

TRADE MARKS ACT 1994
IN THE MATTER OF APPLICATION No 2038519
BY ROBERT WISEMAN & SONS LIMITED
TO REGISTER A SERIES OF TWO TRADE MARKS IN CLASSES 29 & 39

AND IN THE MATTER OF OPPOSITION THERETO
UNDER NUMBER 45674
BY FERRERO SpA & SOREMARTEC SA

BACKGROUND

1) On 27 September 1995, Robert Wiseman & Sons Limited of 159 Glasgow Road, East Kilbride, Glasgow, G74 4PA applied under the Trade Marks Act 1994 for registration of the following series of two trade marks:



2) In respect of the following goods:

In Class 29: "Milk, milk beverages, milk products; dairy products; yoghurt; cream; edible oils and edible fats; butter".

And

In Class 39: "Collection and delivery of goods, milk, milk beverages and milk products".

3) On the 8 October 1996 Ferrero SpA of Via Maria Cristina 41, 10025 Pino Torinese, Torino, Italy and Soremartec SA of Dreve de l'Arc-en-ciel 102, 6700 Schoppach-Arlon, Belgium filed joint notice of opposition to the application. The grounds of opposition, are in summary:

a) The opponents are the proprietors of five registrations (detailed at Annex A) and through substantial use of these marks have acquired reputation in goods sold under these marks.

b) The mark applied for is devoid of any distinctive character and is therefore contrary to Section 3(1) of the Trade Marks Act 1994.

c) Use of the trade mark applied for is prohibited in the UK and so offends against Section 3(4) of the Act.

d) The mark applied for is not the mark of the applicant and so offends against Section 3(6) of the Act.

d) The mark applied for is similar to those of the opponents and so offends against Sections 3(3), 5(2), 5(3) & 5(4) of the Act.

4) The opponents further requested that the Registrar refuse application number 2038519 in the exercise of her discretion. However, under the Trade Marks Act 1994 the Registrar does not have a discretion to refuse an application as she did under the old law. An application can only be refused if it fails to comply with the requirements of the Act and Rules in one or more respects

5) The applicant subsequently filed a counterstatement denying the opponents claims and claiming that they have used their mark for almost fifteen years prior to seeking a registration.

6) Both sides filed evidence in these proceedings. Both sides ask for an award of costs. The matter came to be heard on 7 September 2001 when the applicant was represented by Dr Vitoria of Queens Counsel instructed by Messrs Fitzpatrick's and the opponents by Mr Edenborough of Counsel instructed by Messrs Taylor Joynson Garrett.

OPPONENTS' EVIDENCE

7) The opponents filed a declaration, dated 30 April 1997, by Vivienne Wooll the Manager External Affairs of Ferrero UK Limited, a member company of the Ferrero Group of which Ferrero SpA and Soremartec SA are also members.

8) Ms Wooll states that the opponents utilise a logo which is featured in the five registrations shown at Annex A. The logo is shown at exhibit VW1 and is reproduced below for ease of reference.



9) Ms Wooll states that there have been substantial sales in the UK of products bearing the logo since 1967. At exhibit VW3 she provides figures for sales bearing the logo as follows:

Year	Kinder Surprise Net Revenue £	Kinder Chocolate Net Revenue £	Kinder Maxi Net Revenue £	Kinder Bueno Net Revenue £
1991 / 92	5,437,866	180,736	80,356	964,261
1992 / 93	17,431,869	285,457	183,654	833,688

1993 / 94	11,176,706	244,685	1,625	643,858
1994 / 95	12,384,175	94,743	0	247,829

10) Ms Wooll states that the products have been promoted in the UK via advertisements in newspapers and magazines such as *The Grocer*, *Super Marketing* and *Independent Grocer* and also by television advertisements. Figures for promotion on KINDER CHOCOLATE goods in the UK are provided as follows:

Year	Expenditure
1991 / 92	52,101
1992 / 93	-
1993 / 94	9,333
1994 / 95	128,750

11) It is not stated whether these figures relate to expenditure in UK£.

12) Ms Wooll states that “goods bearing the logo the subject of the application have been advertised and sold throughout Great Britain and Northern Ireland”. She lists principal towns and cities covering the whole of the UK. She also states that:

“I verily believe that the logo the subject of the above application is recognised throughout the trade as indicating the goods of the opponent”

APPLICANT’S EVIDENCE

13) The applicant filed one declaration, dated 22 July 1997, by William G Keane the Secretary and Finance Director of Robert Wiseman Diaries Plc. Mr Keane states that the applicant company is a wholly owned subsidiary of Robert Wiseman Diaries Plc.

14) Mr Keane states that the applicant is also the proprietor of other similar registered trade marks. A detailed list is provided at Annex B. He states that these marks have been in continuous use in the UK “for many years”. At exhibit WGK2 he supplies items of packaging, labels and also brochures all of which show use of the marks at annex B. Only one item, a brochure, shows any dates. There is a reference to the sales in the years to March 1991 and also 1992.

15) Mr Keane supplies turnover figures as follows:

Year	Turnover £
1992	39,000,000
1993	46,036,000

1994	59,743,000
1995	107,935,000

16) Mr Keane states that the applicant has used their trade marks extensively in the UK and that its reputation is “especially established because of the very distinctive livery of the applicant’s transport fleet and the heavy promotion of its distinctive corporate identity”. He continues:

“The applicant’s transport services include the local collection of milk from farms as well as delivery, distribution and transport of the full range of the applicant’s products to numerous retailers, diverse customers, major supermarkets as well as to the ordinary household. ”

17) Mr Keane states that the applicant’s products and services are also promoted by advertising. At exhibit WGK3 he provides three press articles from 1993 - June 1995 which show pictures of the applicant’s mark on vehicles.

18) Mr Keane also comments on the opponents’ evidence. He points out that the opponents do not provide examples of use of the logo, or examples of advertisements. Regarding the sales figures he states that it is not possible to establish whether the sales are of goods bearing the logo, or how the goods are sold.

OPPONENTS’ EVIDENCE IN REPLY

19) The opponents filed another declaration by Ms Wooll. This evidence was challenged by the applicant as it was contended that much was not strictly evidence in reply. At an interlocutory hearing this view was upheld by the Registry and much of the evidence was struck out. I will therefore only refer to that which was deemed acceptable.

20) Ms Wooll states that the application and logo referred to at paragraph 12 above was the opposed application number 2038519.

21) Ms Wooll comments that the applicant has not provided evidence of use of the mark in suit which is different to the applicant’s earlier marks. Also that the turnover figures do not show which goods and/or services they relate to. Similarly the press articles do not show the mark in suit and there is no evidence to back up the claims regarding reputation.

22) That concludes my review of the evidence. I now turn to the decision.

DECISION

23) At the hearing Mr Edenborough stated that although the opponents were not withdrawing any grounds of opposition he would only be referring to the grounds under Sections 3(1) and 5(2). As the opponents have not made out a case for the grounds of opposition under

Sections 3(3), 3(4), 3(6), 5(3) & 5(4) I dismiss these grounds.

24) I first consider the grounds of opposition under Section 1(1) and 3(1) of the Act.

25) Section 1(1) of the Act is in the following terms:

“1 (1) In this Act a “trade mark” means any sign capable of being represented graphically which is capable of distinguishing goods or services of one undertaking from those of other undertakings”.

“A trade mark may, in particular, consist of words (including personal names), designs, letters, numerals or the shape of goods or their packaging.”

26) Section 3(1) of the Act is in the following terms:

3 (1) The following shall not be registered -

(a) signs which do not satisfy the requirements of section 1(1),

(b) trade marks which are devoid of any distinctive character,

(c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,

(d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade.

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.

27) The objection relates to the inherent capacity of the mark to distinguish the applicant's goods. The question is whether the mark in suit is descriptive of the animal from which the goods specified originate. In considering this question I have regard to the comments of Aldous L.J. in *Philips Electronics NV v. Remington Consumer Products Ltd* [1999 RPC 809 at 818]:

“The more the trade mark describes the goods, whether it consists of a word or shape, the less likely it will be capable of distinguishing those goods from similar goods of another trader. An example of a trade mark which is capable of distinguishing is WELDMESH, whereas WELDED MESH would not be. The former, despite its primary descriptive meaning, has sufficient capricious alteration to enable it to acquire a secondary meaning, thereby demonstrating that it is capable of distinguishing. The latter has no such alteration. Whatever the extent of use, whether or not it be

monopoly use and whether or not there is evidence that the trade and public associate it with one person, it retains its primary meaning, namely mesh that is welded. It does not have any feature which renders it capable of distinguishing one trader's mesh from another trader's welded mesh."

28) I also have regard to the comments of Morritt L.J. in the *Bach and Bach Flower Remedies Trade Marks* case [2000 RPC 513 at page 526 line 10]:

"The question is whether or not the word BACH had, by 1979, acquired such a meaning so as to be incapable, without more, of affording the requisite distinction. If it had then section 1(1) is not satisfied, the word BACH cannot be a capricious addition so that registration of the sign would be in breach of paragraph (a); if it had not then the word BACH is an addition to the words FLOWER REMEDIES which is 'capricious' because it is not purely descriptive, so that both the expression BACH FLOWER REMEDIES and the word BACH are capable of affording the necessary distinction. Accordingly I accept the submission that it is both permissible and necessary in considering the application of paragraph (a) to determine the meaning of the word as used at the time of the application for registration. I do not understand Aldous L.J. in *Philips v. Remington* in the passage I have quoted, to have been considering the relevance of use to the meaning of the word."

"The usage in question must be by those engaged in the relevant trade or activity. Normally that will be the usage of the average consumer of the goods in question as described in *Lloyd Schuhfabrik* [European Court of Justice, *Lloyd Schuhfabrik Meyer v. Klijsen Handel BV* 1999 ETMR 690]. Obviously the evidence on that question is not limited to those who are consumers or end-users but may extend to others concerned in the trade such as manufacturers, wholesalers and retailers."

29) Mr Edenborough contended that:

- a) the applicant was primarily involved in the collection, transportation and sale of liquid milk.
- b) The mark in suit was designed to allude to a Friesian cow and therefore by connection to the product of a Friesian cow, namely milk.
- c) The mark was filed in black and white in order to evoke such imagery in the minds of the consuming public.
- d) As a result of a-c the mark in suit offends against Section 3(1)

30) Mr Edenborough referred me to the applicant's evidence which shows road tankers painted in "Friesian livery". However, this is not use of the mark sought to be registered but use of other registered marks which (broadly) have panels of black at the top and bottom separated by a panel of white (see annex B).

31) The applicant is seeking to register a panel divided almost in half by a wavy line. The top half of the panel is coloured black the bottom half white. The mark may cause the average consumer to equate this mark with the skin of a Friesian cow, it then requires the consumer to

conjure up an image of the whole animal. From this point the connection then has to be made with the product. In my opinion the average consumer will not analyse the mark to this extent. The mark merely alludes to the hide of a Friesian cow, it does not depict the animal. I do not consider the mark to be devoid of distinctive character, nor do I consider that it serves in trade to designate the kind, quality, value, or any other characteristic of the goods. Nor has any evidence been provided that the mark is a sign which is commonly used in the trade. The opposition under Section 3(1) fails.

32) The next ground of opposition is under Section 5(2)(b) of the Act which states:-

*5.- (2) A trade mark shall not be registered if because -
(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 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.”

33) An earlier right is defined in Section 6, 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 which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

(b)...

(c) a trade mark which, at the date of application for registration of the trade mark in question or (where appropriate) of the priority claimed in respect of the application, was entitled to protection under the Paris Convention as a well known trade mark.”

34) In determining the question under section 5(2), I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel Bv v Puma AG* [1998 RPC 199], *Canon Kabushiki Kaisha v Metro-Goldwyn-Meyer Inc.* [1999] E.T.M.R. 1, *Lloyd Schfabrik 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* page 224;

(b) the matter must be judged through the eyes of the average consumer, of the goods / services in question; *Sabel Bv v Puma AG* page 224, 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 Schfabrik Meyer & Co. GmbH v Klijsen Handel B.V.* page 84, 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* page 224;

(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* page 224;

(e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v Metro-Goldwyn-Meyer Inc.* page 7 paragraph 17;

(f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either *per se* or because of the use that has been made of it; *Sabel Bv v Puma AG* page 8, paragraph 24;

(g) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel Bv v Puma AG* page 224;

(h) further, the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense; *Marca Mode CV v Adidas AG* page 732, paragraph 41;

(i) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v Metro-Goldwyn-Meyer Inc.* page 9, paragraph 29.

35) As is clear from Annex A to this decision the opponents are relying on a number of registrations. It was claimed in the statement of grounds that each of the marks contained the device shown at paragraph 8 above. It appears to me that the device does not appear in all of the marks shown at Annex A. At best they all have a wavy line in them. At the hearing Mr Edenborough accepted it was not clear if the device was exactly the same. However, he felt that if they were all slightly different then “that is in essence showing that there is a range of slightly wavy marks that could be confused, one with the other. If you take those, then what is the difference between those and the mark that forms the subject of the application. That is in essence the reason why, or illustrative of the fact that there could be a likelihood of confusion between one and the other”.

36) When considering the opponents’ marks at annex A I would describe them as “busy” marks. Most contain the name of the company and a product name. One has a human figure, whilst two have cartoon animals upon them. They also have a depiction of the product itself or the ingredients contained within the product. I accept that they all have a wavy line dividing a lower black portion from an upper white portion. The ratio of these sections differs somewhat but the lower portion covers on average less than 25% of the mark. In my view the average consumer will not analyse the mark and break down its constituent parts in this manner. I do not consider the marks to be similar.

37) The opponents’ marks are registered, broadly speaking, for chocolate products in class 30. The applicant seeks registration for milk and dairy products in class 29 and the collection and transportation of such goods in class 39. The products are not similar.

38) With all of this in mind I come to the conclusion that when all factors are considered, that there was no realistic likelihood of confusion at 27 September 1995. Consequently, the opposition under Section 5(2)(b) fails.

39) The opposition having failed the applicant is entitled to a contribution towards costs. Dr Vittoria sought damages over and above the normal registry scale as the opponents did not pursue at the hearing a number of the grounds originally pleaded. I was referred to the Registry practice note TPN2 [2000] RPC 598 and Rizla Ltd's Application [1993] RPC 365. The opponents case was said to be "frivolous and was begun or maintained by the opponents without a genuine belief that there was an issue to be tried as can be seen by the lack of care which went into the preparation of Ms Wooll's evidence and from the total absence of admissible or cogent evidence".

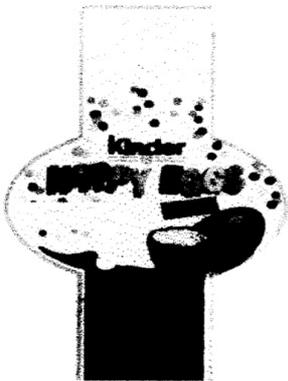
40) For the opponent Mr Edenborough pointed out that the opposition began prior to the Practice direction and that extensive negotiations had been undertaken and were curtailed by the applicant's request for a hearing.

41) I do not believe that the opposition was either frivolous or vexatious, although clearly there was a lack of care in the evidence provided by the opponents. I therefore do not propose to go outside the Registry scale of costs. I order the opponents to pay the applicant the sum of £1535. This sum 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 06 day of November 2001

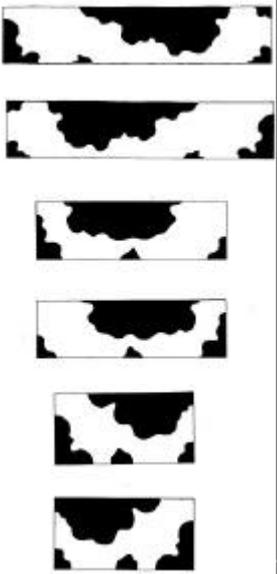
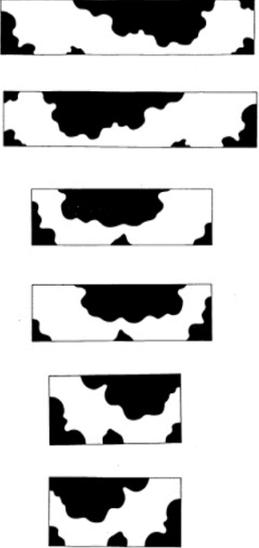
George W Salthouse
For the Registrar
The Comptroller General

ANNEX A

Mark	Number	Effective Date	Class	Specification
	1525450	1.2.93	30	Chocolate and chocolate products; all included in Class 30.
	1529878	16.3.93	30	Cold pastry products with filling comprising milk, cocoa and/or other ingredients enrobed with chocolate or chocolate flavoured with or without granulated covering; all included in Class 30.
	1561631	8.2.94	30	Chocolate, chocolate products and confectionery; all being shaped in an egg form and all with a creamy filling; all included in Class 30.

	1569173	19.4.94	30	Products consisting of hazelnut milky filling surrounded by wafer and coated with chocolate.
	1390446	5.7.89	30	Milk chocolate bars; all included in Class 30.

ANNEX B

Mark	Number	Effective Date	Class	Specification
	1511963	3.9.92	39	The delivery of goods and transport of goods by road; all included in Class 39
	1511962	3.9.92	29	Milk, milk beverages and milk products; all included in Class 29.

