I have only been provided with two invoices (both to the same customer), they are both dated within the relevant period (2007 and 2008) and amount to some £132,000 (there is, of course, no de minimis rule). While FFL’s evidence is far from perfect, when considered as a totality, and in the absence of any challenge from Dairy, I am prepared (just) to accept that within the relevant period FFL have made genuine use of its MINSTREL trade mark and that this use has been in relation to cheese. Although in its pleadings FFL claim use on cheese and cheese spreads, there is, as far as I can tell, no evidence showing the trade mark used on cheese spreads. Regardless, as the average consumer would, in my view, describe FFL’s use as being in relation to cheese, cheese represents a fair specification, and it is on this basis I shall conduct my further comparison.

Section 5(2)(b) – case law

17. In his decision in *La Chemise Lacoste SA v Baker Street Clothing Ltd* -BL O/330/10 (approved by Arnold J in *Och-Ziff Management Europe Ltd v Och Capital LLP* [2011] FSR 11), the Appointed Person, Mr Geoffrey Hobbs QC, expressed the test under this section (by reference to the CJEU cases mentioned) on the basis indicated below:

The CJEU cases

Sabel BV v Puma AG [1998] RPC 199; Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc [1999] RPC 117; Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V. [2000] F.S.R. 77; Marca Mode CV v Adidas AG & Adidas Benelux BV [2000] E.T.M.R. 723; Matratzen Concord GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), Case T-6/01; Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH C-120/04; Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) C-334/05 P.

The principles

“(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, 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, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may, in certain circumstances, be dominated by one or more of its components;

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) 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;

(k) if the association between the marks causes the public to wrongly believe that the respective goods [or services] come from the same or economically-linked undertakings, there is a likelihood of confusion.”

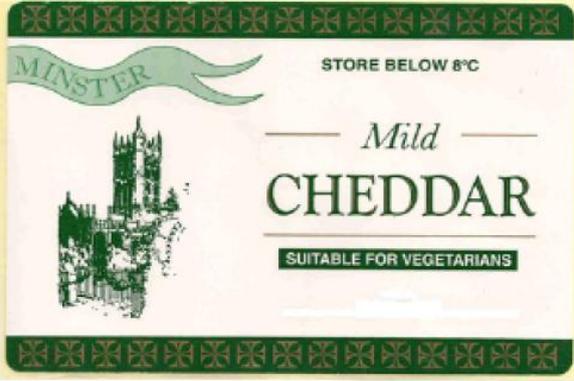
The average consumer and the nature of the purchasing process

18. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods and then to determine the manner in which these goods will be selected by the average consumer in the course of trade. The average consumer of cheese is the general public. As to how the goods will be selected, I agree with FFL that cheese will be bought by the eye from, for example, the fridge in a supermarket or by oral means by asking for the cheese by name at, for example, a delicatessen counter. Although there is no evidence on the point, my own experience suggests that while self-selection from a fridge in a retail setting may be the more popular method by which cheese is selected, aural considerations (in the context mentioned above) will also, I think, play a part in the selection process. Although the selection of cheese is a relatively frequent, inexpensive purchase, as it is a product for which the average consumer is likely to have a preference i.e. for a particular type and strength of cheese, the average consumer will, in my view, pay a reasonable degree of attention to their selection.

Comparison of goods

19. As I have concluded that FFL has made genuine use of its MINSTREL trade mark in relation to cheese, and as Dairy's specification refers to a cheese product, the competing goods are identical.

Comparison of trade marks

Dairy's trade mark	FFL's trade mark
	MINSTREL

20. The average consumer is considered to be reasonably well informed, circumspect and observant but perceives trade marks as wholes and does not pause to analyse their various details. In addition, he rarely has the chance to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has kept in his mind. In reaching a conclusion on similarity, I must identify what I consider to be the distinctive and dominant components of the respective trade marks and, with that conclusion in mind, I must then go on and compare the respective trade marks from the visual, aural and conceptual perspectives.

Distinctive and dominant components

21. FFL's trade mark consists of the word MINSTREL presented in upper case. As the word MINSTREL (meaning "a medieval wandering musician who performed songs or recited poetry with instrumental accompaniment" (*Collins English Dictionary 2000* refers)), is likely to be known to the average consumer, as no part of the trade mark is highlighted or emphasised in any way, and because as far as I am aware it is neither descriptive of nor non-distinctive for cheese, there are no distinctive and dominant components, the distinctiveness lies in the trade mark as a whole.

22. Dairy's trade mark consists of a number of elements. In its submissions FFL said:

"The descriptive words Mild CHEDDAR SUITABLE FOR VEGETARIANS and the directional words STORE BELOW 8°C are common to packaging in the cheese industry and would not be seen by the average consumer as being an indication of the origin of the goods.

The picture of the church and the border of cross pattée simply reinforce the conceptual identity of the registration and lend support to the dominant and distinctive element of the registration which is the word MINSTER."

23. I agree that the average consumer would regard the text identified by FFL above as purely descriptive. In my view, the border at the top and bottom of the trade mark (described by FFL as cross pattée) is, in the context of the trade mark as a whole, likely to go largely unnoticed by the average and even if it is noticed it is unlikely to be given any trade mark significance. That leaves the device of (what the parties agree) is a church, the word MINSTER and what I take to be a pennant upon which the word MINSTER appears. In my view, the pennant element simply provides a background for the word MINSTER and would not convey a trade origin message. As far as I am aware, the word MINSTER and the device of a church are neither descriptive of nor non-distinctive for cheese; by virtue of both their size and positioning and because the other elements in Dairy's trade mark are either descriptive or de minimis, they are the distinctive and dominant components of Dairy's trade mark. In addition, as the word MINSTER (meaning "any of certain cathedrals and large churches, usually originally connected to a monastery" (*Collins English Dictionary 2000* refers)), is one which is likely to be known to the average consumer, I agree with FFL that the word MINSTER and the device of a church are likely to evoke the same image in the average consumer's mind.

24. I will now approach the visual, aural and conceptual comparison with these conclusions in mind.

Visual similarity

25. Although Dairy's trade mark is presented in colour, as FFL's trade mark is presented in black and white this does not, for the reasons given by Mann J in *Specsavers International Healthcare Ltd v Asda Stores Ltd* (No. 2) [2011] FSR 1, assist in distinguishing the competing trade marks. When one compares the distinctive and dominant components of Dairy's trade mark with the word MINSTREL, one notes that the word component of Dairy's trade mark contains seven letters whereas FFL's trade mark contains eight. The first five letters are the same i.e. MINST; while the respective endings differ i.e. ER v REL, both endings share two of the same letters albeit in a different order. The device of a church in Dairy's trade mark has no counterpart in FFL's trade mark. Considered overall, there is, in my view, a low degree of visual similarity.

Aural similarity

26. It is well established that where words appear in a composite trade mark, the average consumer will refer to the trade mark by the word elements. In my view, Dairy's trade mark will be referred to by the average consumer as the two syllable word MIN-STER whereas FFL's trade mark will be referred to as the two syllable word MIN-STREL. The aural similarity created by both the identical first syllable and the same first two letters of the second syllable, results, overall, in a fairly high degree of aural similarity between the competing trade marks.

Conceptual similarity

27. I have already touched on the conceptual position in paragraph 23 above. The fact that (broadly speaking) Dairy's trade mark will create an image of a church in the mind of the average consumer whereas FFL's trade mark will evoke an image of a medieval musician, means that the trade marks are conceptually different.

Distinctive character of FFL's earlier trade mark

28. I must now assess the distinctive character of FFL's trade mark. The distinctive character of a trade mark can be appraised only, first, by reference to the goods for which it is registered and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods for which it has been registered as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

29. Although a dictionary word, as the word MINSTREL neither describes nor is non-distinctive for cheese, it is, absent use, a trade mark possessed of a fairly high degree of inherent distinctive character. Although FFL's evidence was (just)

sufficient for it to establish genuine use in relation to cheese, given the inevitable size of the market in the UK for cheese, the evidence provided by FFL falls a long way short of establishing that the use it has made of its MINSTREL trade mark has built upon its inherent characteristics to any significant extent.

Likelihood of confusion

30. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. As I mentioned above, it is also necessary for me to factor in the distinctive character of FFL's trade mark as the more distinctive this trade mark is the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods, the nature of the purchasing process and that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind. Earlier in this decision I concluded that:

- FFL has made genuine use of its MINSTREL trade mark on cheese;
- the average consumer of the goods at issue is a member of the general public who would select the goods by both visual and oral means and will pay a reasonable degree of attention when doing so;
- the competing goods are identical;
- the distinctiveness of FFL's trade mark lies in the trade mark as a whole;
- the word MINSTER and the device of a church are the distinctive and dominant components of Dairy's trade mark;
- there is a low degree of visual similarity, a fairly high degree of aural similarity and the competing trade marks are conceptually different;
- FFL's trade mark is possessed a fairly high degree of inherent distinctive character. The evidence provided does not demonstrate that this distinctive character has been increased to any significant extent.

31. In its submissions, FFL drew my attention to the comments of the CJEU in *Medion AG v Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, in which the court said:

“29. In the context of consideration of the likelihood of confusion, assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark. On the contrary, the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain

circumstances, be dominated by one or more of its components (see *Matratzen Concord*, paragraph 32).

30. However, beyond the usual case where the average consumer perceives a mark as a whole, and notwithstanding that the overall impression may be dominated by one or more components of a composite mark, it is quite possible that in a particular case an earlier mark used by a third party in a composite sign including the name of the company of the third party still has an independent distinctive role in the composite sign, without necessarily constituting the dominant element.

31. In such a case the overall impression produced by the composite sign may lead the public to believe that the goods or services at issue derive, at the very least, from companies which are linked economically, in which case the likelihood of confusion must be held to be established.

32. The finding that there is a likelihood of confusion should not be subject to the condition that the overall impression produced by the composite sign be dominated by the part of it which is represented by the earlier mark.

33. If such a condition were imposed, the owner of the earlier mark would be deprived of the exclusive right conferred by Article 5(1) of the directive even where the mark retained an independent distinctive role in the composite sign but that role was not dominant.

34. This would be the case where, for example, the owner of a widely-known mark makes use of a composite sign juxtaposing this mark and an earlier mark which is not itself widely known. It would also be the case if the composite sign was made up of the earlier mark and a widely-known commercial name. In fact, the overall impression would be, most often, dominated by the widely-known mark or commercial name included in the composite sign.

35. Thus, contrary to the intention of the Community legislator expressed in the 10th recital in the preamble to the directive, the guarantee of the earlier mark as an indication of origin would not be assured, even though it still had an independent distinctive role in the composite sign.”

32. In its submissions FFL also said:

“The word MINSTER has “an independent distinctive role” within [Dairy’s] trade mark”.

33. I agree with FFL that the word MINSTER plays an independent distinctive role in Dairy’s trade mark. In reaching a conclusion on the likelihood of confusion, I note that in *The Picasso Estate v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* (OHIM) – Case C-361/04, the CJEU said:

“20. By stating in paragraph 56 of the judgment under appeal that, where the meaning of at least one of the two signs at issue is clear and specific so that it

can be grasped immediately by the relevant public, the conceptual differences observed between those signs may counteract the visual and phonetic similarities between them, and by subsequently holding that that applies in the present case, the Court of First Instance did not in any way err in law.”

34. However, I also note that in *Nokia Oyj, v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* – Case T-460/07 the GC said:

“66. Furthermore, it must be recalled that, in this case, although there is a real conceptual difference between the signs, it cannot be regarded as making it possible to neutralise the visual and aural similarities previously established (see, to that effect, Case C-16/06 P *Éditions Albert René* [2008] ECR I-0000, paragraph 98).”

35. Having considered the degree of visual and aural similarity between the competing trade marks, the identity in the goods, the reasonable degree of care the average consumer will take when selecting cheese and the concept of imperfect recollection, I am satisfied that the very different conceptual messages the competing trade marks will send to the average consumer are, in the circumstances of this case, (to use the words of the court) sufficient “to neutralise the visual and aural similarities” between the competing trade marks; **FFL’s application for invalidation fails accordingly**. In reaching that conclusion, it has not been necessary for me to deal with the fact that in its counterstatement Dairy said that the trade mark minster had been in use for over 20 years. As Dairy did not file any evidence in support of this assertion, this is not a factor I could have taken into account in any event.

Conclusion

36. As a consequence of my decision above, FFL’s request to invalidate Dairy’s trade mark fails.

Costs

37. Dairy has been successful and is entitled to a contribution towards the cost of the time it has spent on these proceedings. The Registrar usually operates on a published scale of costs. However, since Dairy has not been professionally represented during the proceedings, an award made from the published scale might be larger than its actual expenditure. In BL O/160/08 *South Beck*, Mr Richard Arnold QC, sitting as the appointed person, stated:

“32. Secondly, counsel for the opponent submitted that, if CPR r. 48.6 was applicable, the hearing officer had misapplied it. In support of this submission he pointed out that CPR r. 48.6(4) provides:

The amount of costs to be allowed to the litigant in person for any item of work claimed shall be-

(a) where the litigant can prove financial loss, the amount that he can prove he has lost for time reasonably spent on doing the work; or

(b) where the litigant cannot prove financial loss, an amount for the time reasonably spent on doing the work at the rate set out in the practice direction.

The Part 48 Practice Direction provides at paragraph 52.4 that the amount which may be allowed to a litigant in person under rule 46.8(4) is £9.25 per hour. Counsel submitted that the hearing officer appeared to have awarded the applicant two-thirds of the scale figure which he would have awarded a represented party, and that this could not be justified since the opponent had not proved any financial loss and was very unlikely to have spent over 160 hours on the matter.....

36. In my judgment the approach which should be adopted when the Registrar is asked to make an award of costs in favour of a litigant in person is as follows. The hearing officer should direct the litigant in person pursuant to r. 57 of the 2000 Rules to file a brief schedule or statement setting out (i) any disbursements which the litigant claimed he has incurred, (ii) any other financial losses claimed by the litigant and (iii) a statement of the time spent by the litigant in dealing with the proceedings. The hearing officer should then make an assessment of the costs to be awarded applying by analogy the principles applicable under r. 48.6, but with a fairly broad brush. The objective should be to ensure that litigants in person are neither disadvantaged nor overcompensated by comparison with professionally represented litigants.”

Under the current practice direction, the amount allowed to a litigant in person is £18 per hour.

38. Consequently, Dairy should produce an estimate of its costs, including the number of hours spent on these proceedings, broken down by category of activity, i.e. reviewing the application for invalidation, completing its counterstatement and reviewing FFL’s evidence. **This estimate should be filed within 21 days of the date of this decision and should be copied to FFL who will have 14 days from receipt of the estimate to provide written submissions.** I will then issue a supplementary decision covering the costs of these proceedings.

39. The period for any appeal against this decision will run concurrently with the appeal period for the supplementary decision on costs and so will not commence until the supplementary decision is issued.

Dated this 26th day of November 2012

**C J BOWEN
For the Registrar
The Comptroller-General**