

O-489-18

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3238597
BY STAR CATERING SUPPLIES LTD
TO REGISTER AS A TRADE MARK:**



AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 410387
BY STAR STABILIMENTO ALIMENTARE S.P.A.**

Background and pleadings

1. On 21 June 2017, Star Catering Supplies Ltd (“the applicant”) applied to register the

trade mark  for the following goods and services:

- Class 16 Paper and cardboard; printed matter; bookbinding material; photographs; stationery and office requisites, except furniture; adhesives for stationery or household purposes; artists’ and drawing materials; paintbrushes; instructional and teaching materials; plastic sheets, films and bags for wrapping and packaging; printers’ type, printing blocks.
- Class 29 Meat, fish, poultry and game; meat extracts; preserved, frozen, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs; milk and milk products; edible oils and fats.
- Class 30 Coffee, tea, cocoa and artificial coffee; rice; tapioca and sago; flour and preparations made from cereals; bread, pastries and confectionery; edible ices; sugar, honey, treacle; yeast, baking-powder; salt; mustard; vinegar, sauces(condiments); spices; ice.
- Class 31 Raw and unprocessed agricultural, aquacultural, horticultural and forestry products; raw and unprocessed grains and seeds; fresh fruits and vegetables, fresh herbs; natural plants and flowers; bulbs, seedlings and seeds for planting; live animals; foodstuffs and beverages for animals; malt.
- Class 32 Beers; mineral and aerated waters and other non-alcoholic beverages; fruit beverages and fruit juices; syrups and other preparations for making beverages.

Class 39 Transport; packaging and storage of goods; travel arrangement.

Class 43 Services for providing food and drink; temporary accommodation.

2. The application was published for opposition purposes on 30 June 2017. It is opposed by Star Stabilimento Alimentare S.p.A. (“the opponent”). The opposition is brought under sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 (“the Act”) and is directed against all of the goods and services in the application. Under both of these grounds, the opponent relies upon its UK trade mark registration number 1148182 for the trade mark **STAR**, which the register shows as having a filing and registration date of 5 February 1981. The mark is registered for the following goods, all of which are relied upon under both grounds:

Class 29 Tunny (not live) other than for animals; beans, peas, chick peas and lentils, all being preserved, dried or cooked; mayonnaise, tripe for food for human consumption, chicken paste, stock cubes (meat extracts), bolognese (for food), tomato paste, processed canned foodstuffs and puddings, all included in Class 29.

Class 30 Dried tortellini; tomato ketchup, creme caramels, cocoa, sauces, cannelloni, ravioli, pizzas, processed canned foodstuffs, puddings and vanilla preparations for making polenta, all included in Class 30.

Class 32 Preparations included in Class 32 for making table waters.

3. The opponent claims under s. 5(2)(b) that there is a likelihood of confusion, including the likelihood of association, because of the similarity between the marks and the goods and services. Under s. 5(3), the opponent claims that it has a reputation for all of the goods for which its trade mark is registered and that the relevant public would think there is an economic connection between the users of the marks, leading to unfair advantage and damage to the earlier mark’s reputation.

4. Given its date of filing, the above mark qualifies as an earlier mark in accordance with s. 6 of the Act. In its notice of opposition, the opponent states that it has used its trade mark in relation to all of the goods for which the mark is registered. This statement is made because the earlier mark is subject to the proof of use provisions contained in s. 6A of the Act.

5. The applicant filed a counterstatement denying both grounds of opposition. In particular, it denies that there is any identity or similarity between the marks, or between the goods and services. It put the opponent to strict proof of its claims under both ss. 5(2)(b) and 5(3) and requested that the opponent provide proof of use of its mark for all of the goods relied upon.

6. Only the opponent filed evidence, although the applicant filed written submissions during the evidence rounds. The matter came to be heard before me on 27 July 2018, by telephone conference, at which the applicant was represented by Allan Poulter of Bird & Bird LLP. The opponent chose not to attend the hearing and relies on the papers already filed. I will keep them in mind. The opponent has been represented throughout by Urquhart-Dykes & Lord LLP.

Evidence

7. The opponent's evidence is provided by Eduard Mesegué Bonet, with four exhibits. Mr Bonet has been Legal Department Director for the opponent since 2000.

8. Mr Bonet explains that the opponent was founded in 1948 and that it has since then produced a range of food products sold under the earlier mark. His evidence includes prints from the opponent's website, www.star.it.¹ The prints are not dated, though they support Mr Bonet's assertion that the opponent has traded, at least in Italy, since 1948, producing a range of goods including stocks, sauces and tinned tomatoes. Notwithstanding Mr Bonet's indication that the opponent has sold products in the UK

¹ Exhibit 1.

since at least 2008, the UK is not listed among the countries where the group of companies to which the opponent belongs is said to have an interest “today”.² “STAR” is visible in word form and as reproduced below:



9. Further prints from the opponent’s website are included at exhibit 2. The goods shown include stock cubes (e.g. vegetable, mushroom and “classico”), sauces (e.g. pesto, tomato and Bolognese) and pizza, as well as chopped tomatoes, passata and tomato purée. The mark appears in word form and in the figurative form shown above. However, the evidence bears a copyright date of 2018 (pp. 18, 49), i.e. after the relevant period.

10. Mr Bonet exhibits what he describes as “a small selection” of invoices to UK companies.³ There are four invoices, two of which are dated within the relevant period (March 2016 and October 2015). The figurative mark appears at the top of all the invoices. Notwithstanding that only certain parts of the invoices are in English, the first totals over €9,000 and shows stock cubes (vegetable and seafood flavours), along with two types of pesto. 295 ‘units’, amounting to 2,742 ‘pieces’ (which I assume to be jars in this case) of the pesto are recorded, which accounts for around €5,000 of the invoice total. The second invoice is for mushroom stock cubes and totals over €2000. One of the invoices outside the relevant period (January 2018) is also in respect of pesto sauces.

11. The final exhibit shows the opponent’s goods on sale via UK companies.⁴ Two types of tinned sauce are shown (although one is out of stock), as well as mushroom stock

² §4 and Exhibit 1, p. 10.

³ Exhibit 3.

⁴ Exhibit 4.

cubes, all bearing the figurative mark, reproduced at paragraph 8, above.⁵ The exhibit is not dated.

Proof of use

12. The first matter to be determined is whether, or to what extent, the opponent has shown genuine use of its mark for the goods relied upon. Under s. 6A, the relevant period is the five-year period ending on the date of publication of the opposed mark. Consequently, the relevant period is 1 July 2012 to 30 June 2017.

Legislation and case law

13. The relevant statutory provisions and leading case law are as follows:

“Raising of relative grounds in opposition proceedings in case of non-use

6A- (1) This section applies where -

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

⁵ pp. 59-62.

(3) The use conditions are met if –

(a) within the period of five years ending with the date of publication of the application 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) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) 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, and

(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.

(5) In relation to a Community trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

(6) 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”.

14. Section 100 of the Act is also relevant, which reads:

“100. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it”.

15. In *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*, [2016] EWHC 52, Arnold J. summarised the case law on genuine use of trade marks. He said:

“219. I would now summarise the principles for the assessment of whether there has been genuine use of a trade mark established by the case law of the Court of Justice, which also includes Case C-442/07 *Verein Radetsky-Order v Bunderversvereinigung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223 and Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR 7, as follows:

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

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29].

(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 to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to

secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving 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. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32]”.

16. I also bear in mind the comments of Daniel Alexander Q.C., sitting as the Appointed Person, in *Awareness Limited v Plymouth City Council*, Case BL O/236/13, where he stated that:

“22. The burden lies on the registered proprietor to prove use [...]. However, it is not strictly necessary to exhibit any particular kind of documentation, but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public,”

and further at paragraph 28:

“28. [...] I can understand the rationale for the evidence being as it was but suggest that, for the future, if a broad class, such as “tuition services”, is sought to be defended on the basis of narrow use within the category (such as for classes of a particular kind) the evidence should not state that the

mark has been used in relation to “tuition services” even by compendious reference to the trade mark specification. The evidence should make it clear, with precision, what specific use there has been and explain why, if the use has only been narrow, why a broader category is nonetheless appropriate for the specification. Broad statements purporting to verify use over a wide range by reference to the wording of a trade mark specification when supportable only in respect of a much narrower range should be critically considered in any draft evidence proposed to be submitted”.

17. In *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*, Case BL O/404/13, Geoffrey Hobbs Q.C., sitting as the Appointed Person, stated that:

“21. The assessment of a witness statement for probative value necessarily focuses upon its sufficiency for the purpose of satisfying the decision taker with regard to whatever it is that falls to be determined, on the balance of probabilities, in the particular context of the case at hand. As Mann J. observed in *Matsushita Electric Industrial Co. v. Comptroller- General of Patents* [2008] EWHC 2071 (Pat); [2008] R.P.C. 35:

[24] As I have said, the act of being satisfied is a matter of judgment. Forming a judgment requires the weighing of evidence and other factors. The evidence required in any particular case where satisfaction is required depends on the nature of the inquiry and the nature and purpose of the decision which is to be made. For example, where a tribunal has to be satisfied as to the age of a person, it may sometimes be sufficient for that person to assert in a form or otherwise what his or her age is, or what their date of birth is; in others, more formal proof in the form of, for example, a birth certificate will be required. It all depends who is asking the question, why they are asking the question, and what is going to be done with the answer when it is given. There can be no

universal rule as to what level of evidence has to be provided in order to satisfy a decision-making body about that of which that body has to be satisfied.

22. When it comes to proof of use for the purpose of determining the extent (if any) to which the protection conferred by registration of a trade mark can legitimately be maintained, the decision taker must form a view as to what the evidence does and just as importantly what it does not ‘show’ (per Section 100 of the Act) with regard to the actuality of use in relation to goods or services covered by the registration. The evidence in question can properly be assessed for sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use”.

Genuine use?

18. Whilst the evidence shows use of the mark mainly as part of a logo, I am satisfied that the word “STAR” stands out as the most important element of the logo and that the word clearly indicates trade origin in its own right. The minimal stylisation of the word is insufficient to alter its distinctive character,⁶ and the use as part of a logo still constitutes use of the earlier trade mark for the word “STAR”. This is consistent with the guidance in *Collosseum Holding AG v Levi Strauss & Co*, Case C-12/12, which stated that “use” of a mark includes both independent use and use of the mark as part of another mark.⁷

19. The only documentary evidence dated within the relevant period consists of two invoices. Whilst Mr Poulter argued at the hearing that it is not possible to know what the goods are because they are described in Italian, it is reasonably clear from the evidence that the goods marked “DADO” are stock cubes and that “pesto” is indeed a pesto sauce. Having said that, there is no evidence of any of the opponent’s goods being

⁶ See *Nirvana Trade Mark*, BL O/262/06 at [33]-[34].

⁷ Case C-12/12, §§31-35.

labelled in English, which suggests that any sales to the UK are ancillary to its main business, which appears to be in Italy.

20. In relation to stock cubes, the opponent's specification is not for stock cubes at large but for "stock cubes (meat extracts)". Such wording limits the coverage to goods which fall within the broader term "meat extracts". The invoice evidence shows vegetable, seafood and mushroom stock cubes; the undated website evidence at exhibit 4 also shows mushroom stock cubes. As these stock cubes are not derived from meat, they cannot be relied upon to support the claim of genuine use in relation to "stock cubes (meat extracts)".

21. That leaves the pesto sauces.⁸ Two types are listed, totalling more than €5,000 for over 2,700 jars of sauce. Although Mr Poulter argued that the item descriptions do not indicate the mark "STAR", the figurative "STAR" mark appears at the top of the page. Moreover, despite the other evidence not being dated within the relevant period, it shows use of the figurative mark applied to the jars. It can reasonably be inferred that the opponent's pesto sauces were sold under the earlier mark. I have no reason to believe that the sale of pesto sauce shown in the invoice of March 2016 was token or sham use. The pertinent question is whether this very low level of actual commercial use is warranted in the sector concerned and is, therefore, genuine use for the purposes of s. 6A.

22. No advertising material is shown from the relevant period and there is no evidence of any promotional spend. The invoice is not persuasive evidence of geographically widespread use, given that it is to a single entity and no information is given regarding the nature of the onward sale of the goods in the relevant period, though that is not fatal. Given the quantities and sums shown on the invoice, it is likely that this represents a sale to a wholesaler or, potentially, a large retailer. Wholesale sales are permissible for establishing genuine use and there has, rightly, been no suggestion to the contrary

⁸ Exhibit 3, p. 51.

by the applicant.⁹ I note that there is a second invoice showing the sale of pesto sauces, which is dated January 2018. While there is the potential for this invoice to assist in showing a continuing trade, its weight is diminished because it is dated not only after the end of the relevant period but also after the opposition proceedings had been launched. As a consequence, I am left wondering why, if there were indeed repeat sales within the relevant period, they were not put in evidence instead. There are no turnover figures at all, let alone turnover broken down in relation to the broad range of goods relied upon. I keep in mind that, whilst the assessment of genuine use is not an assessment of economic success, it is necessary to show that the use is “warranted in the economic sector”, which necessarily includes consideration of the market concerned. In this case, there is no evidence of the characteristics of the market. However, the UK market, even just in pasta sauces, is likely to be huge.

23. Standing back and looking at the evidence in the round, I can see no efforts made by the opponent to create a market share in the UK. Any customers which the opponent has achieved appear, on the evidence before me, to have resulted from happenstance. The volume of sales is, in any event, likely to represent only a tiny fraction of the market as a whole. The total absence of context from the evidence, both documentary and narrative, does not assist me in forming a different conclusion. The opponent has not demonstrated genuine use of the earlier mark.

Conclusion

24. The opponent has failed to establish genuine use of the earlier mark within the relevant period. The opposition under both grounds falls at the first hurdle and is dismissed accordingly.

⁹ See *Laboratoire de la Mer Trade Mark* [2006] FSR 5 at [48]-[49].

Costs

25. As the applicant has been successful, it is entitled to a contribution towards its costs. Mr Poulter indicated at the hearing that an award of costs off the scale is sought because of what he described as the unreasonable behaviour of the opponent. In particular, the hearing was requested by the opponent (the applicant initially indicated it was content for a decision to be made from the papers) but three days before the hearing the opponent indicated it would not attend. The applicant had, according to Mr Poulter, already incurred costs in relation to the hearing by that point. Further, the evidence filed by the opponent is said to have been “half-hearted”.

26. I do not consider that the opponent’s behaviour warrants a departure from the scale. The applicant was under no obligation to attend the hearing and, whilst clearly influenced by the opponent’s decision to give oral submissions, there was no requirement for the applicant to do likewise. Although the evidence was inadequate to support the claim, I can see no reason why off-scale costs would be appropriate. I award costs to the applicant as follows:

Considering the notice of opposition and filing a counterstatement	£200
Considering the opponent’s evidence and filing written submissions	£500
Preparing for and attending a hearing	£700
Total	£1400

27. I order Star Stabilimento Alimentare S.p.A. to pay Star Catering Supplies Ltd the sum of **£1400**. This sum is to be paid within fourteen days of the expiry of the appeal

period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 8th day of August 2018

**Heather Harrison
For the Registrar**