

O-522-18

**TRADE MARKS ACT 1994**

**IN THE MATTER OF:**

**TRADE MARK APPLICATION No. 3123913**

**BY RANA'S BAKERY & BRASSERIE LTD**

**TO REGISTER THE FOLLOWING  
AS A SERIES OF TWO TRADE MARKS  
IN CLASS 30**



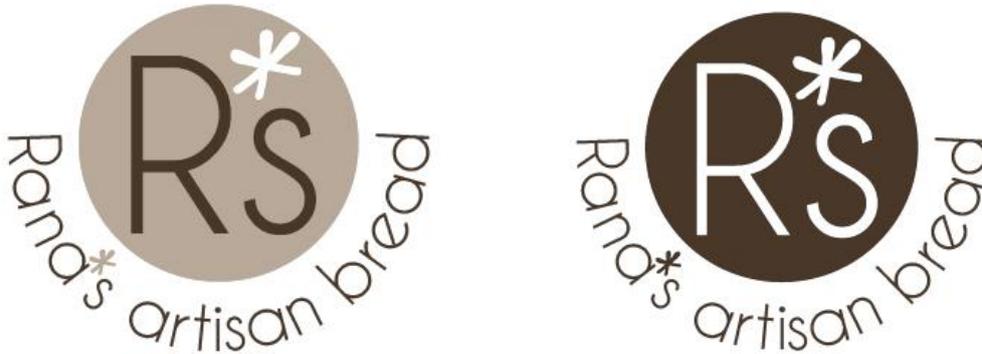
**AND**

**OPPOSITION THERETO (No. 405702)**

**BY PASTIFICIO RANA S.P.A**

## Background and pleadings

1) On 25 August 2015 Rana's Bakery & Brasserie Ltd ('the applicant') applied to register the following trade mark in the UK as a series of two:



2) It was accepted and published in the Trade Marks Journal on 18 September 2015 in respect of the following goods:

Class 30: *Bread*

3) On 18 December 2015, Pastificio Rana S.P.A ('the opponent') opposed the trade mark on the basis of Section 5(2)(b) and 5(3) of the Trade Marks Act 1994 ('the Act'). This is on the basis of its two earlier European Union Trade Marks ('EUTM'):

i. EUTM no. 11807741 for the mark RANA which was filed on 13 May 2013 and registered on 24 September 2013. It is registered in respect of the following services:

Class 43: *Providing of food and drink for guests.*

ii. EUTM no. 1313436 for the mark RANA which was filed on 10 September 1999 and registered on 5 April 2001. It is registered in respect of the following goods:

Class 29: *Meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies, jams, fruit sauces, eggs.*

*Class 30: Sugar, rice, tapioca, sago, flour and preparations made from cereals, bread, pastry and confectionery, ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice.*

4) The opponent argues that the respective goods/services are similar and that the marks are identical or similar. Therefore, there is a likelihood of confusion and the application should be refused registration under section 5(2)(b).

5) The opponent also argues that by virtue of extensive use of RANA in Europe, starting in 1962 in Italy and in the UK since 2002, the opponent enjoys a reputation in the UK for pasta, pasta sauces and the provision of food and drink. Therefore, the opponent contends that the use of the application would be detrimental to the distinctive character or the repute of the opponent's mark. The opponent also argues that the applicant would gain an unfair advantage 'in the sense of 'free-riding' on the investment made by the opponent'. Further, use of the application would be detrimental to the distinctive character of the earlier mark due to loss of sales from the opponent to the applicant. For these reasons, the opponent argues that the application should be refused registration under section 5(3) of the Act.

6) The applicant filed a counterstatement denying the claims made and requested that the opponent provides proof of use of its earlier EUTM 1313436 for all the goods relied upon. The request for proof of use is made because the aforementioned earlier mark is subject to the proof of use provisions contained in section 6A of the Act. According to that section, the relevant period in which genuine use must be established is the five-year period ending on the date of publication of the mark applied for. The relevant period is, therefore, 19 September 2010 to 18 September 2015.

7) Both sides filed evidence in these proceedings. This will be summarised to the extent that it is considered appropriate/necessary. Both sides also request an award of costs in its favour.

8) A hearing took place via video link on 12 June 2018, with the opponent represented by Mr Stobbs of Stobbs IP. The applicant filed written submissions in lieu of the attending the hearing.

9) Each of the earlier EUTMs are for the mark RANA (word). Since the opponent's earlier EUTM 11807741 is not the subject to proof of use, it may rely upon all of the services for which the mark is registered. Therefore, I shall begin with assessing the opponent's claim based on this registration.

### **DECISION - section 5(2)(b)**

#### *Legislation and case-law*

10) Section 5(2)(b) of the Act is as follows:

“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 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”.

### **Comparison of goods and services**

11) In the judgment of the Court of Justice of the European Union in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

“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 intended purpose and their method of use and whether they are in competition with each other or are complementary”.

12) The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- (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.

13) The respective goods and services are as follows:

<b>Applicant's goods</b>	<b>Opponent's services</b>
Bread	Providing of food and drink for guests

14) The applied for bread are everyday staple goods purchased by the public at large. The opponent's services are for the provision of food and drink for guests. The provision of food and drink per se are broad services which cover café, restaurants, delicatessens, etc. The nature of goods and services are different since goods are tangible items you purchase to consume whereas services are intangible which you simply use.

15) During the hearing Mr Stobbs argued that the applied for goods would be sold in delicatessens. He argued that such establishments are also likely to sell bread and therefore they are sold in the same establishments. Therefore, I do accept that in some instances the applicant's bread could be provided in the same establishments as covered by the opponent's services. However, I note that the services are not for the sale of bread, they are for services for the provision of food which by definition includes bread.

16) Whilst the public at large will purchase the applied for bread and so the end users will be the same, this is too far a generalisation for similarity to arise. Whilst the respective goods and services are not in competition, I do also consider there to be a degree of complementarity between the goods and services since those providing food are likely to serve bread.

17) Taking all of the above into account, I consider there to be a low degree of similarity between the opponent's services and the applicant's goods.

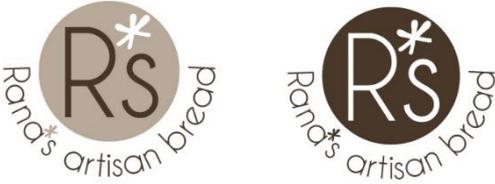
### **Comparison of marks**

18) It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

19) It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

20) The respective trade marks are shown below:

Opponent's mark	Applicant's mark
<p>RANA</p>	 <p>(series of two)</p>

21) In terms of overall impression, the earlier mark consists of the single word RANA. Since this is the only element of the opponent's mark, the overall impression and its distinctiveness are contained in that word.

22) The application is a series of two with the only difference between the two being a lighter shaded circle. This makes no material difference between the marks and I shall simply refer to them collectively. The application consists of a number of elements, including the words 'Ranas artisan bread' which are placed below a circle containing 'R\*s'. Since the applied for goods are bread, the words 'artisan bread' are descriptive and therefore do not provide any trade mark significance. The applicant argues that 'Rana is not the dominant element of the Application. The dominant element is the 'R\*s' which appears in much larger font in the centre of the mark surrounded and further emphasised by a circle device. Although there is some similarity between the marks this is at a low level.'

23) I agree that given its size and position, the circle which contains the letters R\*s (with the apostrophe being replaced by a star device) is a dominant and distinctive element of the mark. However, I also consider the word Rana\*s (with the apostrophe being replaced with a star device) to be equally dominant, particularly since there is likely to be a mental link between the 'R\*s' in the circle standing for 'Rana\*s'.

24) Visually, whilst the application includes the '\*s', this will be perceived as the possessive form of Rana. Therefore, the marks coincide with Rana and Rana\*s in the possessive form. However, there are other elements present in the application that are not in the opponent's mark, namely the device and the non-distinctive words ARTISAN BREAD. They are visually similar to a moderate degree.

25) I do not consider it likely that the R's in the opponent's mark will be enunciated. Further, given the descriptive nature of the words 'Artisan bread' these words will also not be spoken. Therefore, the respective marks will be referred to as 'Rana' and 'Ranas'. The differing 's' sound at the end of the opponent's mark does slightly alter the sound, however since it is merely the possessive form of Rana, I consider them to be aurally similar to a high degree.

26) From a conceptual perspective, the opponent argues that RANA would be remembered as a name and therefore the marks are conceptually similar. For a conceptual message to be relevant, it must be capable of immediate grasp by the average consumer.<sup>1</sup> There is no evidence to support that RANA is a commonly known and recognised name in the UK. The evidence does show that it is an Italian name but I am not satisfied that a sufficient proportion of the relevant public would recognise it as a name. With regard to the application, since the word RANA is used with a possessive 'S' followed by 'artisan bread' it is more indicative of 'RANA' being a name. However, this concept is not immediately grasped and it would therefore be meaningless to the relevant public. Of course, the words 'ARTISAN BREAD' are descriptive but have no trade mark significance. Whilst 'R\*S' does not convey a meaning, there will be a mental-link between these letters and Rana's. Taking all of

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<sup>1</sup> Case C-361/04 P *Ruiz-Picasso and Others v OHIM* [2006] ECR I-00643; [2006] E.T.M.R. 29

these factors into account, neither mark has a meaning and therefore they are conceptually neutral.

### **Average consumer and the purchasing act**

27) The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer, Case C-342/97*.

28) In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

29) The average consumer for the goods and services in question are members of the general public. The applicant's goods are inexpensive goods which are purchased on a daily basis following a visual inspection of the bread on shelves in supermarkets and shops. I also take into account aural orders following discussions with sales staff, particularly since the bread may be behind the counters in bakeries and delis. I consider the level of attention paid is low. With regard to the opponent's services, the level of attention paid will depend on the nature of the food and drink establishment, the type of food and drink sold and the prices charged. For takeaway services the food is likely to be snack types and the level of attention would be low. Conversely to dine at an expensive restaurant, more attention will be paid. Regardless of the venue, I

consider the purchasing process to primarily be visual, but aural use of the mark may also play a part.

### **Distinctive character of the earlier trade mark**

30) In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

31) The level of distinctive character of a trade mark can vary, depending on the particular goods at issue: a mark may be more distinctive for some goods than it is for others. Distinctiveness can also be enhanced through use of the mark. There has been no explicit claim of enhanced distinctiveness but evidence of use has been filed in support of its section 5(3) of the Act claim. During the hearing Mr Stobbs correctly stated that the RANA mark does not have a reputation for the services. Accordingly, it

follows that it does not have an enhanced degree of distinctive character. This is clearly reflected in the evidence.

32) In view of the above, I have only the inherent distinctive character position to consider. The earlier mark consists of the word RANA which does not have a concept and it is therefore considered to be an invented word (or a word of foreign origin). On this basis, I find that the inherent distinctive character of the earlier mark to be high.

### **GLOBAL ASSESSMENT – Conclusions on Likelihood of Confusion.**

33) The factors assessed so far have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17), a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). However, there is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused. Confusion can be direct (which effectively occurs when the average consumer mistakes one mark for the other) or indirect (where the average consumer realises the marks are not the same, but puts the similarity that exists between the marks and goods/services down to the responsible undertakings being the same or related). In terms of indirect confusion, this was dealt with by Mr Iain Purvis QC, sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10 where he noted that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the

common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

34) In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, Mr James Mellor Q.C., sitting as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls another mark to mind. This is mere association not indirect confusion

35) In terms of direct confusion, even taking into account imperfect recollection, I do not consider it likely that the average consumer will mistake one mark for the other.

36) The position is not so straightforward when I consider indirect confusion. I have found that the respective goods and services are similar to a low degree. I have also found that the marks are aurally similar to a high degree and visually similar to a moderate degree. From a conceptual perspective, the position is neutral.

37) I have found that the goods are likely to be purchased following a visual inspection of the goods, though I do not discount aural considerations. Since the earlier mark is of high distinctive character, which does increase the likelihood of confusion<sup>2</sup>, plus it is a dominant and distinctive element of the application (albeit in possessive form), I consider that the average consumer will assume that the goods and services emanate from the same or connected undertakings. There is a likelihood of indirect confusion.

## **Conclusion**

38) As the opposition is successful in its entirety based upon this ground, there is no need to consider the position in respect of the remaining earlier registration. Further, since the section 5(3) claim does not materially improve the opponent's position a decline to consider that ground of attack.

## **COSTS**

39) The opponent has been successful and is entitled to a contribution towards its costs. In the circumstances I award the opponent the sum of £1500 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Preparing a statement and considering the other sides counterstatement	£400
Preparing evidence and considering the other side's evidence	£500
Preparing for and attending a hearing	£400
Official fee	£200
<b>TOTAL</b>	<b>£1500</b>

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<sup>2</sup> Kurt Geiger v A-List Corporate Limited, BL O-075-13, Mr Iain Purvis Q.C. as the Appointed Person

40) I therefore order Rana's Bakery & Brasserie Ltd to pay Pastificio Rana S.P.A the sum of £1500. The above sum should be paid within 14 days of the expiry of the appeal period or, if there is an appeal, within 14 days of the conclusion of the appeal proceedings.

**Dated this 22<sup>nd</sup> day of August 2018**

**Mark King**

**For the Registrar,**

**the Comptroller-General**